

# Intellectual property right assignments Q&A: Russian Federation

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This Q&A provides country-specific commentary on the following standard documents:

*Assignment of intellectual property rights: Cross-border.*

*Assignment of trade marks: Cross-border.*

*Assignment of copyright: Cross-border.*

*Assignment of patents: Cross-border.*

*Assignment of industrial designs: Cross-border.*

*Waiver of moral rights: Cross-border.*

*Letter confirming assignment of intellectual property rights: Cross-border.*

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## Key aspects of intellectual property right assignments

### Definition of intellectual property rights

**Q1. Does the definition of "Intellectual Property Rights" in *Standard document, Assignment of intellectual property rights: Cross-border: clause 1.1* include any rights that are not recognised in your jurisdiction? If yes, what are those rights?**

Rights in get-up, domain names and goodwill are not recognised as intellectual property (IP) rights or unfair competition under Russian law. Trade dress and the right to sue for passing off may be protected separately within the doctrine of unfair competition. Also, moral rights and business names cannot be assigned.

All assignable IP rights and the scope of IP transfer must be properly defined in the agreement (that is, all relevant titles, applicable registration and/or application numbers must be specified). The wording "any and all" is not sufficient from a Russian law perspective.

**Q2. Should this definition be amended to include any additional rights that are recognised in your jurisdiction? If yes, what are those rights?**

In addition to the rights listed in this definition, the following IP rights should be added to cover all IP rights assignable in Russia:

- Rights to selection achievements (such as, plant varieties and animal breeds).

- Rights to topologies of integrated circuits (that is, mask works).

These additional IP rights must be properly defined in the agreement, as noted above, in order to be assigned.

### **Assigning the benefit of licences to use intellectual property rights**

**Q3. Subject to any restrictions in the terms of the relevant licence, is it possible to assign the benefit of a licence to use intellectual property (IP) rights? If yes:**

- **Are there any restrictions on this (such as on the identity of the assignee or the price of the assignment)?**
- **Does the assignment have to comply with any particular formalities to be valid and enforceable?**
- **Does the burden of the licence automatically pass to the assignee along with the benefit?**

It is possible to assign the benefit of a licence to use IP rights to a third party. The assignment must be made with the IP owner's consent and can be free of charge, if the parties have agreed this by way of contract.

The original licence must be attached to the assignment agreement, and the change of licensee must be recorded with the Federal Service for Intellectual Property (*Rospatent*) to be valid and enforceable against third parties.

If the assignor (ex-licensee) transfers all of its rights and obligations under the licence, including the right to use the IP rights and the obligation to pay royalties, the burden of the licence automatically passes to the assignee (new licensee) along with the benefit of it.

### **Assigning future intellectual property rights**

**Q4. Is it possible to assign future IP rights? If yes, does an assignment have to comply with any formalities additional to the existing assignment, or do any additional documents need to be entered into, for that future assignment to be valid and enforceable?**

It is possible to assign future IP rights, including rights to obtain patents and rights to developing copyrighted subject matter, by way of an agreement between the parties. The Russian Supreme Court has confirmed this legal position.

Any formalities additional to the existing assignment usually depend on the nature of the future IP rights and the parties' arrangements in each situation. In certain cases, after the creation of future IP rights, registration of the assignment must follow the execution of the agreement.

### **Implied covenants**

**Q5. Do any of the laws applicable to IP assignments in your jurisdiction imply covenants relating to title?**

The law applicable to IP assignments, and in particular the Russian Civil Code, imply certain covenants relating to legal title. For example, that the assignor is the valid rights' holder and entitled to sell (assign) the IP rights to a third party.

Other covenants, such as that the IP is free from any encumbrances and adverse rights, are implied from the fundamental civil law principles of good faith and fair dealing, which are enforced by the courts.

### **Right to sue for past infringements**

**Q6. Is it possible to assign the right to sue for past infringement or misuse of IP rights? If yes, is this right automatically transferred to an assignee on an assignment of the relevant IP rights, or must it be expressly included in the terms of the assignment?**

It is possible to assign the right to sue for past infringement or misuse of IP rights. This right, including the right to claim damages or compensation, must be expressly included and properly described in the terms of the assignment.

To avoid disputes, the assignment must be supported by the relevant title documents (for example, an effective court decision), or the parties should assess the criteria for determining the amount of assigned damages (compensation), as well as the period of infringement.

**Q7. If it must be expressly included, comment on whether the clauses below are effective to assign the right and, if not, set out any necessary amendments to make them so:**

- *Standard document, Assignment of intellectual property rights: Cross-border: clause 2(c)*
- *Standard document, Assignment of trade marks: Cross-border: clause 2(c)*
- *Standard document, Assignment of copyright: Cross-border: clause 2*
- *Standard document, Assignment of patents: Cross-border: clause 2(e)*
- *Standard document, Assignment of industrial designs: Cross-border: clause 2*

It would be advisable to insert additional wording in the clauses above to specify the following:

- The amount of assigned damages (compensation), if possible.
- The assigned period of infringement.
- The assigned infringement and the illegal activities of the infringing party.

