

Patents, trade marks, copyright and designs in Russian Federation: overview

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PATENTS

1. What are the legal requirements to obtain a patent?

Inventions

An invention will be afforded patent protection if it:

- Relates to a product or a process.
- Is new.
- Involves an inventive step.
- Is capable of industrial application.
- Does not fall under one of the excluded categories (see *Question 2*).

Utility models

Technical solutions relating to devices will also be afforded patent protections if they:

- Are new.
- Are capable of industrial application.
- Do not fall under one of the excluded categories (see *Question 2*).

2. What categories are excluded from patent protection?

The following categories are excluded from patent protection:

- Discoveries, scientific theories and mathematical methods.
- Aesthetic solutions.
- Rules and methods for games and intellectual or business activity.
- Computer programs.
- Presentations of information.
- Plant and animal varieties and biological methods for producing them, except for microbiological methods and products produced by such methods.
- Topologies of integrated circuits.
- Methods of human cloning and human clones.
- Methods of genetic modification of human stem cells.
- The use of human embryos for industrial and commercial purposes.

- Solutions contrary to the public interest and to humanitarian principles and morality.

3. Which authority registers patents? Does its website provide guidance on the application procedure?

The Federal Service for Intellectual Property (Rospatent) registers patents in Russia. Guidance and forms on the application procedure are available online in Russian (www.rupto.ru) (www.fips.ru).

Once the application is submitted, it will be examined formally and then substantively. The formal examination will determine whether the application contains all the documents mentioned and whether the documents provided comply with all the requirements. The substantive examination will assess whether the application meets the disclosure and legal requirements of a patent.

The substantive examination of a utility model application begins straight after the formal examination. However, the substantive examination of an invention application begins only after the applicant or a third party has submitted an examination request. The request must be made within three years from the filing date of the invention application otherwise, the application will be withdrawn.

An application will be rejected if one or more of the following apply:

- The invention or utility model relates to one of the excluded categories (see *Question 2*).
- The information provided in the application does not meet the disclosure requirements.
- At least one of the patentability criteria is not met (see *Question 1*).

4. On what grounds and when can third parties oppose a patent application or challenge an issued patent?

Patent applications cannot be opposed by third parties. However, observations may be filed with the Federal Service for Intellectual Property after the application is published. The validity of an issued patent can be challenged by a third party during the lifetime of the patent if the:

- Subject matter of the patent is not patentable.
- Invention or utility model is insufficiently disclosed in the patent.

- Patent object extends beyond the content of the originally filed application.
- Patent is granted to an applicant not entitled to the patent or incorrectly identifies the inventors.
- Patent was granted when there were several applications outstanding for identical subject matter with the same priority date.

After the patent has expired or been terminated early, its validity can be challenged on the above grounds but only by an interested person (for example, a person accused of patent infringement).

5. When does patent protection start and how long does it last?

Inventions patent

Provisional patent protection starts from the date of publication of the application. Therefore, any person using the invention while an application is pending may have to pay compensation to the patent owner, if the patent is granted.

Full patent protection starts from the grant of the patent and can last 20 years from the date of filing of the application, subject to the payment of maintenance fees. The term of protection of patents for pharmaceuticals and agrichemicals can be extended for up to five years.

Utility models patents

Protection of utility models patents can last ten years from the date of filing of the application, subject to the payment of maintenance fees. No patent term extension is provided for utility model patents.

6. On what grounds can a patent infringement action be brought?

Third parties are prohibited from carrying out the following acts without authorisation of the patent owner:

- Importing into Russia, making, using, offering for sale, selling, putting on the Russian market by any means or keeping for such purposes, an item incorporating a patented product.
- Importing into Russia, making, using, offering for sale, selling, putting on the Russian market by any means or keeping for such purposes, a product obtained directly from the patented process.
- Importing into Russia, making, using, offering for sale, selling, putting on the Russian market by any means or keeping for such purposes, a device implementing the patented process.
- Using the patented process.

