

GORODISSKY & PARTNERS

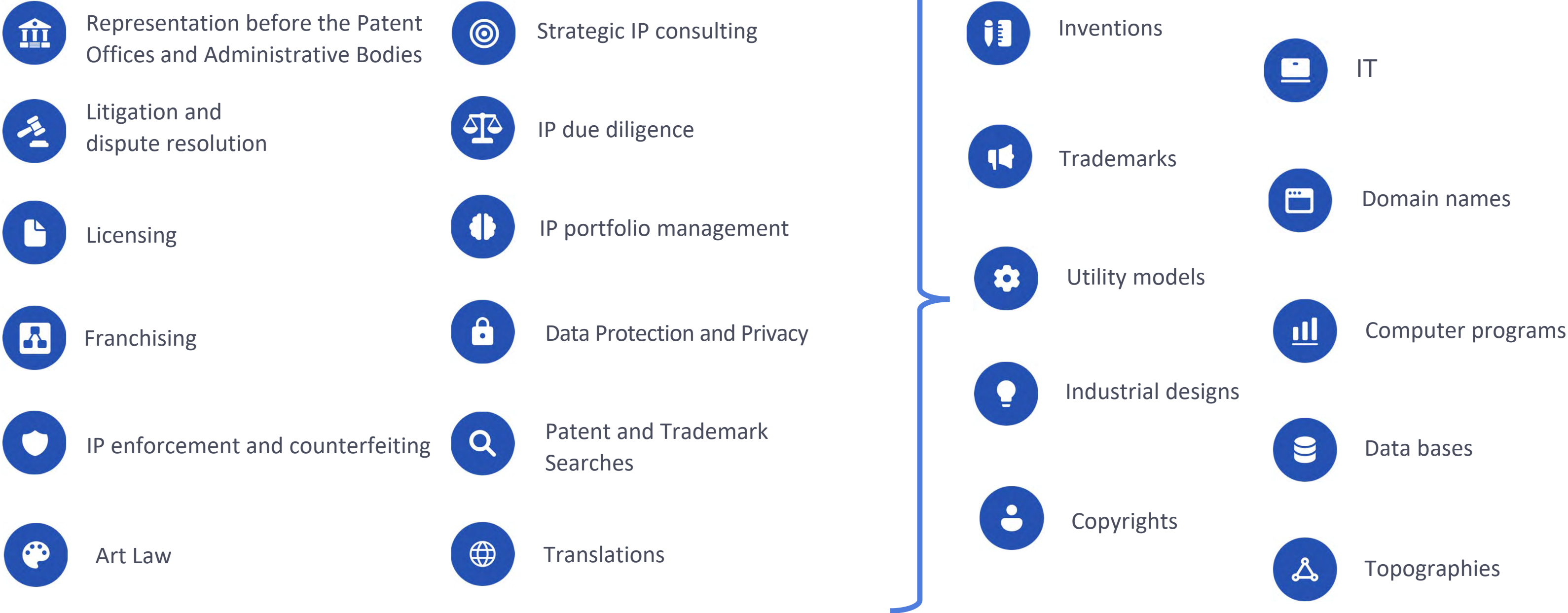
Since 1959

Intellectual Property & TMT

