

Russia

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I. REQUIREMENTS FOR DESIGN PROTECTION

A. Legal Framework

1. *Basics of Design Right*

In Russia, the intellectual property right that protects the visual appearance of industrial or handicraft articles is referred to as an ‘industrial design patent’, or more commonly an ‘industrial design’. The Russian industrial design system is based on the following documents:

- Part IV of the Civil Code of the Russian Federation (the ‘Code’);
- Rules for preparing, filing and examination of industrial design application (the ‘Rules’);
- Requirements to the industrial design application documents (the ‘Requirements’);
- The Locarno Agreement Establishing International Classification for Industrial Designs;
- The Paris Convention for the Protection of Industrial Property;
- The Agreement on Trade Related Aspects of Intellectual Property Rights.

In Russia exclusive rights to industrial designs are recognised through registration in the State Register of Industrial Designs and certified by design patents issued by the Russian Patent and Trade Mark Office (‘Rospatent’).

According to Article 1352 of the Code, an industrial design is a solution defining the outer appearance of an industrial or a handicraft article. Paragraph 12 of the Requirements states that articles can be, for example, packages, labels, composite articles, sets of articles, type fonts or independent parts of article.

Patent protection as industrial designs will not be granted to:

- designs where all features are defined exclusively by technical function of the article;
- designs misleading a consumer of an article regarding the manufacturer of the article or a place of manufacture of the article, or a good for which the article is a container, a package or a label;
- designs including, reproducing or imitating official symbols or signs (flags, emblems, insignias, banknotes etc.); abbreviated or full names of international and intergovernmental organisations, their flags, emblems, and other symbols and signs; official control, guarantee marks or hall-marks, seals, awards and other insignias;
- designs which are contrary to public interests, principles of humanity and morality.

According to Article 1391 of the Code an industrial design application undergoes a formal examination and a substantive examination. In case of a positive result of examination, an industrial design patent is granted. The industrial design patent is valid for five years with possibility of four extensions for five years each.

2. *Overview of Statutory Requirements*

Article 1352 of the Code stipulates two criteria of patentability of industrial designs: ‘novelty’ and ‘originality’.

A design is ‘novel’ if its overall appearance was not generally known, anywhere in the world, before the priority date of the application for the industrial design. In other words, design protection is given only to those industrial designs that possess absolute worldwide novelty.

The Russian design law provides for a novelty ‘grace period’ for design applications. The novelty grace period exempts disclosures made by its author, or by any person who lawfully received the disclosures from the author, if the application for the industrial design was filed within twelve months from the date when the information was disclosed.

An industrial design is ‘original’ if the essential features thereof are determined by the creative nature of the specificities of the article. In particular, a design is original if there is no prior art design for an article of similar function that produces the same impression on the informed consumer. During novelty and originality examination, the examiner takes into consideration all industrial design applications, invention applications, utility model applications and trademark applications of other applicants filed in the Russian Federation before the priority date of the application for the industrial design.

3. *Non-Functionality Requirement*

Article 1352 of the Code states that a design is not eligible for design protection when all of its constituent visual features are defined exclusively by the technical function of the article.

4. *Means for Claiming Design Rights*

In order to obtain an industrial design patent it is necessary to file an industrial design application with Rospatent. As stipulated in Article 1377 of the Code, an industrial design application should comprise:

- a request for the grant of an industrial design patent with the indication of the applicant and of the authors and addresses thereof;
- a set of representations of the industrial design providing a complete perception of essential features of the industrial design, which determine aesthetic specificities of the outer appearance of the article;
- a written description of the industrial design;
- a Power of Attorney;
- a certified priority document, if Paris Convention priority is claimed.

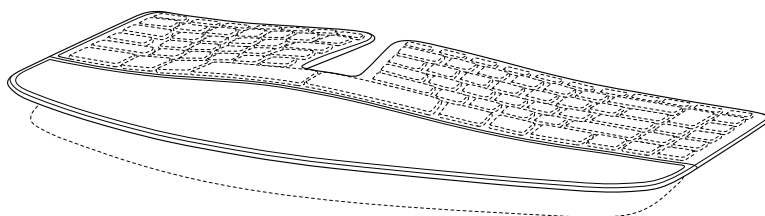
The filing date for the industrial design application is accorded when the request and reproductions are filed.