Further, a patent may be infringed by taking active steps creating the threat of direct infringement.

Under the doctrine of equivalents, patent infringement can take place if there has been unauthorised use of an equivalent feature of the patented invention on the priority date of the invention and not the actual patented invention. However, the doctrine of equivalents does not apply to utility models.

7. Which courts deal with patent infringement actions?

The following courts deal with patent infringement actions:

- First instance: a district court of general jurisdiction (if at least one of the parties is an individual, but not registered as an entrepreneur).
- First instance: a commercial court (when all parties to the case are legal entities or private entrepreneurs).
- Appeals: appeal courts examine cases after the corresponding courts of instance. The Intellectual Property Rights Court hears cassation appeals from the commercial courts.

8. What are the defences to patent infringement actions?

The defences to patent infringement actions include:

- Non-infringement.
- Private non-commercial use.
- Experimental use (including trials and studies performed for the purposes of obtaining a marketing authorisation).
- Exhaustion of exclusive rights.
- Preparation of medicinal products in a pharmacy.
- Prior user's right.
- The claim is time barred under the statute of limitation.

9. What are the remedies in patent infringement actions?

The remedies in patent infringement actions include:

- Injunctions (including preliminary).
- Damages or statutory monetary compensation.
- Delivery up and destruction of the infringing goods.
- Destruction of tools mainly used or intended for the production of infringing goods.
- Publication of the infringement judgment.

10. Is there a fast-track and/or a small-claims procedure for patent infringement actions?

There are no fast-track or small-claims procedures for patent infringement actions.

TRADE MARKS

11. What are the legal requirements to obtain a trade mark?

A trade mark can be any sign (word, symbolic, three-dimensional, or otherwise) that:

- Is capable of representing the goods and services of legal entities and individual entrepreneurs.

- Is distinctive (or in some cases capable of acquiring distinctiveness).
- Is non-descriptive.
- Is non-deceptive.
- Is not otherwise excluded from protection on absolute grounds (for instance, not contrary to public policy, principles of morality or not a sign excluded from protection due to an international treaty of the Russian Federation).
- Does not conflict with other parties' earlier exclusive rights.

12. Is it necessary or advisable to register trade marks?

The registration of a trade mark is absolutely necessary and highly advisable in order to acquire the exclusive right to use it. Only well-known marks can be protected without registration.

13. Which authority registers trade marks? Does its website provide guidance on the application procedure?

The Federal Service for Intellectual Property (Rospatent) registers trade marks in Russia. Guidance and forms on the application procedure are available online in Russian (www.rupto.ru) (www.fips.ru).

Within one month of filing, there is a formal examination of the application to check that the application and the accompanying documents comply with the statutory requirements. After the formal examination, there is a substantive examination where the mark is assessed to see if it complies with the legal requirements for trade mark protection (see *Question 11*).

14. On what grounds can the regulatory authority refuse to register a trade mark?

The Federal Service for Intellectual Property can refuse to register a trade mark if the sign:

- Lacks distinctiveness.
- Consists only of elements generally used for the indication of certain goods or those that characterise the goods.
- Contains elements that are false or misleading to the consumer in respect of a product or its manufacturer, or that are contrary to public interests and the principles of humanity and morality.
- Is identical or confusingly similar to official names and images of particularly valuable objects of the cultural heritage of the Russian people, or of worldwide cultural or natural heritage.
- Contains, represents or imitates some official symbols, names, and insignia.
- Contains or consists of a geographical indication protected in a WTO member-state with respect to wines or spirits, if the sign is applied for wines or spirits not having the appropriate geographical origin.
- Is identical or confusingly similar to another person's earlier trade mark protected in Russia, or applied for registration in Russia, with respect to the same or similar goods, or

contains elements that are identical or confusingly similar to the earlier trade mark.

