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# GORODISSKY

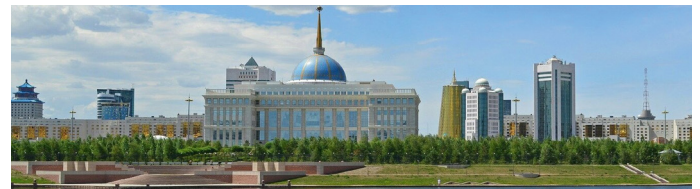
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# G-NEWS

GORODISSKY & PARTNERS  
IP & TMT LAW  
INFORMATION BULLETIN

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## Gorodissky & Partners opens 14<sup>th</sup> branch office



Our new office opened on December 1st in Nur-Sultan city, Kazakhstan. Mr. Arman Sauganbaev, Lawyer and Patent Attorney, previously – Deputy Head of Legal Department at “Kazakh Agro Technical University”, joined Gorodissky international team as a head in Kazakhstan.

# EURASIAN INDUSTRIAL DESIGN

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The introduction of the Eurasian Design protection system is one of the recent notable events in the Eurasian region. The countries-signatories to Eurasian Patent Convention (EAPC) signed on September 09, 2019 a Protocol on Protection of Industrial Designs (Protocol), which entered into force on March 17, 2021. The Protocol enlarged the functionality of the Eurasian Patent Convention as it now provides for a possibility to obtain a Eurasian patent for industrial design by the way of filing of a single application with the Eurasian Patent Office (EAPO) situated in Moscow, Russia.

As from June 01, 2021 the EAPO started to accept applications for Eurasian industrial designs. Actually, the Protocol is valid for six countries: Russia, Armenia, Azerbaijan, Kyrgyzstan, Tajikistan and Kazakhstan. The other countries signatories to EAPC (Belarus, Turkmenistan) are supposed to implement respective national procedures for joining the Protocol.

The Eurasian Design protection system can be a good alternative to the national filing of a separate design application in each country of interest or to filing an application through Hague system of international registration of industrial designs, in particular, because the procedure of obtaining an Eurasian Design Patent is expected to be more cost-effective.

## WHAT IS EURASIAN INDUSTRIAL DESIGN?

According to the Protocol an Eurasian industrial design (EAID) is a solution of an outer appearance of an industrial or handicraft article, which should be patentable according to set criteria, in particular, packaging, label, composite article, set of articles, typeface, as well as an independent part of an article.

The Eurasian Design Patent is issued for an industrial design that is new and original in its essential features, which are the features defining aesthetic peculiarities of the outer appearance of an article, in particular the form, configuration, ornament (pattern), combination of colors, lines, contours, texture of the material the article is made of.

Accordingly, an EAID can obtain protection in case it is:

- new and not known from the information that became publicly available in the world before the filing / priority date of the industrial design;
  - original what means that the essential features of the article have a creative character, in particular, if there is no prior known solution with similar purpose which makes the same overall impression on the informed user.
- The Patent Instruction to the Protocol provides for a “grace period” of 12 months for filing an application for an EAID without affecting the patentability in case the information related to this design has been disclosed by the author, applicant or other person who received this information from them.

It is important to note that the novelty and originality of the claimed design will be checked by the Examiner of the EAPO at the stage of substantive examination only in case an opposition is filed by a third party (based on non-compliance with said patentability criteria) and only in frames of information and materials submitted with the opposition.

## NON-PATENTABLE SOLUTIONS

The Patent Instruction provides for a list of solutions that cannot be protected as EAIDs, which will be checked by the Examiner of the EAPO.

Already on the stage of formal examination the Examiner will check if the claimed design is not contrary to public interests or principles of humanity and morality even in one of the Member States of the Protocol. On the stage of substantive examination the Examiner will check if the claimed design should be considered as non-patentable because:

- it includes, reproduces or imitates official symbols (including state symbols or signs), or their recognizable parts, or names and symbols/signs of international organizations (or their

recognizable parts) without the respective consent of competent state bodies or competent bodies of international organizations; or official control, warranty or hallmarks, seals, awards and other insignia (or their recognizable parts). These elements can be included in the Eurasian industrial design as non-protectable elements in case the consent of mentioned competent bodies is obtained;

- all features of the claimed design are determined exclusively by technical function of the article.

The following requirements will be checked by the Examiner on the stage of substantive examination only in case of oppositions by third parties against the claimed design, namely, the proposed solution should be deemed non-patentable in case:

- it includes, reproduces or imitates official names or pictures of cultural heritage sites or their recognizable parts without the consent of respective competent bodies of a Member State or without the consent of the respective right holder (these elements can be included in the Eurasian industrial design as non-protectable elements in case the consent is obtained);
- it is identical or confusingly similar with prior trademarks of third parties (filed and published or already protected on the territory of a Member State) or it includes such trademarks;
- it is identical or confusingly similar with copyrighted objects earlier known on the territory of a Member State or it includes such objects without the consent of the copyright holder;
- it is capable to mislead the consumers in respect of the article or its manufacturer, or place of origin.

## FILING REQUIREMENTS

An application for an EAID is to be filed with the EAPO on paper or electronically in the Russian language.

The applicants not domiciled in Member States of the Protocol should be represented by Eurasian Patent Attorneys duly registered before the EAPO. The application must indicate:

- the name and address of the applicant

- the name and address of the author of the design
- the address for correspondence
- the title of the industrial design
- the indication of the article or the product connected with the claimed design
- the class of the International classification of industrial designs (ICID)
- the priority claim (if any)

The application should also include a set of pictures of the claimed design with different views, but no more than seven views for each claimed design. The pictures can be submitted in the form of photos, drawings or computer-generated pictures or as copies thereof.

It is allowed to use dashed lines or color marking in order to show the parts or elements which are disclaimed from claiming protection by the applicant. The parts or elements of the articles that are claimed for protection should be represented by solid lines.

The application can include up to 100 industrial designs provided that they all relate to one class of the ICID. However, in case the pattern is claimed as an industrial design it can be included in one application with other designs relating to a different class of the ICID.

## PROCEDURES BEFORE THE EURASIAN PATENT OFFICE

Having received an application for EAID the EAPO conducts a preliminary (formal) examination and checks if the claimed design and enclosed documents comply with formal requirements and verifies if the claimed design does not contradict the principles of humanity and morality at least in one Member State.

In case of positive result of preliminary examination the application is published for opposition purposes within a month from the date of forwarding the notification about positive result of formal examination. It is important to note that no deferment of publication is provided.

Within two months from the publication date third parties (and also a national State Patent Office if

it is provided by the legislation of the respective Member State of the Protocol) are entitled to file an opposition against the application for EAID on the basis that the claimed design is not new or original or represents a non-patentable solution according to the Protocol / Patent Instruction.

In case of positive result of preliminary examination the EAPO conducts a substantive examination with due account of oppositions, if filed by third parties. The novelty and originality of the claimed design will be checked by the substantive examination only in case a third party files an opposition insisting that the claimed design does not comply with these criteria. The Examiner's check in this case will be limited only by the information submitted along with the opposition. The substantive examination may result in issuance of a decision of grant or decision of refusal. The decision of refusal can be objected by the applicant with the EAPO within three months from the date of forwarding the decision. In case the decision remains negative it can be further appealed with the President of the EAPO within four months from the date of its forwarding to the applicant.

The Protocol provides for a possibility to transform the application for an EAID into national applications in the Member States of the Protocol (per choice of the applicant) in case of refusal to grant a Eurasian Design Patent.

In case of positive decision the EAID is registered in the Register of the EAPO and published in the Official bulletin within two months subject to payment of the respective fees and the Eurasian Design Patent is issued promptly after publication. The Eurasian Design Patent is valid on the territory of all Member States.

## VALIDITY AND INVALIDATION

The term of validity of an Eurasian Design Patent is 5 years counting from the date of filing an application and it can be extended for a term of 5 years several times, but the overall term of validity cannot be more than 25 years.

According to provisions of the Protocol and Patent Instruction the Eurasian

Design Patent can be challenged and held invalid in full or in part in two ways: as a result of an administrative procedure before the EAPO or as a result of proceedings in the national Court(s) or other competent bodies of Member States.

An administrative invalidation procedure before the EAPO can be initiated by any person as well as by a national State Patent Office (if it is provided by the legislation of the respective Member State) by filing an invalidation action within six months from the date of publication of the Eurasian Design Patent.

The decision rendered as a result of consideration of the invalidation action can be further appealed with the President of the EAPO within four months from the date of forwarding the decision to the party.

The invalidation of the Eurasian Design Patent as a result of administrative procedure before the EAPO concerns all Member States.

The Eurasian Design Patent can be also challenged and held invalid in full or in part by national Court(s) or other competent bodies of Member States. The invalidation procedure is regulated in this case by the legal provisions of the respective Member State. In case the decision of invalidation is issued as a result of proceedings in national Court(s) or other competent bodies of Member States it will be valid only for the territory of the Member State where such decision was issued.

The Eurasian Design Patent will remain valid on the territory of Member States where the decision of invalidation was not rendered.

## DISPOSAL OF EAID EXCLUSIVE RIGHTS

The Eurasian Patent Convention provides different options for disposal of his exclusive right to the EAID. Assignment.

The Eurasian industrial design can be assigned but it should be noted that the assignment of the exclusive right to the EAID shall be permitted for the territories of all the Member States within which the patent is valid only and partial assignment shall not be allowed.

Another approach shall be applied when the patent covers several industrial designs. In this case the assignment of the exclusive right for the EAID to another person shall be possible for all or any of the industrial designs specified in the EAID patent. At that the assignment of an industrial design shall not be allowed if it can be the reason for consumer's confusion with regard to the manufacturer of the product or place of manufacture of the product.

## LICENSING

According to the Eurasian Patent Convention the EAID may be as subject of a license agreement concluded with respect to any Member State on the territory of which the EAID patent is valid.

## PLEDGE

The exclusive right to the EAID may also be a subject of a security of interest (pledge) agreement, in which the parties may specify the date from which the pledge of the exclusive right to the EAID arises. If such a date is not specified in the agreement, the pledge arises from the date of the conclusion of the security of interest agreement by default. The parties are generally free to determine the terms of the agreement provided that it includes the following mandatory provisions: a subject of the agreement, the results of the assessment of the exclusive right to pledged industrial design, substance, value and duration of fulfillment of the obligation secured by the pledge.

After the security of interest agreement is concluded the EAID patent owner shall still have the right to dispose of the exclusive right to the EAID in order to fulfill the pledge obligation if otherwise is not envisaged by the agreement.

## RECORDALS AND PUBLICATION

According to the Eurasian Patent Convention the assignment and security of interest agreements must be registered before the Eurasian Patent Office

and shall be considered valid for third parties only after its registration with the Eurasian Patent Office.

The license agreement must be registered by the national patent office of that Member State in respect of territory of which the relevant agreement has been concluded.

At that the national patent office shall immediately after the registration of the license agreement notify the Eurasian Office of such registration.

The Eurasian Patent Office shall publish information about assignments, licenses and security of interest agreements in the official bulletin of the Eurasian Patent Office.

## ENFORCEMENT OF EAID EXCLUSIVE RIGHTS

The exclusive right to the EAID is valid within the territory of all Member States, joined to the EAID protection system, and the EAID patent owner shall have the right to enforce his EAID exclusive rights in accordance with the national laws and procedural rules applicable to the national industrial designs in the Member State on territory of which the infringement takes place.

The scope of legal protection afforded by a Eurasian industrial design patent shall be determined by the essential features of the industrial design that are reflected in the images of the product.

## TEMPORARY LEGAL PROTECTION.

According to the Rule 84 of the Patent Instruction to the EAPC the EAID shall enjoy a temporary legal protection for the EAID in the territory of all Member States. At that the scope of temporary legal protection shall be determined by the all of the essential features of the industrial design, which are reflected in the images of the product published by the Eurasian Patent Office.

The patent owner shall have the right to claim reasonable compensation from the persons who used the claimed industrial design during the period between the date of the EAID application publication and date of the EAID patent publication, in accordance with the national legislation of the Member State in which territory the industrial design has been used. The temporary legal protection shall not be deemed to have occurred if a patent application has been rejected, the possibilities for appeal of which have been exhausted, or if the Eurasian application is considered withdrawn.