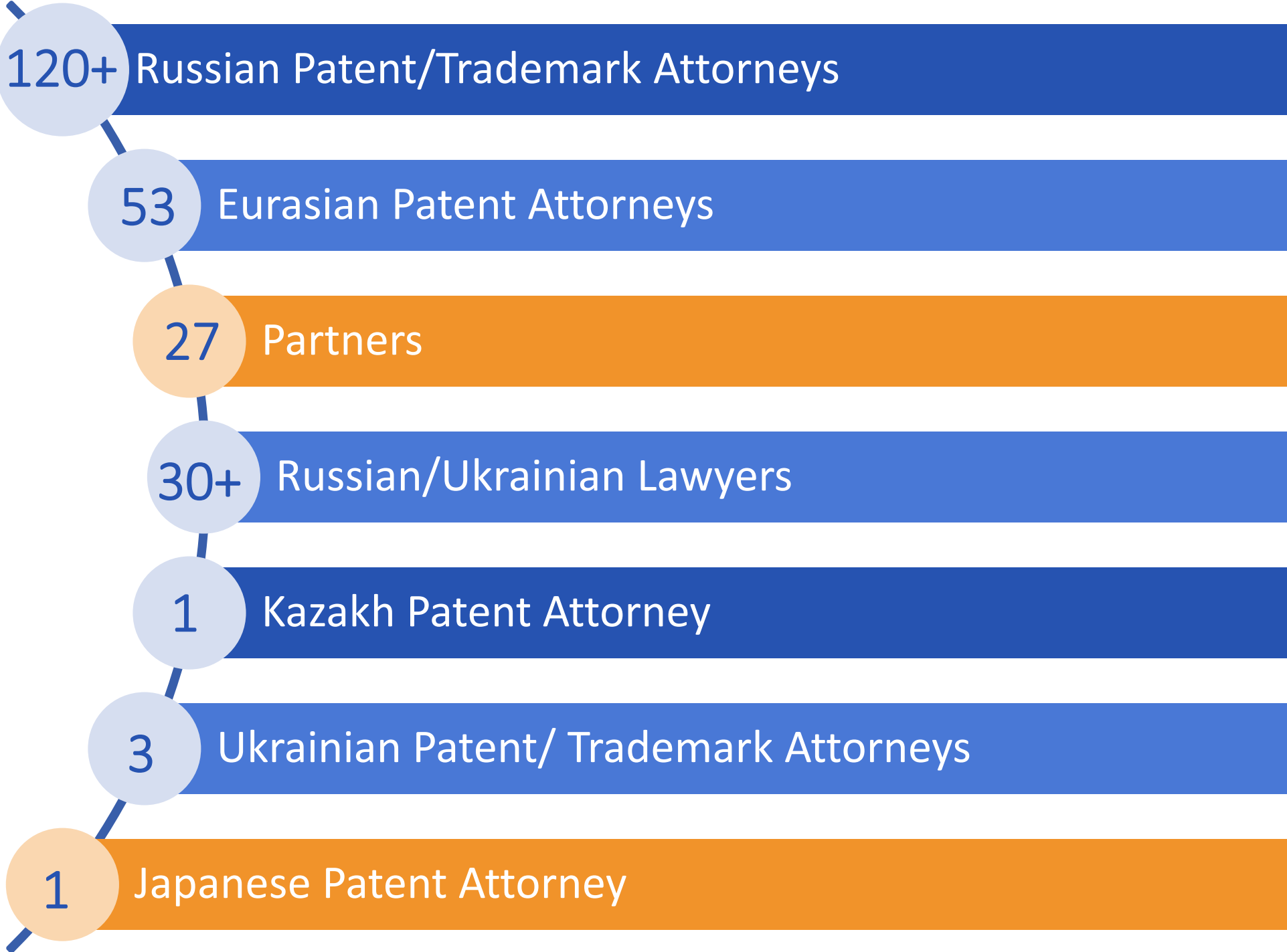
GORODISSKY
INTELLECTUAL PROPERTY TMT