### **Right of priority**

**Q8. Do applicants for registered IP rights have the right to seek a priority date for their applications? If yes, is it possible to assign that right of priority along with the IP right to which it relates? Are there any formal requirements for a valid and enforceable assignment of the right of priority?**

Applicants for registered IP rights, such as rights to inventions, utility models and industrial designs, have the right to seek a priority date for their applications.

It is possible to assign that right of priority along with the IP right to which it relates.

The right of priority transfers automatically with the assignment of IP rights. This applies for all IP rights.

### **Tax considerations**

**Q9. What tax charges and tax considerations typically arise on an assignment of IP rights? Do these vary depending upon:**

- **The type of IP right being assigned?**
- **Whether the assignor or assignee is an individual or corporation?**
- **Whether the assignor or assignee is tax-resident?**

**If yes, explain those variations.**

#### **Corporate income tax and value added tax (VAT)**

Generally, an assignor must pay corporate income tax at 20% on the consideration payable on an assignment of IP, and VAT at 20% on the consideration payable on an assignment of trade marks, "foreign" computer programs and databases or national computer programs and databases not included in the special/unified Register and copyright.

The assignment of inventions, utility models, industrial designs, know-how, national computer programs (included in the special/unified Register), national databases (included in the special/unified Register) and topologies of integrated circuits is exempt from VAT.

#### **Foreign assignor and local assignee tax liability**

Consideration payable to a foreign assignor by a local assignee under an assignment of IP rights is subject to corporate income tax at 20%, unless there is a double tax treaty between Russia and the state where the assignor resides that provides tax relief.

If the foreign assignor does not have a permanent establishment or representative office in Russia, the local assignee must:

- Withhold corporate income tax from the consideration and send this to the state budget, unless there is a double tax treaty between Russia and the foreign state where the assignor resides.
- Withhold VAT from the consideration for a trade mark or copyright assignment and send it to the state budget. Therefore, the foreign assignor should add VAT at 20% to the consideration payable by the local assignee under an assignment of trade marks, "foreign" computer programs and databases or national computer programs and databases not included in the special/unified Register and copyright.

The local assignee can deduct the VAT amount, and the amount of consideration, when paying its own corporate income tax to the state budget.

#### **Transfer pricing**

Parties must also comply with local transfer pricing rules. The consideration for the assigned IP rights must comply with the relevant market price to avoid additional charges and penalties.

**Q10. Set out any amendments necessary to the standard documents below to reflect tax charges and considerations arising in your jurisdiction:**

- *Standard document, Assignment of intellectual property rights: Cross-border.*
- *Standard document, Assignment of trade marks: Cross-border.*
- *Standard document, Assignment of copyright: Cross-border.*

- *Standard document, Assignment of patents: Cross-border.*
- *Standard document, Assignment of industrial designs: Cross-border*

It would be advisable to change the VAT clause in the above standard documents into the following (universal) clause:

"The amounts payable to the Assignor will not be reduced by any deduction or withholding for any present or future taxes, levies, imposts, duties, fees, charges or liabilities imposed by any governmental tax authority in Russia, including any interest, additions to tax or penalties applicable to any of the foregoing (collectively, 'Taxes'). If Legal Requirements impose an obligation on the Assignee to deduct or withhold Taxes directly from any amount paid to the Assignor, then the Assignee will deduct or withhold the required amount and will timely pay the full amount deducted or withheld to the relevant governmental tax authority in accordance with Legal Requirements. The amount paid to the Assignor will be increased so that after the deduction or withholding has been made in accordance with Legal Requirements, the net amount actually received by the Assignor will equal the full amount originally invoiced or otherwise payable. To the extent any Legal Requirements require or allow any such deduction, payment or withholding to be paid by the Assignee directly to a governmental tax authority, the Assignee must account for and pay such amounts promptly and provide the Assignor with receipts or other proof of such payment promptly upon receipt."

#### **Power of attorney**

**Q11. Is it common practice for an assignee to seek to include a power of attorney in an assignment of IP rights? If yes, comment on whether *Standard document, Assignment of intellectual property rights: Cross-border: clause 7.2* is sufficient to grant a valid and enforceable power of attorney. If not, set out below any necessary amendments to make it so.**

It is not common practice for an assignee to seek to include a power of attorney in an assignment of IP rights. However, for assignment recordal purposes, the assignment will require both parties to sign, execute and deliver all necessary and required documents, including the powers of attorney (or the power of attorney from either of the parties) issued to respective patent and trade mark attorneys, which must be submitted to *Rospatent*. It is for a must for power(s) of attorney to be issued to respective patent and trade mark attorneys, since it(they) enable(s) them to liaise with *Rospatent* on the recordal issues.