The written description of the industrial design does not define the scope of protection. It is used to conduct a rational dialogue between the applicant and the examiner when establishing terminology, which will be used not only during the examination of the application, but also during hearings in the Chamber for Patent Disputes and in the courts.

The set of representations of the industrial design may consist of photographs, CAD or line drawings with or without surface shading. It should be pointed out that number of views in industrial design application must not exceed seven.

The subject matter of design can be a whole article or an independent part thereof. Using broken lines, it is possible to obtain protection for portions of an article that are not separable. According to Paragraph 32 of the Requirements, an applicant can designate by broken lines those portions of the overall design of the article that the applicant does not wish to protect. There are no special requirements for depicting broken lines. Any interrupted line will accepted by Rospatent. The portions of the overall design of the article for which protection is sought must be shown in solid lines. An example of a partial design is shown in Figure 1.

Figure 1: Industrial Design Patent No. 91017



Industrial Design Patent No. 91017 covers any keyboard having the same or similar contour of the housing, which produces on the informed consumer the same impression, independently of the shape of keys and the base.

B. Policy Considerations Behind Non-Functionality Requirement

There is no express policy position set forth in the Code, Regulations, Rules or case law, for the non-functionality requirement of Article 1352 of the Code.

In the author's opinion, the reason behind the policy is to prevent design protection being awarded when no design has actually been created by the faculties of the designer. In instances where the design is purely dictated by technical function, the appearance of the item is preordained once the designer decides to create an article that can achieve the particular technical function.

C. Compliance with Non-Functionality Requirement

1. Tests

The multiplicity of forms approach has typically been applied to whether a particular appearance of a design is dictated only by technical function of the article to which it is applied. Prior art having different appearances but fulfilling the same or similar function as that of the claimed design is highly relevant. An example of use of this approach is shown *infra* at section I.D. of this chapter.

2. Impact of Related IP Rights and Must-Fit Parts

If all constituent visual features of a design are defined exclusively by the technical function of the article, the design is not eligible for protection. Information on the functionality of the article can be found in various places. Disclosure regarding features of a design set forth in a related utility patent has the same impact as if such disclosure was found in any other available source of information, for example in a trade journal, technical article, etc.

There is no express bar prohibiting design protection for designs that are 'must-fit' parts. Of course, any such part will be subject to the non-functionality rule of Article 1352 of the Code.

3. Designs Not Viewable in Normal Use

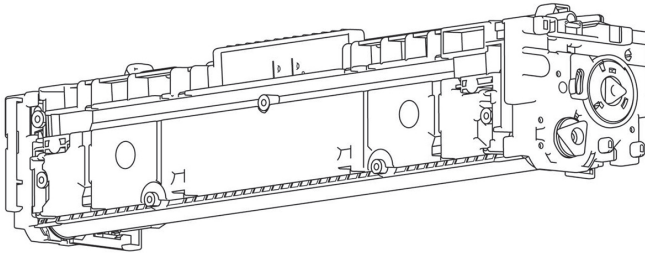
There is no statutory requirement that a design of an article be viewable in normal use to be eligible for protection. Relatedly, cross-sectional views are not accepted by Rospatent.

According to Paragraph 32 of the Requirements, any industrial or a handicraft article, in particular a package, a label, a composite article, a set of articles, a type font and an independent part of article, must conform to the following requirements:

- (a) a composite article is an article consisting of components for assembling the composite article (for example automobiles), and the composite article can be disassembled and assembled;
- (b) a component for assembling is an independent part of the composite article, which can be removed without destruction of the composite article and repeatedly used for assembling the composite article;

- (c) an independent part of article is a distinct part thereof, which is visible during normal use of the article;
- (d) sets of articles are groups of articles having common function and use (for example a set of furniture, a set of dishes etc.);
- (e) 'normal use' is use made by an end user and which does include use during creation, maintenance or repair of article.

Figure 2: Industrial Design Patent No. 99167



For example, the design for the printer cartridge in Figure 2, while not viewable in normal use, is eligible for design protection.

