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G-NEWS

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GORODISSKY & PARTNERS
PATENT AND TRADEMARK ATTORNEYS
IP LAWYERS

Law Deals a Blow to the List of Features

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Patents for inventions push forward the technological progress but are not usually seen to the naked eye. Industrial designs strike the eye of the consumer and push forward his demand. A famous Mark Twain saying «Clothes Make the Man» mutatis mutandis fits the design: The outer appearance makes the industrial design. Until late last year filing a design application was a headache for the applicant because Russia, as in other areas, pursued its own way. In order to file an application it was necessary to compile a list of essential features by analogy with applications for invention even though the pictures were all the same there. The list of essential features played a key role in defining the scope of protection of a design. It is true that the list » page 2

of essential features could be corrected before the patent was granted however if it was granted without describing a particular important feature this could become a problem on the market. The infringer could avoid being chased if he deliberately omitted one of the features given in the list of essential features or if a particular essential feature was added in the list without need.

The new law dismissed the list of essential features which move understandably expands the scope of protection. The law now provides that an industrial design is used in the product if the product is characterized by essential features which produce the same impression on the informed user as the impression produced by a patented industrial design on condition that both products serve the same purpose. The provision has become less «mathematical» but more «humane». The accent has been shifted to expert evaluation rather than to formal listing of features. The absence of one or several features in a design or some difference in the embodiment of a design will not take the design out of protection on condition that the design produces the same impression on the informed user as the patented industrial design. On the other hand, the absence of the list of essential features may complicate solution of the disputes on patentability or infringement. The body considering the dispute will be guided by pictures only and there will be a wider scope for the parties to argue which of the features is «more essential if at all» in the contested industrial design and the one which is compared to it. The law introduced the concept of a hypothetical «informed user» who will judge upon originality of the patented design and compare it to the allegedly counterfeit article. The «informed user» has come to Russia from Europe so patterns of his behavior may possibly influence the Russian judiciary and the Patent Office. Anyway some time should pass until the informed user is naturalized in Russia. Until then the Patent Office and the parties in dispute will have more leeway to assess what is to be considered as essential features of the design while on the other hand, there will be some uncertainty as to what particular specific features are essential in considering the difference between the industrial design and the one which is cited or considered as infringing the rights.

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The description of the industrial design remains essential for the patent application. The law does not set requirements for the description. There exist earlier rules drafted by the Patent Office which explain that the description of the industrial design should disclose the essence of the design through description of its essential features and particulars of its outer appearance. The new rules have not yet been adopted however there are drafts from which we may infer that the Patent Office would like to have a detailed description of the industrial design. Neither the law nor judicial practice, which is yet non-existed, explain the meaning of the description of the industrial design. The law only states that the scope of protection is determined by the combination of essential features shown in the pictures contained in the patent. Though the requirement to submit a description is there it is not clear where it fits in the picture.

The documents needed to establish priority are less in number. The applicant has to submit only a set of pictures which give a clear and complete understanding of essential features of the industrial design which define its aesthetic quality. Description of the industrial design may be submitted later.

The list of non-patentable subject matters has been reduced. Now all architectural objects are patentable instead of only small architectural forms. Objects of unstable shape have been excluded from non-patentable objects though this novelty has little practical application: one can hardly imagine how a stream of water or a gaseous substance may be patented. On the other hand, a new non-patentability requirement has been introduced: non-patentable shall be designs which may mislead the consumer in respect of the manufacturer or of the place of manufacture or of the product for which the claimed design is used as a package. If the claimed industrial design is identical or looks like a trademark or produces a similar impression such design may be patented if there is an agreement to that effect of the owner of the trademark. This requirement, to an extent, puts the industrial design on the same footing with some trademarks for which letters of consent are needed in certain situations. An industrial design patent may be obtained for a label in the same way as a trademark registration may be obtained for a label. Hence this limitation may be regarded as well grounded.

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Requirements for making changes in the application have become more stringent. The applicant may submit changes only in response to examiner's inquiry. The changes should not add or delete essential features present or absent in the originally filed documents. The applicant should carefully prepare the images of the industrial design. No changes will be possible after filing.

A number of changes in the law affect the examination procedure. While evaluating novelty and originality of the claimed design the examiner may cite information on the outer appearance of similar articles not only contained in the earlier filed patent applications for industrial designs but also in the patent applications for inventions, utility models, and

trademarks. It so happens that patent applications for whatever subject matters may contain drawings or pictures which show the outer appearance of the patented article in which an invention or a utility model is used. Likewise, a trademark application may concern a 3D mark or a trademark for a label. The outer appearance of such articles may be protected by a patent or a trademark. It goes without saying that all publicly available information may also be cited which raises questions with regard to novelty and originality. In fact the scope of information which may be cited has been substantially enlarged.

