

GORODISSKY & PARTNERS PATENT AND TRADEMARK ATTORNEYS

INFORMATION
BULLETIN

 **GORODISSKY
& PARTNERS**

74

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#1 (74) 2011, MOSCOW, RUSSIA

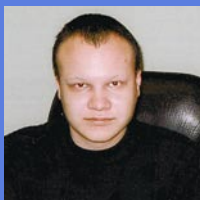
A TEAM OF 10 IP LAWYERS AND ATTORNEYS OF GORODISSKY & PARTNERS FROM THE MOSCOW AND ST. PETERSBURG OFFICES WILL ATTEND THE 133RD INTA ANNUAL MEETING

May 14-18, 2011 In San-Francisco. Details are inside.



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PROTECTION ALL ROUND



Rights to a trademark in HTML code were recognized as infringed for the first time in Russia. Russian company Communication Engineering (plaintiff), a client of Gorodissky & Partners,

addressed the Arbitration (Commercial) court of St.Petersburg and Leningrad Region with a suit against Russian firm STR (defendant), claiming that when the designation «EXPRO», which is a registered trademark (Certificate No. 294499), is typed in a search bar of the Rambler search engine (<http://www.rambler.ru/>), the search results page shows under No. 1 a link to a source located on the Internet at www.str-telekom.ru. This source contains information

concerning activities of STR, a competitor of the plaintiff, that is involved in the supply of communication equipment. To prove infringement of rights of the trademark, the plaintiff furnished a notarized print copy of the web-site www.str-telekom.ru, and a print copy of the HTML code of the web-page www.str-telekom.ru, according to which the code structure comprises the following record: «title» STR ZAO – main/telecommunications equipment,

IT SHOULD BE STRESSED THAT THE TRADEMARK EXPRO EXISTED SOLELY IN THE FIELD OF THE HTML DOCUMENT («TITLE» HEADING) ON THE DEFENDANT'S WEB-SITE. THE TRADEMARK WAS DIRECTLY MENTIONED NEITHER ON THE WEB-SITE, NOR ON GOODS ADVERTISED BY THE SITE OWNER.

communications materials, plinth, switching and protection, subscriber protection device, ground systems, EXPRO «title».

It should be stressed that the trademark EXPRO existed solely in the field of the HTML document («title» heading) on the defendant's web-site. The trademark was directly mentioned neither on the web-site, nor on goods advertised by the site owner.

The main matter in dispute was whether use of a trademark in the HTML code could constitute an infringement of the exclusive rights to such a trademark as provided in article 4(2) of the Russian Trademark Law (the latter was effective at the time of the alleged infringement) if used on the Internet, particularly,

literary work, even if it is registered as a trademark, cannot be regarded as an infringement of exclusive rights to such a trademark.

The defendant's representative substantiated its arguments with well-known lines from a poem by Alexander Pushkin:

«Я помню чудное мгновение...»
(A magic moment I remember...)

These lines were quoted to demonstrate that Pushkin's poem did not breach any rights to the trademark «ЧУДНОЕ МГНОВЕНИЕ» (that can be rendered as «MAGIC MOMENT») (Certificate No. 192367).

However, the Federal Arbitration (Commercial) Court of the North-Western district disagreed with this position,



in a domain name and via other addressing modes (a similar provision is found in article 1484 of the Russian Civil Code at present).

According to the initial pleading of STR, it had not been established that they had introduced the information into the field «title» in the search engine, or when they did. In fact, as long as Rambler Internet Holding, Russia, was the owner of the Rambler search engine, it was this company that would have been responsible for putting up the information in question. The first instance court agreed with the defendant's arguments and dismissed the suit. The Court Decision was not subjected to appeal proceedings, although the plaintiff filed a cassation with the Federal Arbitration (Commercial) Court of the North-Western district.

In its opinion for the cassation, the defendant advanced the argument that it was Rambler Internet Holding, not the defendant, that should bear responsibility for placing information on the owned resource.

The defendant put forward a new thesis in support of its position:

Article 7(1) of the Russian Law «On Copyright and Neighbouring Rights» (a similar provision is found in article 1259(1) of the Russian Civil Code) states: «Copyright subject matters shall incorporate literary works (including computer programs)». Therefore, the HTML code, being a computer program, enjoys legal protection as an independent subject matter of copyright.

It follows from the foregoing that the mere mentioning of a word sign in a

reversed the court decision and remanded the case for a new trial.