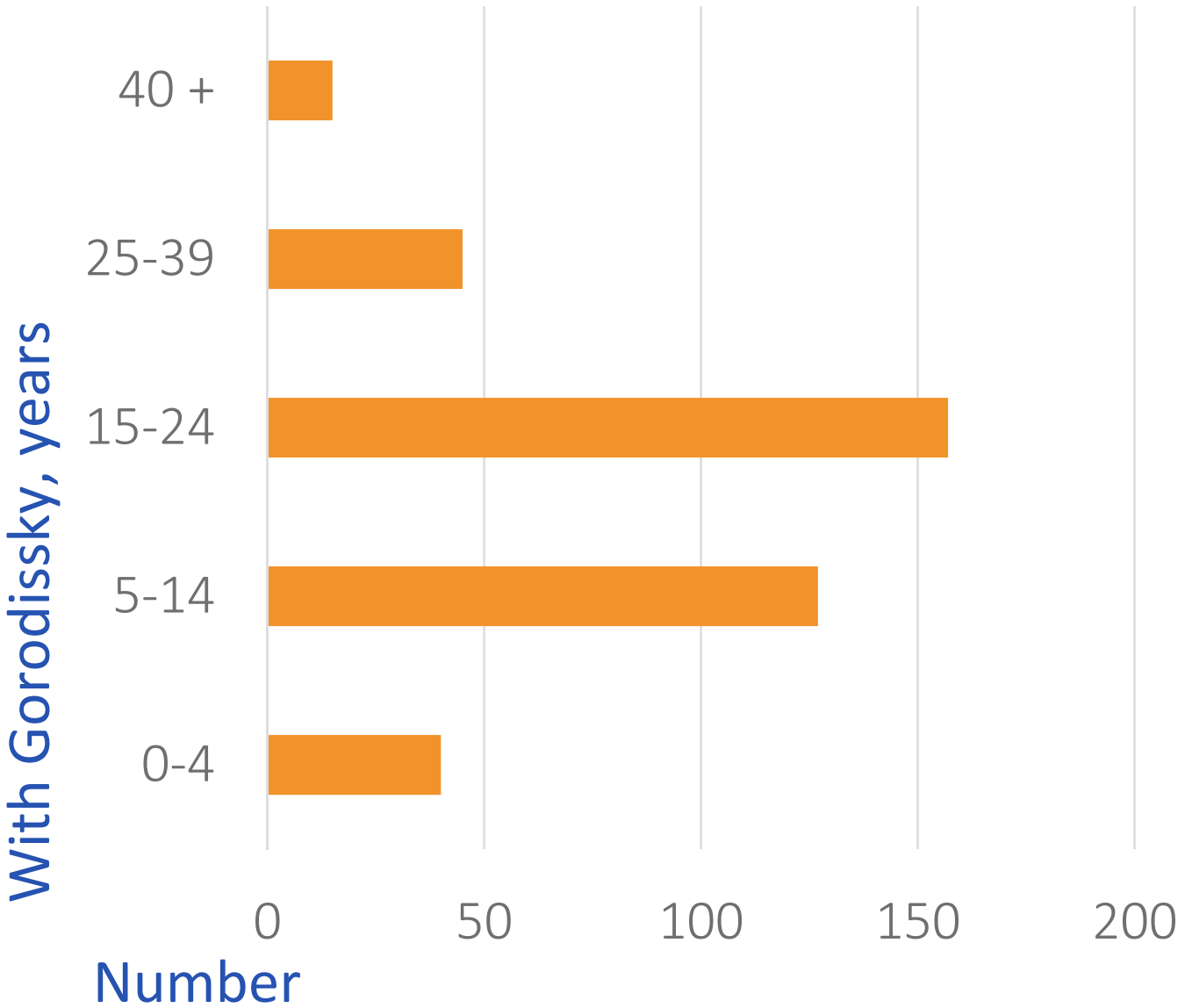
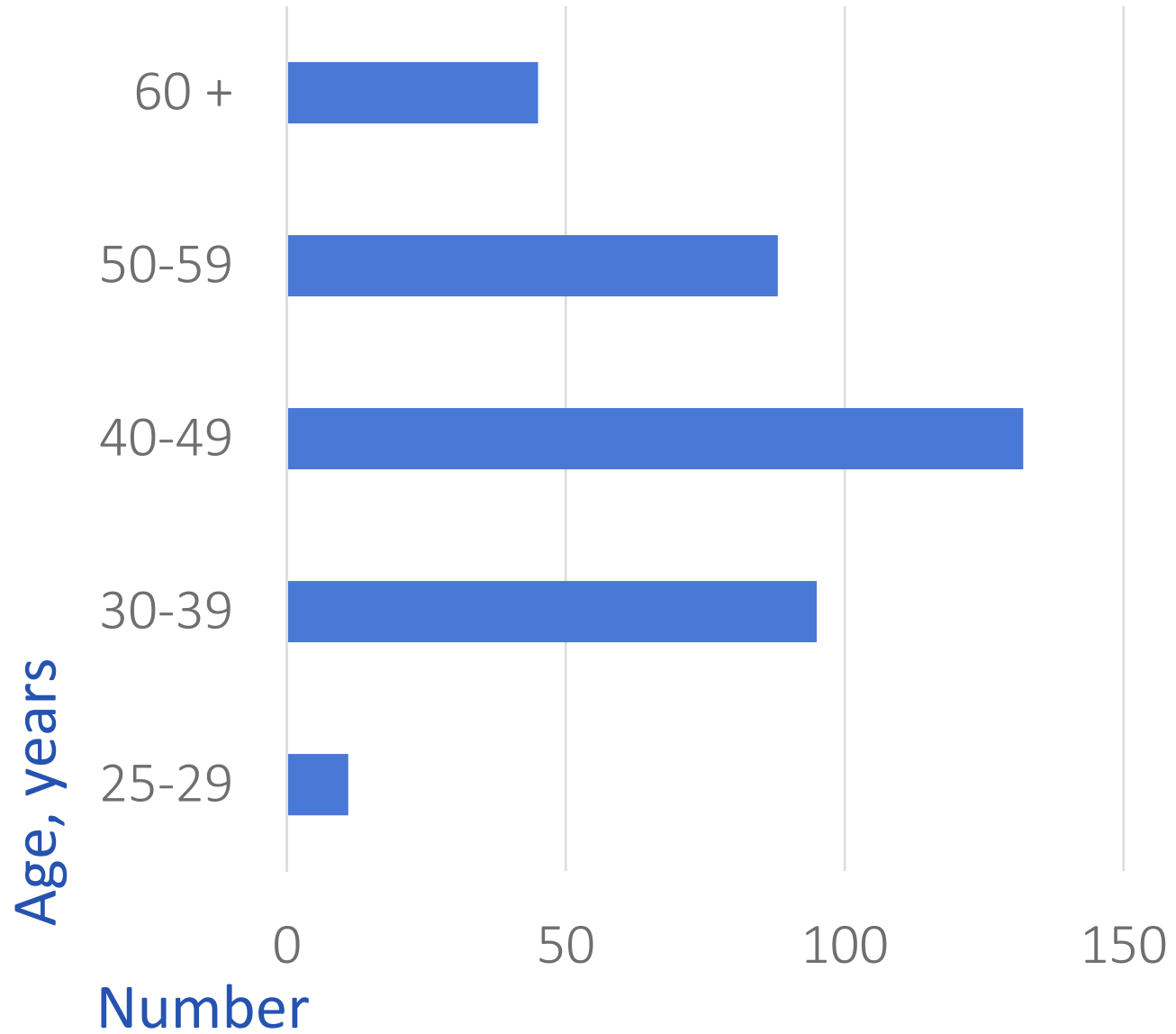
FIRM'S SERVICES