# OVERVIEW OF NEWS IN THE FIELD OF INTELLECTUAL PROPERTY (RUSSIA, CIS) (JANUARY TO AUGUST 2021)

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## INTERNATIONAL TREATIES OF THE RUSSIAN FEDERATION

### RUSSIA COMPLETED THE RATIFICATION OF THE PROTOCOL ON THE PROTECTION OF INDUSTRIAL DESIGNS TO THE EURASIAN PATENT CONVENTION; THE INSTRUMENT OF RATIFICATION OF THE RUSSIAN FEDERATION WAS HANDED OVER TO THE WIPO DIRECTOR GENERAL

The instrument of ratification by the Russian Federation of the Protocol on the Protection of Industrial Designs to the Eurasian Patent Convention dated September 9, 1994, was handed over to Daren Tang, Director General

of the World Intellectual Property Organization (WIPO), on January 11, 2020, during the visit of Head of Rospatent Grigory Ivliev to Geneva (Switzerland). This marks the completion of the procedures required for the Protocol to become effective for Russia. The Protocol was adopted at the diplomatic conference in Nur-Sultan on September 9, 2019, and was signed by Azerbaijan, Kyrgyzstan, Armenia, Kazakhstan, Russia, and Tajikistan. In accordance with the established procedure, the Protocol became effective for the first three states that ratified it (Kyrgyzstan, Azerbaijan, and Armenia) on March 17, 2021, i.e., three months after the third state (Armenia) deposited an instrument of ratification to the depositary for storage. The Protocol became effective for Russia on April 11, 2021, and for Kazakhstan on April 12, 2021. On April 12, the EAPO Administrative Council approved and put into effect the Addenda

to the Patent Regulations (Part II. Industrial Designs is included) and an addendum to the Regulation on Fees (fees on applications and patents for industrial designs are established).

Admission of Eurasian applications for industrial designs started on June 1, 2021, and the first application was submitted by State Space Corporation ROSCOSMOS for the design of an astronaut's chair.

#### TREATY ON TRADEMARKS OF THE EAEU BECAME EFFECTIVE

On August 26, World Intellectual Property Day, the Treaty on Trademarks, Service Marks, and Appellations of Origin of the Eurasian Economic Union dated February 3, 2020, became effective.

The Treaty is a fundamental document for formation of a regional system of trademarks, service marks, and appellations of origin of the EAEU.

The Treaty, in particular, stipulates:

- Introduction of the concepts “EAEU trademark” and “EAEU appellation of origin,”
- A possibility to file one application for an EAEU trademark or one application for an EAEU appellation of origin to any patent office of the Union States subsequently obtaining legal protection in all EAEU countries simultaneously,
- An applicant's interaction with only one office—a one stop principle,
- Maintenance of the Unified Register of EAEU Trademarks and the Unified Register of EAEU Appellations of Origin posted on the official EAEU website.

So far, however, (in November 2021) it is not possible to file trademark applications though all regulating documents seem to have been adopted.

#### REGULATIONS AND FEES TO THE TREATY ON TRADEMARKS OF THE EAEU WERE APPROVED

On May 18, the Council of the Eurasian Economic Commission approved the Regulations to the Treaty on Trademarks, Service Marks, and Appellations of Origin of the Eurasian Economic Union dated February 3, 2020. The Regulations contain the rules necessary for performance of the said Treaty as well as standard forms of documents. In particular, the Regulations provide for a possibility to file an application on paper or as an electronic document.

A list of types of legal actions in registration, legal protection, and use of EAEU trademarks and EAEU appellations of origin, for which fees are charged, and fee rates were also approved.

The fees are established in Swiss francs.

## LAWS AND DRAFT LAWS

#### LAW ON 3D MODELS AND ELECTRONIC TITLES OF PROTECTION BECAME EFFECTIVE

**Federal Law No. 217-FZ dated July 20, 2020,**

On Amendments to Part IV of the Civil Code of the Russian Federation (on expanded use of electronic technologies when registering subject matters of intellectual property rights) became effective on January 17, 2021.

Now applicants can attach electronic 3D models of the claimed subject matter to application materials when

they file applications for an invention, utility model, industrial design, and trademark.

The law also makes it possible to obtain patents for inventions, utility models, and industrial designs in electronic form. At their wish, applicants still can obtain the same in hard copy as well.

#### MECHANISM OF USING INVENTIONS WITHOUT THE PATENT HOLDER'S CONSENT IS CHANGED

In the first half of 2021, two laws were adopted, which amended Part IV of the Civil Code, regulating a possibility to use patented inventions, utility models, and industrial designs without the patent holder's consent.

First, **Federal Law No. 107-FZ dated April 30, 2021** (became effective on May 11, 2021) adopted new wording of Article 1360 of the Civil Code on the use of an invention, a utility model, or an industrial design in the interests of national security.

As per this new wording, the Government may decide on use of a patented invention, a utility model, or an industrial design “*in extreme urgency related to the defense and security of the state and to the protection of the people's life and health.*” As per the previous wording of Article 1360 of the Civil Code, the Government could do so “*in the interests of defense and security*” only.

According to the law, the new wording of Article 1360 of the Civil Code makes it possible, if necessary, to promptly compensate for the lack or shortage in the country of patented medicines or medical devices required to protect people's life and health.

Second, **Federal Law No. 212-FZ dated June 11, 2021** (effective date is June 22, 2021), supplemented Part IV of the Civil Code with Article 1360.1 on the use of an invention for manufacture of a medicine for its export. The law is aimed at implementing the norms of Federal Law No. 184-FZ dated July 26, 2017, On Adoption of the Protocol Amending the Agreement on Trade-Related Aspects of Intellectual Property Rights.

The new article gives the Government the right to use the invention without the patent holder's consent for production of a medicine in Russia for its export to a country needing it.

Such a decision should comply with the terms and conditions of the international treaty (in particular, Article 31bis of the TRIPS Agreement) and contain information on the scope of manufacture of the medicine, while the package of the medicine manufactured in accordance with this decision of the Government should bear a special designation.

According to the law, the new article of the Civil Code allows Russia to arrange production of medicines on its territory based on the mechanism envisaged by such an article for their delivery to foreign countries at an affordable price in order to combat epidemics and other emergencies.

Both, in case of use in the interests of national security and in case of production for export, the decision of the Government should be accompanied by the relevant notice sent to the patent holder as soon as possible and payment of a pro rata compensation to him.

The Government should establish methods for determining the amount of the compensation and the procedure for its payment as well as, when using for export, the procedure for notifying the patent holder, the grounds and the procedure for taking a decision and determining the period of its validity.

**ON AUGUST 1, 2021, FEDERAL LAW NO. 262-FZ DATED JULY 31, 2020, ON AMENDMENTS TO PART IV OF THE CIVIL CODE BECAME EFFECTIVE**

The law introduces a procedure for preliminary information search and preliminary evaluation of patentability under applications for inventions and utility models engaging Russian specialized scientific and educational organizations accredited by Rospatent. Applicants can use the preliminary information search service at their discretion.

At the same time, they get additional opportunity to change the application materials after obtaining the results of such a search when submitting a request for substantive examination of the application. The results of the preliminary search and preliminary evaluation of patentability will be taken into account by Rospatent when conducting substantive examination of the application.

In addition, in accordance with the amendments to Article 1378 of the Civil Code, from August 1 it became possible to change an application for invention when submitting a request for substantive examination. Also, from August 1, due to the amendments to Article 1386 of the Civil Code, it became impossible to submit a request for an information search on an application for invention without conducting a substantive examination of the application.

**A DRAFT LAW ON CLARIFICATION OF THE PROCEDURE FOR COMPENSATION FOR INFRINGEMENT OF THE RIGHT TO A TRADEMARK WAS SUBMITTED TO THE STATE DUMA**

On January 25, 2021, the Government submitted to the State Duma a **draft law on amendments to Article 1515 of the Civil Code**, which clarifies the procedure for determining a compensation to the right holder for illegal use of a trademark (No. 1100176-7). The draft law was prepared in pursuance of resolution of the Constitutional Court No. 40-P dated July 24, 2020, regarding the case on constitutional review of Sub-clause 2 of Clause 4 of Article 1515 of the Civil Code. In accordance with the Civil Code, the right holder may, at his discretion, demand that the infringer pay a compensation instead of reimbursement of the losses. The compensation may amount to a double cost of the goods, on which the trademark is illegally placed, or a double value of lawful use of the trademark. This provision of the Civil Code was recognized by the Constitutional Court as partially non-compliant with the Constitution to the extent that it does not allow the court to reduce, taking into account the facts of a particular case, the compensation if such a compensation is many times more than the losses caused to the right holder. The Government proposes setting forth that, depending on the nature of infringement and other facts of the case, the compensation for infringement of the exclusive right to a trademark may be reduced by the court but it may not be less than the cost of the goods, on which the trademark is illegally placed, or the value of the right to use the trademark to be determined based on the price, which, under comparable circumstances, is usually charged for lawful use of the trademark. On May 18, the draft law was adopted by the State Duma in the first reading.

**GOVERNMENT BRINGS THE CIVIL CODE IN LINE WITH THE MARRAKESH TREATY**

On June 16, the State Duma received a draft law prepared by the Government on amendments to Article 1274

of the Civil Code (No. 1193643-7). The draft law is intended to bring the Russian law in line with the provisions of the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired, or Otherwise Print Disabled (hereinafter the “Marrakesh Treaty”), to which the Russian Federation acceded in 2018. Article 1274 of the Civil Code already provides for a possibility to use—with no intent to derive profit—works that are lawfully made public, without the right holder’s consent and without paying such a right holder a fee, by creating, reproducing, and distributing these works in special formats (using raised dots and other special methods) intended for use by those who are blind and visually impaired.

The draft law also establishes the possibility to import copies of such works and expands a range of beneficiaries of this regulation: in addition to those who are blind and visually impaired, persons who are otherwise print disabled as defined in the Marrakesh Treaty will also have the right of access to such copies.

The draft law also supplements Article 1274 of the Civil Code with a provision on the right of libraries and organizations determined by the Government and protecting the rights and interests of disabled persons to internationally exchange copies of the works created in special formats with competent authorities of foreign states.

**SUPREME COURT ON UNFAIR COMPETITION**

On March 4, 2021, the Plenum of the Supreme Court issued **resolution No. 2 On Certain Issues Arising Due to Application of Anti-monopoly Legislation by the Courts**.

Among other things, the resolution contains a section “prohibition of unfair competition”—Clauses 30 to 32. In this section, the Plenum clarified, inter alia, the following points: To prove the actual unfair competition, it is necessary to establish both specific features defined by the norms of Articles 14<sup>1</sup> to 14<sup>7</sup> of the Law on Protection of Competition and common features of unfair competition provided for by Clause 9 of Article 4 of this Law and Article 10-bis of the Paris Convention for the Protection of Industrial Property.

A list of forms of unfair competition is not exhaustive (Article 14<sup>8</sup> of the Law on Protection of Competition). When qualifying the actions of a specific person as an act of unfair competition based on Article 14<sup>8</sup> of the Law on Protection of Competition, the common features of unfair competition defined by Clause 9 of Article 4 of the Law on Protection of Competition and Article 10-bis of the Paris Convention for the Protection of Industrial Property should be evaluated.

**SUPREME COURT ON PRE-TRIAL SETTLEMENT**

On June 22, 2021, the Plenum of the Supreme Court issued **resolution No. 18 On Certain Issues of Pre-trial Settlement of Disputes Considered in Civil and Commercial Proceedings**.

Among other things, Clause 16 of the said resolution clarifies that, if the legislation establishes the minimum and maximum limits of compensation for infringement of the exclusive rights to the results of intellectual activity, which amount may be determined by the court (for example, Articles 1301, 1311, 1406<sup>1</sup>, and 1537 of the Civil Code, i.e., from 10,000 to 5,000,000 rubles), the pre-trial procedure for dispute settlement is considered to be complied with when the request contains an indication

of a specific substantive dispute related to the infringement of the claimant's rights and a proposal to the defendant to settle such a dispute. Also, Clause 30 of the Resolution of the Plenum of the Supreme Court clarifies the procedure and time limits for sending by the interested party to the trademark owner of a pre-trial proposal to abandon or to alienate the trademark as provided for in Clause 1 of Article 1486 of the Civil Code (on the consequences of trademark non-use). The proposal should be sent subject to the provisions of Article 165<sup>1</sup> of the Civil Code (on legal communications) to the address of the individual's registration at the place of residence or stay and to the individual engaged in entrepreneurial activities as an individual entrepreneur or a legal entity—to the address specified in the Unified State Register of Individual Entrepreneurs or in the Unified State Register of Legal Entities, respectively. In addition, the interested party's proposal should be sent also to all addresses specified in the State Register of Trademarks or in the relevant register provided for by the international treaty of the Russian Federation.

The sending of the proposal to these addresses evidences compliance with the pre-trial dispute settlement procedure, even in case such addresses are actually inaccurate (Clause 2 of Article 51, Clause 1 of Article 1232 of the Civil Code). Failure to comply with this procedure is the sending of the proposal by the interested party to only one of the addresses specified in Clause 1 of Article 1486 of the Civil Code; to the address not specified in the Unified State Register of Legal Entities or the State Register of Trademarks; via e-mail, but not to the postal address of the right holder; before the expiration of three years from the date of state registration of the trademark. At the same time, the court clarified that, if the actual receipt of the proposal from the interested party is confirmed (Clause 1 of Article 165<sup>1</sup> of the Civil Code), the non-observance of the procedure for its sending cannot evidence non-compliance with the mandatory pre-trial dispute settlement procedure. In case the interested party sent a proposal in violation of the procedure or time limits provided for in Clause 1 of Article 1486 of the Civil Code, new proposals may be sent without waiting for the expiration of the three-month period from the sending date of the previous proposal.

