

# Designs

## 2019

### A Global Guide

Russia

**Gorodissky & Partners (Moscow)**

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# Russia

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## Legal framework

Russian design law is incorporated into Part IV of the Civil Code. Additional provisions regarding application proceedings are set out in the Rules on Design Patent Application Proceedings and the Instructions for Design Patent Application Documents.

Generally recognised principles and norms of international law and treaties are also an integral part of the Russian legal system. International treaties apply directly and where such a treaty conflicts with Russian civil law, the international treaty will prevail. Russia is a signatory to the following international treaties relating to design matters:

- the Paris Convention for the Protection of Industrial Property;
- the Locarno Agreement Establishing an International Classification for Industrial Designs;
- the Agreement on Trade-Related Aspects of IP Rights; and
- the Hague Agreement Concerning the International Registration of Industrial Designs.

Although Russia is not a case law country, in practice decisions and resolutions of the Supreme Court, as well as the case law of the IP Court, affect the application of the design law provisions.

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 Trademark Office (Rospatent).

Designs relating to applied art subject matter may be protected in some cases by copyright. The existence, exercise and enforcement of copyright require neither registration of the work nor observation of any other formalities.

Two-dimensional (2D) or three-dimensional (3D) designs can also be protected by means of 2D and 3D trademark registration.

## Unregistered designs

In some cases, if it can be proved that a design falls within the scope of copyright law, copyright protection may apply regardless of registered design protection. Copyright protection of an unregistered design starts

from the creation of the work and lasts for the author's lifetime plus 70 years.

In addition, an unregistered design for trade dress can enjoy protection against copying and imitation under unfair competition rules (according to the Federal Law on Protection of Competition).

### Registered designs

The author of the design or his or her legal successors or assignees (individuals or legal entities) can apply for and own a design patent.

Where an industrial design is made by an employee in the course of his or her duties or pursuant to a special task entrusted to him or her by the employer, the employer will be entitled to apply for a design patent, unless otherwise stipulated in the contract (eg, employment contract) between employee and employer.

If a design is created under a contract, the customer will be entitled to apply for a design patent (unless the contract provides otherwise). The contractor in this case can use the industrial design for its own purposes on the terms and conditions of a free, non-exclusive licence.

The outer appearance of an industrially made or handmade product can be registered as an industrial design. An industrial design may be 3D, 2D or a combination thereof.

Patent protection as an industrial design will not be granted to:

- solutions whose features are determined exclusively by the technical function of the article;
- designs that may mislead consumers in respect of the producer or place of manufacture of the article, or the goods for which the article serves as a container, its packaging or label;
- designs that reproduce or imitate official symbols, names or other distinctive signs; or
- designs that are contrary to the public interest or to principles of humanity and morality.

To be eligible for patent protection, an industrial design must be new and original. A design is considered new if the combination of its essential features (as identified in the submitted images) is unknown from information generally available worldwide before the priority date. A 12-month grace period is provided for prior disclosure of the design by the author, applicant or a person who

obtained information on the design from the author or applicant.

An industrial design is considered original if its essential features are determined by the creative character produced by the distinct aesthetic aspects of the article concerned – that is, if no known design produces the same overall impression on the informed consumer as the claimed industrial design.

When determining the novelty and originality of the claimed design, all publicly available patent, utility model and design applications previously filed with Rospatent are taken into account (and thus may be a bar to novelty and originality).

The application fee for a single industrial design is Rb4,700. For a group of designs, the application fee is Rb4,700 plus Rb3,200 for each additional design. The fee for registration and issuance of a design patent is Rb4,500. The average costs associated with filing and prosecution of an application and grant of a patent are approximately \$1,700 including official fees and patent agent fees.

Annual maintenance fees are Rb1,700 for the third and fourth years of validity, Rb2,500 for the fifth and sixth years of validity and so on, up to Rb24,000 for the 21st to 25th years of validity.

The fee to appeal a rejection or grant decision is Rb2,500 for each industrial design in the application. The fee to file an invalidation action is Rb4,500 for each industrial design in the patent.