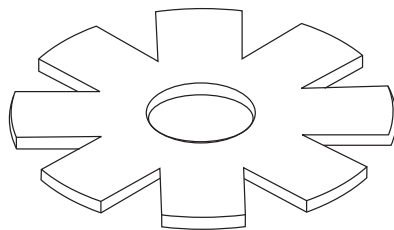
D. Case Law Examples Dealing with Non-Functionality Requirement

An Official Action was issued by Rospatent with respect to an industrial design application for an 'earth electrode plate of spark plug for internal combustion engine' (Figure 3).

Figure 3



Prior art
(used as evidence of alternative designs)

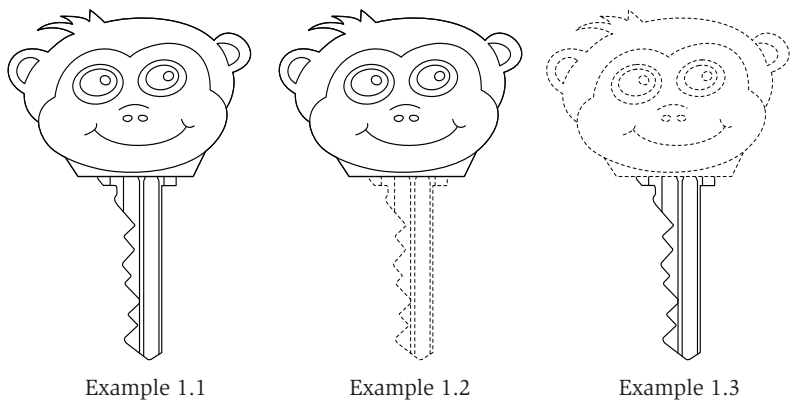


Refused industrial design

In the Official Action, the examiner stated that the design is ineligible for protection because the appearance of the electrode plate was dictated solely by the plate's

technical function. In response to the Official Action, the applicant submitted prior art (shown in Figure 3 above) to show that the electrode plate can take different forms while executing the same technical function. The examiner withdrew the refusal agreeing that the presence of such prior art confirms the fact that the shape of the article was not dictated solely by the electrode plate’s technical function. As a result, an industrial design patent was granted. This is an example showing how evidence of a multiplicity of forms can overcome the low hurdle of the non-functionality requirement.

E. Hypothetical Fact Patterns (‘Monkey Key’ Hypothetical)



Example 1.1 is directed to the entire key. All aspects are depicted in solid lines, including the key head and the key blade. Example 2.2 is a partial design, being directed to only the key head. (Note: the key blade of Example 1.2 is disclaimed as it is shown in broken lines.) The key head, which is in the fanciful shape of a monkey’s head, is not dictated solely by the function of the key. It can take many forms. Thus, the design rights of Examples 1.1 and 1.2 would be eligible for protection; the fact that they have functional qualities would not disqualify them from receiving design protection.

In Example 1.3, the industrial design right is directed to only the key blade. Here, the design is likely not patentable as all features of the key blade, including the shape of all teeth, are dictated by technical function. In other words, the key must take this form to service a mating key hole.

F. Tactical Considerations

1. Procurement

In order to minimise finding of ‘functionality’, it is advisable to omit all portions that may arguably be found to be dictated solely by technical function, which the applicant does not wish to protect. Another way to minimise finding of ‘functionality’ is by filing of multiple embodiments. The existence of multiple embodiments may

tend to show that the design is not dictated solely by technical function; this is a proactive way to show that there are alternative forms available.

2. *Litigation*

A party challenging the validity of a design right on functionality grounds faces a difficult battle. To be successful, they must show that all of the design's features are defined exclusively by the technical function of the article. For example, a challenge to a design right on a tyre must establish that all features, including the tyre tread and wall surfaces, are dictated only by technical function.

The design right holder can typically fend off such a challenge by showing that at least some parts of the design could be designed differently. The design right holder can show that the designer did have choices. The entire appearance was not preordained by the function. (The fact that there are thousands of tyre designs militates strongly in favour of the design right holder.)

II. SCOPE OF PROTECTION

A. Legal Framework

1. *Articulation of Scope of Protection*

According to Article 1354 of the Code, the scope of protection is defined by a combination of essential features, all of which must be depicted in the representations of design in the industrial design patent.