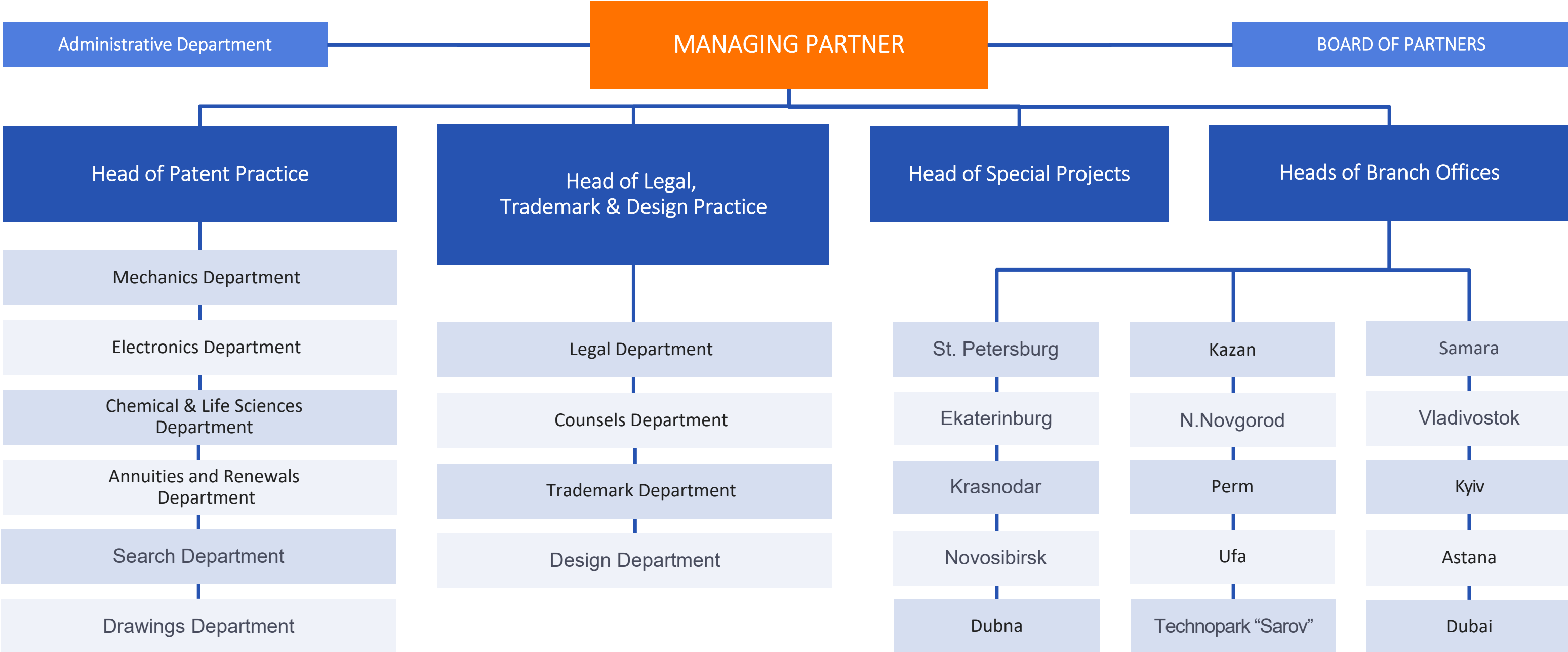
OUR TEAM



OUR IP ATTORNEYS AND LAWYERS



FIRM'S STRUCTURE



FIRM'S BRANCH OFFICES

RUSSIA

- Moscow
- St-Petersburg
- Kazan
- Ekaterinburg
- Perm
- Samara
- Krasnodar
- N. Novgorod
- Technopark «Sarov»
- Novosibirsk
- Vladivostok
- Ufa
- Dubna

