



Comparison Manual on Trademark Application and Examination Procedures in the BRICS Countries

15 September 2022



**Comparison Manual on Trademark
Application and Examination Procedures
in the BRICS Countries**

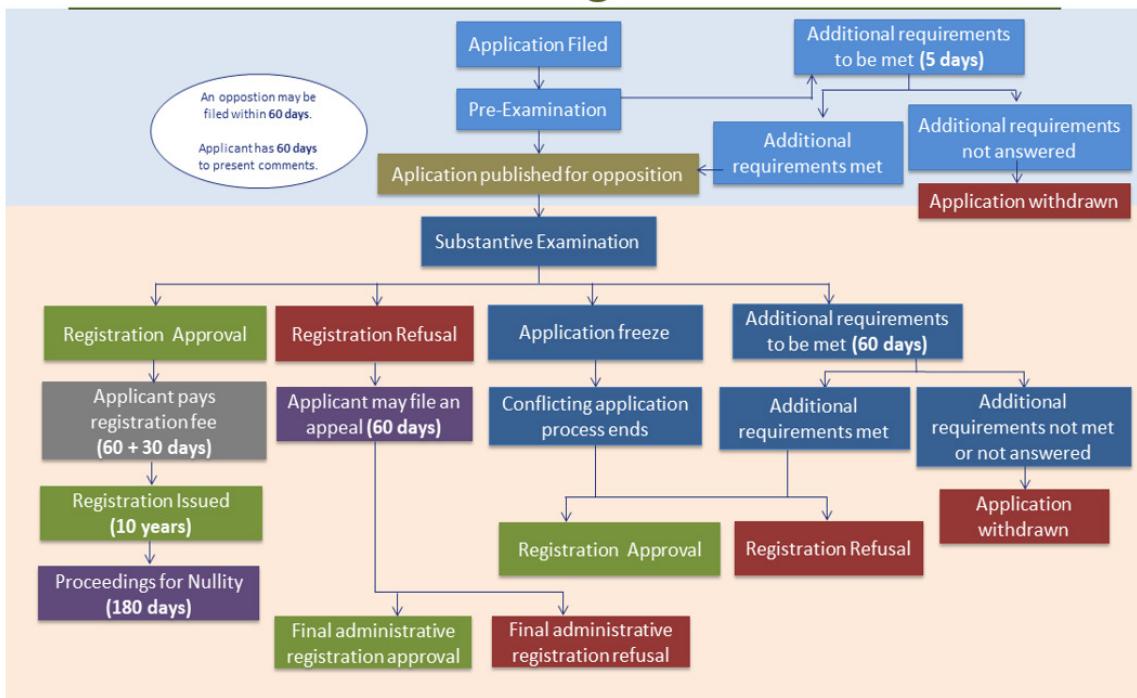
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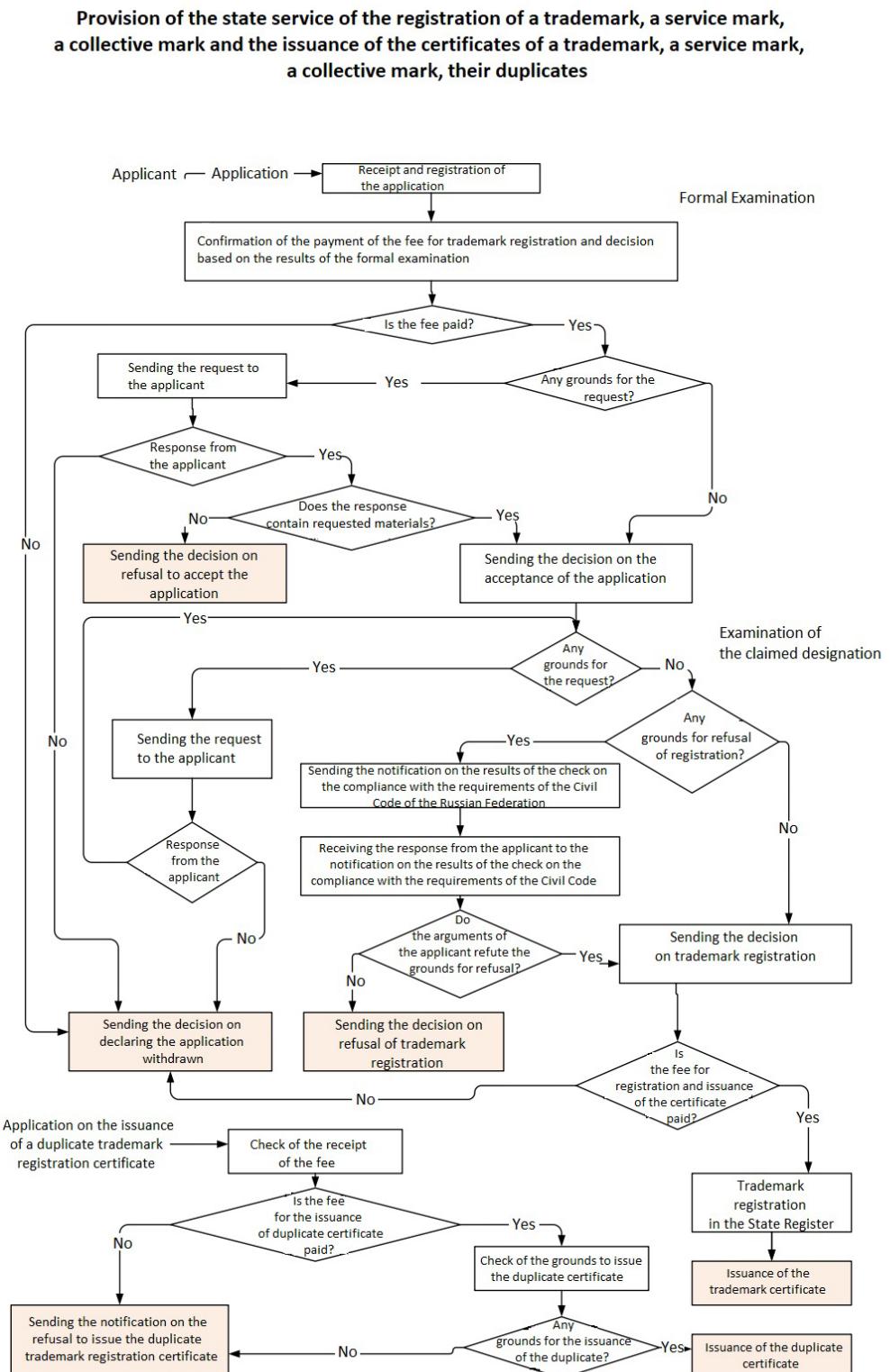
1. Overview of the trademark Registration Procedures

- Brazil-INPI(National Institute of Industrial Property)