#### **Assistance with future proceedings**

**Q12. Is it usual for an assignor to be obliged to assist the assignee in obtaining, defending and enforcing the assigned rights, and to assist with any proceedings that relate to them after completion of an assignment (see for example *Standard document, Assignment of intellectual property rights: Cross-border: clause 7.1(b)*)?**

This is not usual practice. However, in certain instances (for example, trade mark non-use cancellation actions) an assignor's assistance clause may be reasonable and efficient, and therefore may be added to the assignment.

#### **Perfecting the assignment**

**Q13. Does either party have to take any additional steps after execution of an assignment for an assignee to receive and enjoy the full benefit of an assignment? If yes, briefly describe those additional steps, and whether they vary depending on the IP right being assigned.**

An assignment of IP rights must be made in writing and signed by both parties. Notarisation and legalisation of the assignment agreement is not required. However, it is mandatory to record an assignment of:

- Patents (including for inventions, utility models and industrial designs).
- Trade marks and service marks (including under national and international registrations).
- Computer programs and databases (only if they are registered with *Rospatent*).
- Topologies of integrated circuits (only if they are registered with *Rospatent*).
- Selection achievements (such as, plant varieties and animal breeds).

Failure to record an assignment of the above IP rights will result in the transfer of the rights being invalid and unenforceable against third parties.

### Liability

**Q14. Is it possible for an assignor to seek to limit or exclude all liability that might arise after execution of an assignment in relation to the assigned rights (see for example *Standard document, Assignment of intellectual property rights: Cross-border: clause 9*)?**

It is not possible for an assignor to exclude its liability that might arise after execution of the assignment in relation to the assigned rights, unless there is a force majeure event (for example, pandemic or epidemic) proved by a certificate from the relevant government authority.

The assignor can limit its liability under the assignment by limiting the reimbursement of damages to a smaller amount or up to a defined amount, or reimbursement of actual damage or lost profits only. The court will assess such a limitation in each case.

**Q15. Is it possible to limit or exclude liability for death and personal injury under particular circumstances?**

It is possible to exclude a party's liability under an assignment of IP rights arising from death of a party, as it is considered a valid legal ground for termination of obligations in accordance with Russian civil law. If personal injury leads eventually to the lack of legal capacity of the party, the liability of the (incapable) party can be limited.

### Guarantor

**Q16. Is it possible for a third party to guarantee the obligations of an assignor in an assignment of IP rights? If yes, is it usual for the guarantor to be made a party to the assignment and/or does a separate guarantee agreement need to be entered into by the parties?**

It is possible for a third party to guarantee the obligations of an assignor in an assignment of IP rights. Usually, a separate guarantee agreement, whether bilateral or trilateral, is entered into by the parties and attached to the assignment. If the guarantee agreement is not made in writing it will be invalid by law.

### Formalities for assignment

**Q17. Does an assignment of IP rights have to comply with any particular formalities to be valid and enforceable (including in relation to format, language and execution)? If yes, describe briefly what these are for each type of IP right.**

## Trade marks

An assignment of a trade mark must be in writing and signed by both parties. In addition to being executed in the Russian language, the assignment can be signed in a bilingual format or in English and accompanied with a Russian translation.

A trade mark assignment must be recorded with *Rospatent* (see *Question 22*). Failure to record the assignment will render it invalid and unenforceable against third parties.

## Copyright

An assignment of copyright must be in writing and signed by both parties. In addition to being executed in the Russian language, the assignment can be signed in a bilingual format or in English and accompanied with a Russian translation.

Recordal of a copyright assignment is not required, unless it relates to a computer program or database that is registered with *Rospatent*. Failure to record an assignment of a registered computer program or database will render it invalid and unenforceable against third parties.

## Patents and know-how

An assignment of patents must be in writing and signed by both parties. In addition to being executed in the Russian language, the assignment can be signed in a bilingual format or in English and accompanied with a Russian translation.

A patent assignment must be recorded with *Rospatent*. Failure to record the assignment will render it invalid and unenforceable against third parties.

An assignment of know-how must be in writing but does not have to be recorded.

## Industrial design right

An assignment of an industrial design must be in writing and signed by both parties. In addition to being executed in the Russian language, the assignment can be signed in a bilingual format or in English and accompanied with a Russian translation.

The assignment must be recorded with *Rospatent*. Failure to record the assignment will render it invalid and unenforceable against third parties.