UKRAINE

- Kiyv

KAZAKHSTAN

- Astana

UAE

- Dubai

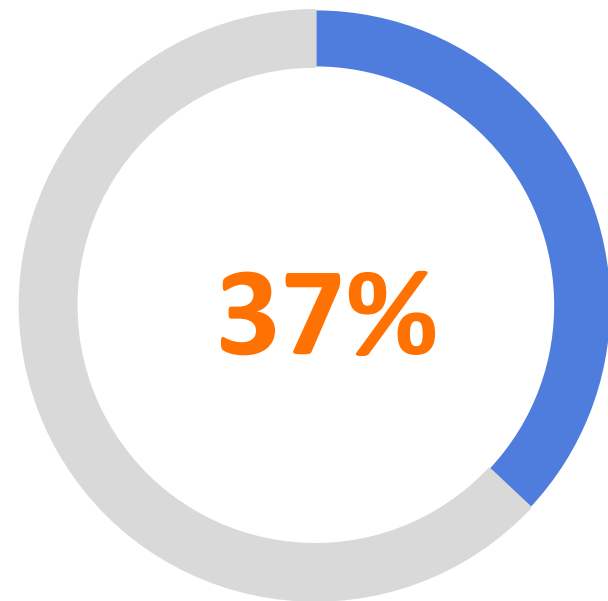


OUR PROFESSIONAL PRINCIPLES

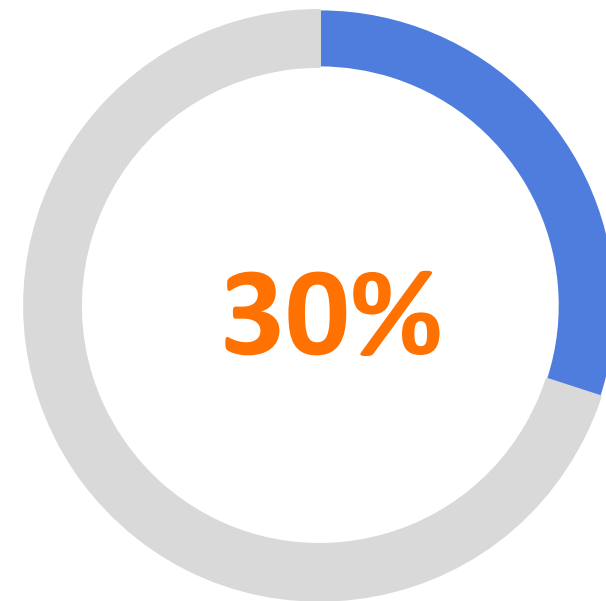


FIRM'S SHARE* ON THE RUSSIAN MARKET IN 2023

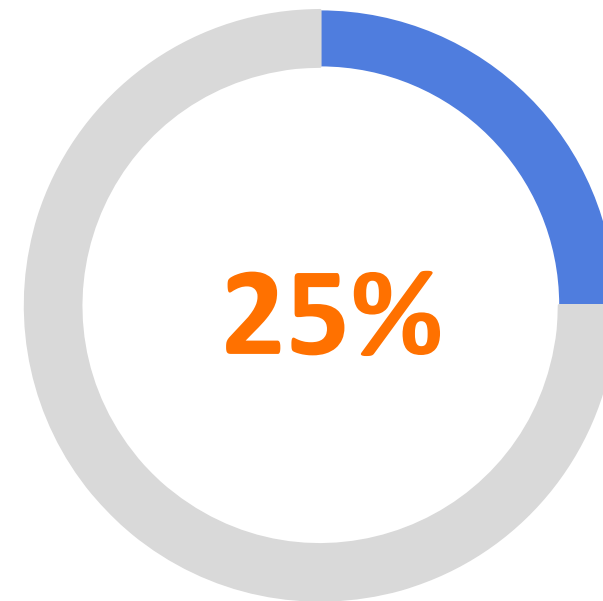
*New IP cases of foreign applicants



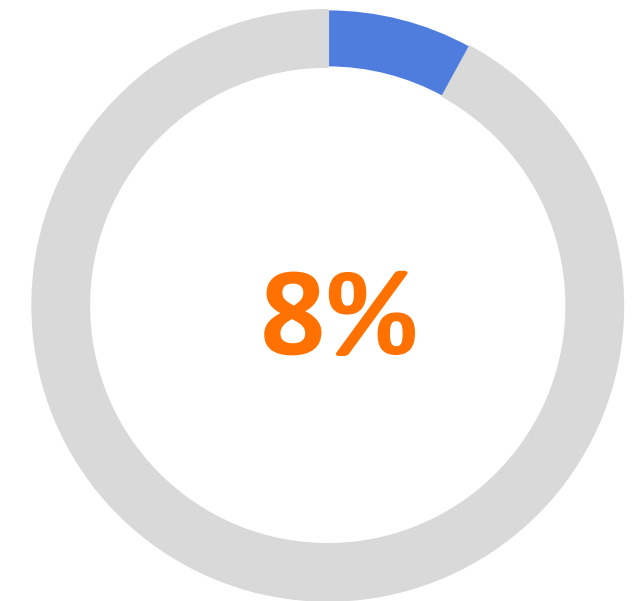
RU PATENT APPLICATIONS



EURASIAN PATENT APPLICATIONS

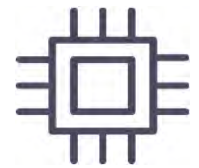


RU DESIGN APPLICATIONS



RU TRADEMARK APPLICATIONS

NEW CASES* OF THE FIRM ON THE RUSSIAN MARKET IN 2023



3334

applications for inventions
and utility models



132

Cases in common and commercial
courts, IP court and Supreme court



1206

applications for trademarks



57

Licensing, franchising, assignments
and security agreements



355

applications for designs

*Foreign and national clients

PROJECTS

GORODISSKY IP SECURITY

GORODISSKY IP MOBILE

GORODISSKY IP PATADMIN

GORODISSKY *Art Law*

GORODISSKY
INTELLECTUAL PROPERTY TMT

GORODISSKY IP SCHOOL

GORODISSKY YIP

OUR PUBLICATIONS



March 18 2022

Software is not to be pirated in Russia Gorodissky & Partners | Tech, Data, Telecoms & Media - Russia



ANTON MELNIKOV

On 4 March 2022, the Kommersant Publishing House published an article which stated that the Russian authorities are measures to support the economy due to ongoing sanctions pressure. The article suggested that one such measure is the abolition of criminal and administrative liability for the use of pirated software from countries that support sanctions. This has resulted in speculation on the Internet that IP piracy is gaining traction in Russia.

