

Rising to new challenges

It is expected that in the foreseeable future, IP issues on the Internet will be no more complicated than regular market infringement matters

Protection of trademarks and other intellectual property on the market has long been commonplace in Russia, and in most cases is successful. However, the Internet has presented new challenges in this regard. Approximately half of Russia's population are active internet users – a figure which emphasises the importance of regulating content that is placed on the Internet.

Hence, it is necessary to formulate solutions to the specific IP issues that arise on the Internet. The Internet is a medium that is readily available to anyone; it is virtual, mercurial and global. The international community is accustomed to regulating problems on a country-by-country basis as they arise. With regard to the Internet, experience obtained through legal and judicial practice is applicable only to a certain extent. To date, judicial practice has formulated solutions in case of conflicts between trademarks and domain names. Copyright has also been addressed in the law. For example, Part IV of the Civil Code (Article 1270) provides that saving information on a computer is considered as 'use' of a copyrighted work. Transmission of a copyrighted work is also considered use of the work. However, these provisions are difficult to enforce when they are applied to content that is distributed online.

Part IV of the Civil Code explicitly provides (in Article 1252) that in case of a conflict of means of individualisation, the means that shall have priority are those for which the right arose earliest. Conflicts related to '.ru' domain names are resolved in court. The courts have devised a clear approach to this issue, even in cases where it is impossible to find the administrator of a domain name. If a trademark is older than a domain name, the court will notify the administrator of the domain name accordingly; if there is no response, it will

issue a judgment cancelling the domain name. Company names are treated in the same way as trademarks.

Other issues are more difficult to regulate. Trademarks are regulated territorially by national laws and international agreements, and protection is effected in the territory of the country in which the trademark is protected. The Internet is a powerful commercial tool, which has led to substantial use of trademarks online. As consumers cannot physically see or feel products that are available online, they are largely guided by familiar trademarks which enjoy a good reputation. Websites may be located anywhere, so consumers looking for specific goods may come across an advertisement which originated from anywhere in the world. The versatile character of the Internet allows the use of all types of trademark (eg, verbal, figurative, three-dimensional, sound), with the exception perhaps of olfactory – at least at the present time. Trademarks may infringe, even if they cover homogeneous goods. If a trademark does not cover a particular product, there will be no infringement. However, this is a problem that is not specific to the Internet.

The use of intellectual property online is something that is still under discussion, but has not yet been resolved in full. Nevertheless, progress is being made. The Russian authorities take measures to deal with unauthorised placement of content on the Internet. Recently, a Moscow prosecutor issued a ruling to prohibit the operation of a popular torrent tracker, www.torrents.ru. The site is no longer functioning in Russia, but it has moved to the Bahamas and is operating from there. This confirms that there are no simple solutions to this problem. There is limited information available regarding online enforcement. According to a source,

during a six-month period in 2007, 90 sites were shut down and 38 criminal cases were initiated against site administrators.

Another example is social media site *Vkontakte*. Its rules attempt to thwart the unauthorised placement of content by users. Any party may notify *Vkontakte* about infringement of IP rights and request that infringing material be deleted from the site. However, this is not done automatically. The applicant must prove that it is the author or authorised representative of the content, and that the content infringes copyright. *Vkontakte* will consider the complaint and will delete the content if it considers the complaint to be well grounded.

Several Russian laws deal with such issues, even though they do not have direct bearing on intellectual property. The forthcoming changes to the Civil Code will define an 'internet site'. According to the proposals, to be considered by the Russian *Duma* in the near future, an internet site is understood as an aggregate of independent pieces of information systematised in such a manner that they may be placed on the Internet. This will help in evaluating the importance of presenting information on the Internet in various cases (eg, where a product bearing a trademark is advertised on a particular site).

The original version of the Law on Information, Information Technologies and Protection of Information was adopted in 2006; it was amended in July 2012. The amendment concerned the use of information on the Internet. Article 15.1 was added, which provides for an integrated register of domain names, indicators of internet sites and IP addresses.

The amendment sought to restrict access to sites which contain information whose dissemination in Russia is prohibited.

Now, the limitation concerns pornographic content and information on the preparation and use of narcotic substances and other subjects that would offend public interest. The integrated register will be created by the Federal Service for the Supervision of Communications. The decision to include offending sites will be taken by competent government bodies and passed on to the operator of the register. The operator of the register will notify the provider that a particular domain name or internet site has been included in the register. Within one day of receipt of notification, the provider will notify the owner of the domain name or site; the owner will be compelled to delete any offending information within one day. If the owner does not delete the relevant information, the provider will immediately restrict access to the site. The full list of offending websites can be found at www.sapret-info.gov.ru.

This law has been criticised because, according to some, it restricts freedom of information. This criticism may be justified; enforcement of the law will show whether the critics have grounds to make such statements. The law does not concern intellectual property; however, it does provide legal mechanisms by which access to some information may be restricted.

So far, there have been no discussions with regard to the application of the Law on Information, Information Technologies and Protection of Information to intellectual property, but it seems that the law provides a solution to the transborder dissemination of information which may infringe IP rights in Russia. Unlike the treatment of offensive information, the decision to restrict access to infringing intellectual property should be taken by courts, which will bring online infringement cases within the framework of routine enforcement of intellectual property. This is not an entirely new idea. In 1998 the United States passed the Digital Millennium Copyright Act, according to which copyright owners may initiate a court action, and the court will issue a ruling obliging the provider to discontinue service of copyright infringers.

Russia is moving in the same direction; it is expected that in the foreseeable future, IP issues on the Internet will be no more complicated than regular market infringement matters. **WTR**



Vladimir Biriulin

Partner

BiriulinV@Gorodissky.ru

Vladimir Biriulin graduated from Moscow State Linguistic University in 1969 as an interpreter of Spanish, English and French, and from both Moscow University of Law in 1981 and the Central Institute of Intellectual Property (Moscow). He worked in a major IP firm between 1973 and 1998, before joining Gorodissky & Partners. He now counsels clients on IP legislation, international IP treaties, conventions and agreements, technology transfer and licensing, infringement of IP owners' rights, unfair competition and copyright, and also litigates IP cases.