## GOVERNMENT ENACTMENTS AND DEPARTMENTAL ENACTMENTS

### RULES FOR REMUNERATION PAYMENT FOR EMPLOYEE INVENTIONS, UTILITY MODELS AND INDUSTRIAL DESIGNS WERE APPROVED

On January 1, 2021, Decree of the Government No. 1848 dated January 16, 2020, became effective, which approved the Rules for Payment of Remunerations for Employees' Inventions, Utility Models, and Industrial Designs. As per the new Rules (the previous ones were adopted in 2014), for the employer's use of an employee's invention, an employee's utility model, or an employee's industrial design, the employee who is the author of the same

should be paid a remuneration in the amount of three average salaries (previously, one salary) for the last 12 calendar months of such a development being in use. If the employer sells a license for the use of a patented employee's invention, utility model, or industrial design, the employee should be paid 10% of the license fees received by the employer; if the patent for the employee's invention, utility model, or industrial design is alienated, the employee should be paid 15% of the remuneration received by the employer. The Rules approved by the Government apply when there is no relevant agreement concluded between an employer and an employee on the amount of, conditions, and procedure for payment of such a remuneration. The Decree defines the period of validity of the Rules—until January 1, 2027.

### GOVERNMENT AMENDED REGULATION ON PATENT FEES

On June 17, 2021, decree of the Government No. 922 was adopted, which made some amendments to the Regulation on Fees Charged When Patenting Inventions, Utility Models, Industrial Designs and When Registering Trademarks, Geographical Indications, and Appellations of Origin. The amendments, first, are caused by the law adopted last year (No. 217-FZ dated July 20, 2020), under which an electronic form is determined to be the main form of a patent and a certificate issued by Rospatent.

A paper document should be issued upon a separate request of the applicant. Therefore, the Regulation on Fees provides for a fee amounting to 2,000 rubles for issuing a patent or a certificate on paper. These amendments became effective on June 21, 2021.

The decree of the Government also takes into account that, on August 1, the provisions of law No. 262-FZ dated July 31, 2020, will become effective, under which applicants will be able to apply to the organizations accredited by Rospatent for a report on preliminary information search and an opinion on evaluation of patentability of claimed inventions or utility models. The decree establishes that, when submitting such reports and opinions to Rospatent, a fee for a substantive examination of the application is reduced by half (by 50%). This amendment is effective from August 1, 2021. In addition, the decree changed the fee for the substantive examination of an application for invention. If, before the amendment, this fee depended on when (at the time of or after filing of an application) a request for a substantive examination was submitted, then, as a result of this change, a single amount of the fee for an examination is established, regardless of the time of submission of the request for such an examination: 12,500 rubles + 9,200 rubles for each independent claim exceeding 1. This amendment is also effective from August 1, 2021.

### GOVERNMENT APPROVED THE REGULATIONS ON ACCREDITATION OF ORGANIZATIONS CONDUCTING PRELIMINARY PATENT SEARCH AND PRELIMINARY PATENT EXAMINATION

The Government approved the Regulations on Accreditation of a Russian Scientific or Educational Organization by Rospatent as an Organization That Can Conduct a Preliminary Information Search on the Claimed Inventions or Utility Models and Preliminary Evaluation of Their Patentability (Decree of the Government No. 1202 dated July 15, 2021). The Regulations will become effective on March 1, 2022, and will remain in force until March 1, 2028.



In accordance with Clause 3 of Article 1246 of the Civil Code, the Regulations determine the requirements for an organization that can be accredited for conducting a preliminary patent search and preliminary evaluation of patentability, the procedure for its accreditation by Rospatent, and the grounds and procedure for terminating its accreditation.

The activities of the accredited organization should be carried out in the subject area of expertise corresponding to certain indexes of the International Patent Classification or the Cooperative Patent Classification. At least 2 permanent employees, one of whom has an academic degree or an academic rank in the relevant field of science, having at least 3 years of experience of scholarly work in the specified field of science and technology, should work at such an organization.

The organization should have access to specialized search databases that allow conducting patent searches in the minimum PCT documentation.

Employees who will conduct preliminary patent search and evaluation of patentability should pass an examination, during which it is checked whether they have the necessary knowledge of the legislation of the Russian Federation in the field of legal protection of inventions, utility models, and practical skills in conducting information search and evaluation of patentability of an invention or a utility model.

**THE COURT FOUND THE RECOMMENDATIONS ADOPTED BY ROSPATENT TO BE CONTRADICTING THE LAW ON PATENT ATTORNEYS IN THE PART ESTABLISHING THE RULES FOR CALCULATING THE WORK EXPERIENCE OF POTENTIAL PATENT ATTORNEYS (DECISION OF THE IP COURT DATED FEBRUARY 09, 2021, RESOLUTION OF THE PRESIDIUM OF THE IP COURT DATED JUNE 07, 2021, RULING OF THE SUPREME COURT DATED SEPTEMBER 27, 2021, ON CASE No. SIP-660/2020)**

In accordance with Clause 4 of Part 2 of Article 2 of Federal Law No. 316-FZ dated December 30, 2008, On Patent Attorneys, one of the requirements for candidates to acquire the patent attorney status is at least 4-year work experience as a patent attorney in accordance with the specialization, in which an individual wishes to be certified and registered as a patent attorney.

The twentieth paragraph of the Recommendations for the Preparation and Execution of Documents to Confirm Four-Year Work Experience as a Patent Attorney (approved by the Assessment Board of Rospatent on July 21, 2019) stipulates that, when calculating 4 years of work experience of a potential patent attorney in any of the specializations, the period of work after obtaining higher education should be taken into account.

Considering the Recommendations in this part to be contradicting the Law on Patent Attorneys, one of potential patent attorneys turned to the IP Court (hereinafter the “IP Court”) filing a claim to invalidate the Recommendations in this part.

Having considered the claim, the IP Court found that this provision of the Recommendations, where appropriate, actually served as a basis for Rospatent to refuse to admit to the qualifying examination. At the same time,

as pointed out by the court, the provisions of Part 2 of Article 2 of the Law on Patent Attorneys require the legal fact of obtaining higher education and the legal fact of four-year experience as a patent attorney and the Recommendations adopted by Rospatent establish in this part different rules for calculating work experience of candidates, i. e., contradict the law that prevails.

These facts established by the court allowed the IP Court to recognize the Recommendations in this part as inconsistent with the provisions of Part 2 of Article 2 of the Law On Patent Attorneys, which are clarified by them, and to be ineffective in this part from the date of their adoption. The Supreme Court, where Rospatent filed a cassation appeal, did not review the decision of the IP Court.

## DISPUTES OVER GRANTING AND TERMINATION OF LEGAL PROTECTION

**IP COURT SUPPORTED ROSPATENT IN THE DISPUTE OVER EXTENSION OF THE NOVARTIS PATENT (DECISION OF THE IP COURT DATED MAY 4, 2021, ON CASE No. SIP-766/2020)**

Novartis AG filed a claim with the IP Court to invalidate the Rospatent’s decision to **refuse extension of the validity period of the exclusive right to the invention** and patent No. 2400477 certifying this right.

In support of the asserted claims, the company states that Rospatent unlawfully did not establish the compliance of the scope of legal protection of the invention under patent of the Russian Federation No. 2400477 with the medicine Zikadia.

The company noted that the Procedure for Issue and Validity Period of an Additional Patent for Invention and Extension of the Patent for Invention approved by order of the Ministry of Economic Development No. 809 dated November 03, 2015 (hereinafter “Procedure No. 809”), does not contain a requirement that, for possible extension of the invention, the subject matter of which legal protection is a group of chemical compounds described by the general structural formula, the active substance should be expressly disclosed in the specification of the application with examples of its preparation and research for physicochemical properties and biological activity.

The court found the following facts:

In accordance with Sub-clause 7 of Clause 7 and Sub-clause 1 of Clause 8 of Procedure No. 809, in order to correctly resolve a disputable situation, the court should establish that the medicine specified in the application for extension of the validity period of the exclusive right to the invention, for which the approval was issued, was disclosed in the specification of invention and falls within the scope of legal protection provided by patent No. 2400477 as at the date of its priority. In order to check the validity of the reasons given by Rospatent and to establish the facts included in the fact to be proven in the case under consideration, the IP Court

engaged a specialist, who was asked a number of questions proposed by the company and Rospatent.

The specialist engaged to consult on the case confirmed the position of Rospatent that the relevant substance is not disclosed in the specification of patent No. 2400477. The specialist also confirmed the argument of Rospatent that there is no data in the specification of patent showing that the compound has such activity that allows its use in the medicine Zikadia.

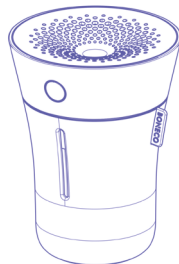
The court found that it does not appear from the specification of patent No. 2400477 that the claims characterize a product (a particular compound Ceritinib), which refers to the medicine Zikadia and for which the approval was obtained in accordance with the procedure established by the legislation of the Russian Federation.

The IP Court concluded that the Rospatent’s position that the updated claims for the additional patent (variants I and II) do not characterize the compound Ceritinib, which refers to the medicine Zikadia, for which the approval was obtained, which evidence that they were not identical, is grounded and, therefore, that Rospatent correctly applied Clause 8 of Procedure No. 809 and Clause 2 of Article 1363 of the Civil Code.

**FOREIGN TRADEMARK IN THE INDUSTRIAL DESIGN PREVENTS GRANTING LEGAL PROTECTION TO THE DESIGN (ROSPATENT’S DECISIONS No. 2020B04564 AND No. 2021B00066 DATED MARCH 24, 2021, ON INTERNATIONAL REGISTRATIONS OF INDUSTRIAL DESIGNS No. DM/102419 AND No. DM/205779)**

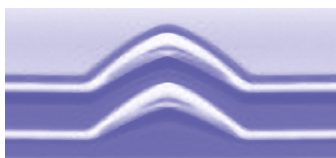


DM/102419



DM/205779

Images of the industrial design under international registration DM/102419 (Car) in the name of PSA AUTOMOBILES SA contained visual element matching the trademark under international registration No. 1109556 in the name



of AUTOMOBILES CITROËN, which, in the Rospatent’s opinion, prevents granting legal protection to the industrial design in Russia, since it may mislead the consumer (Sub-clause 2 of Clause 5 of Article 1352 of the Civil Code).

Objecting to the refusal to grant protection, the owner of the international registration of the industrial design, first, pointed out that the right holder of the trademark (Automobiles Citroën) and the applicant’s company (PSA Automobiles SA) are related companies and belong to one group of PSA Group companies.

Second, considering the disputable visual element as insignificant, the applicant provided the changed images of the industrial design, where there is no such an element.

Taking into account the changes made, Rospatent satisfied the objection and granted legal protection in the Russian Federation to the industrial design under international registration No. DM/102419



When conducting examination of the industrial design under international registration No. DM/205779 (Air Humidifier) in the name of BONECO AG, Rospatent established that the image of the industrial design includes the verbal designation “BONECO,” which makes the same general impression as the trademark of another entity, protected in the Russian Federation in relation to similar goods of Class 11 and having an earlier priority,—the trademark under Russian certificate No. 426526 registered in the name of PLASTON AG.

This fact, according to Rospatent, prevents granting protection to the industrial design, since it will mislead the consumer (Sub-clause 2 of Clause 5 of Article 1352 of the Civil Code).



Trademark No. 426526

Objecting to the refusal to grant legal protection, BONECO AG reported that the applicant had become the right holder of trademark No. 426526 as a result

of the assignment of the exclusive right to such a trademark. Taking into account this fact, Rospatent satisfied the objection and granted legal protection in the Russian Federation to the industrial design under international registration No. DM/205779.

**SWATCH AG (SWITZERLAND) FAILED TO CHALLENGE THE GRANTING OF LEGAL PROTECTION TO THE TRADEMARK “iWATCH” REGISTERED BY APPLE INC. (USA) (DECISION OF ROSPATENT (CHAMBER FOR PATENT DISPUTES) No. 2019B03159 DATED MARCH 11, 2021)**



Trademark № 586910

Swatch AG based its appeal against the registration of trademark No. 586910

with the following grounds:

- The mark is confusingly similar to the Swatch AG’s series of trademarks under international registrations Nos. 469696, 614932, 508191, 496846, 506123, 962366, 962367, (in violation of Clause 6 of Article 1483 of the Civil Code);



Trademark № 469696



Trademark № 614932



Trademark № 508191



Trademark № 496846



Trademark № 506123



Trademark № 962366



Trademark № 962367

- The mark is descriptive in relation to the goods in Classes 09 and 14 of the ICGS (in violation of Clause 1 of Article 1483 of the Civil Code).

Rospatent dismissed the appeal filed by Swatch AG and retained the legal protection of the trademark “iWatch”. With regard to the distinctiveness of the registered designation with regard to the goods in Classes 9 and 14 of the ICGS, Rospatent noted the following points. The prefix “i” in the designation before the word “Watch” leads to a certain change in the semantics of the word “watch” within this designation.