**Q18. If some form of consideration must be transferred between the parties for an assignment to be valid and enforceable, is a nominal sum acceptable, or must it be an amount that reflects the current market value of the IP rights being assigned, whether for tax reasons or otherwise?**

Free-of-charge assignments of IP rights between commercial organisations and business entities (companies) are prohibited by law.

Nominal consideration is not advisable for assignment deals involving companies, since they may be deemed to be sham transactions that can be challenged.

For transfer pricing compliance and certain tax reasons, it is highly advisable to include an amount that reflects the current market value of the IP rights being assigned. Otherwise, it is possible to assign IP rights under the cost-approach valuation method.

## Compliance with local law and practice

**Q19. Are any of the terms in the standard documents below invalid, unenforceable or contrary to standard practice in your jurisdiction? If yes, set out any necessary amendments to make those terms valid, enforceable and reflective of standard practice.**

- *Standard document, Assignment of intellectual property rights: Cross-border.*
- *Standard document, Assignment of trade marks: Cross-border.*
- *Standard document, Assignment of copyright: Cross-border.*
- *Standard document, Assignment of patents: Cross-border.*
- *Standard document, Assignment of industrial designs: Cross-border.*

The following amendments are necessary:

- *Standard document, Assignment of intellectual property rights: Cross-border.*  
*Clause 9 and clause 2(b) must be removed.*
- *Standard document, Assignment of trade marks: Cross-border.*  
*Clause 8 and clause 2(b) must be removed.*
- *Standard document, Assignment of copyright: Cross-border.*  
*Clause 8 must be removed.*
- *Standard document, Assignment of patents: Cross-border.*  
*Clause 8 must be removed.*
- *Standard document, Assignment of industrial designs: Cross-border.*  
*Clause 8 must be removed.*

## Brexit

**Q20. Are any amendments required to the standard documents below to reflect the fact that the UK left the EU on 31 January 2020, and a transition period ended on 31 December 2020?**

- **If yes, set the amendments out below and, if necessary, briefly explain them.**
- **If amendments are required but will depend upon the terms agreed between the UK and the EU in the trade and co-operation agreement governing their future relationship, set out the amendments for each scenario below.**
- **If no amendments are necessary, insert "no amendments".**

No amendments are necessary to the following standard documents:

- *Standard document, Assignment of intellectual property rights: Cross-border*



- *Standard document, Assignment of trade marks: Cross-border.*
- *Standard document, Assignment of copyright: Cross-border.*
- *Standard document, Assignment of patents: Cross-border.*
- *Standard document, Assignment of industrial designs: Cross-border.*

## Registration and recordal aspects of intellectual property right assignments

### Registrable intellectual property rights

**Q21. Which IP rights are registrable in your jurisdiction? Provide a link to the website of the relevant registry in each case.**

The following IP rights are registrable:

- Patents (inventions and utility models): [new.fips.ru/en](http://new.fips.ru/en).
- Industrial designs: [new.fips.ru/en](http://new.fips.ru/en).
- Trade marks: [new.fips.ru/en](http://new.fips.ru/en).
- Appellations of origin of goods: [new.fips.ru/en](http://new.fips.ru/en).
- Computer programs and databases: [new.fips.ru/en](http://new.fips.ru/en).
- Topologies of integrated circuits: [new.fips.ru/en](http://new.fips.ru/en).
- Selection achievements: [gossort.com](http://gossort.com).

### Assignment recordal/registration

**Q22. Can an IP assignment be recorded at the IP registry in your jurisdiction? If yes, is this optional or a statutory requirement? If the position varies depending on the IP right being assigned, explain those variations.**

#### Trade marks

See *Question 13* and *Question 17*. The assignment must be recorded with *Rospatent* or it will be invalid and unenforceable against third parties. There is no specific timeframe for recordal. The recordal costs are subject to agreement between the parties.

#### Copyright

See *Question 13* and *Question 17*. Assignment recordal is not required except for computer programs and databases registered with *Rospatent*. Failure to record an assignment of registered computer programs and databases will render it invalid and unenforceable against third parties. There is no specific timeframe for recordal. The recordal costs are subject to agreement between the parties.

#### Patents and know-how

See *Question 13* and *Question 17*. Assignment recordal is mandatory for patents, but not for know-how. Failure to record a patent assignment will render it invalid and unenforceable against third parties. There is no specific timeframe for recordal. The recordal costs are subject to agreement between the parties.

### **Industrial design right**

See *Question 13* and *Question 17*. Assignment recordal is mandatory for industrial designs. Failure to record an assignment will render it invalid and unenforceable against third parties. There is no specific timeframe for recordal. The recordal costs are subject to agreement between the parties.