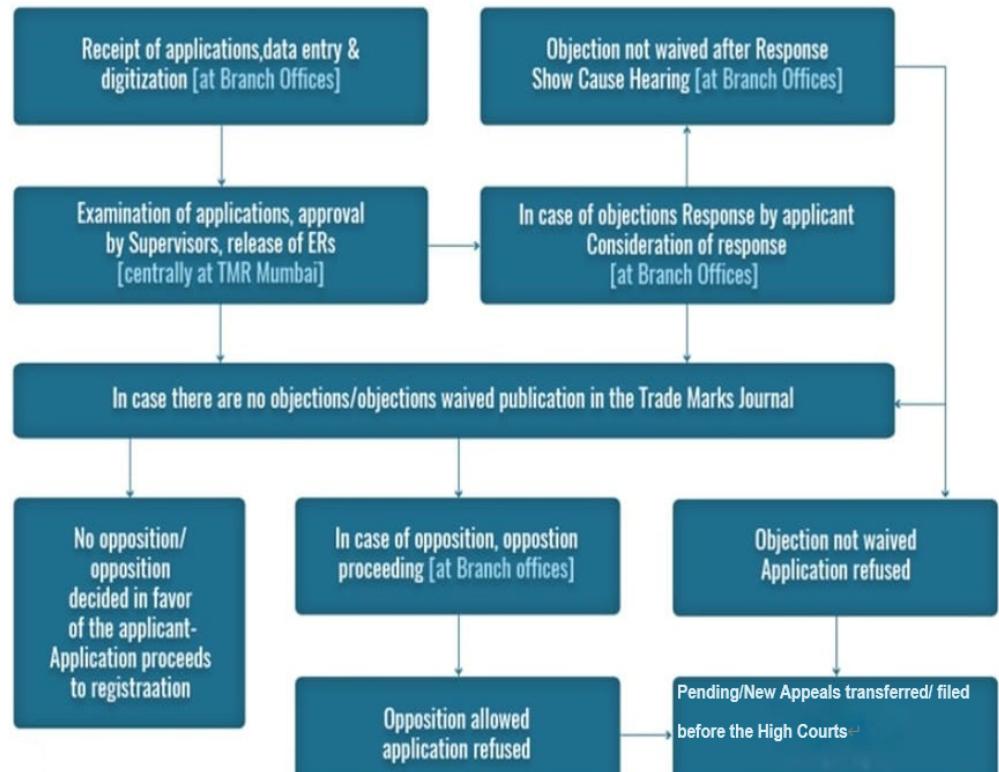
Trademark Registration Process



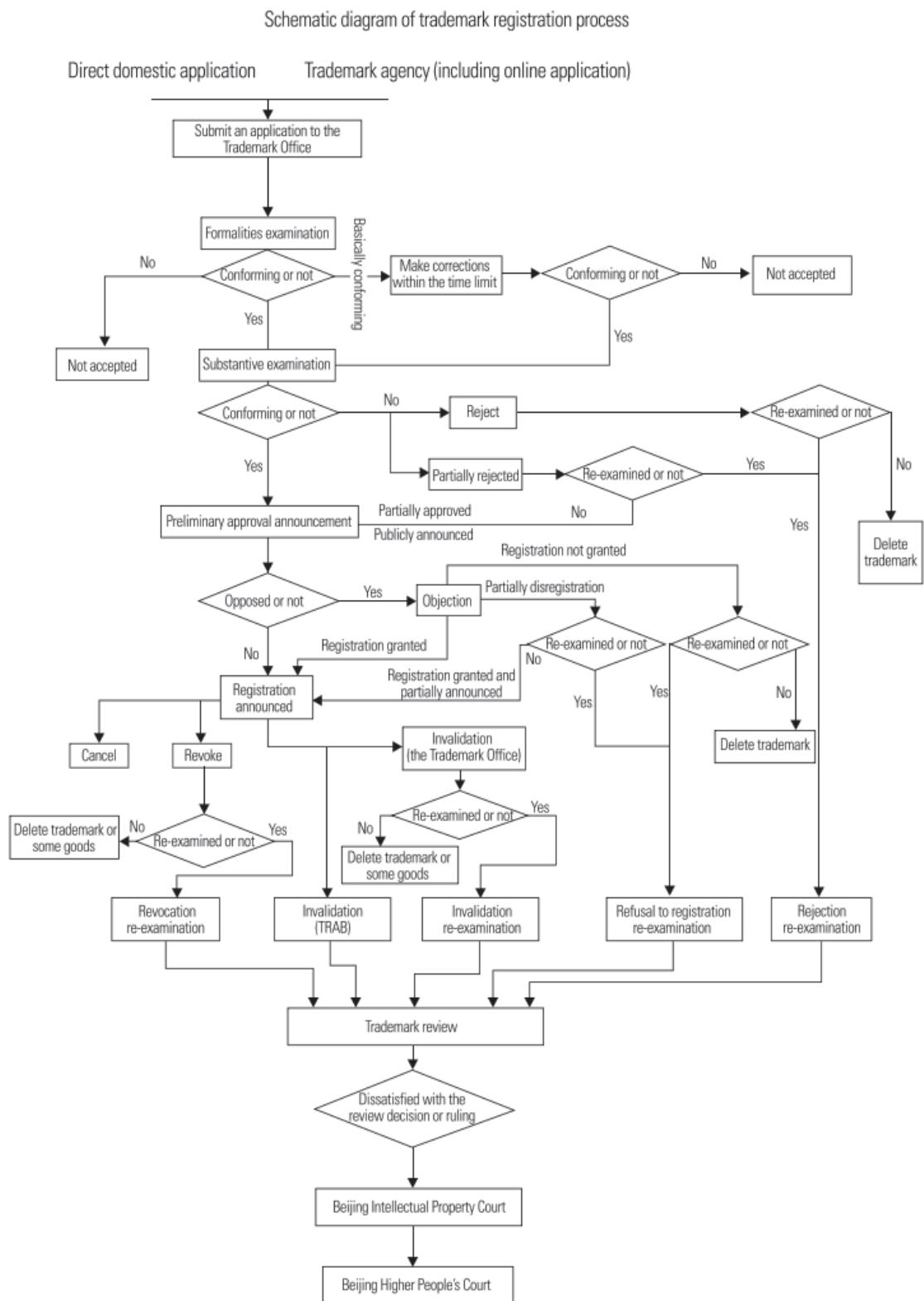
- Russia- Rospatent (Federal Service for Intellectual Property)



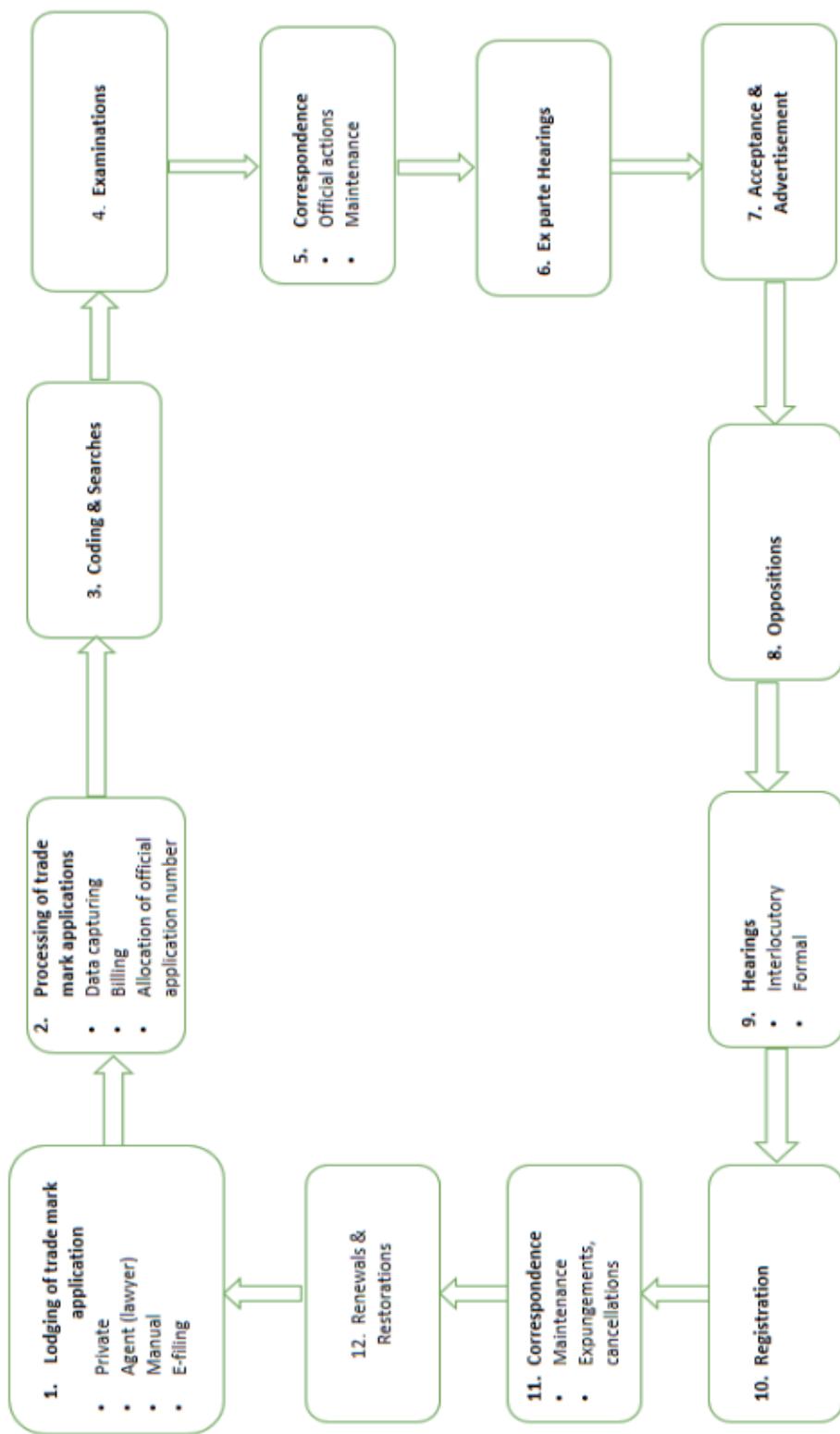
- India- CGPDTM (Office of Controller General of Patents, Designs and Trademarks)