In general, the designation individualizes the watch produced by Apple Inc. functioning as a high-tech portable electronic device (“iWatch”), which belongs to the line of innovative high-tech products of the company well known in Russia (“iPhone,” “iPad,” “iPod,” “iMac”), which already routinely used by a large number of Russian consumers identifying these products of the company by the prefix “i,” which is always present in their names. Due to the long and intensive use of the mark by its right holder, the disputed designation is clearly associated with Apple Inc. and the relevant line of its products in the Russian market. With regard to the similarity of the mark to the series of the appellant’s marks, Apple Inc., in its response to the appeal, noted that during the consideration of application No. 2013718527, under which the disputed trademark was registered, this issue had already been considered by Rospatent (decision No. 2015B01407 dated March 22, 2016), and Rospatent established the lack of confusing similarity between the designation iWatch and the opposed trademarks of Swatch AG.

Rospatent found that marks Nos. 469696, 614932, 508191, 496846, and 506123 are, in fact, the word “SWATCH,” which is an English lexical unit meaning “a sample of cloth; a collection of samples; a collection of samples of cloth; a characteristic sample of something; a typical representative; a patch; a small collection; a sample, a copy; a group; a portion.” The marks under international registrations Nos. 962366 and 962367 are the same word “SWATCH,” but are preceded by the letters “i” or “e”, respectively, in a graphically different original (bold) font, which do not change the semantics of the word “SWATCH” executed in a different graphic manner.

The comparative analysis of the trademark “iWatch” and the marks under international registrations Nos. 469696, 614932, 508191, 496846, 506123, 962366, and 962367 conducted by Rospatent showed that they, in the Rospatent’s opinion, have completely different meaning because of the word “SWATCH” having the above semantics. In addition, the marks under comparison differ in sounds, and they also make a different general visual impression, due to different font style and different composition of letters.

In the Rospatent’s opinion, the semantic factor that causes the dissimilarity between the designations under comparison that have certain semantic meanings and (or) cause certain semantic associations.

Taking into account the well-known reputation in Russia of the applicant’s product line (“iPhone,” “iPad,” “iPod,” “iMac,” and “iWatch”) identified by the prefix “i,” which is always present in its name, is crucial for their perception in general.

Rospatent did not find it, in principle, possible for a Russian consumer to have an idea that similar goods, to identify which the trademarks under comparison are designed, belong to one manufacturer.

Thus, disputed trademark No. 586910 and the opposed marks under the international registrations are not confusingly similar for similar goods.

**THE NAMES OF SAINTS AND FEELINGS OF BELIEVERS WERE THE SUBJECT MATTER OF CONSIDERATION BY ROSPATENT AND THE IP COURT (DECISIONS OF ROSPATENT (CHAMBER OF PATENT DISPUTES) No. 2020B03605 AND 2020B03606 448104 DATED FEBRUARY 05, 2021, DECISION OF THE IP COURT DATED AUGUST 19, 2021, ON CASE SIP-181/2021)**

Trademarks No. 196200 (priority dated April 21, 2000) and No. 448104 (priority dated March 11, 2010) were registered in the name of a Russian legal entity, including

**SAINT-VINCENT St. Vincent**

Trademark № 196200

Trademark № 448104

in relation to goods in Class 33.

An interested party filed an objection to granting of protection to the said marks for the reasons, inter alia, of non-compliance of registration with the requirements of Sub-clause 2 of Clause 3 of Article 1483 of the Civil Code, since the registration of the name of Saint Vincent for alcoholic beverages contradicts moral principles.

Considering that the parties to the dispute presented various contradictory evidence regarding the reasons for challenging and that the dispute had a clear religious basis. Rospatent used Clause 43 of the Rules of the Chamber of Patent Disputes, as per which it was established that “when considering the dispute, the collegium may request the opinions of independent experts in the area corresponding to the subject matter of the dispute” and turned to the religious spiritual educational organization of higher education Moscow Theological Academy of the Russian Orthodox Church approaching Mikhail Anatolyevich Tikhonov (Bishop of Zvenigorod Theodorite) in order to obtain an independent opinion as to whether the disputed trademark offends the religious feelings of believers or not.

As per the letter of the Legal Department of the Moscow Patriarch’s Office and the opinion of the Moscow Theological Academy, “the application of images or names of saints to certain products, including alcoholic beverages, can be regarded as an action intended to offend the religious feelings of believers.

The feelings of believers are the reverence of a person for what is sacred to him in accordance with his religious convictions, and such a sacred thing to the person is undoubtedly his religious convictions, the articles of religion, the personalities and deeds of saints, as well as the sacred images and texts, any other religious items, places of religious veneration (pilgrimage).

The use of the name of a saint recognized by a religious denomination registered in accordance with the established procedure or of his image cannot be the exclusive right of any individual or legal entity that is not a religious organization or not established by it. Registration of trademarks containing the names of alcoholic beverages, which can be attributed to church semantics, offends the feelings of believers...

Religious organizations may freely use the religious symbols of the religion to which they belong. However, the religious symbols should not be subject to state registration.” The opinion of the Moscow Theological Academy supported by the Legal Department of the Moscow Patriarch’s Office concluded: “Holy martyr Vincent (November 24, 304) is venerated by the Orthodox and Catholic faiths.

In this regard, no registration of the trademark containing the words “St. Vincent” or “SAINT VINCENT” is allowed.” Taking into account those opinions, the collegium concluded that the legal protection of the trademark under certificates No. 196200 and No. 448104 was granted in violation of the requirements of the Law, since it offends religious feelings and contradicts the public interests, the principles of humanity and morality.

As a result of consideration of the objections, Rospatent canceled the said trademarks.

The trademark owner, who disagreed with the Rospatent’s decisions, filed a claim with the IP Court to invalidate the Rospatent’s decisions (cases No. SIP-179/2021 and No. SIP-181/2021).

Within case SIP-181/2021, having also requested the opinion of specialists about “Saint Vincent” and having analyzed the evidence presented by the parties during the consideration of the dispute in Rospatent, the court concluded that Rospatent did not properly investigate the real meaning of the disputed designation (SAINT VINCENT). The findings of the administrative body in this part do not take into account the cumulative evidence and do not correspond to really existing expertise on this issue. The conclusion of Rospatent that the disputed designation can offend the feelings of believers is based on single evidence, which is evaluated by the court critically, since it is refuted by other evidence submitted to the files of the case, including the opinions of specialists.

The said conclusion of the administrative body is made without investigating and evaluating other evidence submitted to the files of the case as well as without taking into account the actual content of the public interests and principles (in particular, religious ones), which allegedly could be violated through the use of the disputed designation, and without taking into account the will of the right holder to reduce the list of goods individualized by the disputed designation.

As a result, the IP Court invalidated the Rospatent’s decision and obliged Rospatent to reconsider the objection to trademark No. 196200.

A court hearing on similar case No. SIP-179/2021 regarding invalidation of trademark No. 448104 is scheduled for December 01, 2021.

**SEGWAY HAS NO DISTINCTIVENESS  
IN RUSSIA (DECISION OF THE IP COURT  
DATED APRIL 28, 2021, ON CASE  
No. SIP-904/2020)**

Segway Inc. (USA) turned to Rospatent for registration of the designation SEGWAY as a trademark. Rospatent refused the application, since, in the Rospatent’s opinion, the word “segway” lost its distinctiveness.

The applicant appealed the Rospatent’s decision with the IP Court, stating the following points in its appeal.

The designation is not perceived as a term, while there is no word “SEGWAY” in the dictionaries of terms, and it is a word invented by the applicant. The Internet resources, based on which Rospatent drew its conclusions, relate to online stores, but not to manufacturers of goods.

The designation “SEGWAY” was registered as a trademark by the patent offices of Kazakhstan, the United States of America, Japan, Indonesia, the United Kingdom, in all 28 countries of the European Union. Also, legal protection was granted to the trademark under international registration No. 1479885 in Belarus, Colombia, India, Monaco, Namibia, the Philippines, and Serbia.

Previously, the trademark SEGWAY had been already registered in Russia, but the exclusive right to it expired. When dismissing the appeal, the IP Court stated the following points.

The use of products of various companies referred to as “segways,” “mini segways,” “rudderless segways,” and “segway accessories” along with hoverboards, bicycles, etc. in the Internet catalogs evidences the use of such a designation as a specific name and the loss of its distinctiveness.

The fact that Rospatent referred to the websites of online stores, rather than to manufacturers of goods, does not deny the correctness of Rospatent’s conclusions about the loss of distinctiveness (in online stores, segways are a category of goods along with bicycles and hoverboards). Although Rospatent unreasonably classified the disputed designation as a term, the erroneous conclusion of Rospatent has no effect on the legality of its decision to refuse to register the trademark.

Granting legal protection to the designation in other states does not mean its mandatory protection in Russia.

The actual grant of legal protection to the trademark SEGWAY earlier does not change the decision, since the records for each application are managed separately, taking into account the actual facts.

As a result, the IP Court recognized the refusal of Rospatent to grant protection to the designation “SEGWAY” as lawful and dismissed the appellant’s claims.

**THE FACT OF THE EXISTENCE  
OF THE EXCLUSIVE RIGHT TO THE SUBJECT  
MATTER OF COPYRIGHT AND OTHER  
ACTUAL FACTS REQUIRED TO APPLY  
SUB-CLAUSE 1 OF CLAUSE 9 OF ARTICLE  
1483 OF THE CIVIL CODE SHOULD  
BE ESTABLISHED IN THE CONTEXT  
OF THE ADVERSARIAL PROCEDURE  
OF THE DISPUTE CONSIDERATION  
ALLOWING ITS PARTIES TO PRODUCE  
EVIDENCE, MAKE ARGUMENTS  
AND OBJECTIONS. THE STATE AUTHORITY  
CANNOT REPLACE THE PARTY TO THIS  
DISPUTE WITH ITSELF (RESOLUTION  
OF THE PRESIDUM OF THE IP  
COURT ON CASE No. SIP-479/2020  
DATED FEBRUARY 18, 2021, RULING  
OF THE SUPREME COURT No. 300-ES21-  
7871 DATED JULY 20, 2021)**

Rospatent refused to register the designation as a trademark and reasoned its refusal, among other things, by the fact that the phrase “the Barber of Siberia” included in the claimed designation is identical to the name of the known work—the movie directed by Nikita Mikhalkov. Rospatent considered such registration to contradict Clause 3 and Sub-clause 1 of Clause 9 of Article 1483 of the Civil Code. The applicant challenged the Rospatent’s decision in the IP Court.



**СИБИРСКИЙ  
ЦИРЮЛЬНИК**

The IP Court recognized the Rospatent’s conclusion on non-compliance of the designation claimed for registration with the provisions of Clause 3 of Article 1483 of the Civil Code of Russia as not grounded on the norms of the current

legislation, since Rospatent did not prove that, due to inclusion of the word element “the Barber of Siberia” in the designation, the consumer may be misled with regard to the person providing services in classes 35, 41, and 44 of the ICGS or may think that it is used upon Nikita Mikhalkov’s consent.

The IP Court also pointed out that, in accordance with Sub-clause 1 of Clause 9 of Article 1483 of the Civil Code, restrictions on registration of trademarks identical to the names of known works are set forth for the benefit of right holders and their successors, that is why the persons entitled to file objections to granting legal protection to a trademark for such a reason are only the right holders of the works known in the Russian Federation and their successors.

As per Clause 1 of Article 1499 of the Civil Code, during the examination of the claimed designation, it is not subject to check for its compliance with the requirements of Sub-clause 1 of Clause 9 of Article 1483 of the Code, but is checked only for compliance with the requirements of Article 1477 and Clauses 1 to 7, Sub-clause 3 of Clause 9 (with regard to industrial designs), Clause 10 (with regard to means of individualization and industrial designs) of Article 1483 of the Civil Code.

**Thus, the ground given in Sub-clause 1 of Clause 9 of Article 1483 of the Civil Code is not subject to check by Rospatent either at the stage of examination of the application (Clause 1 of Article 1499 of the Code) or at the stage of challenging the refusal to register the trademark, since this stage consistently follows from the stage of consideration of the application. To check the compliance of the claimed designation with the requirements of Sub-clause 1 of Clause 9 of Article 1483 of the Civil Code, the law provides for another legal mechanism and another procedure that correspond to the substance of the interest protected by this norm — challenging of an already registered trademark by an interested party by submitting an appropriate objection (Sub-clause 1 of Clause 2 of Article 1512, Clauses 1 and 2 of Article 1513 of the Code).**

The fact of the existence of the exclusive right to the subject matter of copyright and other actual facts required to apply Sub-clause 1 of Clause 9 of Article 1483 of the Civil Code should be established in the context of the adversarial procedure of the dispute consideration allowing its parties to produce evidence, make arguments and objections. The state authority cannot replace the party to this dispute with itself.

The IP Court invalidated the Rospatent’s decision and obliged it to register the claimed designation as a trademark. Rospatent filed a cassation appeal with the Supreme Court, but the Supreme Court did not review the decision of the IP Court.