### Procedures

Design applications are filed with Rospatent. Online filing is not available. Applicants that are not resident or established in Russia must appoint a patent attorney registered with Rospatent as their agent.

An industrial design application should comprise:

- a request for the grant of an industrial design patent which indicates the name and address of the applicant and author;
- a set of representations of the design that fully conveys the essential features which arise from the design's particular aesthetic aspects;
- a perspective view drawing, ergonomic diagram and similar representations, where necessary to convey the essence of the industrial design; and
- a description of the industrial design.



An application must relate to a single industrial design or a group of related designs which form a single creative idea (ie, the unity requirement). An unlimited number of designs can be included in a group.

The application must be filed using a standard Russian-language form. It should indicate the name and address of the applicant and the name, citizenship and address of the author.

Representations of the design (eg, photographs, drawings, computer scripts) must give a full and detailed impression of the external appearance of the product incorporating the design.

The description should disclose:

- the Locarno class and title of the design;
- the intended use of the design;
- the closest prior art;
- a list of the submitted illustrations; and
- the essence of the design.

Design applications are subject to formal and substantive examination. Formal examination is conducted to determine whether:

- the application contains all of the required documents;
- the documents comply with the formal requirements; and
- all prescribed fees have been paid.

Substantive examination verifies the design's compliance with the conditions of patentability (ie, novelty and originality) and commences immediately after a successful formal examination.

Changes to a design application can be made only on the examiner's request. Submission of new images which add or remove essential features is not allowed.

Following a successful substantive examination, the design will proceed to grant. The grant fee should be paid within four months from grant. After payment of the fee, Rospatent will enter the design in the State Register of Industrial Designs and grant the design patent. Immediately after registration, information relating to the design is published in the *Official Bulletin of Rospatent* ([www1.fips.ru/wps/portal/ofic\\_pub\\_en/#page=bulletin&type=PO](http://www1.fips.ru/wps/portal/ofic_pub_en/#page=bulletin&type=PO)). Publication includes a representation of the design. Designs registered with Rospatent can also be accessed through the EU Intellectual Property Office's DesignView search tool

(<https://www.tmdn.org/tmdsview-web/welcome>). The entire application file is publicly accessible after publication of the design patent. Deferred publication is unavailable.

If the applicant disagrees with the examiner's decision, it may lodge a reasoned appeal with Rospatent within seven months. Further appeal against Rospatent's decision may be filed with the IP Court.

Design applications cannot be opposed by third parties. However, a design patent may be invalidated, in whole or in part, at any time during its period of validity on the following grounds:

- The patented design does not comply with the conditions of patentability specified by law.
- The patent adds or removes essential features of the design (as stipulated in the filed application).
- The patent was granted in breach of the established procedure, where several applications with the same priority date were filed for an identical design.
- The patent was granted with an incorrect indication of the author or owner.

Invalidation actions on the first three grounds are filed with Rospatent, while invalidation actions on the last ground are filed with the IP Court. Rospatent's decision on an invalidation action may be appealed to the IP Court.

The validity of a design patent can be challenged on the above grounds after its expiry or early termination, but only by an interested person (eg, a person accused of patent infringement).

### Enforcement

The owner of a design patent has the exclusive right to use the protected design. The scope of protection extends to any product that produces the same overall impression on the informed consumer as the patented design.

The manufacture, use, import, sale, offer for sale or any other form of commercialisation or storage for such purposes of a product incorporating a registered design without the rights holder's consent constitutes infringement. The product is deemed to incorporate a patented design if it has all the essential features of the patented design or an equivalent combination of features that produces the same overall impression on the informed consumer as the patented design,



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Alexander Vasilets graduated from the People's Friendship University of Russia as an engineer-linguist and from the law faculty of the Russian State Academy of Intellectual Property. In 1999 he joined Gorodissky & Partners and in 2006 he was promoted to partner at the firm.

He heads the design department and his primary focus is design prosecution across a wide range of industries and jurisdictions. He has vast experience and counsels clients on issues relating to proceedings before the Russian Patent and Trademark Office and foreign patent offices, as well as enforcement of design owners' rights. He is a member of the International Association for the Protection of Intellectual Property.