- China-CNIPA (China National Intellectual Property Administration)



- South Africa-CIPC (Companies and Intellectual Property Commission)



2.The acceptable types of trademark

- Brazil-INPI(National Institute of Industrial Property)**

-Figurative trademarks;

-Nominative trademarks (or word trademarks);

-Mixed trademarks (mix figurative and words);

-3D trademarks;

- Collective trademarks;

-Certification trademarks;

-Position trademarks.

- Russia- Rospatent(Federal Service for Intellectual Property)**

- Word trademarks;

- Pictorial trademarks;

- Combined trademarks;

- Three-dimensional trademarks (it is necessary to provide all projections of the designation or 3D model);

- Sound trademarks (it is necessary to provide a sample of the phonogram);

- Positional trademarks (the image of the claimed designation shows its location on the product for which the trademark registration is requested);

- Trademarks consisting exclusively of one or more colors (registration subject to proof of distinctiveness);

- Holographic trademarks;

- Changing trademarks (a video recording is presented on a data medium, including the reproduction of the designation and an additional printed frame-by-frame reproduction of such designation).

- India- CGPDTM(Office of Controller General of Patents, Designs and Trademarks)**

The marks acceptable by the Trademark Registry in India are: device, brand, heading, label, ticket, name, signature, word, letter, numeral shape of goods, packaging or combination of colors or any combination thereof and which are capable of being represented graphically and also capable of distinguishing the goods or services of one person from those of others.

The Non-traditional marks acceptable by the Trademarks Registry in India are- Sound marks and

Three Dimensional Marks.

- **China-CNIPA(China National Intellectual Property Administration)**

Trademark law of the People's Republic of China stipulates that "In respect of any visual sign capable of distinguishing the goods or service of one natural person, legal entity or any other organization from that of others, including any word, design, letters of an alphabet, numerals, three-dimensional symbol, combinations of colors, sound and their combination, an application may be filed for registration."

- **South Africa-CIPC(Companies and Intellectual Property Commission)**

- Ordinary trademarks:

Device, name, signature, word, Letter, numeral, shape, configuration, pattern, ornamentation, color, container for goods, or combination of the above.

- Non-traditional trademarks:

Three-dimensional trademarks, color trademarks, holograms, motion/multimedia trademarks, position trademarks, gesture trademarks, sound trademarks, olfactory (smell/scent) trademarks, taste trademarks, and texture trademarks.

3. The application documents, means of submission, related requirements and conditions of acceptance

- **Brazil-INPI(National Institute of Industrial Property)**

-The requirements of application documents:

- 1) Power of attorney (if applicable);
- 2) Priority Documents (if applicable);
- 3) Regulation of use of collective mark (if applicable);
- 4) Technical documentation for certification mark (if applicable).

-Means of submission:

All documents must be submitted online. They can be present together with the application or within 60 days after application.

- **Russia- Rospatent(Federal Service for Intellectual Property)**

- The requirements of application documents:

- 1)an application for state registration of a designation as a trademark with an indication of the applicant, his place of residence or location;

2) the claimed designation, including at the request of the applicant its three-dimensional model in electronic form;

3) the list of goods, in respect of which the state registration of a trademark is requested and which are grouped by classes of the International Classification of Goods and Services for Registration of Marks.

- Means of submission:

1) to address to Rospatent directly in person;

2) to send an application via a postal organization;

3) by fax, followed by the submission of the original application documents transmitted by fax;

4) through the official Rospatent website using the information systems of FIPS;

5) using the federal state information system "Unified portal of state and municipal services (functions)" in the information and telecommunication network "Internet".

- Requirements and conditions for accepting an application:

The application submitted to Rospatent is registered in the absence of grounds for refusal to accept it. The grounds for refusal to accept the application are:

1) the application submitted on paper does not contain an application for state registration of the designation as a trademark, collective mark (hereinafter, respectively, the application, trademark registration), the application is not readable or is not presented in Russian, the application does not specify the applicant, his location or place of residence;

2) submission of application documents on paper, which is impossible to process for technical reasons related to the condition of the paper medium;

3) submission of application documents in electronic form in violation of the Requirements for electronic filing of the application.

- **India- CGPDTM(Office of Controller General of Patents, Designs and Trademarks)**

- The requirement and conditions are mentioned in the Trade Marks Rules 2017 as follows:

1) Fees (Rule 10): The fees to be paid in respect of applications, oppositions, registration, renewal, expedited processing of application or any other matters under that are specified in The First Schedule.

2) Forms (Rule 11): The Forms are set forth in the Second and the Third Schedules. Any Form, when filed at the Trade Marks Registry, shall be accompanied by the prescribed fee.

3) Size (Rule 12): All applications, notices, statements, or other documents except trademarks,

authorized or required by the Trade Marks Act, 1999 (as amended) or the Trade Marks Rules, 2017 made there under, served, left or sent, at or to the Trade Marks Registry or with or to the Registrar shall be typewritten and printed in Hindi or in English in legible characters with deep permanent ink upon strong paper of A-4 or legal size on one side only, and shall have on the left hand side thereof a margin of not less than four centimeters.

4) Sign (Rule 13): Any document required to be signed under the Trade Marks Act, (as amended) and Trade Marks Rules, 2017 shall be signed by the applicant or opponent or by a person duly authorised for the purpose.

5) Authorization of Agent (Rule 19)

6) Statement of user in applications (Rule 25): -An application to register a trademark shall, unless the trademark is proposed to be used, contain a statement of the period during which, and the person by whom it has been used in respect of all the goods or services mentioned in the application. In case, the use of the trademark is claimed prior to the date of application, the applicant shall file an affidavit testifying to such use along with supporting documents.

- **China-CNIPA(China National Intellectual Property Administration)**

- The requirements of application documents:

1) Handling of applications for trademark registration by mainland China natural persons: an *Application for Trademark Registration* filled out according to the relevant requirements and signed by the applicant, trademark specimens, a copy of business license for individual industrial and commercial households, and a copy of ID card. When the same applicant handles more than one trademark registration applications at the same time, only one copy of ID card and one copy of the business license for individual industrial and commercial households should be submitted.