**PATENT HOLDER’S EXPENSES INCURRED BY HIM IN A LEGAL CASE WITH ROSPATENT OVER THE INVALIDATION OF THE PATENT CAN BE RECOVERED FROM THE APPELLANT AGAINST THE PATENT (RESOLUTION OF THE PRESIDUM OF THE IP COURT DATED MARCH 01, 2021, ON CASE NO. SIP-685/2017, RULING NO. 300-ES19-4135 OF THE SUPREME COURT DATED JULY 01, 2021)**

The patent holder challenged the Rospatent’s decision to invalidate its patent in the IP Court rendered upon

the appeal filed with Rospatent by the Company (case No. SIP-685/2017). The Company was brought by the court into the proceedings as a non-party intervener.

The dispute lasted more than three years; 17 court hearings were held.

As a result, the IP Court invalidated the Rospatent’s decision and obliged it to renew the patent.

Upon the patent holder’s application, the court recovered legal expenses of the claimant from Rospatent and the Company: 125,000 rubles from Rospatent and 2,250,000 rubles from the Company.

The Company filed a cassation appeal against the court ruling on the apportionment of legal expenses in the case.

The Company pointed out that the immediate reason for the Patent Holder turning to the court was the adoption by Rospatent of the disputed decision, the compliance of which with the law was to be proved by Rospatent.

Therefore, in the opinion of the cassation appellant, the court expenses for consideration of the claim in the court of first instance should be recovered from Rospatent and cannot be charged to a third party, since the filing of an appeal against a patent is provided for by the current law.

By dismissing the cassation appeal, the IP Court noted the following points.

Not only the parties to the relevant dispute, but also other persons, including non-party interveners, are included in the parties of the relations for reimbursement of legal expenses.

Having got the opportunity to enjoy procedural rights, a third party also assumes procedural duties, one of which is the duty to reimburse legal expenses.

The third party may be obliged to reimburse the legal expenses incurred as attorney’s fees by the other party to the case, provided that there are grounds to do so. The IP Court reminded the position of the Supreme Court, according to which, if the actions of a third party resulted in an increase in the legal expenses of other parties to the case, such a third party is obliged to reimburse them to the relevant extent.

Thus, the procedural conduct of the parties to the case, which contributes to the increase in the legal expenses, is a ground for charging such expenses to the relevant extent to a particular person.

At the same time, contrary to the Company’s arguments, the procedural status of the party to the case (a party or a non-party intervener) does not itself determine that the legal expenses incurred in connection with the consideration of the case are basically charged exactly to the party, not to the third party.

When apportioning legal expenses, the court took into account the fact that a considerable number of written representations were submitted by the Company during the consideration of the dispute, to which the Patent Holder had to respond by submitting appropriate objections.

At the same time, the Patent Holder’s objections related only to the arguments and evidence of the Company, for which reason the expenses for their preparation should not be charged to Rospatent.

Based on the foregoing, the IP Court reasonably concluded that the increase in the Patent Holder’s legal expenses was due precisely to the active procedural actions of the Company, not of Rospatent.

The Supreme Court refused to review the resolution of the Presidium of the IP Court.

# DISPUTES OVER INFRINGEMENT OF THE EXCLUSIVE RIGHT

**CONSTITUTIONAL COURT ON COMPENSATION OF THE DEFENDANT'S COURT COSTS IN PARTIAL SATISFACTION OF THE DISPUTE OVER THE INFRINGEMENT OF THE RIGHT TO THE TRADEMARK (RULING NO. 1622-O DATED JULY 20, 2021, CASE No. A40-104559/2019)**

The commercial court satisfied in part the claims of the right holder of the trademark (Hyundai Motor Company) to recover from the defendant a compensation for infringement of the exclusive right to the trademark: the claimed compensation (500,000 rubles) was reduced by the court to 50,000 rubles as part of the compensation provided for by Clause 4 of Article 1515 of the Civil Code. Later the defendant filed a claim with court to recover from the claimant legal expenses incurred as the attorney's fees amounting to 170,000 rubles. By the ruling of the commercial court, the claim was satisfied in part: 17,000 rubles were recovered.

At the same time, the court pointed out, in particular, that the imposition on the claimant being the person, whose right was infringed, the duty to pay the defendant the amount of the legal expenses, which is several times higher than the compensation recovered from the defendant for his infringement, does not comply with the requirements for justice, equality, and balance of the parties' rights and legitimate interests.

The defendant turned to the Constitutional Court with a claim challenging the constitutionality of Part 1 of Article 110 "Apportionment of Legal Expenses between the Parties to the Case" of the Commercial Procedure Code and Clause 4 of Article 1515 "Liability for the Illegal Use of the Trademark" of the Civil Code. In the opinion of the claiming defendant, the challenged legal provisions contradict Articles 19 (Part 1), 46 and 48 of the Constitution, since they do not allow the defendant in the dispute over the protection of intellectual rights to exercise his right to reimbursement of legal expenses to the extent exceeding the amount of compensation recovered from him.

When refusing to accept the claim for consideration, the Constitutional Court pointed out that the criterion for adjudging legal expenses when making the decision is the conclusion of the commercial court on whether the claim asserted by the claimant is lawful or unlawful. In its turn, such a conclusion is directly associated with the conclusion of the commercial court contained in the judgment (Part 5 of Article 170 of the Commercial Procedure Code) on whether the claim should be satisfied, including in part, since only satisfaction of the claim by the commercial court confirms that its enforcement (or enforcement of its part) by the court is lawful and results in restoration of the infringed rights and freedoms, which, by virtue of Articles 19 (Part 1) and 46 (Parts 1 and 2) of the Constitution leads to required reimbursement for legal expenses.

This is also reflected in the rules for the apportionment of legal expenses between the parties to the case as

established by Part 1 of Article 110 of the Commercial Procedure Code. At the same time, this rule does not exclude the duty of the commercial court, when deciding on reimbursement of legal expenses incurred by a party as attorney's fees, to assess such expenses from the point of view of their necessity, justifiability, and reasonability as well as based on the tasks assigned to the commercial court to make a fair and just decision, taking into account that no one may benefit from his illegal or bad-faith conduct (Clause 4 of Article 1 of the Civil Code). This is also the basis for the law enforcement practice of commercial courts (Clause 47 of Review of the Court Practice of the Supreme Court No. 2 (2020) approved by the Presidium of the Supreme Court on July 22, 2020).

This legal regulation, being one of the legal methods provided for by law to establish a balance between the procedural rights and duties of the parties to the case, thereby contributes to the implementation of the requirements of Article 17 (Part 3) of the Constitution of the Russian Federation.

Thus, Part 1 of Article 110 of the Commercial Procedure Code of the Russian Federation and Clause 4 of Article 1515 of the Civil Code of the Russian Federation, which does not regulate the apportionment of legal expenses, may not be considered as infringing the constitutional rights of the claimant in the respect specified by him.

**PRICE OF THE LICENSING AGREEMENT CANNOT BE AUTOMATICALLY USED WHEN CALCULATING COMPENSATION FOR INFRINGEMENT OF EXCLUSIVE RIGHTS (CLAUSE 31 OF REVIEW OF THE SUPREME COURT NO. 2 (2021): PRACTICE OF APPLICATION OF THE LEGISLATION ON RIGHTS TO RESULTS OF INTELLECTUAL ACTIVITY AND MEANS OF INDIVIDUALIZATION; RULING OF THE SUPREME COURT NO. 310-ES20-9768 DATED JANUARY 26, 2021, ON CASE A48-7579/2019)**

A company filed a statement of claim with the commercial court against an entrepreneur for recovery of 180,000 rubles as a compensation for the infringement of the exclusive right to trademark No. 289416 at a double rate of the value of the right to use the trademark.

By the decision of the court of first instance, the claim was satisfied in part. The court reduced the compensation to be recovered to 10,000 rubles, taking into account the legal position set out in resolution of the Constitutional Court of the Russian Federation No. 28-P dated December 13, 2016.

The decision of the court of first instance was changed by the resolution of the commercial court of appeal upheld by the resolution of the IP Court; the claims were satisfied in full. The courts considered that there is no ground for decreasing the compensation below the minimum limit—there is no simultaneous infringement of the exclusive rights to several intellectual property subject matters as the claimant filed a claim for protection of the exclusive right to one trademark.

The Collegium on Economic Disputes of the Supreme Court of the Russian Federation reversed the judgments and remanded the case for a new trial to the court of first instance on the following grounds.

At the same time, the Supreme Court pointed out that in accordance with Clause 4 of Article 1515 of the Civil

Code, the right holder may demand, at his discretion, that the infringer pay compensation at a double rate of the value of the right to use the trademark as determined based on the price that, under comparable circumstances, is usually charged for lawful use of the trademark, instead of reimbursement of losses.

As per the explanations set out in Clause 61 of resolution of the Plenum of the Supreme Court of the Russian Federation No. 10 dated April 23, 2019, asserting the claim for recovery of compensation at a double rate of the value of the right to use, the claimant should provide a calculation and substantiation of the amount to be recovered as well as the documents confirming the value of the right to use. At the same time, the defendant's arguments on disagreement with the claimant's calculation of the compensation may be based on challenging the license price specified by the claimant.

The court determines the compensation within the limits established by law, depending on the nature of infringement and any other facts of the case, taking into account reasonability and justice requirements. Taking into account the nature of the infringement committed and the defendant's financial straits, if there is a relevant statement from him, the court may reduce the compensation below the amount established by Sub-clause 2 of Clause 4 of Article 1515 of the Civil Code. This legal position is reflected in resolution of the Constitutional Court of the Russian Federation No. 40-P dated July 24, 2020.

Submission to the court of a licensing agreement (other agreements) does not imply that compensation in all cases should be determined by the court at a double rate of the price of the specified agreement (the value of the right to use), since, taking into account the norms of Clause 4 of Article 1515 of the Civil Code, the basis for the calculated compensation should be the price that is usually charged for lawful use of the relevant trademark under comparable circumstances in the manner used by the infringer.

The defendant may challenge the compensation calculated based on the licensing agreement by substantiating a different value of the right to use the relevant trademark in view of the substance of the infringement, the terms and conditions of this agreement, or other evidence, including other licensing agreements and the opinion of an independent appraiser.

If the compensation is calculated by the claimant based on the licensing agreement submitted by him, the court correlates the terms and conditions of this agreement and the circumstances of the infringement: the term of the licensing agreement; the scope of the right granted; the methods of using the right under the agreement and the method of the infringement; the list of goods and services for which the right of use is granted and in relation to which the infringement is committed; the territory where the use is allowed (the Russian Federation, the constituent entity of the Russian Federation, or other territory); other circumstances.

Therefore, the commercial court may determine a different value of the right to use the relevant trademark in the manner and to the extent used by the infringer, and, respectively, a different compensation as compared to that asserted by the claimant.

If the compensation is determined by the court based on the value of the right to use as established by the court, which appeared to be less than that asserted by the claimant, then the determination by the court of the compensa-

tion at a double rate of the value of the right, which is lesser than the asserted claim, does not constitute a decrease in the compensation.

**REGARDING INADMISSIBILITY  
OF A SITUATION WHERE  
THE COMPENSATION RECOVERED  
IS SIGNIFICANTLY LOWER THAN  
THE NECESSARY EXPENSES INCURRED  
BY THE RIGHT HOLDER WHEN HANDLING  
THE CLAIM UNDER CONSIDERATION  
(RESOLUTION OF THE IP COURT DATED  
FEBRUARY 04, 2021, AND RESOLUTION  
OF THE 11TH COMMERCIAL COURT  
OF APPEAL DATED MARCH 31, 2021,  
ON CASE No. A65-37557/2019)**

A Company filed a claim with the Commercial Court for recovery of 180,000 rubles from an individual entrepreneur (hereinafter the "Defendant") as a compensation for the infringement of the exclusive rights to trademark No. 289416 (based on a double rate of the value of the right to use).

The court of first instance satisfied the claim in part by recovering from the defendant 10,000 rubles in favor of the Company as a compensation for the infringement of the exclusive rights to the trademark.

The court of appeal changed the decision and recovered from the Defendant a compensation for the infringement of the exclusive right to the trademark in favor of the Company in the amount of 154 rubles 12 kopecks.

The IP Court reversed the resolution of the court of appeal and remanded the case for a new trial to the court of appeal.

During the reconsideration, the court of appeal concluded that there were no grounds to reverse the decision of the court of first instance.

The claimant filed a claim for recovery of compensation in the amount of 180,000 rubles based on Clause 2 of Article 1515 of the Civil Code, namely, at a double rate of the value of the right to use the trademark as determined based on the price that, under comparable circumstances, is usually charged for legal use of the trademark.

In support of the claims, the claimant submitted a licensing agreement dated October 01, 2016, with regard to trademark No. 289416, concluded by the Company with another person and valid until July 22, 2024.

By reducing the amount of compensation to 10,000 rubles, the court of first instance proceeded from the fact that it was not deprived of the opportunity to determine the compensation using different methods established by the norms of the current law, including by applying the norms of Clause 1 of Article 1515 of the Civil Code to the legal relations in dispute.