This suggestion has caused concern among Russian IT companies, which have described the measure as destructive. It indicated that it would have obvious and immediate negative consequences for import substitution and the domestic market. Russian IT associations pointed out that allowing the illegal use of foreign software would instantly make it free, while Russian IT products to compete with "free" foreign software.

to waive responsibility for the use of unlicensed software and offers the same level of protection for Russian IT products to compete with "free" foreign software.

GORODISSKY Patent Enforcement and Unfair Competition in Russia



Anton Melnikov, LL.M., Senior Lawyer at Gorodissky & Partners

patent rights constitutes patent infringement, moreover, under particular circumstances, it can result in criminal prosecution.

remedies provided by civil law, it is possible to file a patent infringement lawsuit and collect sufficient proof to initiate an unfair competition case against the infringer.

1. In the course of the investigation, the antitrust body collects documents and information that can be further used in patent infringement cases to confirm the fact of the patent infringement as well as the amount of compensation or damages claimed.

2. Violation of the Competition Protection Law can result in significant negative consequences for the infringer that may deter others from infringing patent rights.

Secondly, it is possible to proceed with filing an application through Hague system of international arbitration.

"To rely on remedies provided by civil law, it is necessary to file a patent infringement lawsuit and collect sufficient proof"



GLOBAL IP PATRIK 27

PATENTABILITY OF CRYSTALLINE FORMS: RUSSIA

Current practice of patenting new crystalline forms of biologically active compounds in the Russian Federation

Elena Nazina and Lev Zhilin of Gorodissky & Partners to Rospatent's approach to the patentability of crystalline forms of biologically active compounds resulting in the termination of issuance or protection of such forms.

A patent in the Russian Federation can be obtained both in accordance with the national patent legislation in the Federal Service for Intellectual Property (Rospatent), or in accordance with the Eurasian patent legislation in the Eurasian Patent Office (EAPO). Obtaining a patent for such inventions as a group of compounds, an individual chemical compound, or salts, esters, isomers thereof, as well as crystalline forms of the compound became possible in 1992 with the entry into force of the USSR Patent Law.



ELENA NAZINA

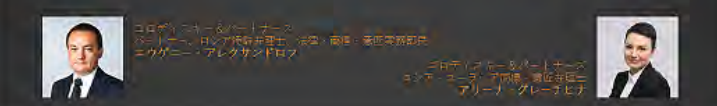
Until recently, the requirements and approaches for the examination of such inventions, in particular crystalline forms, were the same for national and Eurasian applications and were harmonized with many other jurisdictions.



LEV ZHILIN

The crystalline form of a compound in comparison with its amorphous form, as a rule, has a number of physicochemical properties providing it with certain advantages that make it possible to obtain, store, and use the compound efficiently. However, obtaining the crystalline form of a biologically active substance, both the first and subsequent, is a complex process with unpredictable results. Despite the fact that various methods of obtaining crystals are generally known, due to the many factors affecting the formation of a crystal and its growth, knowledge of the state of the art does not allow the inventor to predict in advance with confidence not only the

ロシアでのビジネス中止後のブランド管理



ブランドスクワッターの増加
この数年、欧米企業には、外的要因からロシアでの取引やその他のビジネス活動を再検討する動きが見られる。なかにはロシアでのビジネスの全面終了、縮小、停止を発表する企業もあった。このような状況に際して、一部の市場関係者は、不正の目的を持って、有名ブランドやそのイミテーションを、そのブランドの真の所有者の同意なく、自分たちの名前前で登録しようとしている。彼らは、場合によっては自分の商標出願が審査に合格するかもしれないと信じ、また審査で有名ブランドが引用された場合、例えば不使用を理由に引用商標を取り消そうとするかもしれない。

ブランドスクワッターたちは、2022年2月初旬から6月にかけて、登録された有名商標と同一または類似する商標をロシア特許庁 (Rospatent) に200件以上出願しており、この数は今後増加する可能性がある。もちろん、商標の出願をしただけでは商標登録は保証されず、各出願は方式審査と実体審査を通過する必要がある。その際、出願されたすべての出願が、実体審査の段階まで到達するわけではない。出願のなかには、手数料未納のまま手続が止まり、所定の期間内に手数料が支払われず出願が取り下げられたものとみなされたものもある。

また、出願人自身が別の理由で取り下げることもある。例えば、マクドナルドがロシアでの事業終了を発表した後、野菜缶詰の製造を専門とするルスボールブランドグループに属する「ロシア特許」の権利が含



TOP GEAR TRADEMARK PROTECTION

Trademark squatter eliminated by the BBC after attempted exploitation of the TOP GEAR mark

Vladimir Biriulin, Partner, Russian Patent Attorney, Head of Special Projects, of Gorodissky & Partners evaluates the recent case that almost saw the loss of the TOP GEAR mark for the BBC!