2) Handling of applications for trademark registration by mainland China legal persons or other organizations: an *Application for Trademark Registration* filled out according to the relevant requirements and stamped with the applicant's official seal, trademark specimens, and a copy of identification document. When the same applicant handles multiple trademark registration applications at the same time, only a copy of identification document (such as a copy of business license) should be submitted.

3) Handling of applications for trademark registration by residents of Hong Kong, Macao and Taiwan: Residents of Hong Kong, Macao and Taiwan should entrust a legally established trademark agency to handle trademark applications. Residents of Hong Kong, Macao and Taiwan who hold *Mainland Travel Permit for Hong Kong and Macao Residents*, *Mainland Travel Permit for Taiwan Residents* or *Residence Permit for Hong Kong, Macao and Taiwan Residents* within their validity periods (more than one year) can handle trademark applications by themselves. An applicant who handles trademark registration directly at the trademark registration hall should submit: an *Application for Trademark Registration* filled out according to the relevant requirements and signed by the applicant, trademark specimens, copy of identification document, a travel permit or residence

permit. Residents of Hong Kong, Macao and Taiwan who meet the requirements for self-application can also file an application through the trademark online application system. For the specific procedures, please refer to the “Online Application” column of the China National Trademark website (<http://sbj.cnipa.gov.cn/>).

4) Handling of applications for trademark registration by foreigners: Foreigners should entrust a legally established trademark agency to handle trademark applications. Foreigners who have a habitual residence in China can handle trademark applications by themselves. An applicant who handles trademark registration directly at the trademark registration hall should submit: an *Application for Trademark Registration filled* out according to the relevant requirements and signed by the applicant, trademark specimens, a copy of identification document, and a copy of *Foreign Permanent Resident ID Card* issued by the public security department or a copy of *Foreigner Residence Permit* with a validity period of more than one year. Foreigners who have a habitual residence in China can also file an application through the trademark online application system. For the specific procedures, please refer to the “Online Application” column of the China National Trademark website (<http://sbj.cnipa.gov.cn/>).

- Means of Submission:

1) There are two ways for applicants within China (excluding Hong Kong, Macao and Taiwan) to submit the documents: one is to handle the applications by themselves; the other is to entrust a trademark agency registered with the CNIPA to handle the applications. Applicants who handle the applications by themselves can submit an application for trademark registration online through the online service system. For details, please refer to the “Online Application” column of the China National Trademark website (<http://sbj.cnipa.gov.cn/>). Applicants can also handle trademark registration applications at the Registration Hall of the Trademark Office of CNIPA, the Office of the Trademark Office in Zhongguancun National Independent Innovation Demonstration Zone, the trademark examination cooperation centers established by the Trademark Office outside Beijing, or the trademark acceptance windows established by the local market supervision departments or the intellectual property departments entrusted by the Trademark Office. Any foreign person or foreign enterprise intending to apply for the registration of a trademark or for any other matters concerning a trademark in China shall appoint any of such organizations as designated by the State to act as its or his agent, except for foreigners or foreign enterprises that have a permanent residence or business office in China.

2) In terms of document submission methods, if an applicant handles the application by himself, the applicant or the handler should directly submit the application documents to the Trademark Registration Hall of the Trademark Office of CNIPA (or the Office of the Trademark Office in Zhongguancun National Independent Innovation Demonstration Zone, the trademark examination cooperation centers established by the Trademark Office outside Beijing, or the trademark acceptance windows established by the local market supervision departments or the intellectual property departments entrusted by the Trademark Office). Applicants who meet the requirements can also submit the application documents through the online application system; the agent can submit

the application documents directly, by post or by an express enterprise to the CNIPA, or through the online application system.

- **South Africa-CIPC(Companies and Intellectual Property Commission)**

- Manual Application:

- 1) Complete the application form. The original form TM1 must be submitted to CIPC via post, or courier services, or placed in the drop box outside the CIPC office at the dti Campus, 77 Meintjies Street, Sunnyside, Pretoria.

- 2) When applying for a trade mark, please note that you have to file a separate trade mark application for each international class of goods or services for which you would like to use your trade mark. For example, if you manufacture and also sell cars, you have to lodge two trade mark applications:

- a. One in class 12 for manufacturing of motor vehicles; and

- b. One in class 35 for selling of motor vehicle.

- 3) To identify the correct class for goods or services, please view the International Classification of Goods and Services. Alternatively, contact the CIPC Office for assistance. Our staff will be able to assist you to identify the correct class/es for your goods and/or services.

- 4) Indicate the class in Field 51 of form TM1.

- 5) Indicate all the goods and/or services for which you would like to use the trade mark in Field 57 of form TM1. Please Take care not to put goods or services belonging in different classes on one trade mark application form. If you do so, your application will not be processed and will be returned to you requesting you to indicate the goods/services of interest for one class only, and also advising you to lodge further applications for the additional class/es.

- 6) Field 74 of form TM1 "address for service" is the address at which you will be receiving all the communications from the Office. Please be sure to inform the Office by requesting "a change of address for service" on form TM2 in case this address changes. The address for service MUST at all times be an address within the Republic of South Africa.

- 7) Should your application comply with all the formal requirements, and the required official fee has been received by the Office, the application will be allocated an application date and an official application number. All communications with the Office should at all times include the application number as reference.

- Electronic Application:

- 1) When applying for a trade mark, please note that you have to file a separate trade mark application for each international class of goods or services for which you would like to use your trade mark. For example, if you manufacture and also sell cars, you have to lodge two trade mark

applications:

- a. One in class 12 for manufacturing of motor vehicles; and
- b. One in class 35 for selling of motor vehicle.

3) To identify the correct class for goods or services, please view the International Classification of Goods and Services. Alternatively, contact the CIPC Office for assistance. Our staff will be able to assist you to identify the correct class/es for your goods and/or services.

4) Take care not to put goods or services belonging in different classes on one trade mark application form. If you do so, your application will not be processed and will be returned to you requesting you to indicate the goods/services of interest for one class only, and also advising you to lodge further applications for the additional class/es.

5) "Address for service" is the address at which you will be receiving all the communications from the Office. Please be sure to inform the Office by requesting "a change of address for service" on form TM2 in case this address changes. The address for service MUST at all times be an address within the Republic of South Africa.

6) Should your application comply with all the formal requirements, and the required official fee has been received by the Office, the application will be allocated an application date and an official application number. All communications with the Office should at all times include the application number as reference.

4. Classification and identification of goods and services

- **Brazil-INPI(National Institute of Industrial Property)**

INPI adopts the Nice Classification of Goods and Services. We also have a national list – based on the same criteria and class numbering – to classify typical Brazilian products and services not available in Nice List.

- **Russia- Rospatent(Federal Service for Intellectual Property)**

The trademark application must contain the list of goods in respect of which state registration of a trademark is requested and which are grouped by classes of the International Classification of Goods and Services for Registration of Marks (ICGS).