During the new trial, the first instance court engaged as third party Rambler Internet Holding who confirmed in its testimony that the content of the «title» tag («metatag») affected both search results and the web-site position in such search results as users' inquiries were processed. Yet, the court decision was to dismiss the

ON JANUARY 14, 2011 THE ARBITRATION (COMMERCIAL) COURT OF ST.PETERSBURG AND LENINGRAD REGION CEASED THE LITIGATION ON THIS CASE.

suit again, said decision having been left unaltered by the appealing instance.

The court referred to experts' opinions subject to which the use of the designation EXPRO in the HTML code of the web-site was not regarded as an addressing mode; said codes were a markup language for the original text of the web-document that comprised special symbols (tags) enabling to see a page as it had been created by a designer.

Communication Engineering company had to file another cassation.

By a new judgment in this case, the Federal Arbitration (Commercial) Court of the North-Western district cancelled the judicial acts of the first and appeals instances and remanded the case to the same arbitration court for a new trial. As a result of the third trial, the first instance court finally recognized the actions of STR as illegal.

The court established that STR initially had committed an infringement of the rights of the plaintiff as a rightholder while developing the HTML code for its

web-site. Consequently, when the word «EXPRO» was inserted in the search engine, this web-site was shown among the search results, but bore no relation to the designation in question. Since the web-site of STR offers similar products to those for which the plaintiff's trademark was registered, defendant's use of this trademark caused a leap in visits to its own web-site, the trademark thereby promoting and marketing the products sold by the defendant.

STR argued that Rambler Internet Holding was actually responsible for the information in question, because it was they who administered the web-site and who bore responsibility for developing the HTML code. However, the aforementioned arguments were not accepted. As a matter of fact, the court applied the provisions of Article 10.bis of the Paris Convention to settle a complicated hi-tech dispute in the 21st century: «The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition. Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition. The following in particular shall be prohibited: all acts of such a nature as to create a confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor».

It was found that for Russian customers, the trademark «EXPRO» was associated with a product of a specific manufacturer. Customers use search engines on the Internet and focus on gaining informa-

tion about such products specifically. Consequently, the defendant used a designation, the rights to which belong to the plaintiff, in the HTML code of its web-site without any legal and justifiable reasons, thereby unlawfully attracting potential customers in order to promote and market the products offered for sale. This time it was STR that filed an appeal to this decision, but the appeal failed. On January 14, 2011 the Arbitration (Commercial) Court of St.Petersburg and Leningrad Region ceased the litigation on this case.

OUR NEW EURASIAN PATENT ATTORNEYS



VALENTIN KIRILLOV

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Graduated from the Moscow Bauman State Technical University as a design engineer.

Started working in the Russian PTO as an examiner.

Valentin Kirillov is accredited at the Center of judicial examination of the Russian Ministry of Justice as a forensic expert on inventions and utility models. Speaks English and German. Leisure – sports and classical literature.



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Graduated from Leningrad Mechanical Institute (St.Petersburg) in 1986 as a mechanical engineer, then - from Central Institute of Intellectual Property (Moscow) and Russian Intellectual Property Institute (Moscow).

«Best Lawyers» (USA) ranks Viktor Stankovsky as a leading practitioner in patents in Russia. Speaks English and French. Leisure – tourism.



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Graduated from the St.Petersburg Institute of Cinema and Television in 1993 as an engineer, then – from the St.Petersburg branch of the Russian State Institute of Intellectual property. Speaks English. Leisure – music, cinema, literature.

133RD INTA ANNUAL MEETING

MAY 14-18, 2011
IN SAN-FRANCISCO

A TEAM OF 10 IP LAWYERS AND ATTORNEYS OF GORODISSKY & PARTNERS FROM THE MOSCOW AND ST. PETERSBURG OFFICES WILL ATTEND THE 133RD INTA ANNUAL MEETING MAY 14-18, 2011 IN SAN-FRANCISCO.

We invite our clients and other participants of the conference to visit our Hospitality Suite, which will be opened from **May 15 to May 17 (business hours 9:30-17:00)** at San Francisco Marriott Marquis Hotel, Sierra H Meeting Room, to discuss the latest amendments in the Russian IP legislation, particular cases, issues of cooperation etc.

Gorodissky & Partners will host a Reception at 133rd INTA Annual Meeting on **May 15, 2011 (Sunday) at 12.00** at San Francisco Marriot Marquis Hotel, Golden Gate Ballroom.