### **Other**

See *Question 13* and *Question 17*. Assignment recordal is mandatory for registered topologies of integrated circuits and for patented achievements of selection. Failure to record an assignment will render it invalid and unenforceable against third parties. There is no specific timeframe for filing. The associated costs are subject to contract.

**Q23. Is it usual to include a mechanism in the terms of an assignment to ensure that the assignor satisfies its obligation to record the assignment, or that the assignee is able to take action if the assignor fails to do so?**

It is usual to include a mechanism in the terms of an assignment to ensure that the assignor or assignee satisfy their respective obligations (as agreed) to file and record the assignment.

A special clause covering the procedure, timing and payment for assignment recordal is normally included in the assignment.

## **Warranties and indemnities in intellectual property right assignments**

### **Express warranties from assignor**

**Q24. Is it usual for an assignee to seek certain express warranties from an assignor in an IP assignment? If yes, comment on whether the clauses below reflect the scope of express warranties typically given by an assignor and, if not, set out any necessary amendments so that they do:**

- *Standard document, Assignment of intellectual property rights: Cross-border: clause 4.*
- *Standard document, Assignment of trade marks: Cross-border: clause 4.*
- *Standard document, Assignment of copyright: Cross-border: clause 4.*
- *Standard document, Assignment of patents: Cross-border: clause 5.*
- *Standard document, Assignment of industrial designs: Cross-border: clause 4.*

It is usual for an assignee to seek certain express warranties from an assignor in an IP assignment. No amendments are necessary to the above clauses.

### **Implied warranties from assignor**

**Q25. Is it usual for certain warranties to be implied into the terms of an IP right assignment in your jurisdiction? If yes, briefly describe what those implied warranties are, which types of IP assignments they apply to (if not all), and whether their application can be excluded from the terms of an assignment. State any relevant legislation.**

See *Question 5*. It is not possible to exclude the application of implied warranties relating to legal title and the validity of IP rights.

### **Assignor indemnity**

**Q26. Is it usual for an assignee to seek an indemnity from an assignor? If yes, comment on whether the clauses below reflect standard practice in your jurisdiction and, if not, set out any necessary amendments so that they do.**

- *Standard document, Assignment of intellectual property rights: Cross-border: clause 5.*
- *Standard document, Assignment of trade marks: Cross-border: clause 5.*
- *Standard document, Assignment of copyright: Cross-border: clause 5.*
- *Standard document, Assignment of patents: Cross-border: clause 6.*
- *Standard document, Assignment of industrial designs: Cross-border: clause 5.*

It is usual for an assignee to seek an indemnity from an assignor.

In each of the clauses listed above, it is advisable to specify the exact amount (cap) on the indemnity or, at least, the indemnity calculation procedure, as this is specifically required by Article 406.1(1) of the Russian Civil Code.

**Q27. Does an assignee have a general obligation at law to mitigate any loss that it may suffer or incur as a result of an event that would give rise to a claim under an indemnity? State any relevant legislation.**

There is no such specific obligation at law. However, by law a court can reduce the claimed indemnity amount, if it has been proved that the party has deliberately caused an increase in the indemnity amount.

## **Assigning specific types of intellectual property rights**

### **TRADE MARKS**

#### **Partial assignment**

**Q28. Is it possible to make a partial assignment of a registered trade mark?**

It is possible to make a partial assignment of a registered trade mark. However, a partial assignment may not be possible if the assignor wants to keep the trade mark registration in connection with certain other goods or services similar to the assigned ones, as such an assignment may lead to confusion among consumers in the market.

There are other statutory provisions relating to misleading consumers that could prevent a partial assignment from being made.

#### **Goodwill**

**Q29. What is understood by the term "goodwill" in your jurisdiction?**

The term goodwill that is usually attached to a trade mark under UK or US law is not recognised in Russia. A similar concept (intangible asset) is the business reputation of the business entity, although it is not protected as an IP right, and it cannot be assigned.

**Q30. Is goodwill automatically transferred to the assignee of a trade mark, or must it be expressly included in the terms of an assignment (see for example *Standard document, Assignment of intellectual property rights: Cross-border: Clause 2(b)* and *Standard document, Assignment of trade marks: Cross-border: Clause 2(b)*)? Does this depend upon whether the trade mark is registered or unregistered?**

Not applicable (see *Question 29*).

### Co-ownership

**Q31. Is it possible to co-own trade marks? If yes, are co-ownership agreements used to formalise the terms upon which the parties agree to co-own trade marks?**

It is not possible to co-own trade marks. This position is supported by recent local court practice, including the Russian Supreme Court.

### Copyright in trade marks

**Q32. Under what circumstances might a trade mark also be protected by copyright? Is there anything additional that an assignee must do to ensure that copyright in a trade mark is transferred to it by the terms of an assignment?**

Three-dimensional (3D) trade marks, logos and other artistic creations (designations) can qualify for copyright protection. The assignee must ensure that the copyright owner has consented to the registration of a trade mark for the copyrighted work by the assignor, and have a copy of a letter of consent at hand as confirmation. However, there is no need to have copyright in a trade mark separately transferred to the assignee in the assignment.