-Requirements for the list of goods:

1) the application must indicate the number(s) of the ICGS class(es) with indication of the names of the goods for which trademark registration is requested. The goods grouped by the ICGS classes should be designated by terms that allow to identify the goods.;

2) the list of goods is intended to indicate specific goods in respect of which trademark registration is requested, and may not consist only of areas of activity or generalized names of groups of goods

to which the goods may relate;

- 3) the goods of each class must not contain duplicate names;
- 4) each product must have its own unique name;
- 5) the list of goods of each class begins with a two-digit number of the ICGS class, and then the names of individual goods are indicated through a dash;
- 6) all names of goods in the list are given in lowercase letters. The commonly used part of the product name can be given in uppercase (capital) letters;
- 7) if the goods belong to different species (generic) groups, the names of the goods are separated from each other by a semicolon. The names of goods belonging to the same type are separated by a comma;
- 8) a dot is placed at the end of the list of each class;
- 9) the text of the list of each subsequent class is separated by a line spacing;
- 10) if the name of the product or service can be used in other classes, then it is necessary to additionally indicate:
 - in relation to the product - the purpose, function of the product, the material of which it is made, or the principle of its operation;
 - in relation to the service - the purpose (scope) of the activity that corresponds to the selected class;
- 11) if the list of goods includes a product for which there is no corresponding term in the ICGS, the generic (specific) concept is additionally indicated in the name of such a product, taking into account the generally accepted terminology;
- 12) the goods specified in the highlighted application must be listed in the original trademark application and not be homogeneous with the goods remaining in the original application.

- **India- CGPDTM(Office of Controller General of Patents, Designs and Trademarks)**

India adopts the International Classification of Goods and Services (NICE) for the purposes of registration of trademarks, according to which the goods and services are categorized into 45 classes, with Goods covered in Classes 1 to 34 and Services covered under Classes 35 to 45. The Classification search tool TMclass or the Classification of Goods published by the Indian Trademark Office can be used to know the class in which a particular good or service falls.

- **China-CNIPA(China National Intellectual Property Administration)**

The International Classification of Goods and Services for the Purposes of the Registration of Marks

(Nice Classification).

- **South Africa-CIPC(Companies and Intellectual Property Commission)**

The purpose of classifying goods and services is to limit the protection that can be claimed in respect of a trade mark and, therefore, clearly determine the scope of protection.

South Africa applies the NICE International Classification System in respect of the classification of trademarks and has been doing so for several decades.

The NICE International Classification of Goods and Services (11th Edition) consists of 34 goods classes and 11 service classes. The relevant edition in use by the Office of the Registrar is as published on the CIPC website from time to time.

5. The search methods for non-national character trademarks (including device trademarks, foreign language trademarks, etc.)

- **Brazil-INPI(National Institute of Industrial Property)**

INPI treats non-national character trademarks as figurative trademarks.

In other words, they are classified under the Vienna Category 28 (Inscription in Various Characters) and in the equivalent section (28.1 INSCRIPTIONS IN ARABIC CHARACTERS; 28.3 INSCRIPTIONS IN CHINESE OR JAPANESE CHARACTERS; 28.5 INSCRIPTIONS IN CYRILLIC CHARACTERS; 28.7 INSCRIPTIONS IN GREEK CHARACTERS; 28.9 INSCRIPTIONS IN HEBREW CHARACTERS; 28.11 INSCRIPTIONS IN LATIN CHARACTERS; 28.17 INSCRIPTIONS IN HISTORICAL, CUNEIFORM OR HIEROGLYPHIC CHARACTERS; 28.19 INSCRIPTIONS IN OTHER CHARACTERS).

- **Russia- Rospatent(Federal Service for Intellectual Property)**

Examination of non-national applications (international registrations) is carried out using automated trademark systems of the Russian Federation.

- **India- CGPDTM(Office of Controller General of Patents, Designs and Trademarks)**

In device mark search, the trademark system enables the examiner to find out earlier trademarks having same/similar features. All trademarks consisting of any figurative elements are codified as per International Classification of the Figurative Elements of Marks (commonly referred to as ‘Vienna Codification’). Under Rule 28 of the Trade Mark Rules 2017, Where a trade mark includes words in a language other than English/Hindi and/or characters other than Roman/Devnagari characters, the applicant must file, a precise TRANSLATION AND TRANSLITERATION of each such word and number in English or in Hindi and state the language to which the word(s) or number(s) belong in support of the trade mark application.

- **China-CNIPA(China National Intellectual Property Administration)**

For trademarks composed of Latin letters, they should be retrieved as English trademarks; trademarks composed of non-Latin letters, such as Japanese, Korean, Arabic, etc., should be retrieved as graphic trademarks.

6. The basic principles of trademark examination

- **Brazil-INPI(National Institute of Industrial Property)**

INPI analyzes both absolute and relative grounds under a first to file system.

- **Russia- Rospatent(Federal Service for Intellectual Property)**

Trademark examination is carried out for their compliance with the requirements of Article 1477 and paragraphs 1-7, subparagraph 3 of paragraph 9 (in terms of industrial designs), paragraph 10 (in terms of means of individualization and industrial designs) of Article 1483 of the Civil Code of the Russian Federation.

The above points include both absolute grounds and relative grounds for refusal.

In the Russian Federation there is a procedure for filing an appeal by any interested person against the registration of a trademark before a decision is made on the application (Article 1493 of the Civil Code of the Russian Federation).

- **India- CGPDTM(Office of Controller General of Patents, Designs and Trademarks)**

Section 34 of the Trade Marks Act, 1999 (as amended) entitles the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior—(a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or (b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his; whichever is the earlier, and the Registrar shall not refuse (on such use being proved), to register the second mentioned trade mark by reason only of the registration of the first mentioned trade mark.

- **China-CNIPA(China National Intellectual Property Administration)**

Trademark law of the People's Republic of China requires a comprehensive examination of trademark registration applications, which includes examination for absolute and relative grounds. Examination for absolute grounds means whether a trademark in respect of which an application for registration is filed is a sign that should not be used as a trademark according to the law, including three circumstances: first, signs that are prohibited from being used as trademarks, such as State name, national flag, national emblem; second, signs that lack distinctiveness, such as only including

common names, signs that only directly indicate the characteristics of product quality, main raw materials, function and purpose, and a three-dimensional trademark uses a functional sign, etc; third, malicious trademark registration applications not for the purpose of use. Trademark applications that should be rejected by absolute grounds will be rejected according to the law. Examination for relative grounds means to examine whether a trademark in respect of which an application for registration is filed conflicts with any prior application of another person, or any trademark that has been preliminarily approved and registered earlier, or conflict with any prior right acquired by another person.

- **South Africa-CIPC(Companies and Intellectual Property Commission)**

Trademark examination is performed by CIPC on both absolute and relative grounds for refusal.

7. The average period and statutory time limit of each examination transaction

- **Brazil-INPI(Instituto Nacional da Propriedade Indusrial)**

TRANSACTION	AVERAGE PERIOD	STATUTORY TIME LIMIT
Formal exam	15 days	-
Substantive exam	10 months	-
Opposition exam	18 months	-
Invalidation	13 months	5 years after registration
Cancellation (Nullity)	42 months	180 days after registration
Appeal	10 months	60 days after denial

- **Russia- Rospatent(Federal Service for Intellectual Property)**

-The average period of formal examination is 3 weeks from the date of confirmation of payment of fees for legally significant actions. At the same time, the maximum period for conducting a formal examination is established by Article 1498 of the Civil Code of the Russian Federation and is one month.

-The maximum term of examination of the claimed designation is essentially established by the Civil Code of the Russian Federation and is 12 months from the date of acceptance of the application for consideration (from the date of the end of the formal examination).

-Objections (invalidation, cancellation):

The first meeting of the board on objections to the decisions of Rospatent must be held no later than 1 month from the date of acceptance of the objection for consideration, and on objections and applications against granting legal protection to a trademark or on early termination of a trademark - no later than 2 months from the date of acceptance of the objection or application for consideration.

If the results of the formal examination of the objection or application do not confirm the payment of the fee in the amount and in the manner prescribed by the Regulations on Patent Fees, the

first meeting of the board must be held no later than 3 months from the date of acceptance of the objection or application for consideration.

Within a period of up to 2 months from the date of the board meeting at which its conclusion was formed, the head of Rospatent or a person authorized by him, based on the results of the dispute consideration, makes one of the following decisions: to satisfy the objection or application in whole or in part; to refuse to satisfy the objection or application.