A grace period has been extended. It was previously six months. Now it has been doubled. This new provision is obviously to the advantage of the applicants. In the first place, accidental disclosure gives more opportunities to the applicant to rectify the situation by filing an application within a longer span of time. Besides, the designer, prior to filing a patent application may wish to test his design on the market, evaluate its commercial potential and choose to file it in Russia if he sees that the design sells well in his home country.

It is worth noting that the above and some other changes in the law were conditioned by the intention of the law makers and the Patent Office to harmonize protection of the designs with the regulation prevalent in the European Union. Though, in some cases those attempts were not consistent enough: the description of the industrial design has been retained in the patent application though, as has been mentioned above, it does not have critical importance and is not a requirement in the countries of the European Union. Also, rigid requirements to limit opportunities for introducing changes in the application in the European Union were explained by excessive workload of the European Patent Office while the number of design patent applications in Russia is not yet commensurate with the European Patent Office which would warrant introduction of such requirement.

There is yet another amendment of the law which concerns the term of validity. The old law provided that a patent for an industrial design could be granted for 15 years. That term of validity could be extended by another term at the choice of the patent owner but not exceeding 10 years. The amendments introduced a shortened basic term of validity of 5 years with the possibility of multiple extensions by 5 year periods. The overall term of validity remains 25 years. It is not clear why such changes have been made all the more that annual fees should have been paid every year under the old law as well as they should be paid annually under the current law.

The law introduced a limitation of the rights of the patent owner in what concerns assignment of rights. A new provision sets forth that the exclusive right for an industrial design shall not be assigned if the assignment may confuse the consumer with regard to the goods or their manufacturers. If the patent owner issues an exclusive license to a licensee he will not be able to use the industrial design himself in the scope provided in the exclusive license. If the patent owner plans to use his patent himself he should include a relevant provision in that exclusive license agreement.

Summarizing the above review of amendments of the law pertaining to industrial designs it should be noted that the law has become more friendly to the applicants and patent owners and more attractive for filings. This responds to the trend consisting in that modern consumers have become more demanding to the appearance of the goods they buy. As time goes by the Patent Office and judiciary will accumulate practice and it will become clear whether the law has to be improved further.

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Events (conferences, seminars, news)

08.07.2015 // TOKYO

Gorodissky & Partners and AIPPI Japan held a Seminar «Obtaining and enforcement of IP rights in Russia». The speakers at the seminar were: Yury Kuznetsov, Partner, Head of Patent Practice, Russian & Eurasian Patent Attorney – «New Russian Patent Legislation», Alexey Kratiuk, Partner, Trademark Attorney – «Trademarks in Russia», and Evgeny Alexandrov, PhD, Chief Lawyer – «IP Legal matters». The Seminar was attended by Japanese businessmen, lawyers and examiners from the JPO.

23.06.2015 // CHEBOKSARY

Sergey Vasiliev, PhD, Senior lawyer (Gorodissky & Partners, Moscow), gave a presentation «Global and local «patent wars» in IT field» at the Round table «Innovative economy and high-technology business» at the VIII Cheboksary Economic Forum «Regions: new sources of economic development». The Round table gathered over 70 attendees from state institutions, business circles and mass media.

2-3.06.2015 // MOSCOW

Sergey Medvedev, PhD, LLM, Senior Lawyer, Valery Narezhny, PhD, Consultant, and Olga Yashina, Lawyer (all from Gorodissky & Partners, Moscow), gave presentations at the seminar «IP rights turnover: reform of part IV of the Russian Civil Code and court practice» hosted by IRSOT Institute at the Moscow Congress Hotel Alpha Izmailovo. The seminar gathered many positive comments from over 50 attendees.

28.05.2015 // ST.PETERSBURG

Valery Medvedev, Managing Partner, Patent & Trademark Attorney (Gorodissky & Partners, Moscow), delivered the speech «Restrictions on Trademark use by plain and highly standardized product packaging» at the Business breakfast «Legal Regulation of IP Rights» organized by Gorodissky & Partners and DLA Piper at the V St.Petersburg International Legal Forum.
The consideration focused on acceptability and principles of IP rights restrictions on national level and in international conventions, attracted great interest and caused vivid discussion among over 70 attendees.

02-06.05.2015 // SAN DIEGO

Team of 12 trademark attorneys and IP lawyers from Gorodissky & Partners Moscow and Kiev offices, attended the 137th Annual INTA Meeting held in San Diego, USA.
On May 3-5 the firm's clients and other attendees of the Conference could visit the Gorodissky Hospitality Suite at the hotel Marriott Marquis San Diego Marina to discuss with our attorneys and lawyers their pending clients' cases as well as the IP legislation in Russia, CIS and Eurasian economic unity, and developments in the firm.
The firm's Reception, which was traditionally organized during the Conference gathered about 1000 guests and took place at the hotel Marriott Marquis San Diego Marina on May 3.
On May 5, 2015 Gorodissky & Partners hosted a seminar at which the presentations on effective protection and use of trademark and design rights in Russia were delivered by attorneys and lawyers of the firm.

Photo: At the Reception

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