The BBC registered TOP GEAR in 2005 under No 538851 with priority of December 10, 2013, in Class 38. There was also another TOP GEAR trademark (No 339837 in Classes 38, 41, 42, 43) registered by a Russian company in December 2007 with priority of October 25, 2005. That company was in the process of liquidation but immediately before that came into effect a Russian entrepreneur, who is notorious for cybersquatting, acquired the trademark in August of 2016. The entrepreneur dealt with immovable property only.



VLADIMIR BIRIULIN

Notwithstanding, the BBC's trademark was canceled on formal grounds (CPC's decision dated March 30, 2018). We do not discuss the reasons behind the registration of the BBC's trademark though an identical trademark No. 339837 had been registered years before.

The BBC filed a cancellation action against trademark No. 339837 because of non-use. The BBC argued that the trademark owner was not an interested person and that the only goal of the trademark owner was to do harm. In the meantime, the disputed trademark was withdrawn by the trademark owner but before that, he had filed and obtained another TOP GEAR registration No. 62309 with priority of April 2016. This registration interfered with the bona fide use of the trademark by the BBC. Indeed, the BBC intensively used TOP GEAR in Russia. There was a TV show in Russia and a magazine under the same name.

Comparing the protection of selection achievements in Russia, Ukraine, and Kazakhstan

PROTECTION OF SELECTION ACHIEVEMENTS

and Arman Sauganbayev of comparative analysis for the protection of breeding materials through patents granted in respective jurisdictions.



ANNA DEGTYAROVA



OLGA KOLSYUBALSKA



ARMAN SAUGANBAYEV

Vladimir Rybchak, Partners at Gorodissky and Arman Sauganbayev of the procedure and protection available to



VLADIMIR RYBCHAK



VACHESLAV RYBCHAK

Résumés
Evgeny Alexandrov, PhD, Partner, Head of Legal, Trademark & Design Practice. Evgeny joined Gorodissky & Partners in 2016, and in 2019 was promoted to partner at the firm. Advises clients on the legal (non-contentious) and illegal (contentious) use of B/V/T, unfair competition and false advertising, parallel imports and anti-counterfeiting, licensing and franchising, media and technology. He is one of the most experienced and strongest B/V/T litigators in Russia. He represents clients before commercial courts and courts of general jurisdiction, administrative and law enforcement bodies. Often speaks at IP conferences and regularly publishes articles in the Russian and foreign magazines and internet portals. AlexandrovEggorodissky.com

Vacheslav Rybchak, Partner, Head of Design Department
Vacheslav joined Gorodissky & Partners in 1999 and in 2010 was promoted to partner at the firm. Specializes in obtaining legal protection for industrial designs, trademarks, and appellations of origin of goods. Vacheslav is intensively involved in invalidation/cancellation proceedings representing clients before the Russian and Eurasian Patent Office and in the courts. He is a regular speaker at IP seminars and conferences in Russia and abroad and also an author of several publications in foreign IP professional magazines. RybchakV@gorodissky.com

REGULAR PUBLICATIONS

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GORODISSKY
INTELLECTUAL PROPERTY TMT
МОСКВА / ST. PETERSBURG / ЮРИЯ / KAZAN / NOVOSIBIRSK / SANKT-PETERBURG / NOVOSIBIRSK / SANKT-PETERBURG / SAMARA / KAZAN / PERM / VLADIVOSTOK / UFA / KIEV / ASTANA / DUSHANBE

G-NEWS

#154 (2023)



Merry Christmas and Happy New Year!

ART MARKET DEALS: NECESSARY STEPS WHEN BUYING A WORK OF ART

Natalia Nikolaeva
Partner, Trademark Attorney,
Regional Director
(Novosibirsk)

Yaroslava Gorbunova
Trademark Attorney,
Senior Lawyer
(St. Petersburg)




At the end of October, the media spotted an offer to sell the painting “Suprematism” by the famous avantgarde artist Kazimir Malevich, posted by an anonymous seller on a popular private ads service

OVERVIEW OF NEWS IN THE FIELD OF INTELLECTUAL PROPERTY (RUSSIA, CIS) (March to August 2023)

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LAWS AND DRAFT LAWS

THE CONSTITUTIONAL COURT OBLIGED THE GOVERNMENT TO CHANGE THE RULES FOR PAYMENT OF REMUNERATION FOR EMPLOYEE'S INVENTIONS (RESOLUTION NO. 10-II DATED MARCH 24, 2023)

While considering the case on the complaint of Gidrobiz-Service LLC, the Constitutional Court checked the compliance with the Constitution of Clause 4 of Article 137 0 of the Civil Code and Clause 3 of the Rules for Payment of Remunerations for Employee Inventions, Employee Utility Models, and Employee Industrial Designs approved by the Government. Having recognised the above provisions as not contradicting the Constitution, the Constitutional Court nevertheless indicated that when considering a dispute on remuneration payment, the court may reduce the amount of remuneration to an employee for the use of the employee subject matter of patent law established by the Rules approved by the Government, if:

- Employer is not utilizing (underutilizing) the subject matter.
- There is no expected benefit to the employer from the use of the subject matter due to unforeseen circumstances or other valid reasons.