- **India- CGPDTM(Office of Controller General of Patents, Designs and Trademarks)**

The trademark registration process takes approximately 18 months in cases without any objections or oppositions. Examination both formality and substantive takes approximately 1-2 months. The time limit for opposition proceedings may differ from approximately 1 year in cases where the opposition is on technical grounds, to approximately 5 years in cases where the evidence stage is completed.

If the trademark has not been used for a continuous period of 5 years from the date of registration of the mark and three months prior to filing the application for registration, an application for cancellation /rectification may be filed by any aggrieved person as per Section 47 of The Trade Marks Act, 1999 (as amended). .

- **China-CNIPA(China National Intellectual Property Administration)**

- 1) The legal trademark examination period is 9 months (from the date of reception of application to the time of examination conclusion is made).Now the average trademark examination period is 4 months.
- 2) The legal trademark opposition period is 12 months (from the date of expiry of the announcement to the time when the decision on whether to approve the registration is made).
- 3) The legal period for trademark review of rejection due to opposition is 12 months (from the date of receipt of the application to the time the review decision is made).
- 4) The legal period for trademark review of refusal is 9 months (from the date of receipt of the application until the time the review decision is made).
- 5) The legal period for trademark invalidation of a registered trademark is 9 months for absolute grounds and 12 months for relative grounds (from the date of receipt of the application until the time the decision is made).
- 6) The legal period for trademark cancellation is 9 months (from the date of receipt of the application until the time the decision is made).

7) The legal period for trademark review of cancellation is 9 months (from the date of receipt of the application until the time the review decision is made).

8. Possible grounds of refusal

- Brazil-INPI(National Institute of Industrial Property)**

Visually perceptible distinctive signs that are not included in the legal prohibitions are susceptible to registration as a trademark. The Brazilian law indicates that the following is not registrable as a trademark:

I - official, national, foreign or international coat of arms, weapons, medal, flag, emblem, badge and monument, as well as the respective designation, figure or imitation;

II - letter, number and date, separately, unless covered in a sufficiently distinctive manner;

III - expression, figure, drawing or any other sign contrary to morals and good customs or that offends the honor or image of people or violates freedom of conscience, belief, religious cult or idea and feeling worthy of respect and veneration;

IV - designation or acronym of public entity or body, when registration is not required by the public entity or body;

V - reproduction or imitation of a characteristic or differentiating element of the title of establishment or company name of third parties, liable to cause confusion or association with these distinctive signs;

VI - sign of a generic, necessary, common, vulgar or simply descriptive character, when related to the product or service to be distinguished, or that commonly used to designate a characteristic of the product or service, in terms of nature, nationality, weight, value, quality and time of production or service provision, unless covered in a sufficiently distinctive manner;

VII - sign or expression used only as a means of advertising;

VIII - colors and their denominations, unless arranged or combined in a peculiar and distinctive way;

IX - geographical indication, its imitation liable to cause confusion or a sign that could falsely induce a geographical indication;

X - sign that induces a false indication as to the origin, origin, nature, quality or usefulness of the product or service for which the brand is intended; XI - reproduction or imitation of an official nature, regularly adopted to guarantee a standard of any kind or nature;

XII - reproduction or imitation of a sign that has been registered as a collective or certification mark by a third party, considering that the collective and certification marks that have already been used and whose registrations have been extinguished cannot be registered in the name of a third party, before the expiration of the period of 5 (five) years, counted from the extinction of the registration.

XIII - name, award or symbol of a sporting, artistic, cultural, social, political, economic or technical, official or officially recognized event, as well as imitation susceptible to creating confusion, except when authorized by the competent authority or entity promoting the event;

XIV - reproduction or imitation of title, policy, currency and banknote of the Union, States, Federal District, Territories, Municipalities, or country;

XV - civil name or its signature, family name or patronymic and image of third parties, except with the consent of the holder, heirs or successors;

XVI - well-known pseudonym or nickname, singular or collective artistic name, except with the consent of the holder, heirs or successors;

XVII - literary, artistic or scientific work, as well as titles that are protected by copyright and are likely to cause confusion or association, except with the consent of the author or titleholder;

XVIII - technical term used in industry, science and art, which is related to the product or service to be distinguished;

XIX - reproduction or imitation, in whole or in part, even with an addition, of a registered trademark of another person, to distinguish or certify an identical, similar or similar product or service, liable to cause confusion or association with another's trademark;

XX - duality of marks of a single owner for the same product or service, except when, in the case of marks of the same nature, they are sufficiently distinctive;

XXI - the necessary, common or common form of the product or packaging, or even one that cannot be dissociated from a technical effect;

XXII - object that is protected by a third party's industrial design registration; and

XXIII - sign that imitates or reproduces, in whole or in part, a mark that the applicant evidently could not be unaware of due to its activity, whose owner is headquartered or domiciled in the national territory or in a country with which Brazil maintains an agreement or which ensures reciprocity of treatment, if the mark is intended to distinguish an identical, similar or similar product or service, capable of causing confusion or association with that other's mark.

Russia- Rospatent(Federal Service for Intellectual Property)

1. State registration as trademarks is not allowed for designations that do not have distinctive ability or consist only of elements:

1) entered into general use for the designation of goods of a certain type;

2) being generally accepted symbols and terms;

3) characterizing the goods, including indicating their type, quality, quantity, property, purpose, value, as well as the time, place and method of their production or sale;

4) representing a form of goods that is determined solely or mainly by the property or purpose of the goods.

1.1. The provisions of paragraph 1 of this Article shall not apply to designations that:

1) acquired distinctive ability as a result of their use;

2) consist only of the elements specified in subparagraphs 1-4 of paragraph 1 of this article and forming a combination having a distinctive ability.

2. State registration as trademarks is not allowed for designations including, reproducing or imitating official symbols, names and distinctive signs or their recognizable parts:

1) state symbols and signs (flags, coats of arms, orders, banknotes, etc.);

2) abbreviated or full names of international and intergovernmental organizations, their flags, coats of arms, other symbols and signs;

3) official control, warranty or assay stamps, seals, awards and other honorary distinctions.

3. State registration as trademarks is not allowed for designations representing or containing elements:

1) being false or capable of misleading the consumer about the product or its manufacturer;

2) contrary to public interests, principles of humanity and morality.

4. State registration as trademarks of designations identical or confusingly similar to official names and images of especially valuable objects of cultural heritage of the peoples of the Russian Federation or objects of world cultural or natural heritage, as well as images of cultural values stored in collections, collections and funds, is not allowed if registration is requested in the name of persons who are not their owners, without the consent of the owners or persons authorized by the owners, to register such designations as trademarks.

5. In accordance with an international treaty of the Russian Federation, state registration as trademarks is not allowed for designations representing or containing elements that are protected in one of the states-parties to this international treaty as designations that allow identifying wines or alcoholic beverages as originating from its territory (produced within the boundaries of a geographical object of this State) and having a special quality, reputation or other characteristics that are mainly determined by their origin, if the trademark is intended to designate wines or alcoholic beverages that do not originate from the territory of this geographical object.

6. Designations cannot be registered as trademarks, if they are identical or similar to the point of confusion with:

1) trademarks of others, applied for registration in respect of similar goods and having an earlier priority, if the application for registration of a trademark is not withdrawn, deemed withdrawn or not made a decision on refusal of state registration;

- 2) trademarks of other persons protected in the Russian Federation, including in accordance with an international agreement of the Russian Federation, in respect of similar goods and having earlier priority;
- 3) trademarks of other persons recognized in accordance with the procedure established by the Civil Code as well-known trademarks in the Russian Federation, in respect of homogeneous goods from a date earlier than the priority of the claimed designation.