- Is identical or confusingly similar to appellations of origin protected in Russia with respect to any goods, or contains elements identical or confusingly similar to a protected appellation of origin.
- Is identical or confusingly similar to an earlier registered industrial design, or contains elements identical or confusingly similar to a protected industrial design.

15. On what grounds and when can third parties oppose a trade mark application or cancel a registration?

Third parties cannot oppose trade mark applications (although observations can be filed with the Federal Service for Intellectual Property (Rospatent) after the application is published). A registered trade mark, at any time during its validity, can be challenged by an interested person (for example, a person accused of infringement) on the grounds that:

- It does not meet the absolute requirements for registration.
- It conflicts with another person's earlier right (copyright, registered design, personal name, company name, commercial designation, compliance mark, name of a plant or animal variety).
- The trade mark owner is not a legal person or an individual entrepreneur.
- It is registered in the name of the owner's agent or representative without the owner's consent.
- The use of the trade mark would indicate a connection between the goods or services designated with the trade mark and the owner of an earlier well-known mark, and the interests of the owner of the well-known mark are likely to be damaged by this use.

Within five years of the official publication of a registered trade mark, an interested person can file a request for trade mark invalidation with Rospatent, if the trade mark:

- Is confusingly similar to an appellation of origin already protected in Russia.
- Is identical or confusingly similar to an existing trade mark in respect of identical or similar goods or services.
- Contains elements that conflict with another person's earlier right.

An interested party can apply to have the protected trade mark terminated if it is not genuinely used during any consecutive three-year period after registration. This application must be made to the Intellectual Property Rights Court.

16. When does trade mark protection start and how long does it last?

Trade mark protection starts from the date of registration and is valid for ten years from the date that the trade mark application is filed. The registration can be renewed indefinitely for further ten year periods on the payment of a renewal fee.

17. On what grounds can a trade mark infringement action be brought?

A trade mark infringement action can be brought in Russia if all of the following applies:

- Another person is using or has used a sign that is identical or similar to the registered trade mark without authorisation from the owner of the registered trade mark.
- The sign is in relation to goods or services that are identical or similar to the goods and services relating to the registered trade mark.
- There is a likelihood of consumer confusion.

In case of a well-known trade mark, an infringement action can be brought in circumstances where the goods and services are not similar, provided that both the following apply:

- Customers are likely to associate the infringer's mark with the owner of the well-known mark.
- The interests of the owner of the well-known trade mark are likely to be damaged by this use.

18. Which courts deal with trade mark infringement actions?

See *Question 7*.

19. What are the defences to trade mark infringement actions?

The defences to trade mark infringement actions include:

- Exhaustion of the right.
- Use of another registered trade mark, earlier company name or trade name.
- Use is necessary to indicate the intended purpose of the goods or services (in particular as accessories or spare parts, or in case of maintenance or repair services).
- Abuse of right on the owner's part.
- The claim is time barred under the statute of limitation.

20. What are the remedies in trade mark infringement actions?

The remedies in trade mark infringement actions are the same as in patent infringement actions (*see Question 9*).

21. Is there a fast-track and/or a small-claims procedure for trade mark infringement actions?

There are no fast-track or small-claims procedures for trade mark infringement actions.

COPYRIGHT

22. What are the legal requirements to obtain copyright protection?

Copyright protection subsists in works of science, literature (including computer programs and databases) and art that:

- Result from a person's creative activity.
- Are fixed in a tangible medium.
- Meet the relevant requirements regarding nationality or domicile of the author and the country of first publication (works first published in Russia or works first published outside Russia providing that the author(s) are citizens of Russia, a WTO member-state or other states participating with Russia in international treaties providing copyright protection).

Performances, phonograms, broadcasts, databases (in respect of their content), and works of science, literature and art that are first published after they have entered the public domain can be protected by way of related rights protection.

23. Can copyright be registered? If so, is registration required?

Registration of copyright is not required. However, applicants have the option to register software and databases in the Register of Computer Programs and Register of Databases at the Federal Service for Intellectual Property.

