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INSIGHTS OF THE EUROPEAN COMMUNITIES TRADE MARK ASSOCIATION

IP LEGEND: WIM MAK

BY

NICOLE VAN ROON

INTERVIEW WITH MICHAEL
SHORT, LEGAL COUNSEL,
EVENT LEGAL SERVICES,
UEFA, SWITZERLAND

INTERVIEW BY

ANNA OSTANINA

*The Dugald Stewart Monument is a memorial
to the Scottish philosopher Dugald Stewart.*

*It is situated on Calton Hill overlooking
the city of Edinburgh.*



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Enjoy !



AUTHOR:

Ekaterina Fourmanova

Associate, Trade Mark & Design Attorney

Gowling WLG (International) Inc.

ekaterina.fourmanova@gowlingwlg.com



VERIFIER:

Igor Motsnyi

Partner, Trade Mark Attorney

Motsnyi Legal Services

motsnyi@motsnyi.com

On 27 July 2018, the Russian State Duma passed the first reading of the draft Bill 'On Amendments to Part IV of the Civil Code of the Russian Federation', which concerns geographical indications.

The Bill will introduce geographical indications as an independent form of intellectual property which will co-exist with appellations of origin, which are currently protected under Russian law.

Among the most famous Russian names registered as appellations of origin are

KHOKHLOMA painting, GZHEL porcelain, ZHOSTOVO painting, ESSENTUKI mineral water, RUSSIAN VODKA and ABRAU-DURSO sparkling wine.

Such famous foreign names as ASTI and PROSECCO for Italian wines, TEQUILA for a Mexican national alcoholic spirit, HABANOS for Cuban cigars, PROSCUITTO DI PARMA for Italian dry-cured ham, GRANA PADANO, PARMIGIANO REGGIANO, GORGONZOLA for Italian cheeses and others are already protected as appellations of origin in Russia.

While appellations of origin are used by

consumers as a way of ensuring the high quality and special features of a product, appellations of origin are still not widely used in practice. Currently, only about 170 appellations of origin are registered in Russia, 35 of which are owned by foreign manufacturers. In contrast, more than 3000 geographical indications and appellations of origin are protected in the European Union, underscoring the significant untapped opportunity for domestic and foreign applicants that have yet to explore these forms of protection in Russia.

Case law has revealed a number of problems in the law on appellations of origin, which has kept it from realising its full potential in Russia. Under the current law, an appellation of origin incorporating the name of a geographical place in a foreign country can be granted only if such name is protected in that foreign country as an appellation of origin as opposed to other means of protection. *Rospatent* (the Russian Federal Service for Intellectual Property) has continuously refused foreign applicants seeking protection for their geographical indications on these grounds in Russia.

According to the proposed definition, a geographical indication is a designation that identifies a product as originating from the territory of a geographical object, where the certain quality, reputation and other



Geographical Indications to be Introduced in Russia: What Does this Mean for Local and Foreign Businesses?



characteristics of the product are substantially determined by their geographical origin. At least one stage of the product manufacturing process must fall within the said geographical object.

This definition highlights an important difference between geographical indications and appellations of origin, since, as regards the latter, the complete manufacturing process, as well as the raw materials, must be localised within and originate from the geographical area concerned.

Protection of a new geographical indication – or a registered one – may be obtained by one or several individuals or legal entities by way of filing an application with *Rospatent*. Notably, the draft Bill also proposes that a geographical indication may be registered by a group of producers (e.g. an association) organised and acting according to the legislation of the country of origin.

The application shall include information describing the connection between the essential features of the product – namely the quality, reputation

and other characteristics – with the place of the product's origin or manufacture, along with documents confirming the same. Unlike with

appellations of origin, there will be no strict requirement to describe the unique qualities of the goods or provide evidence that all the goods produced under a certain geographical indication will be characterised by a single unique set of features.

State registration of a geographical indication can be granted to a designation, allowing identification of the product as originating from the geographical area located in a foreign

country, provided that this designation enjoys protection as a geographical indication, or another form of exclusive IP right in the country of origin. Protection may be granted only to the right holder whose right is secured in the country of origin. Should the right holder lose its right in the country of origin, the geographical indication protection will terminate in Russia.

According to the Bill, earlier registered appellations of origin cannot be granted parallel protection as geographical indications for the same type of goods. At the same time, existing registered appellations of origin and those newly filed may be converted into geographical indications in relation to the same type of goods, assuming all the respective requirements be met.

The exclusive right for a geographical indication will be valid for ten years after the application filing date and may be renewed for an unlimited number of subsequent ten-year periods, provided that the right

holder maintains the possibility of manufacturing the product with the same characteristics and level of quality.

The right holder will be entitled to use the geographical indication in relation to the product it is registered for by all means provided by the law, as well as prohibit third parties from using the geographical indication – even as a translation from another language or with a disclaimer 'sort', 'type' or 'imitation', as well as other confusingly similar designations likely to mislead consumers.

Right holders will be entitled to use the warning sign 'registered appellation of origin of goods'

or 'registered geographical indication', as well as respective symbols – by analogy with the ® symbol used for registered trade marks – in order to show the status of their rights.

Just like with the appellation of origin, the disposal of exclusive rights in a geographical indication, such as the transfer of rights to a third party or granting a licence, will be prohibited.

The Bill on GIs is a welcome innovation. It aims to fulfil Russia's World Trade Organization (WTO) obligations under Articles 22 and 23 of the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement, which requires protection of geographical indications and is in line with the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications.

Introducing geographical indications as a separate form of intellectual property is likely to promote regional Russian brands and raise awareness among consumers, attract investment, support rural settlements, generate employment and contribute to the development of tourism.

Foreign producers will enjoy enhanced protection of their products in Russia by securing the rights to a more accessible means of intellectual property protection offered by a geographical indication.

The new legislation is aimed at preventing products from being misleading in terms of their place of origin on the market and combating the import and sale of counterfeit products in Russia.

As a part of the general legislative process, a Bill has to undergo three readings at the Russian State Duma before it is in force. The Bill is currently undergoing further amendments in preparation for its second reading. «

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