Registration as a trademark in respect of homogeneous goods of a designation confusingly similar to any of the trademarks specified in subparagraphs 1 and 2 of this paragraph is allowed with the consent of the right holder, provided that such registration cannot be a reason for misleading the consumer. The consent cannot be revoked by the right holder.

The provisions provided shall not apply to designations confusingly similar to collective marks.

7. Designations identical or confusingly similar to a geographical indication or an appellation of origin protected in accordance with the Civil Code, as well as with a designation applied for registration as such before the priority date of the trademark, may not be registered as trademarks in respect of any goods, except if such geographical indication or such a name or a designation confusingly similar to them is included as an unprotected element in a trademark registered in the name of a person, having the right to use such a geographical indication or such an appellation, provided that the trademark registration is carried out in respect of the same goods for the individualization of which such a geographical indication or such an appellation of origin of the goods is registered.

8. Designations identical or confusingly similar to a firm name or trade designation protected in the Russian Federation (separate elements of such names or designations) or to the name of a selection achievement registered in the State Register of Protected Selection Achievements, the rights to which in the Russian Federation arose from other persons earlier than the priority date of the registered trademark, may not be registered as trademarks for homogeneous goods.

9. Designations cannot be registered as trademarks, if they are identical to:

- 1) the name of a work of science, literature or art known in the Russian Federation on the date of filing an application for state registration of a trademark, a character or a quotation from such a work, a work of art or a fragment thereof, without the consent of the right holder, if the rights to the corresponding work arose earlier than the priority date of the registered trademark;
- 2) the name, pseudonym or designation derived from them, portrait or facsimile of a person known in the Russian Federation on the date of filing the application, without the consent of this person or his heir;
- 3) an industrial design, a mark of conformity, the rights to which arose earlier than the priority date of the registered trademark.

The provisions of this paragraph shall also apply to designations confusingly similar to the objects

specified therein.

10. Designations may not be registered as trademarks in respect of homogeneous goods, the elements of which are means of individualization of other persons protected in accordance with the Civil Code, designations similar to them to the extent of confusion, as well as objects specified in paragraph 9 of this Article.

State registration as trademarks of such designations is allowed if there is an appropriate consent provided for in paragraph 6 and sub-paragraphs 1 and 2 of paragraph 9 of this article.

11. On the grounds provided in this Article, legal protection is also not granted to trademarks registered in accordance with international treaties of the Russian Federation.

- **India- CGPDTM(Office of Controller General of Patents, Designs and Trademarks)**

The absolute and relative grounds for refusal of a mark are provided under Sections 9 ,11 and 13 of The Trade Marks Act, 1999(as amended). The competent authority is the Registrar of Trademarks.

- Absolute grounds (Section 9 and 13) :

1) Section 9(1) lays down, the trade marks-

a. which are devoid of any distinctive character, that is to say, not capable of distinguishing

the goods or services of one person from those of another person.

b. which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or services;

c. which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade. [Two exceptions to this rule are the marks which have “acquired distinctiveness” and “well-known trademarks”]

2) Section 9(2) lays down, A mark shall not be registered as a trade mark if -

a. it is of such nature as to deceive the public or cause confusion:

b. it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;

c. it comprises or contains scandalous or obscene matter;

d. its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950.

3) Section 9(3) lays down, A mark shall not be registered as a trade mark if it consists exclusively of -

a. the shape of goods which results from the nature of the goods themselves;

- b. the shape of goods which is necessary to obtain a technical result;
- c. the shape which gives substantial value to the goods

Prohibition of registration of names of chemical elements or international Non-Proprietary Names

Under Section 13, the registration of a word as a trademark, which is commonly used and accepted name of any single chemical element or compound in respect of chemical substances or preparation is prohibited. Also the law prohibits registration of a word which is declared by the World Health Organization (WHO) and notified by the Registrar as international non-proprietary name, or which is deceptively similar to such name.

- Relative grounds (Setion 11):

1) Section 11 lays down-

1.A trade mark shall not be registered if, because of:

- a.its identity with an earlier trade mark and similarity of goods services covered by the trade mark;
(or)
- b.its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark.

2.A trade mark which –

- a.is identical with or similar to an earlier trade mark
- b.is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor.

3.A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented:

- a.by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or
- b.by virtue of law of copyright.

• China-CNIPA(China National Intellectual Property Administration)

- Possible reasons for rejecting a trademark application

1) Absolute reasons: first, signs that are prohibited from being used as trademarks, such as State name, national flag, national emblem; second, signs that lack distinctiveness, such as only including common names, signs that only directly indicate the characteristics of product quality, main raw materials, function and purpose; third, malicious trademark registration applications not for the purpose of use.

2) Relative reasons: identical with or similar to the trademarks that applied for registration earlier, have been preliminarily approved and registered earlier.

- Relief measures

If the trademark registration applicant refuses to accept the rejection, it may apply to the Trademark Office for review within 15 days after receiving the notification of rejection.

• **South Africa-CIPC(Companies and Intellectual Property Commission)**

- Absolute grounds:

1) If a trade mark does not fit the definition of a trade mark, Section 10(1) states that it cannot be registered.

2) A trade mark must be capable of distinguishing (i.e. must be "distinctive"). Therefore if a trade mark is not distinctive, it cannot be registered.

3) In terms of Section 10(2)(b), prohibits the registration of trade marks that are comprised solely of words or signs which are descriptive of the product or service and would therefore be required by other traders to conduct their business.

4) Section 10(2)(c) prohibits the registration of all generic features and includes all signs such as shapes, colours, configurations, patterns and ornamentation which have become customary in the current language or established practices of the particular trade at the date of application.

5) In terms of Section 10(3), the proprietor of a trade mark is seen as the person who has bona fide (honestly and in good faith) first made use of, or appropriated, a mark, in relation to the goods or services offered thereunder, as a trade mark. The fact that a trade mark might be registered in another country does not by default mean that an applicant in South Africa cannot adopt and register the trade mark. This flows from the nature of a trade mark as in general being territorial in protection. Of course there are exceptions hereto, for example foreign trade marks which are possibly well-known in South Africa. The relevant factors to consider when determining a bona fide claim to proprietorship include:dishonesty; breach of confidence; sharp practice.

6) Section 10(4) deals with the requirement that there must be a real and bona fide intention to use the trade mark in relation to the goods or services as applied for, in the course of trade. If an applicant has not made use of the trade mark at the date of application, he must have a bona fide intention of using the mark as a trade mark either himself or through any person permitted by him or to be permitted by him, in the future. An intention to use the mark as simple ornamentation would not qualify as a bona fide intention to use the mark as a trade mark.

7) In terms of Section 10(5) of the Act, registration is excluded in the following instances:The shape which results from the nature of the goods themselves; The shape which is necessary to obtain a technical result; The shape which gives substantial value to the goods.The more closely the shape, configuration, colour or pattern is to being purely functional, the more likely it is or will become

likely to limit the development of any art or industry.

8) When dealing with container trade marks, Section 10(11) provides that a container for goods is registrable as long as it does not limit the development of any art or industry.

9) Section 10(7) deals with the prohibition of the registration of a trade mark where the applicant has an improper motive or intention for seeking registration. An example would be where the trade mark contains copyrighted material of a 3rd party.

This section follows on from Section 10(3), which requires a bona fide claim to proprietorship. Although an applicant is not barred from registering a trade mark which is registered outside South Africa, if the applicant had contact with the proprietor or establishment of the foreign trade mark and thereafter sought registration in South Africa, he would be seen as acting male fide (in bad faith).