### Acquiescence

**Q33. If a registered trade mark owner has acquiesced in the use of a later trade mark whilst being aware of such use, is the owner prevented from applying for a declaration that the later trade mark is invalid, or from opposing the use of the later trade mark? If yes, how long must the period of acquiescence be before this rule applies, if at all? Are there any exceptions to this rule?**

If a registered trade mark owner has acquiesced in the use of a later trade mark while being aware of such use, the owner is not prevented from applying for a declaration that the later trade mark is invalid, or from opposing the registration of the later trade mark.

Trade mark registration can be challenged on different grounds, including absolute and relative grounds. Bad faith trade mark acquisition and use can also be a valid ground for invalidation.

A cancellation action based on absolute grounds, or bad faith trade mark acquisition and use, can be brought at any time within the term of trade mark protection. A cancellation action based on relative grounds can be brought within five years following the date of trade mark publication.

A cancellation action based on non-use can be filed (on compliance with the special pre-trial procedure) if the conflicting mark is not used within three consecutive years.

## COPYRIGHT

### First owner of copyright work

**Q34. Is the general rule that the author of a copyright work (the person who creates it) is the first owner of that work? Are there any exceptions to this rule? If yes, briefly describe them.**

The general rule is that the author of a copyright work is the first owner of that work.

If the author (an employee) created the work in the course of their employment, the employer is the first owner of the exclusive rights in the employee's work, unless there is an agreement to the contrary.

Where a work is commissioned under a contract, the ownership of exclusive rights to the created copyright work can be assigned to the respective party (as agreed). By default, the customer owns the exclusive rights to the commissioned (contracted) work (*Article 1296(1), Russian Civil Code*).

### Recognition of moral rights

**Q35. Does your jurisdiction recognise moral rights, or any equivalent or similar rights that accrue to the author of a copyright work? If yes, provide a brief overview of those rights.**

Moral rights (also known as personal (non-proprietary) rights) are recognised and protected in Russia.

The author of a copyright work has the following personal (non-proprietary) rights:

- The right to claim authorship of that work (right of authorship).
- The right to use and authorise the use of the work with or without the author's name and pseudonym (right of the author to the name).
- The right to carry out alterations or modifications to the work (right of integrity).
- The right to publish or otherwise make public the work, or to authorise any of these (right of publication).
- The right to recall a decision to publish the work, on payment of damages to the respective assignee or licensee (right of recall).

The right of authorship, right of the author to the name and the right of integrity are protected for an unlimited duration.

**Q36. Set out below any necessary amendments to clause 6 in each of the following standard documents to reflect the typical approach to moral rights (or the equivalent rights) in your jurisdiction:**

- Standard document, *Assignment of intellectual property rights: Cross-border*.
- Standard document, *Assignment of copyright: Cross-border*.

Clause 6 would need to be removed in order for each of these documents to reflect the typical approach to moral rights in Russia.

Waivers of moral rights are null and void.

In certain instances, however, it is possible with the author's consent to:

- Distribute the copyrighted work without the author's name.
- Alter and modify the distributed copyright work, if necessary.
- Correct certain errors, provided that the correction does not affect the integrity of the perception of the work.
- Register the copyright work (for example, computer program) with *Rospatent*, or deposit it with the accredited organisation, without mentioning or disclosing the author.

### Assertion of moral rights

**Q37. Do some or all moral rights have to be asserted by the author before they apply, or do they take effect immediately upon creation of a copyright work?**

Moral rights take effect immediately on creation of a copyright work. The assertion of moral rights is not required by law.

### Assignment and waiver of moral rights

**Q38. Can moral (or similar) rights be assigned and/or waived? Is the author the only one entitled to assign and/or waive them, or can an assignee of the works to which they relate also assign and/or waive them?**

Moral rights cannot be assigned and/or waived, and so any purported assignment or waiver would be null and void under Russian law.

**Q39. Comment on whether *Standard document, Waiver of moral rights: Cross-border* is valid and enforceable in your jurisdiction and, if not, set out below any necessary amendments to make it so, and briefly explain your reasons.**

*Standard document, Waiver of moral rights: Cross-border* would not be valid or enforceable in Russia. However, it is possible to obtain a letter of consent from the author to:

- Anonymously use the copyright work.
- Register or deposit the copyright work without an indication of the author's name.
- Alter or modify the copyright work (for example, for clarification purposes).
- Make the copyright work public for the first time.