According to Article 1352 of the Code, essential features are those which define the aesthetic appearance of the article, in particular, shape, configuration, ornament, combination of colours, lines, contours, and texture of material of the article.

According to Article 1358 of the Code, an industrial design is considered to be used in an article if the article contains all essential features of the industrial design or a combination of essential features that produces the same overall impression on the informed consumer as the overall impression produced by the patented industrial design, provided that the articles have a similar function.

In the initial application, the applicant need not describe the scope of protection of the design in words. Nevertheless, in any appeal to the Chamber of Patent Disputes regarding the validity of the design, the applicant is sometimes asked to articulate in writing what it believes to be the essential features of the industrial design.

2. *Effect of Prior Art Corpus on Scope of Protection*

If the prior art is visually close to the patented industrial design, the scope of protection afforded to the design right will be relatively narrow. In contrast, if the appearance of the patented industrial design is quite different from the prior art, the scope of protection afforded to the design right will be relatively broad.

If the patented industrial design comprises elements that are found in the prior art, those elements are not removed from the scope of protection. The fundamental

tenet of Article 1358 of the Code applies (see II.A.1 *supra*). There are no rights granted for independent elements of the overall appearance. Thus, there is no difference in treatment of ‘old’ and ‘new’ features in the assessment of the scope of protection.

3. *Effect of Functional Features on Scope of Protection*

a. *Features Dictated Solely by Technical Function*

According to Article 1352 of the Code, features that are dictated only by the technical function of the article are excluded from a design’s scope of protection. For example, the round shape of a tyre is excluded from the scope of protection.

b. *Features Not Dictated Solely by Technical Function, but Nevertheless Serving a Function*

If features are not solely dictated by technical function, but nevertheless serve a function, such features are protectable features of the industrial design. For example, features such as the appearance of the tyre tread, while functional, are not removed from the scope of protection.

c. *Impact of Related IP Rights, Industry Standards, Must-Fit Components*

While there is no express exclusion for elements of the overall design whose shape is dictated by industry standards, such elements may be excluded as their form will be considered to be dictated solely by technical function. For example, features relating to parts such as a hexagonal shank of drill bit or a USB port of a laptop made in accordance with industry standards are features that are dictated solely by the technical function and thus likely excluded.

Nevertheless, the outer appearance of two parts that are design to mate together (e.g. scissors and a sheath) are likely eligible subject matter. The design of each is in the hands of the designer, not external functionalities.

B. *Test(s) for Determining Whether a Feature is ‘Dictated Solely by Technical Function’*

A feature of a design will be said to be dictated solely by technical function if there are no alternative appearances for the feature. In other words, the same test used for determining whether a design right is refused on functionality grounds is used for determining whether a feature is excluded from a design scope of protection. It is important to note that only those portions that are dictated solely, i.e. exclusively and for no other reason, by technical function are excluded from the scope of protection. If a feature is only *largely* dictated by technical function, as opposed to *solely* dictated by technical function, it will not be excluded from the scope of protection. The law seeks to exclude, and only exclude, those portions where the designer made no design contribution.

C. Policy Considerations Underlying Treatment of Functional Features

There is no express policy position set forth in the Code, Regulations, Rules or case law for why functional features are excluded from a design scope of protection under Article 1352 of the Code.

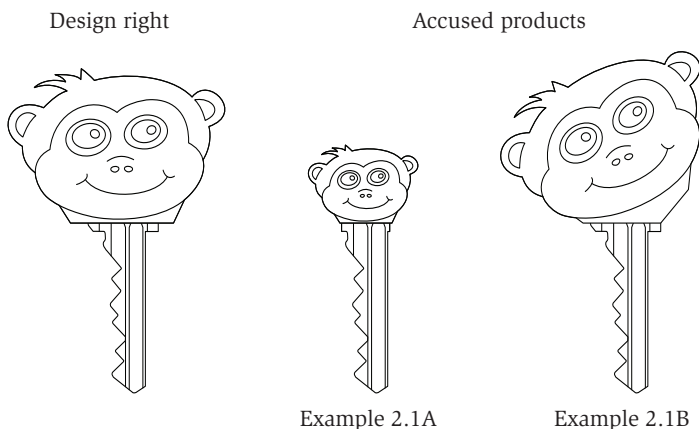
In the author's opinion, the reason behind the policy is once again to prevent protection being awarded when no design has actually been created by the faculties of the designer. In instances where the features are purely dictated by technical function, such appearances are preordained once the designer decides to incorporate the function of the feature. There is no design to reward.