10) Section 10(8) of the Act gives effect to South Africa's international obligations under Article 6ter of the Paris Convention for the Protection of Industrial Property of 1883. In respect of marks which consist of or contain the flag, the armorial bearings or any other emblem, or an imitation from a heraldic point of view, or the name, or the abbreviation of the name, of any international organisation of which one or more convention countries are members, such use may be allowed by the Registrar if the use does not "...suggest to the public that a connection exists between the organisation and the mark, or is not likely to mislead the public as to the existence of a connection between the organization and the proprietor of the mark".

11) Section 10(9) aims to prohibit the registration of any mark which suggests that the mark (and therefore the applicant) is vested with a power which only the State and State Organs can be vested with.

- Relative grounds:

1) Both Sections 10(6) and 10(17) deal with the protection of trade marks that are well-known (the dilution provisions). These sections are not used by the Office for purpose of provisional refusal of an application, and are mainly used in opposition and rectification proceedings. For the sake of completeness however, a discussion on these sections will follow later in this document.

2) Section 10(12) of the Act states that the following trade marks cannot be registered: "*mark which is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be contra bonos mores, or be likely to give offence to any class of persons..*"

3) Section 10(13) of the Trade Marks Act states that the following trade marks cannot be registered: "*mark which as a result of the manner in which it has been used would be likely to cause deception or confusion..*"

4) Section 10(14) sets out the ground for refusal dealing with a conflict of prior registered rights. It states that the following trade marks shall not be registered: "*mark which is identical to a registered trade mark belonging to a different proprietor or similar thereto that the use thereof in relation to*

goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which such trade mark is registered, would be likely to deceive or cause confusion, unless the proprietor of such trade mark consents to the registration of such mark..."

5) Section 10(15) sets out the ground for refusal dealing with a trade mark application being in conflict with an earlier pending trade mark application. It states that the following trade marks shall not be registered:"*...subject to the provisions of section 14 and paragraph (16), a mark which is identical to a mark which is the subject of an earlier application by a different person, or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which the mark in respect of which the earlier application is made, would be likely to deceive or cause confusion, unless the person making the earlier application consents to the registration of such mark..."*

6) Section 10(16) stipulates that a mark is unregistrable if it: "*...is the subject of an earlier application as contemplated in paragraph (15), if the registration of that mark is contrary to existing rights of the person making the later application for registration as contemplated in that paragraph.*"

9. Approval and gazette

- Brazil-INPI(National Institute of Industrial Property)**

The procedure for gazetting begins at the end of the week on every Friday. Every document generated and signed is prepared and reviewed during the following week. On the following Tuesday the gazette is published.

- Russia- Rospatent(Federal Service for Intellectual Property)**

A trademark may be registered if a letter of consent is provided from the right holder of a confusingly similar trademark with an earlier priority.

A trademark may be registered if the consent of the competent state body is provided, if such trademark includes state symbols, or such trademark is confusingly similar to the names of objects specially protected in the Russian Federation.

- India- CGPDTM(Office of Controller General of Patents, Designs and Trademarks)**

The procedure for approval of a Trademark is done Online and the mark is subsequently advertised in the Trademark Journal. The Trademark Journal (TMJ) , is published class-wise every Monday by the Trademark Office.

- China-CNIPA(China National Intellectual Property Administration)**

The Trademark Office should examine the applications for trademark registration that have been accepted in accordance with the relevant provisions of the Trademark Law. If an application

for registration conforms to the provisions or conforms to the provisions to the extent that the trademark is used on some of designated goods only, the Trade Office should preliminarily approve and gazette the trademark. If no opposition is filed during the three-month public announcement period, registration should be granted, a trademark registration certificate should be issued, and the trademark should be publicly announced.

- **South Africa-CIPC(Companies and Intellectual Property Commission)**

The Patent Journal is published monthly on the website and is available to access and search and download free of charge.

10. Trademark Opposition Procedures and Requirements

- **Brazil-INPI(National Institute of Industrial Property)**

Every trademark examiner is trained to exam trademark applications that received oppositions and trademark applications that did not. However, there is a group of experts that works mostly on examination of oppositions. Those who oppose a trademark application can claim both absolute and relative grounds.

- **Russia- Rospatent(Federal Service for Intellectual Property)**

In accordance with Article 1493 of the Civil Code of the Russian Federation, after the publication of information about the application before making a decision on the state registration of a trademark, any person has the right to submit to Rospatent an appeal in writing containing arguments about the inconsistency of the claimed designation with the requirements of Articles 1477 and 1483 of the Civil Code of the Russian Federation.

In case of receipt of the specified appeal, arguments about the non-compliance of the claimed designation with the requirements of Articles 1477 and 1483 of the Civil Code of the Russian Federation are taken into account when conducting an examination of the claimed designation.

In case of state registration of a trademark in the State Register of Trademarks, the granting of legal protection to it may be challenged and invalidated in accordance with paragraph 1 of Article 1513 of the Civil Code of the Russian Federation by filing an objection by the interested person to the Chamber for Patent Disputes.

The grounds for challenging and invalidating the granting of legal protection to a trademark are provided for in Article 1512 of the Civil Code of the Russian Federation.

- **India- CGPDTM(Office of Controller General of Patents, Designs and Trademarks)**

UnderSection 21 of the Trade Marks Act, 1999 (as amended), any person may oppose a trademark application - by filing a Notice of Opposition on the prescribed form along with the prescribed fee within four months post publication of the mark in the Trademarks Journal. The opponent does

not necessarily have to be a registered proprietor of a trademark. A copy of notice of opposition shall be ordinarily served by the Registrar to the applicants within three months of the receipt of the same by the appropriate office. The counterstatement required by Sub-section (2) of Section 21 shall be sent on Form TM-O within two months from the receipt by the applicant of the copy of the notice of opposition from the Registrar. A copy of the counter statement shall be ordinarily served by the Registrar to the opponent within two months from the date of receipt of the same. Evidence in support of the Opposition and Application, if any are filed by the parties under Rule 45 and Rule 46 of The Trade Marks Rules, 2017. Under Rule 47 of The Trade Marks Rules, 2017, within one month, the opponent may file evidence in response to the applicant's evidence. After the closure of the evidence the matter is heard by the Registrar and decided upon merits of each case.

- **China-CNIPA(China National Intellectual Property Administration)**

- Trademark opposition procedures

Including formalities examination and substantive examination.

1) Formalities examination: conduct legal examination on the formality elements of an opposition application such as writing format and standards, subject qualification, clear factual reasons and legal basis, and make a decision on whether the opposition application is accepted or rejected.

2) Substantive examination: in accordance with the examination standards and the evidence materials provided by the party concerned, conduct legal examination on the opposition grounds claimed by the opponent and the defending grounds of the person against whom the opposition is filed, and make a decision on whether the registration of the opposed trademark is allowed or not allowed and whether registration of part of the goods (services) is not allowed.

- Relevant requirements:

For a trademark for which the preliminary approval is publicly announced, within 3 months from the date of announcement, if the prior right holder, stakeholder believes it violates the provisions of Article 13 Paragraph 2, Article 13 Paragraph 3, Article 15, Article 16 Paragraph 1, Article 30, Article 31, or Article 32 of the Trademark Law, or any individual believes that it violates the provisions of Article 4, Article 10, Article 11, Article 12, or Article 19 Paragraph 4 of the Trademark Law, he may file an opposition to CNIPA. The application for trademark opposition submitted should have clear reasons, facts and legal basis, and should be accompanied by relevant evidence materials. If the party concerned needs to add relevant evidence materials after filing the opposition application or the statement of defense, they should declare them in the trademark opposition application or the statement of defense, and submit them within 3 months after the date of submitting the trademark opposition application or the statement of defense. In case the party concerned fails to submit them within the time limit, he should be deemed as giving up the right to supplement relevant evidence materials.