At the same time, the court of first instance noted that the application of this norm does not evidence a decrease in the compensation but helps to correlate the offense with an adequate liability for infringement of the rights of the claimant, who did not prove the amount of the value of the right to use the trademark.

In the same decision, the court of first instance came to the conclusion that in this case there are facts specified in resolution of the Constitutional Court of the Russian Federation No. 28-P dated December 13, 2016, to reduce the compensation, namely: the offense was committed by an individual entrepreneur for the first time, the use of intellectual property, the rights to which belong to other

persons, in violation of these rights is not substantial part of his business activities, it is not gross (the seller was not consciously aware of the counterfeit nature of the products sold by him), the entrepreneur previously did not commit similar infringements, including in relation to the claimant's rights.

The amount claimed was recognized by the court of first instance to be excessive, contradicting the principles of reasonability and justice, having "punitive" nature, and not meeting the requirements for liability differentiation depending on all relevant circumstances.

Taking into consideration this fact, taking into account the insignificant degree of the defendant's guilt, the nature and consequences of the infringement, the insignificant price of the goods, based on the principles of justice and compensation adequacy to the infringement consequences as well as taking into account the fact that the defendant sold only one item of the counterfeit goods, the court concluded that the recovery from the defendant of compensation in the amount of 10,000 rubles in favor of the right holder would be just, since this compensation amount would be adequate to the circumstances of the offense and would be aimed at restoring the infringed right.

The court of appeal disagreed with this approach.

The court of appeal pointed out that, contrary to the explanations set out in Clause 35 of the Review of Court Practice in Cases Related to the Resolution of Disputes over Intellectual Rights Protection approved by the Presidium of the Supreme Court on September 23, 2015 (hereinafter the Review dated September 23, 2015) and in Clause 59 of resolution of the Plenum of the Supreme Court No. 10 dated April 23, 2019, the court of first instance arbitrarily changed the type of compensation from the one chosen by the claimant and established by Sub-clause 2 of Clause 4 of Article 1515 of the Civil Code to the one provided for by Sub-clause 1 of Clause 4 of the same Article of the Code without a statement from the entrepreneur.

**Method of compensation chosen by the claimant implies proving and determining, during the consideration of the legal case, the value of the right to use the trademark as determined based on the price that, under comparable circumstances, is usually charged for lawful use of the trademark.**

The court of appeal takes into account the point of the IP Court in this case that the duration of use of the trademark under the license cannot be one day, since such a period does not correspond to the period for which the license is usually granted. Taking into consideration that the duration of the reporting period of the licensing agreement is set in months, the court of appeal takes one month as the period for which the right to use the result of intellectual activity may be granted.

In addition to the duration of use of the exclusive right and the quantity of goods marked with the trademark, other criteria should be also counted, based on which the price is determined, which, under comparable circumstances, is charged for lawful use of the intellectual property subject matter, in particular: the scope of the right granted; the methods of using the right under the agreement and the method of the infringement; the list of goods and services for which the right of use is granted and in relation to which the infringement is committed; the territory where the use is allowed.

The licensing agreement dated October 01, 2016, granted the licensee the right to use the trademark in the Rus-

sian Federation for all goods included in classes 07, 09, 12, and 20 of the ICGS using various methods provided for by law.

The court of appeal noted that, in the case under consideration, an individual entrepreneur engaged in retail trade infringed the right to the trademark by selling the goods bearing the image of the claimant's trademark; the claimant's rights were infringed in one city of one of 85 regions of the Russian Federation; the trademark was used when selling one item of product.

Taking into account the above facts, the compensation calculated based on Sub-clause 2 of Clause 4 of Article 1515 of the Civil Code would be significantly lower than the expenses incurred by the claimant when filing the claim under consideration with the commercial court.

At the same time, the court of appeal takes into account that, in his response to the appeal, the defendant considered it correct to uphold the decision of the court of first instance, thereby agreeing to the compensation amounting to 10,000 rubles.

Taking into account the defendant's position, as well as taking into account the point of the court of cassation in this case on inadmissibility of a situation where the compensation recovered is significantly lower than the necessary expenses incurred by the right holder when handling the claim under consideration, the court of appeal determines the compensation to amount to 10,000 rubles.

**SALE OF COUNTERFEIT GOODS ITSELF IS NOT A GROUND FOR RECOVERY OF THE LOST PROFIT FROM THE INFRINGER IN FAVOR OF THE RIGHT HOLDER. THE LATTER SHOULD PROVE THAT, IN ORDINARY COURSE OF BUSINESS, HE WOULD HAVE RECEIVED A PROFIT IN THE RELEVANT AMOUNT (RULING OF THE SUPREME COURT NO. 309-ES17-15659 DATED APRIL 13, 2021, ON CASE A34-5796/2016).**

The Company turned to the commercial court filing a claim against the Enterprise for recovery of losses in the form of lost profit caused by the infringement of the Company's exclusive right to the utility model "Throttle Valve" under patent of the Russian Federation No. 55066.

The claiming Company considered as losses in the form of lost profit the income gained by the Defendant from the sale of counterfeit products under agreements concluded by the Defendant based on the tender results. The court of first instance and the court of appeal dismissed the claim.

The IP Court reversed the decisions of the inferior courts and remanded the case for a new trial.

Having disagreed with this decision of the IP Court, the Defendant filed a cassation appeal with the Supreme Court.

When reversing the resolution of the IP Court and upholding the decisions of the court of first instance and the court of appeal, the Collegium on Economic Disputes of the Supreme Court stated the following points.

When dismissing the claim, the court of first instance and the court of appeal proceeded from the claimant's failure to prove the set of conditions necessary to recover losses from the defendant in the form of lost profit in the claimed amount.

When reversing the judgments rendered in the case and remanding the case for a new trial, the IP Court



disagreed with the conclusions of the courts that, when the exclusive right is infringed, its holder would incur losses only if the agreement with the purchaser of the goods was concluded with the right holder as a successful bidder.

The IP Court pointed out that the dismissal of the right holder's claims when found that the defendant actually infringed the right holder's right evidences an ungrounded limitation of the right holder's judicial protection.

At the same time, the IP Court noted that the market launch of counterfeit goods naturally entails a decrease in the right holder's income, therefore, his lost profit as a result of the infringement of the exclusive right by the defendant is a normal consequence that does not require proving. However, the IP Court did not take into account that the provisions of Article 15 of the Civil Code and Clause 12 of Plenum Resolution No. 25 on recovery are universally applicable and do not depend on what rights and legitimate interests are infringed.

When asserting the claim for recovery of the lost profit due to the infringement of his exclusive right and linking the amount of the lost profit to the conclusion by the Defendant of the said agreements following the results of the tender procedures, the claimant should prove that:

- He took the necessary measures to gain income and made the necessary preparations for this purpose,
- Conclusion of these agreements with the Defendant was the only obstacle evidencing the impossibility for the Company to gain income he could count on.

The court of first instance and the court of appeal came to the lawful conclusion that the Company failed to prove that there is a cause-and-effect relation between the Enterprise's actions and the Company's losses in the form of lost profit in the claimed amount.

However, no agreement could be concluded with the Company due to the fact that the cost of the goods offered by it was not lowest after the Defendant's bid.

The Supreme Court noted that the IP Court did not take into account that the market launch of counterfeit goods does not exempt the right holder from proving that there is a set of conditions necessary to recover losses in the form of lost profit from a relevant person. Therefore, the infringement committed by the Enterprise was not the only obstacle to the Company gaining profit.

The bare fact that the claimant incurs costs on the production of products has no legal meaning, since the courts of two instances found that the claimant did not produce evidence that, in ordinary course of business, he would gain a profit in the amount specified by him.

Based on the foregoing, the Supreme Court reversed the IP Court's resolution and upheld the decisions of the court of first instance and the court of appeal on refusal to recover losses in the form of lost profit.

**EXCLUSIVE RIGHT TO THE INVENTION IS NOT RECOGNIZED AS INFRINGED, SINCE THE FACT THAT THE DEFENDANT GAINED PROFIT OR OTHER INCOME FROM ITS ILLEGAL USE IS NOT PROVEN (RULING OF THE SUPREME COURT No. 304-ES21-7802 DATED MAY 24, 2021, ON CASE No. A70-17552/2019)**

The patent holder of the invention "Method for Multi-channel Video Monitoring of Road Junctions," patent No. 2442217 (invention priority dated January 17, 2011) turned to a municipal public institution filing a notification

and then a complaint, where he asserted that the institution had been using his invention for a long time and proposed to agree to conclude a licensing agreement.

In response to the complaint, the institution stated that it is the right holder of patent No. 2690134 for the invention "Method for Video Monitoring of Objects" (invention priority dated May 30, 2018).

The courts of three instances dismissed the claimant's claims for recovery of compensation and prohibition for the defendant to use the invention.

The courts recognized that the defendant's invention certified by patent No. 2690134 "Method for Video Monitoring of Objects" is dependent on claimant's invention No. 2442217 and is used by it without the claimant's consent. However, the courts found no grounds for recovery of compensation from the defendant, since this use was lawful. As per Clause 2 of Article 13581 of the Civil Code, a dependent invention may not be used without authorization from the holder of the patent for another invention or another utility model, on which it is dependent.

At the same time, in accordance with Article 1359 of the Civil Code, any use of an invention, a utility model, or an industrial design for personal, family, household, or any other needs not related to any entrepreneurial activities, unless the purpose of such use is to derive profit or income, is not an infringement of the exclusive right.

Based on the evidence produced by the claimant and the institution and on the explanations of other persons involved in the case, the courts concluded that the city budget or the defendant did not receive any funds from the installation and use of the equipment, which use entails the use of the claimant's invention.

Thus, in this case, the defendant did not receive any profit or other income from the use of the disputed invention, for which reason the courts concluded that there is no infringement of the claimant's exclusive right to the inventions and, as a consequence, refused to recover compensation.

The Supreme Court refused to retry the case and upheld the decisions of the inferior courts.


## OTHER DISPUTES


**COURT SUPPORTED THE ANTI-MONOPOLY SERVICE IN A DISPUTE WITH DAIMLER AG AND KYB CORPORATION (DECISIONS OF THE COMMERCIAL COURT OF MOSCOW No. A40-222446/2020 DATED AUGUST 11, 2012, AND DATED AUGUST 12, 2021, ON CASE A40-221391/2020)**


The court of first instance agreed with the opinion of the Federal Anti-monopoly Service of Russia that the unreasoned refusal of the right holder to issue independent importers a permit to import the original goods bearing the right holder's trademark, when the right holder has no procedure for consideration of importers' requests for such a permit (consent) and there is confirmed demand for these goods from Russian consumers, evidences the unfair use by the right holder of his exclusive right, which, in turn, is an act of unfair competition in relation to Paragraph 2 of Article 10 bis of the Paris Convention. Daimler and KYB filed their appeals against the decision of the court of first instance.

## 1. WELL-KNOWN TRADE MARKS

In the first half of 2021, Rospatent recognized the following trademarks as well-known.


Trade Mark	
Right Holder	Avito Holding AB, Sweden
Goods/Services	35 – promotion of goods for third parties; 38 – electronic display services [telecommunication services]
Date of Becoming Well-Known	May 18, 2018


Trade Mark	
Right Holder	Paldo Co, Ltd, Republic of Korea
Goods/Services	30 – instant noodles
Date of Becoming Well-Known	December 31, 2018


Trade Mark	
Right Holder	JADRAN-GALENSKI LABORATORIJ d.d., Croatia
Goods/Services	05 – nasal rinsing medicines
Date of Becoming Well-Known	May 31, 2020

Trade Mark	
Right Holder	MOON-DESIGN LLC
Goods/Services	20 – sofas
Date of Becoming Well-Known	December 01, 2020

Trade Mark	
Right Holder	Starodvorskie Kolbasy CJSC
Goods/Services	29 – sausage products
Date of Becoming Well-Known	December 01, 2020

Trade Mark	
Right Holder	All-Russian Non-governmental Organization of Small and Medium Business OPORA RUSSIA
Goods/Services	35 – business information; business research; business consulting; business management consulting
Date of Becoming Well-Known	December 31, 2019

Trade Mark	
Right Holder	Gazprom Neft PJSC
Goods/Services	04 – motor fuel, gasoline, diesel fuel (all goods for sale at gas-filling stations). 37 – vehicle service stations [refueling and servicing]; gas-filling station services
Date of Becoming Well-Known	December 31, 2018

Trade Mark	
Right Holder	Napitki iz Chernogolovki-Aqualife LLC
Goods/Services	32 – non-alcoholic beverages; mineral and carbonated water
Date of Becoming Well-Known	June 01, 2020

## 2. APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS

In January to August 2021, Rospatent registered the following appellations of origin and geographical indications:

Number in the Register of Geographical Indications and Appellations of Origin	Geographical indication/ appellation of origin	Goods	Geographic location
256	Mari Podkogol (Podkogolyo)	Pastries	Mari El Republic
257 (GI)	Eiskaya	therapeutic mud, mud mask	Eysk, Krasnodar Territory
258 (GI)	Voronezh Ice Cream	ice cream	Voronezh, Voronezh Region
259 (GI)	고려홍삼 Korean Red Ginseng	red ginseng	Republic of Korea
260 (GI)	Kuban	wines	Kuban (region), Krasnodar Territory
261 (GI)	Matsesta tea	tea	Matsesta River valley
262	Chuvash Hop	hop	Chuvashia
263 (GI)	Troitsk Shawl		

264 (GI)	<b>Altai Mountains Kazy</b>	kazy	Republic of Altai
265 (GI)	<b>Agin National Costumes</b>	men's, women's and children's national costumes, including holiday ones	Agin Buryat District of Zabaykalye Territory
266 (GI)	<b>Toyrosho of Agin Buryats</b>	Headdress	Agin Buryat District of Zabaykalye Territory
267 (GI)	<b>Maykop Lemonade</b>	lemonades	Maykop, Republic of Adygeya
268	<b>Sakhalin Natural Dried Seaweed</b>	dried seaweed	Sakhalin Region
269 (GI)	<b>Semigorye</b>	wines, sparkling wines	Semigorye vine and wine-producing region of Krasnodar Territory

### A FOREIGN GEOGRAPHICAL INDICATION IS REGISTERED IN RUSSIA FOR THE FIRST TIME

On February 26, 2021, Rospatent granted legal protection in Russia to the first foreign geographical indication “고려홍삼 Korean Red Ginseng”.