D. Case Law Examples of Treatment of Functional Features in Infringement and Validity Analyses

To the author's knowledge there are no available cases whereby features dictated solely by the technical function of an article were excluded from a design's scope of protection.

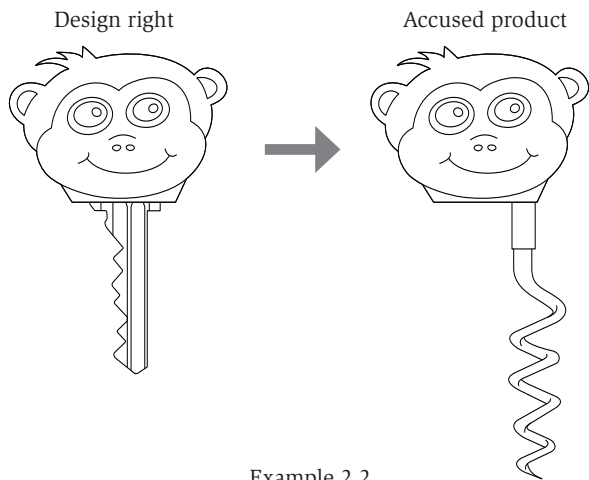
E. Hypothetical Fact Patterns ('Monkey Key' Hypothetical)

1. Infringement Examples



As to Examples 2.1A and 2.1B, the key head is identical in all three designs. The key of the design right differs in appearance from the accused products with respect to size and orientation. Nevertheless, before conducting the comparison for infringement, we must first examine whether there are any features that must be excluded from the scope of protection of the design. Here, the key blade portion likely will be excluded from the design's scope of protection, under the reasoning that its form is dictated solely by technical function.

If the blade is removed from the analysis, the scope of the claim is limited to the key head. Seeing that the shape of key heads are identical, the accused designs of Examples 2.1A and 2.1B would likely infringe the design right.

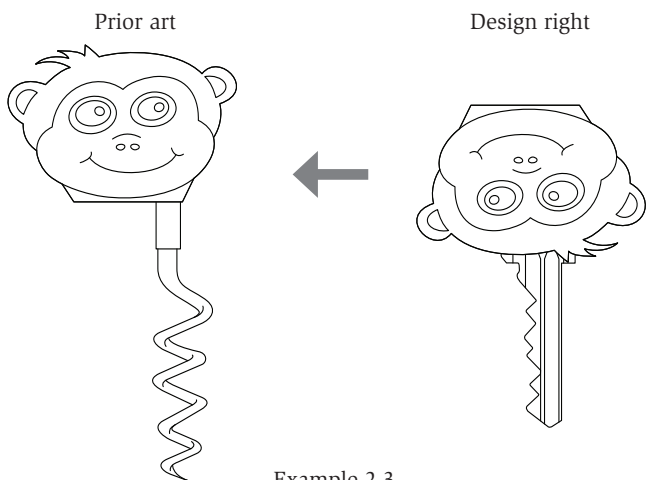


Example 2.2

With respect to Example 2.2, a dispositive issue on infringement is the fact that the design right is directed to a key, while the accused product is directed to a corkscrew. These two items fulfil very different functions. Indeed, the design right for the key relates to Locarno class 08-07, while the accused corkscrew product relates to Locarno class 07-06.

Article 1358 of the Code, makes it clear that the scope of protection of the design right only extends to articles having *similar* functions. Thus, for Example 2.2, inasmuch as the design right and accused products are directed at products having very different functions, there can be no infringement.

2. **Validity Example**



Example 2.3

As to Example 2.3, the design right for the key will likely be found to be not original. The key head is identically found in the prior art, and the only missing portion is the key blade. The substitution of the key blade (of a size and shape needed to engage a corresponding key hole) for the corkscrew will not satisfy the originality requirement. Accordingly, the design right of Example 2.3 is most likely invalid.