We invite you to join us for the evening and enjoy the Russian party with famous Russian dishes and extraordinary live performance of the Russian folk ensemble.

NEWS

DECEMBER 24, 2010 // MOSCOW



PHOTO: VALERY MEDVEDEV

«Gorodissky & Partners» held the Annual corporate meeting. Valery Medvedev, Managing Partner, reported about the main results of the firm's activity and professional achievements of the firm and attorneys in 2010.

Some staff significantly contributed to the firm's prosperity in 2010 was awarded Diplomas and gifts:

- Marina Kolesnikova, Patent Attorney
- Julia Pakhomova, Trademark Attorney
- Nadezhda Kasimova, Assistant
- Elena Shushunina, Assistant

After that, a New Year party with a nice entertainment program took place.

DECEMBER 16, 2010 // KHANTY-MANSIYSK

Viktor Gorshkov, Partner, Gorodissky & Partners (Moscow), gave a presentation «Patenting of inventions abroad» at the Annual Regional IP Conference «Issues of protection and use of IP objects» held by Technopark of High Technologies (Khanty-Mansiysk). The Conference gathered about 40 regional SMEs.

DECEMBER 13, 2010 // SKOLKOVO, MOSCOW REGION

Yury Kuznetsov, Partner, Gorodissky & Partners (Moscow), was among the speakers at the Panel discussion «Knowledge capitalization. Considering issues of IP management in Russia and other countries» held at the Innovation Forum «Russia, forward!».

DECEMBER 7-10, 2010 // MOSCOW REGION, HOTEL «ZAR'YA»

The Chamber of Patent Attorneys held the XVI Annual Conference «Three years under Part IV of the Russian Civil Code». Vladimir Biriulin, Partner, Dr. Valery Djermakian, Counsel, and Vladimir Mescheriakov, Counsel (all of Gorodissky & Partners, Moscow), were among the speakers with the following presentations correspondingly: «IPRs infringement – what an IP owner can do», «Patent assignment upon filing an opposition with Chamber of Patent Disputes», «Topic issues of patent examination and the latest novels amending patent regulation in Part IV of the Russian Civil Code». Vladimir Mescheriakov also took part in the mock trial – court hearing of an IP case. The Conference gathered about 100 IP specialists.

DECEMBER 7-9, 2010 // MOSCOW

«Expocenter» (Moscow) hosted the II International IP Forum «Expopriority 2010». The Forum included an IP Congress and a Seminar «Trade mark phenomenon». Valery Medvedev, Managing Partner, «Gorodissky & Partners» (Moscow), gave a lecture «Strategy and tactics of using company IPRs for managing innovative business. Modern attitude» in Section 1 «Patenting Strategy» of the Congress. Valery Lyzhin, Trademark Attorney, «Gorodissky & Partners» (Moscow), spoke on «Choice of designation as a trade mark for it successful promotion at the Russian and foreign markets» at the Seminar «Trade mark phenomenon».

DECEMBER 2-5, 2010 // RIO-DE-JANEIRO

The 3rd Annual BRIC IP Forum «The challenges of securing intellectual property rights in emerging markets» was held in Rio-de-Janeiro. Partners of Gorodissky & Partners (Moscow) Vladimir Biriulin and Alexey Kratiuk were among the speakers from Russia with presentations «Parallel import in BRIC» and «Trademarks in Russia», correspondingly. The Forum gathered over 150 attendees most of whom were from Latin America.

Forum is organized by «Daniel Abogados» (Brazil), «Gorodissky & Partners» (Russia), «Remfry & Sagar» (India) and CCPIT (China).



PHOTO: (FROM LEFT TO RIGHT) DENIS DANIEL (DANIEL ABOGADOS, BRAZIL), VLADIMIR BIRIULIN (GORODISSKY & PARTNERS, RUSSIA), VIDYA SAGAR (REMFY & SAGAR, INDIA), ZHONGGI ZHOU (CCPIT, CHINA), RANA GOSAIN (DANIEL ABOGADOS, BRAZIL)

DECEMBER 2, 2010 // KAZAN

Gorodissky & Partners (Kazan) held the IV Annual IP Seminar on protection and enforcement of intellectual property rights. The leading patent/trademark attorneys and lawyers of the Moscow and Kazan offices – Valery Lyzhin, Alla Bogacheva, Dr. Valery Djermakian, Albert Ibragimov, Elvira Shalkina - were the speakers alongside with the officers of the Russian PTO and the Tatarstan Customs.

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