An application for registration of this geographical indication was filed on October 13, 2020, by the KOREAN GINSENG ASSOCIATION consisting of 120 Korean red ginseng manufacturers. According to the product description given in the application, Korean red ginseng is composed of organic and inorganic substances in the following percentages: saponins (3–6%), nitrogenous compounds (12–16%), oil-soluble components (1–2%), vitamins (0.005%), carbohydrates (60–70%), and minerals (4–6%). The moisture content in Korean ginseng is 9–11%.

Korean red ginseng root is grown only in the Republic of Korea in the areas having certain geographical and natural characteristics. The raw materials are processed in accordance with the standards established by the KGA ensuring the product's distinctive appearance and chemical composition. On December 10 of this year, Rospatent registered the Russia's first ever geographical indication “Shuyskoye Soap” for “cosmetic hygienic detergent products: handmade solid toilet soap”.

# INTELLECTUAL PROPERTY NEWS OF THE EURASIAN ECONOMIC UNION AND NEIGHBORING COUNTRIES

### THE PROTOCOL TO THE EAPC BECAME EFFECTIVE

The Protocol on the Protection of Industrial Designs to the Eurasian Patent Convention dated September 9, 1994, was adopted at the diplomatic conference in Nur-Sul-

tan on September 9, 2019, and signed by Azerbaijan, Kyrgyzstan, Armenia, Kazakhstan, Russia, and Tajikistan. In accordance with the established procedure, the Protocol became effective for the first three states that ratified it (Kyrgyzstan, Azerbaijan, and Armenia) on March 17, 2021, i.e., three months after the third state (Armenia) deposited an instrument of ratification to the depository for storage. The Protocol became effective for Russia on April 11, 2021, and for Kazakhstan on April 12, 2021.

On April 12, the EAPO Administrative Council approved and put into effect the Addenda to the Patent Regulations (Part II. Industrial Designs is included) and an addendum to the Regulation on Fees (fees on applications and patents for industrial designs are established).

Admission of Eurasian applications for industrial designs started on June 1, 2021.

### TREATY ON TRADEMARKS OF THE EAEU BECAME EFFECTIVE

On August 26, World Intellectual Property Day, the Treaty on Trademarks, Service Marks, and Appellations of Origin of the Eurasian Economic Union dated February 3, 2020, became effective. The Treaty is a fundamental document for formation of a regional system of trademarks, service marks, and appellations of origin of the EAEU.

The Treaty, in particular, stipulates:

- Introduction of the concepts “EAEU trademark” and “EAEU appellation of origin,”
- A possibility to file one application for an EAEU trademark or one application for an EAEU appellation of origin to any patent office of the Union States subsequently obtaining legal protection in all EAEU countries simultaneously,
- An applicant's interaction with only one office—a one stop principle,
- Maintenance of the Unified Register of EAEU Trademarks and the Unified Register of EAEU Appellations of Origin posted on the official EAEU website.

### REGULATIONS AND FEES TO THE TREATY ON TRADEMARKS OF THE EAEU WERE APPROVED

On May 18, the Council of the Eurasian Economic Commission approved the Regulations to the Treaty on Trademarks, Service Marks, and Appellations of Origin of the Eurasian Economic Union dated February 3, 2020. The Regulations contain the rules necessary for performance of the said Treaty as well as standard forms of documents. In particular, the Regulations provide for a possibility to file an application in paper form or as an electronic document.

A list of types of legal actions in registration, legal protection, and use of EAEU trademarks and EAEU appellations of origin, for which fees are charged, and fee rates were also approved. The fees are established in Swiss francs.

### EURASIAN PATENT OFFICE LAUNCHES THE PHARMACEUTICAL REGISTER (EAPO PHARMACEUTICAL REGISTER)

Since March 1, 2021, the EAPO web portal has the EAPO Pharmaceutical Register containing information on Eurasian patents related to active pharmaceutical ingredients with international non-proprietary names (INN). Starting from March 1, 2021, owners of Eurasian patents may submit to the EAPO a request for inclusion of the corresponding Eurasian patents in the EAPO Pharmaceutical Register.

## 1. ARMENIA

### NEW LAWS ON PROTECTION OF INVENTIONS AND INDUSTRIAL DESIGNS WERE ADOPTED

A new law On Patents was adopted in Armenia (No. ZR-108 dated March 30, 2021), which became effective on July 1, 2021.

The new law excludes computer programs from the list of unprotected subject matters. Clause 6 of Article 12 of the Law stipulates that inventions relating to computer algorithms and software are subject to protection if the invention relates to the method and meets the requirements established by Parts 1 to 3 of this Article, i.e. it is a technical solution relating to the process of actions on a tangible object using physical resources and meets the criteria for patentability, i.e., it is industrially applicable, new and involves an inventive step (for protection by a patent) or does not arise directly from the prior art (for protection by a short-term patent).

The new law excludes the concept of a “utility model.” Instead, the concept of a “short-term patent” for an invention (for 10 years) is introduced.

The same invention may be the subject of an application for a patent and an application for a short-term patent. Two titles of protection may be requested by simultaneously filing the relevant applications by the same applicant (Article 55 of the Law)

A preliminary examination is conducted within 3 months from the filing date of the application and based on its results:

- In case of an application for a patent, a decision is made on the publication of the application in due time;
- In case of an application for a short-term patent, the compliance of the invention with the patentability criteria using the public solutions available to the expert in the relevant art is checked, based on which results a decision is made to grant or refuse to grant a short-term patent for 10 years. In order to obtain a patent for 20 years, a substantive examination should be conducted at the request of the applicant or any third party, which should be filed within 5 years from the date the application was filed or an international application was entered to the national phase. Based on the results of the substantive examination, taking into account the appeals received from third parties after the publication of the application and the arguments provided by the applicant, a decision should be made to issue a patent for 20 years or to refuse to issue a patent.

The information on the new law is posted on the website of the Ministry of Economy at <https://mineconomy.am/ru/news/2318>.

A new law On Industrial Designs was also adopted on March 30 (No. ZR-109), which became effective on July 1, 2021.

Under the new law, instead of a certificate, a patent for an industrial design is issued, but previously issued certificates, which have not expired, are still valid in accordance with the provisions of the new law. Legal protection is also granted to an unregistered industrial design. The term of protection in this instance is 3 years from the date of the first design disclosure in Armenia. Examination of applications includes formal, preliminary, and substantive ones.

Upon a positive preliminary examination, the application is published, after which any interested party may file an appeal within 2 months after publication. The applicant

may submit his arguments against the objection within 1 month. After 3 months from the publication date, a substantive examination should be conducted. All other norms remain unchanged.

## 2. BELARUS

### BELARUS ACCEDED TO THE HAGUE SYSTEM FOR THE INTERNATIONAL PROTECTION OF INDUSTRIAL DESIGNS

On April 19, 2021, the Government of Belarus deposited with Daren Tang, WIPO Director General, an instrument of accession to the Geneva Act (1999) of the Hague Agreement.

Upon accession, three statements were made:

- Belarusian applicants must submit international applications directly to WIPO, they cannot be filed through the IP office of Belarus;
- Belarusian legislation does not provide for postponed publication of information on an industrial design;
- Maximum term of protection of an industrial design in Belarus is 15 years.

The Geneva Act became effective for Belarus on July 19, 2021.

### STATISTICS OF THE BELARUSIAN PATENT OFFICE FOR H1 2021

In the first half of the year, the National Center of Intellectual Property received:

- 253 applications for patents for inventions (a 9.5% increase), including:
  - 201 applications for patents of the Republic of Belarus (a 7.5% increase);
  - 42 applications for Eurasian patents (a 7.7% increase);
  - 10 international PCT applications (a 100% increase);
- 175 applications for patents for utility models (a 6.7% increase);
- 121 applications for patents for industrial designs (an 11.0% increase);
- 3,895 applications for trademark registration (a 13.1% decrease):
  - Under the national procedure, 1,497 applications were received (a 14.0% decrease);
  - Under the international procedure, 2,398 applications were received (a 12.5% decrease).

In the first half of 2021, 331 agreements for transfer of rights to industrial property were registered (a 4.7% increase).

More detailed statistics are available at the website of the National Center of Intellectual Property at [https://www.ncip.by/upload/doc/2021/Data\\_ru.pdf](https://www.ncip.by/upload/doc/2021/Data_ru.pdf).

### CONSIDERATION OF DISPUTES OVER INTELLECTUAL PROPERTY IN THE SUPREME COURT OF THE REPUBLIC OF BELARUS IN 2020

On January 25, 2021, the Supreme Court of the Republic of Belarus published information about the efforts of the Collegium on Intellectual Property Cases of the Supreme Court of the Republic of Belarus in 2020. In 2020, the Collegium on Intellectual Property Cases of the Supreme Court of the Republic of Belarus considered 224 cases, of which 179 cases were disputes in the field of copyright and allied rights; 45 cases were disputes in the field of industrial property rights, of which 2 cases

were complaints against decisions of the Ministry of Anti-monopoly Regulation and Trade of the Republic of Belarus, and 7 cases were complaints against decisions of the Board of Appeal under the patent authority.

The information is available on the website of the Supreme Court of the Republic of Belarus at [http://www.court.gov.by/ru/justice/press\\_office/a064c78c5d9b40b3.html](http://www.court.gov.by/ru/justice/press_office/a064c78c5d9b40b3.html).

### 3. KAZAKHSTAN

On January 12, 2021, Kazakhstan deposited with the WIPO Director General its instrument of ratification of the Protocol on the Protection of Industrial Designs to the Eurasian Patent Convention dated September 9, 1994. For Kazakhstan, the Protocol became effective on April 12, 2021.

### 4. KYRGYZSTAN

#### NEW HEAD OF THE PATENT OFFICE OF KYRGYZSTAN

By Decree of the President of the Kyrgyz Republic No. 337 dated August 10, 2021, Rakhat Topchubaevna Kerimbaeva was appointed Director of the State Agency of Intellectual Property under the Government of the Kyrgyz Republic (Kyr-gypatent) under the Cabinet Council of the Kyrgyz Republic.

### 5. TURKMENISTAN

#### TURKMENISTAN ACCEDED TO THE PATENT LAW TREATY (PLT).

On April 19, 2021, the official representative of Turkmenistan deposited with the WIPO Director General its instrument of ratification on Turkmenistan's accession to the Patent Law Treaty (PLT). For Turkmenistan, the PLT became effective on July 19, 2021.

### 6. UZBEKISTAN

#### IMPROVEMENTS TO THE IP PROTECTION SYSTEM

On January 28, the President of the Republic of Uzbekistan published decree On Measures to Improve the System of Protection of Intellectual Property Subject Matters (<https://president.uz/ru/lists/view/4114>).

Among other things, the decree stipulates, starting from April 1, 2021:

- Registration of trademarks not only in the name of legal entities and individual entrepreneurs, but also in the name of any individuals;
- Determination of the procedure for accelerated examination.

The decree also provides for the introduction into the activities of the patent office of Uzbekistan of the practical application of outsourcing methods during examination of applications.

The decree approved the Roadmap for Strengthening Intellectual Property Protection and the Work Program for the IP Development for 2021–2023. In particular, it envisages preparation of draft laws aimed at increasing liability for infringement of IP rights. It is planned to take measures to accede to a number of WIPO-administered treaties: Marrakesh Treaty, Singapore Treaty on the Law of Trademarks; Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, and the Rome Convention.

Preparation of the Intellectual Property Code is envisaged in the future.

## 7. UKRAINE

#### REVIEW OF COURT PRACTICE ON INTELLECTUAL PROPERTY DISPUTES

On May 25, 2021, the Supreme Court of Ukraine issued a review of disputes on the protection of intellectual property rights. The review of the court's legal positions was prepared based on the decisions rendered from January 2019 to March 2021.

