

Newsletter

Upcoming changes for trademarks with geographical indications and appellations of origin

September 19th, 2022

Dear Ladies and Gentlemen,

We would like to inform you that the President of the Russian Federation has signed the Federal Law № 143-FZ, dated **May 28th, 2022**, on amendments to the Russian Civil Code, regarding the registration of trademarks.

The amendments will come into effect on **May 29th, 2023**:

- **A direct prohibition of registration of trademarks, that could mislead consumers about the place of production of goods**

According to these amendments, if an applied-for trademark is, or contains, the name of a geographical object and the actual location of the applicant, or the place of production of the claimed goods, does not coincide with such a geographical object, such a trademark will be refused, since it may mislead consumers as to the origin, or location, of the goods.

The introduced amendments consolidate the already-established practice related to Rospatent refusals of trademark registration, based on misleading the consumer about the place of goods production.

- **Changes affecting registration of trademarks that include geographical indications, or appellation of origins**

A ban has been introduced on registration of trademarks, in relation to homogeneous goods that include, reproduce, or imitate, protected geographical indications, or appellations, of the origin(s) of goods. An exception to this rule is the case where a geographical indication, or an appellation of origin of goods, included as non-protectable element into a trademark, registered in the name of the owner of such a geographical indication, or appellation of origin.

Thus, trademark registration will be refused, if the applicant does not have the right to a geographical name, in relation to identical goods.

For example, if the designation "Mokshanka" (the name of the source of mineral water in Mordovia) has already been registered as a geographical indication for mineral water, then only the right holder of this geographical indication can lawfully apply for a trademark "Mokshanka", with respect to mineral water.

As for dissimilar goods, a ban has been introduced on registration of trademarks if the use of such a trademark, in relation to particular goods, will be associated by consumers with such a geographical indication, or appellation of origin, and may harm the interests of the holder of the geographical indication, or the name of the appellation of origin.

For example, during the examination of the trademark "Mokshanka", claimed for ice cream, the examination shall analyze possible associations between mineral water, ice cream and the source of the product that might appear to consumers. To register such a trademark, the applicant would have to prove that there is no strong association in the mind of the consumer between the applied-for trademark "Mokshanka" and the mineral water, in respect of which the geographical indication was protected.

In this case it may be possible to use the results of opinion polls, which could show the real overview of the situation and indicate the absence of a real possibility of misleading the consumer, in the case of registration of the "Mokshanka" trademark for ice cream.

The above-mentioned amendments reflect the general legislative approach, according to which superiority of one means of individualization over another, based on the concept of consumer being

misled, i.e., whether there is a risk of misleading the consumers, or not.

Resume

The adopted amendments are aimed at better regulation of registration of trademarks that

include the names of geographical objects and appellations of origin of goods.

It is prohibited to use the marks that could mislead consumers, not only in relation to the manufacturer of the goods, but also to the place of production of the goods.

We hope that the information provided herein will be useful for you. If any of your colleagues would also like to receive our newsletters, please let us know by sending us his/her email address in response to this message. If you would like to learn more about our **Intellectual Property Practice**, please let us know in reply to this email. We will be glad to provide you with our materials.

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If you have any questions, please, do not hesitate to contact ALRUD partner



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Commercial, Intellectual Property,
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