### Exceptions to moral rights

**Q40. Are there any particular types of works that moral rights do not apply to?**

Official documents, state symbols, folklore and data reporting events or facts do not qualify for copyright protection. Therefore, moral rights do not apply to these particular subject matters.

### Database right

**Q41. Under what circumstances might the subject matter comprised in a copyright work also be protected by database right? Is there anything additional that an assignee must do to ensure that rights to use the database are transferred to it by the terms of the assignment?**

According to the Russian Civil Code, a database is an objectivised set of independent materials (articles, calculations, legal acts, court decisions and other similar materials) organised in a way where such materials can be located and processed through a computer.

Copyright protects the selection and location of content (that is, the database's outer appearance). The related right (the database maker's right) protects the content itself (the database materials), and both cannot exist in non-electronic form.

It is possible, but not compulsory, to register the database, whether protected under copyright law or as the database maker's right, with *Rospatent*. A copyright or related rights assignment related to a registered database must be recorded with *Rospatent*, to ensure that the database rights are properly transferred to the assignee (see *Question 22*).

### **First owner of database**

**Q42. Is the general rule that the maker of a database (the person who creates it) is the first owner of the database right in it? Are there any exceptions to this rule? If yes, briefly describe them.**

According to the Russian Civil Code the author of a database (the person who created it) is the first owner of any database right in it.

If the author (employee) created the database in the course of their employment, the employer is the first owner of the exclusive rights in the database, unless agreed otherwise.

Where a database is commissioned under a contract, the ownership of exclusive rights can be assigned to the respective party (as agreed). By default, the customer owns the exclusive rights to the commissioned (contracted) database (*Article 1296 (1), Russian Civil Code*).

The first owner of a *sui generis* right to a database is the person who organised the creation of the database and work related to the collection, processing and location of relevant materials for it. The creation of such a database requires "considerable investment" from a financial, material or organisational perspective. By a default provision of law, the database maker (organiser) will acquire the *sui generis* right to a database that consists of 10,000 independent information elements (materials) (*Article 1334(1), Russian Civil Code*). The database maker's right is protected, irrespective of any copyright vested in the database materials.

## **PATENTS**

### **First owner of invention**

**Q43. Is the general rule that the inventor is the first owner of an invention, and entitled to the rights in any patent granted in respect of that invention? Are there any exceptions to this general rule? If yes, briefly describe them.**

The general rule is that the inventor is the first owner of an invention.

According to Article 1370(3) of the Russian Civil Code, if the inventor (employee) created the invention in the course of their employment, the employer is the first owner of the exclusive rights in the employee's invention, unless agreed otherwise.

Where an invention is created under a research and development (R&D) or similar contract, the ownership of exclusive rights to the created invention can be assigned to the respective party (as agreed). By default, the contractor owns the exclusive rights to inventions and utility models created under R&D or similar contracts (*Article 1371(1), Russian Civil Code*).

### Divisional applications

**Q44. Do patent applicants have the right to file "divisional patent applications"? If yes, is it possible to assign that right, along with the patent to which it relates? Are there any formal requirements for a valid and enforceable assignment of the right to file divisional applications, other than listing it in the manner shown at *Standard document, Assignment of patents: Cross-border: clause 2(a)(ii)*?**

Patent applicants have the right to file divisional patent applications. It is possible to assign this right along with the corresponding patent application.

Divisional patent applications can be filed for already claimed inventions, or for inventions disclosed (but not claimed) in the parent applications. Parties should note the difference between these two and set out their arrangements in the assignment.

An assignment of the right to file divisional patent applications must be in writing and signed by both parties. Notarisation and legalisation of the assignment is not required. The parties should also notify *Rospatent* about the change of applicant.

### Improvements

**Q45. Briefly describe any potential issues that the obligation in *Standard document, Assignment of patents: Cross-border: clause 3* might give rise to, including in relation to competition law, and set out below any necessary amendments to address them.**

*Standard document, Assignment of patents: Cross-border: clause 3*, as drafted, reflects Russian standard practice in relation to improvements. No amendments are necessary.

## INDUSTRIAL DESIGNS

### First owner of industrial design

**Q46. Is the general rule that the designer is the first owner of any design right in a design? Are there any exceptions to this rule? If yes, briefly describe them.**

The general rule is that the designer is the first owner of a design.

According to Article 1370(3) of the Russian Civil Code, if the designer (employee) created the design in the course of their employment, the employer is the first owner of the exclusive rights in the employee's design, unless agreed otherwise.

Where a design is commissioned under a contract, the ownership of exclusive rights to the created design can be assigned to the respective party (as agreed). By default, the contractor owns the exclusive rights to the commissioned design (*Article 1372(1), Russian Civil Code*).

### Registered and unregistered

**Q47. Do both registered and unregistered design rights subsist in your jurisdiction? State any relevant legislation.**



Both registered and unregistered design rights do subsist and are protected in Russia.