At the same time, the Constitutional Court recognized Clause 3 of the Rules approved by the Government to be inconsistent with the Constitution insofar as it does not allow the amount of remuneration to be determined for a person who co-authored the employee's result of intellectual activity, taking into account personal contribution of such a person to the result obtained, when the calculation of payment based on the amount of his average salary may lead to a clear violation of the principles of justice and proportionality. The Constitutional Court ordered the Government to make the necessary amendments to the Rules.

THE APPROACH TO THE LEGAL PROTECTION OF TRADEMARKS WITH GEOGRAPHICAL ELEMENTS HAS BEEN CHANGED (FEDERAL LAW NO. 143-ФЗ DATED MAY 28, 2022)

On May 29, 2023, amendments to the Civil Code made by the Law on Amendments to Part IV of the Civil Code came into force. The amendments that came into force set a new approach in the protection of trademarks incorporating, reproducing or imitating geographical indications or appellations of origin of goods. First, for goods similar to those for which a geographical indication and appellation of origin of goods are registered, registration of such trademarks (with disclaimer of

FIRM'S CONFERENCES, SEMINARS AND WEBINARS

February 2024



Seminar «Some Aspects of Obtaining and Enforcement of IP Rights for Successful Business Development», Astana

January 2024



12th World Intellectual Property Forum, Bangalore

January 2024



Global Intellectual Property Convention 2024, Delhi

December 2023



International Conference "IP Eurasia/ IP India'23: Innovation Space", Moscow

October 2023



Seminar "Eurasia: New IP Horizons", Dubai

October 2023



Patent Congress-2023 - III Annual AIPPI Congress in the Russian Federation, Moscow

FIRM'S MEMBERSHIP



FIRM RANKINGS

INTERNATIONAL RANKINGS

- Top positions in:



NATIONAL RANKINGS

- Among the best in nominations "Intellectual Property (Consulting)", "Intellectual Property (Litigation)", "Intellectual Property (Registration)", "Personal Data" & "TMT"
- Among the "Best Legal Practices" by Kommersant Publishing House in the nominations "IP Litigation" and "IP Consulting"
- Leader in electronic filings with the Russian PTO in 2015-2023 (Statistics report, Russian PTO)



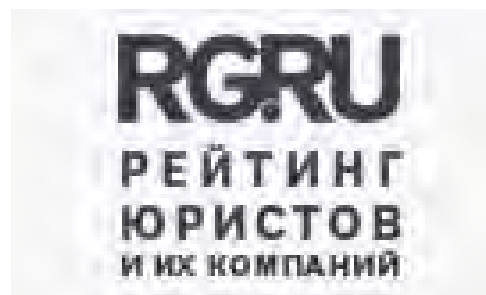
INDIVIDUAL RANKINGS



- 8 practitioners are among the best in Russia in nominations: IP consulting, IP litigation, IP registration and TMT



- Valery Medvedev, Managing partner got the nomination «Intellectual Property»
- Evgeny Alexandrov, Partner, Head of Legal, Trademark & Design Practice - nomination «Healthcare and Pharmaceuticals»



- In the nomination "Intellectual Property" are noted:
- Evgeny Alexandrov, Ph.D., Partner, Head of Legal, Trademark & Design Practice, Sergey Medvedev, Ph.D., LL.M., Partner and Sergey Vasiliev, Ph.D., Partner

Best Lawyers

- 18 IP attorneys and lawyers of Gorodissky & Partners were included in The Best Lawyers™ on «Intellectual Property» & «Litigation»
- Sergey Medvedev, Ph.D., LL.M., Partner, was named "Lawyer of The Year" on Privacy and Data Security Law in Russia



- Valery Medvedev, Vladimir Biriulin, Elena Nazina, Valentin Kirillov and Mikhail Samsonov are among the best on patents;
- Evgeny Alexandrov, Aleksey Kratiuk, Natalia Nikolaeva, Ilya Goryachev and Stanislav Rummyantsev on trademarks and copyright



- Yuri Kuznetsov, Partner, Russian Patent Attorney, Eurasian Patent & Design Attorney, Head of Patent Practice is included in the 2022 edition of the IAM Global Leaders.



- Stanislav Rummyantsev, Senior Lawyer is named in Who's Who Legal Data

FIRM CERTIFICATIONS

- ISO 9001: 2015 Certified (TÜV AUSTRIA CERT GMBH)
- Successfully passed company sustainability rating audit by **EcoVadis**



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