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Nikolay Bogdanov graduated from the Moscow Institute of Electronical Engineering and the Central Institute of Intellectual Property. He started his career in the Russian Patent and Trademark Office, where he served as an examiner, researcher, deputy chief of the legal department, deputy chief of the department for international cooperation and deputy general director.

He contributed to the development of Russian IP legislation and regulations, drafting international agreements on patent harmonisation and participating in intergovernmental negotiations, including those on Russia joining the World Trade Organisation.

Mr Bogdanov joined Gorodissky & Partners in 2004 and was promoted to partner in 2006. He advises clients on Russian and foreign IP legislation, including international IP treaties, conventions, agreements and peculiarities of their implementation in Russia.

provided that the design and the relevant product have a similar purpose.

Civil actions for design infringement are filed at the first-instance commercial court of the location of the infringer. As a cassation court, the IP Court hears design infringement cases on appeal from the first-instance commercial courts and commercial appeal courts.

Available remedies for design patent infringement include:

- issuance of injunctions;
- award of damages, as well as reasonable attorneys' fees;

- confiscation and destruction of infringing goods; and
- publication of the court decision.

In lieu of damages, the design rights holder can demand the following compensation:

- Rb10,000 to Rb5 million, set at the court's discretion in light of the nature of the infringement; or
- double the licence price usually charged under comparable circumstances for lawful use of the patented design.

The same remedies are available for design copyright infringement. However, the compensation that the rights holder can demand in lieu of damages may also be calculated as double the price of the counterfeit copies sold of the work incorporating the design.

If the patent owner would like to claim damages or compensation, it must send a pre-trial warning letter to the infringer asking it to voluntarily pay damages or compensation before taking legal action. If the infringer does not comply with this demand within one month from the date on which the proposal is made, a legal action can be filed with the competent court.

Judicial proceedings for infringement of registered or unregistered designs typically last around three to four months. Complicating circumstances (eg, the need to obtain expert opinions or failure of a party to attend the hearing) may delay proceedings for a further one or two months. If the case is appealed and goes through all court instances, the proceedings may last two years or more.

Administrative liability for the illegal use of registered designs is set out in the Code of Administrative Offences, which establishes fines of Rb1,500 to Rb40,000. The code also establishes fines of Rb12,000 to Rb20,000 for individuals and Rb150,000 to Rb500,000 for legal entities for unfair competition in the form of copying or imitating an unregistered design.

### Ownership changes and rights transfers

The rights holder may dispose of its exclusive right to an industrial design by assignment or licence.

Assignment of a design patent is not allowed if the assignment may mislead consumers in relation to the product or its manufacturer.

Exclusive and non-exclusive licences under a design patent may be granted. The licensor of an exclusive licence cannot use the licensed subject matter within the scope granted to the exclusive licensee unless otherwise provided in the licensing agreement.

Design patents can be pledged. Under the pledge agreement, the pledger can use the industrial design and license it without the pledgee's approval, unless the agreement provides otherwise. However, the pledger

may not assign the patent without the pledgee's consent, unless the agreement provides otherwise.

The assignment, licensing and pledging of design patents are subject to official registration with Rospatent, failing which the relevant rights transfer will be deemed void. Any party to the relevant contract may register the rights transfer.

The rights holder may submit to Rospatent a statement granting any person the right to use the design (ie, an open licence). Following Rospatent's publication of the open licence notice, maintenance fees for the design are reduced by half, starting from the following year. The rights holder must communicate the terms and conditions of the open licence to Rospatent and such terms and conditions will be published at the rights holder's expense. The rights holder must conclude a non-exclusive licensing agreement with any party wishing to use the registered design.

### Related rights

If the design can be deemed a work of art, copyright protection applies regardless of registered design protection.

Where copyrighted subject matter is registered as an industrial design with the copyright owner's consent, protection of the exclusive rights against infringement will depend on the nature of the infringement. If the infringer uses an industrial design, the design patent owner may apply for measures used to enforce patent rights. If the exclusive right to use a work of art is infringed and such infringement is unrelated to the use of the industrial design, the copyright owner may apply for copyright protection measures. **WTR**

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