The text of the Review is available on the website of the Supreme Court at [https://supreme.court.gov.ua/userfiles/media/new\\_folder\\_for\\_uploads/supreme/intel\\_vlasnist\\_27\\_05\\_2021.pdf](https://supreme.court.gov.ua/userfiles/media/new_folder_for_uploads/supreme/intel_vlasnist_27_05_2021.pdf).

#### UKRAINE WITHDREW FROM THE AGREEMENT BETWEEN THE CIS COUNTRIES IN THE FIELD OF INTELLECTUAL PROPERTY

On June 15, 2021, the Verkhovna Rada of Ukraine adopted Law No. 1545-IX, in accordance with which Ukraine withdraws from the Agreement on Cooperation in the Area of Legal Protection of Intellectual Property and on Establishment of Interstate Council on Legal Protection of Intellectual Property concluded on November 19, 2010, in Saint Petersburg.

# NEWS

**1-2 APRIL 2021 // MOSCOW**  
**XII IP FORUM. RUSSIA & CIS**



PHOTO: DMITRY RUSAKOV, HEAD OF BRAND PROTECTION GROUP (GORODISSKY & PARTNERS, MOSCOW)

Sergey Vasiliev, PhD, Partner, Dmitry Rusakov, Head of Brand Protection Group, and Valery Narezhny, PhD, Counsel (all from Gorodissky & Partners, Moscow), took part in the XII IP FORUM. Russia & CIS.

Sergey Vasiliev moderated the session “Protection of rights to RIA on the Internet” at which Dmitry Rusakov made a presentation “The practice of identifying and eliminating violations of your rights on the Internet: technologies and recommendations”. Valery Narezhny presented his report “The practice of protection against unfair competition on the Internet” at the session “Protection against unfair competition and cooperation with the Federal Antimonopoly Service”.

Law Firm “Gorodissky and Partners” acted as the General Partner of the “XXII IP Forum. Russia & CIS”, annually organized by Infor-Media Russia.

**12 MAY 2021 // MOSCOW**  
**THE FIRST TEEN’S IP DAY TRAINING SEMINAR**

Tatiana Pogrebinskaya, Ph.D., Counselor, Vladimir Bashkirov, Head of Patent Research Department, Nikita Maltsev, Ph.D., Lawyer (all from Gorodissky & Partners, Moscow), held the first TEEN’S IP DAY training

webinar on the basics of intellectual property protection, organized by LES International, with the support of the national society — LES Russia and NTA Technopol-Moscow. The speakers spoke about the basics of legal protection of intellectual property and the benefits of such protection; on the peculiarities of the protection of inventions, utility models, industrial designs and trademarks; touched upon some aspects of the legal protection of copyright objects.

Also, the webinar participants learned why patent search is needed and what reverse engineering is, what intellectual property objects can be used to protect the design and brand elements most effectively, and at the end of the webinar an intellectual game was held to consolidate the studied material.

The webinar brought together about 40 participants from different regions of Russia, many of whom are participants of national and international competitions for young inventors.

**26 MAY 2021 // MOSCOW**  
**WEBINAR “EURASIAN DESIGN PROTECTION SYSTEM: TIME TO START”**  
Yury Kuznetsov, Partner, Russian & Eurasian Patent Attorney, Evgeny Alexandrov, Ph.D., Partner, Viacheslav Rybchak, Partner, Trademark & Design Attorney, (all from Gorodissky & Partners, Moscow) held a webinar “Eurasian Design Protection System: Time to Start”, organized by Gorodissky & partners.



PHOTO: VIACHESLAV RYBCHAK, PARTNER (GORODISSKY & PARTNERS, MOSCOW)

The webinar was devoted to the patenting procedure for an industrial design in the Eurasian Patent Office



PHOTO: YURI KUZNETSOV, PARTNER (GORODISSKY & PARTNERS, MOSCOW)

and strategies for its use and aroused great interest of the audience.

**27-28 MAY 2021**  
**LES INTERNATIONAL VIRTUAL ANNUAL CONFERENCE**  
Sergey Medvedev, PhD, LL.M., Partner

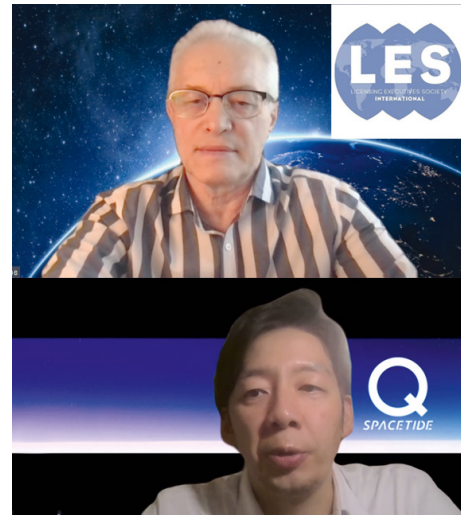


PHOTO: SERGEY ZHUKOV (SPACE TECHNOLOGIES AND COMMUNICATIONS CLUSTER OF SKOLKOVO) MASASHI SATO (SPACETIDE)

(Gorodissky & Partners, Moscow), LES Russia member, moderated the table topic “Emerging Markets of the Eurasian Economic Union (EEU) — It’s Time to License Your IP Assets” organized by Gorodissky & Partners within the LESI Virtual Annual Conference. Sergey Medvedev, Gorodissky & Partners, Russia, Svetlana Khaliullina, Ph.D., Pharmenterprises Ltd., Russia, Madina Tursunova, Legalmax, Kazakhstan and Darya Lando, Lexpatent, Belarus lively discussed the legal, business and practical aspects associated with IP licensing in EEU.

**2 JUNE 2021**  
**11 IP ATTORNEYS OF GORODISSKY & PARTNERS BECAME THE FIRST EURASIAN DESIGN ATTORNEYS**  
11 IP attorneys of Gorodissky & Partners were first in a raw certified as

Eurasian design attorneys. On June 2, 2021, President of the Eurasian Patent Office Saule Tlevlesova awarded them with the relevant Certificates. Certificate No. 1 was presented to Valery Medvedev, Managing Partner with Gorodissky & Partners. Certificate No. 2 was handed to Yury Kuznetsov, Partner, Head of the Patent Practice with Gorodissky & Partners.

**10 JUNE 2021**

FIFTEEN IP PROFESSIONALS OF GORODISSKY & PARTNERS RECOGNIZED IN BEST LAWYERS® RANKING

Yury Kuznetsov, Partner, Russian and Eurasian Patent Attorney, Nikolay Bogdanov, Partner, Russian Patent Attorney, Counsel, Vladimir Bashkirov, Russian and Eurasian Patent Attorney, Dmitry Klimenko, Ph.D., Russian and Eurasian Patent Attorney, Elena Mosina, Russian and Eurasian Patent Attorney, and Oksana Karpenko, Russian and Eurasian Patent Attorney, (all from Gorodissky and Partners, Moscow), demonstrated patent statistics over pandemic timeline, by types of pandemics, including the current one, talked about the situation with patenting new COVID-19

The International Forum of Technological Development “TECHNOPROM” is the largest event in Russia, the main goal of which is to promote domestic scientific developments and innovations.

More than 8500 participants visit the forum annually. This year the forum was dedicated to the Year of science and technology in Russia.

**19 SEPTEMBER 2021 // MOSCOW**

CHARITY PROJECT FOR THE CHILDREN'S REHABILITATION CENTER “SHEREDAR”

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 С.А. ДОРОФЕЕВ	 Е.Е. НАЗИНА	 А.В. КРАТЮК	 В.В. РЫБЧАК	 А.Б. НЕСТЕРОВ
 Л.М. СЕРОВА	 В.М. СТАНКОВСКИЙ	 Н.И. НИКОЛАЕВА	 С.Г. ЕГОРОВ	 Е.З. БАЙКОВСКАЯ

vaccines in Russia, discussed the program of The Russian PTO on accelerated patent examination for inventions on treatment of viruses and accompanying illnesses (pneumonia), and also discussed political issues around permitting use of patented vaccines as an exception from exclusive patentee

right in country pandemic emergency conditions.

Fifteen IP attorneys and lawyers from Gorodissky & Partners were included in The Best Lawyers™ in Russia in the fields of Intellectual Property and Litigation:

Sergey Medvedev, Ph.D., LL.M., Partner, was named The Best Lawyers™ Privacy and Data Security Law “Lawyer of The Year” in Russia.

**14 JULY 2021 // MOSCOW**

WEBINAR “PANDEMICS AND VACCINES. A PATENT VIEW”

Law firm Gorodissky & Partners hosted a webinar “Pandemics and Vaccines. A Patent View”.

**26 AUGUST 2021 // NOVOSIBIRSK**

VIII INTERNATIONAL FORUM OF TECHNOLOGICAL DEVELOPMENT “TECHNOPROM-2021”

Natalia Nikolaeva, Partner, Regional Director (Gorodissky & Partners, Novosibirsk), made presentation at the round table “Technology Licensing: How, What and Why?” within the framework of the business program of the VIII International Forum for Technological Development “Technoprom-2021”.



PHOTO: GORODISSKY & PARTNERS TEAM

Employees of Gorodissky & Partners took part in a charity project and, together with the foundation “Podari derevo”, planted trees in the Children’s Rehabilitation Center “Sheredar”. “Sheredar” is a camp where children and adolescents who have overcome the most terrible diseases can undergo a free rehabilitation sessions. Participants of the project planted 62 maple and mountain ash seedlings on the territory of the camp, according to the age of the firm.

**7-8 OCTOBER 2021 // MOSCOW**

7TH ANNUAL INTERNATIONAL CONFERENCE “PROTECTION OF INTELLECTUAL PROPERTY RIGHTS”

Sergey Vasiliev, Ph.D., Partner, and Ilya Goryachev, Senior Lawyer (both from Gorodissky & Partners, Moscow), made presentations on “Strategies in Patent Disputes” and “IP Issues in Advertising” within the sections “Litigation” and “Comprehensive Protection and Enforcement of IP Rights” at the 7th annual international conference “Protection of Intellectual Property Rights”.

The Conference was organized by the Business Way Forum and gathered almost 200 participants. Новость об открытии филиала



PHOTO: OKSANA KARPENKO, VLADIMIR BASHKIROV, YURY KUZNETSOV, NIKOLAY BOGDANOV, DMITRY KLIMENKO, EKATERINA MOSINA (ALL OF GORODISSKY & PARTNERS, MOSCOW)

# NEWS

22 — 24 NOVEMBER 2021

## 19TH GORODISSKY ANNUAL SEMINAR “IP PROTECTION STRATEGIES FOR SUCCESSFUL DEVELOPMENT OF THE COMPANY”

The 19th Annual Seminar “IP Protection Strategies for Successful Development of the company” was held online by Gorodissky & Partners.

During 3 days, leading IP attorneys and lawyers of the Moscow and Novosibirsk offices, as well as invited speakers from Germany held 3 sessions: patents, trademarks and industrial designs and legal aspects. The most important practical issues and development trends in IP were highlighted at the seminar.



PHOTO: ALEXEY KRATIUK, LIUDMILA SEROVA, VITALY SHISHAYEV, ALEXANDER NESTEROV  
(ALL OF GORODISSKY & PARTNERS, MOSCOW)

The seminar gathered representatives of corporations, lawyers, patent and trademark attorneys, R&D centers and representatives of industrial, insurance, commercial, food, chemical and pharmaceutical companies from 42

cities and 9 countries – over 200 registrants in total. Some attendees participate in the Gorodissky annual seminar year by year.

## GORODISSKY & PARTNERS OPENS A BRANCH OFFICE IN KAZAKHSTAN

1 DECEMBER 2021 // KAZAKHSTAN

Gorodissky & Partners is moving East with an office in Kazakhstan to provide clients with more IP opportunities in Central Asia. Our new office in Nur-Sultan is the next step of Gorodissky & Partners international networking in addition to the Ukrainian branch office. Today Kazakhstan is one of the most dynamically developing countries of Central Asia being among the most powerful operators of natural resources, the flagship in innovations, the most investment and socially attractive region.

Gorodissky and Partners is grateful to Mr. Arman Sauganbaev, Lawyer and Patent Attorney, previously - Deputy Head of Legal Department at “Kazakh

and to continue with us his excellent IP practice started in 2012.

Valery Medvedev, Managing Partner of Gorodissky & Partners, noted: “Opening an office in Nur-Sultan, the capital of Kazakhstan, is part of the firm’s business development strategy outside Russia. We always strive to create the most comfortable conditions for our clients in different jurisdictions as well as to provide the cost-effective and high-quality services according to our corporate standards. We are very glad that Mr. Arman Sauganbaev joined Gorodissky international team. Arman has solid IP and TMT experience and is able to run successfully our new office in Kazakhstan”.

Agro Technical University” for his agreement to head our branch office



PHOTO: ARMAN SAUGANBAEV, PATENT ATTORNEY OF THE REPUBLIC OF KAZAKHSTAN, REGIONAL DIRECTOR, GORODISSKY & PARTNERS (NUR-SULTAN CITY)

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