24. When does copyright protection start and how long does it last?

Copyright protection starts from the creation of the work and lasts:

- For the author's lifetime plus 70 years.
- In case of anonymous or pseudonymous works, 70 years after publication.
- In the case of a work published within 70 years from the author's death, 70 years from the date of first publication.

The protection for related rights starts from the creation of the subject matter, and lasts:

- For performances: the lifetime of the performer, but not less than 50 years from the performance or the date of its fixation or broadcasting.
- For phonograms: 50 years after its fixation, or, in the case of a phonogram which is made available to the public within this period, 50 years after the publication.
- For broadcasts: 50 years after broadcasting.
- For contents of databases: 50 years after completion of the database, or, in the case of a database which is made available to the public within this period, 50 years after the publication.

- For works first published after they have entered the public domain: 25 years after the first publication.

25. On what grounds can a copyright infringement action be brought?

An action for copyright infringement can be brought on the following grounds:

- Violation of an author's moral rights.
- Failure of the collecting organisation to pay the remuneration collected to the right owner.
- Violation of the exclusive right of copyright owners in respect of their works. This includes unauthorised reproduction, distribution, derivation, public display, import, rental to the public, public performance, broadcasting, rebroadcasting, or making available to the public of the work.

An action for related rights infringement can be brought on the following grounds:

- Violation of moral rights of performers, phonogram producers, database producers, or first publishers.
- Failure of the collecting organisation to pay remuneration collected to the right owner.
- Violation of the performers' exclusive right. This includes unauthorised broadcasting, fixation, reproduction, distribution, public performance, rental to the public, or making available to the public of a fixation of the performance.
- Violation of the phonogram producers' exclusive right in respect of their phonograms. This includes the unauthorised public performance, broadcasting, making available to the public, reproduction, import, distribution, or rental to the public of the phonogram.
- Violation of a broadcasting organisation's exclusive right in respect of their radio or television broadcasts. This includes the unauthorised fixation, communication to the public in places accessible to the public against payment of an entrance fee, public performance, rebroadcasting, or making available to the public, reproduction, distribution, or renting out of the fixation of the broadcasts.
- Violation of database producers' exclusive rights in respect of contents of their databases. This includes the unauthorised extraction or re-utilisation of the contents of a database.
- Violation of a first publishers' exclusive right in respect of works published by them. This includes the unauthorised reproduction, distribution, public display, import, rental to the public, public performance, broadcasting, rebroadcasting, or making available to the public of the work.

26. Which courts deal with copyright infringement actions?

See *Question 7*.

27. What are the defences to copyright infringement actions?

The defences to copyright infringement include:

- Non-infringement.
- The work used has entered the public domain.
- The use of the copyright falls under the statutory exceptions to exclusive rights.
- Exhaustion of exclusive rights.
- The claim is time barred under the statute of limitations.

28. What are the remedies in copyright infringement actions?

The remedies in copyright infringement actions are the same as for patent infringement actions (see *Question 9*).

29. Is there a fast-track and/or a small-claims procedure for copyright infringement actions?

There are no fast-track or small-claims procedures for copyright infringement actions.

However, preliminary injunctive relief (that is, blocking access to the infringing content on internet) can be obtained in the Moscow City Court.

REGISTERED DESIGNS

30. What are the legal conditions to obtain a registered design right?

To be eligible for patent protection, a design must:

- Relate to industrial or handicraft articles.
- Be new.
- Be original.

A design patent cannot be granted for a design that:

- Consists only of the features solely dictated by the technical functions of an article.
- Misleads consumers.

31. Which authority registers designs?

The Federal Service for Intellectual Property (Rospatent) registers industrial designs and issues design patents in Russia. Guidance and forms on the application procedure are available online in Russian (www.rupto.ru) (www.fips.ru).

A formal examination of the application is conducted to determine whether it contains all the documents mentioned in the application and whether the documents comply with the requirements.