Registered designs are usually titled as industrial designs protected under patent law. Unregistered designs are usually titled as designs protected under copyright law. Dual protection is possible and recognised by local courts. Termination of copyright protection does not affect the validity of patent protection, and vice versa.

Two-dimensional (2D) or 3D designs can also be protected by 2D and 3D trade mark registrations. In addition, an unregistered design for a trade dress can enjoy protection against copying and imitation under the doctrine of unfair competition.

**Q48. How is the territorial scope of each type of design right determined?**

Registered designs (industrial design patents and trade marks) are only protected in Russia if they are patented and registered with *Rospatent*, or through Russia-designations (for international trade mark registrations).

Unregistered designs (copyright designs) are protected in countries that are signatories of the Berne Convention, including Russia, provided that they have been created due to the designers' input, are original/artistic and fixed in a tangible media of expression.

**Q49. Do both types of design right protect the same aspects of a design? What are those aspects for the respective rights?**

In general, both types of design right protect a product's outer appearance.

However, since a patented/trade marked industrial design and a copyright design protect different methods of design expression (use), enforcement of corresponding IP rights will vary depending on the infringement at issue.

Trade dress protection available under the doctrine of unfair competition also has its own specific requirements (see *Question 50*).

**Q50. Do both types of design right give the proprietor the same duration of protection, and scope of rights, for their design? What are the respective periods of protection and scope of the rights?**

The duration of patent protection for an industrial design is a maximum of 25 years (the initial five years, plus five more extensions).

The duration of trade mark protection for 2D or 3D marks is ten years initially, and can be renewed an unlimited number of times.

The duration of copyright protection for a design is the life of the author plus 70 years after their death.

The duration of trade dress protection available under the doctrine of unfair competition is unlimited (as long as there is competition between conflicting entities, and the trade dress does not become traditional on the market).

The manufacture, use, import, sale, offer for sale or any other marketing or storage for such purposes of a product containing an industrial design, without the owner's consent, constitutes patent (design) infringement. The product is deemed to contain an industrial design if it has all the essential features of the industrial design, or an equivalent combination of features, that produces the same overall impression on the informed consumer as the patented industrial design, provided that the products at issue have a similar purpose.

Unauthorised use of a trade mark, or similar mark, for similar goods and services, constitutes trade mark infringement, provided such use leads to a likelihood of confusion.

The reproduction, sale, importation for the purposes of distribution, making public of a work (design) or its copies, without the owner's consent, may also constitute copyright infringement.

Trade dress copying or imitation is also prohibited as it may be regarded as unfair competition.

**Q51. Are any particular features or types of design excluded from protection under the registered and/or unregistered design right regimes?**

Patent protection for an industrial design will not be granted to any of the following:

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

Trade mark protection has special exclusions in the Russian Civil Code.

Copyright design and trade dress protection available under the doctrine of unfair competition also have specific exclusions set out by law.

## **Confirmatory assignments of intellectual property rights**

**Q52. Under what circumstances are confirmatory assignments of (IP) rights used in your jurisdiction, if at all (see *Standard document, Letter confirming assignment of intellectual property rights: Cross-border*)?**

Confirmatory assignments of IP rights are widely used in Russia. They are also known as notifications on the disposal (assignment) of IP rights, or notarised excerpts from assignment agreements, and are executed by the parties as evidence of the assignment of IP rights (in addition to original assignment agreements).

Usually, these notifications and notarised excerpts are submitted to *Rospatent* for assignment recordal purposes when the parties do not wish to disclose the commercial terms of the deal or other sensitive information (that is, the parties do not wish to submit the original assignment agreements).

Confirmatory assignments cannot replace the assignment agreement, and cannot correct discrepancies or inconsistencies in the assignment agreement.

**Q53. Does a confirmatory assignment of IP rights have to comply with any particular formalities to be valid and enforceable?**

Confirmatory documents related to the assignment of IP rights must be in writing and signed by both parties.

In addition to being executed in the Russian language, the documents can be signed in a bilingual format or in English and accompanied with a Russian translation.

Notarisation and legalisation of such documents is not required.

**Q54. Set out below any necessary amendments to make *Standard document, Letter confirming assignment of intellectual property rights: Cross-border* valid and enforceable in your jurisdiction, and briefly explain your amendments.**

The full and correct company names and addresses of both parties must be provided. The relevant IP registration numbers (for example, patent numbers and trade mark numbers) must be included. The fact that the relevant IP rights have been assigned in full must be clearly stated in the assignment instrument.

**Contributor details**

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**Areas of practice.** IP and TMT, commercial law and licensing, franchising and distribution, dispute resolution and litigation, internet and e-commerce.

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