

World Trademark Review *Daily*

IP adjudicator rejects 14 RUSSIAN STANDARD applications
Israel - Gilat, Bareket & Co, Reinhold Cohn Group

Examination/opposition
National procedures

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Russian Standard Intellectual Property Holding AG and Roust Incorporated, a closed joint-stock company with 100% foreign investments, applied for the registration of 14 RUSSIAN STANDARD trademarks (half of the applications were in Cyrillic script, while the other half were in Latin script) for goods and services in seven different classes, including clothing, coffee, spices, alcoholic beverages, advertising, business management, insurance and financial services.

All 14 applications were rejected by the examiners of the [Israeli Patent and Trademark Office's](#) Department of Trademarks on the grounds that they lacked distinctive character with respect to the goods and services at issue under Section 8(a) of the [Trademarks Ordinance \[New Version\] 5732-1972](#), partly due to the fact that the usual meaning of the word 'Russian' is geographical, contrary to the requirements of Section 11(11) of the ordinance. With regard to some of the marks, an additional ground for rejection (Section 11(9) of the ordinance) was that they were identical, or similar, to a registered mark belonging to a third party and covering the same goods.

The applicants' counter-arguments were also rejected, which led to the case being heard by the registrar.

The deputy registrar of trademarks, in her capacity as intellectual property adjudicator, held that combining the word 'standard' with the word 'Russian' did not annul the latter's geographical meaning and did not render the mark distinctive. Additionally, the adjudicator noted that the presence of a connection between the location where the applicants' vodka was produced - namely, Russia - and the mark indicated that the mark had a geographical meaning.

For these reasons, it was ruled that the mark did not have an inherent distinctive character; therefore, the adjudicator proceeded to examine whether the mark had acquired distinctive character through use, as was claimed by the applicants.

For that purpose, the adjudicator considered:

- the period of time during which the mark had been in use;
- the level of publicity of the mark; and
- the efforts that the owner had invested in order to create an association between itself and the mark.

Based on the evidence provided by the applicants, the adjudicator found that, apart from the two marks applied for in Class 33 (alcoholic beverages), none of the marks had been in use for the goods/services specified in the application. Therefore, the adjudicator inevitably concluded that the marks had not acquired distinctive character through use.

The adjudicator then turned to the marks in Class 33. The *Trademark Gazette* indicated that two identical marks, owned by Roust under its former name, were registered in the same class. In light of this, the adjudicator noted that an application seeking the registration of a mark identical to a mark registered under a different name was always going to be problematic. *De facto*, a trademark aims to enable the public to identify the source of goods or services. Therefore, allowing a "double registration" would sabotage this purpose and mislead the public, who would not know which entity was behind the mark.

Therefore, the adjudicator refused to allow the registration of the two marks in Class 33, since the prohibition on double registrations aims to maintain the purity of the register and prevent consumer confusion.

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