A substantive examination of the application starts immediately after the formal examination is successfully completed. The examination will assess whether the design complies with the legal requirements for design right protection. The application will be rejected if at least one of the following applies:

- It relates to subject matters that cannot be protected.
- At least one of the patentability criteria is not met (see *Question 1*).

32. On what grounds and when can third parties oppose a registered design application?

Third parties are not able to oppose a design application. However, it is possible for third parties to apply to invalidate the registered design right (see *Question 4*).

33. When does registered design protection start and how long does it last?

Following registration, a patented industrial design is protected for an initial five-year period from the filing date. Design protection can be renewed for further five-year periods on payment of a renewal fee up to a maximum of 25 years from the filing date.

34. On what grounds can a registered design infringement action be brought?

Design infringement actions can be brought where a third party does any of the following without the design right owner's consent, in relation to a product that incorporates the registered design right or a design that gives the same overall expression on an informed user:

- Imports into Russia.
- Makes.
- Uses.
- Offers for sale.
- Sells.
- Otherwise puts on the Russian market.

- Keeps for any of the above purposes.

35. Which courts deal with registered design infringement actions?

See *Question 7*.

36. What are the defences to registered design infringement actions?

Defences to design patent infringement include:

- Non-infringement.
- Private non-commercial use.
- Experimental use.
- Exhaustion of exclusive right.
- Prior user's right.
- The claim is time barred under the statute of limitation.

37. What are the remedies in registered design infringement actions?

See *Question 9*.

38. Is there a fast-track and/or a small-claims procedure for registered design infringement actions?

See *Question 10*.

UNREGISTERED DESIGNS

39. What are the legal conditions for unregistered design rights to arise?

Unregistered designs can be protected as a work of art by copyright law (see *Questions 22 to 29*) or by the law on protection against unfair competition.

40. When does unregistered design protection start and how long does it last?

See *Question 39*.

41. On what grounds can an unregistered design infringement action be brought?

See *Question 39*.

42. What are the defences to unregistered design infringement actions?

See *Question 39*.

43. What are the remedies in unregistered design infringement actions?

See *Question 39*.

TRADE SECRETS AND CONFIDENTIAL INFORMATION

44. What are the legal conditions for rights in confidential information to arise?

Confidential information can be protected as a trade secret (know-how) if it:

- Relates to information about the business methods or results of intellectual activity in the sphere of science and technology.
- Has a commercial value due to it being secret.
- Is not freely accessible to third parties on legal grounds.
- Is subject to reasonable measures to keep it secret.

45. On what grounds can an action for unauthorised use of confidential information be brought?

Grounds for action for unauthorised use of confidential information include:

- An unlawful acquisition and disclosure or use of information constituting a trade secret.
- Violation of an obligation of confidence under law or contract.

46. Which courts deal with actions for unauthorised use of confidential information?

See *Question 7*.

47. What are the defences to actions for unauthorised use of confidential information?

The defences to actions for unauthorised use of confidential information are that the confidential information:

- Is not eligible for trade secret protection.
- Is lawfully available to the public.
- Has been developed independently.
- Was used without the knowledge that the use is unlawful.

48. What are the remedies in actions for unauthorised use of confidential information?

The remedies in actions for unauthorised use of confidential information are injunctions and damages.

49. Is there a fast-track and/or a small-claims procedure for actions for unauthorised use of confidential information?

There are no fast-track or small-claims procedures for actions for unauthorised use of confidential information.

THE REGULATORY AUTHORITY

Federal Service for Intellectual Property

W www.rupto.ru

Main areas of responsibility. Patents (inventions, utility models, industrial designs), trade marks, appellations of origin, registration of copyright in computer programs and databases, registration of rights in topologies of integrated microcircuits and registration of IP transactions.

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Areas of practice. IP protection, use, prosecution and enforcement; IP agreements; IP due diligence and audits; unfair competition and false advertising; dispute resolution and litigation; anti-counterfeiting and anti-piracy.