

# GORODISSKY & PARTNERS

Patent & Trademark Attorneys  
IP Lawyers

*Practicing since 1959*



# GORODISSKY

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Vladivostok • Novosibirsk • Perm • Sarov • Dubna • Ufa • Kyiv • Astana • Dubai

# FIRM'S SERVICES



Representation before  
the Patent Offices and  
Administrative Bodies



Litigation and  
dispute resolution



IP enforcement and  
counterfeiting



Licensing



Franchising



Strategic IP consulting



IP due diligence



IP portfolio  
management



Data Protection and  
Privacy



Patent and Trademark  
Searches



Translations



Inventions



Trademarks



Utility models



Industrial designs



Computer programs



Data bases



Topographies



Copyrights



Art Law



Domain names



IT

# OUR TEAM

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Russian Patent/  
Trademark Attorneys

120+

Eurasian Patent  
Attorneys

54

Ukrainian Patent/  
Trademark Attorneys

3

Kazakh  
Patent Attorney

1

390+  
specialists

30+

Russian/Ukrainian  
Lawyers/Attorneys at Law

26

Partners

1

Japanese  
Patent Attorney

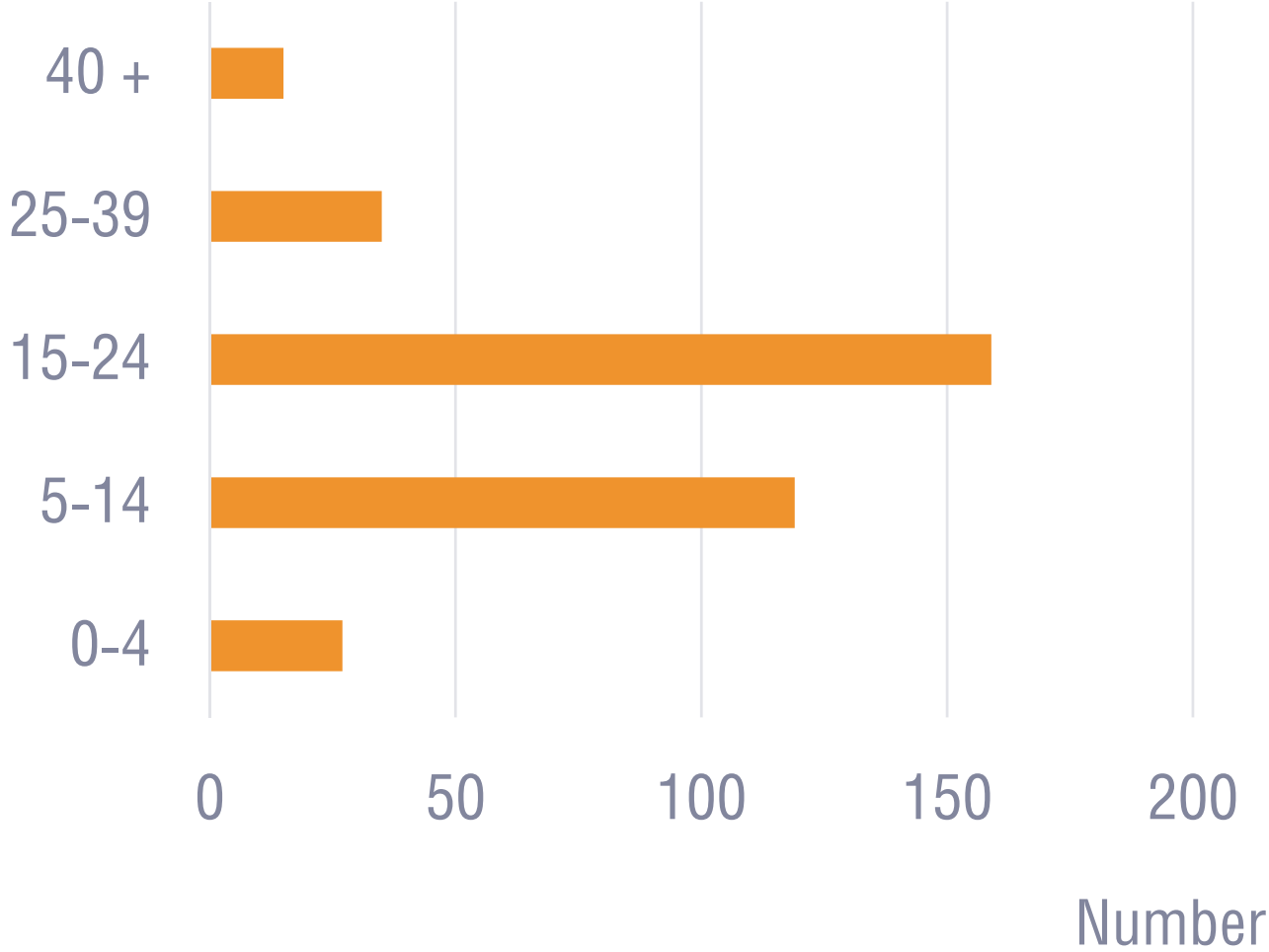
# OUR IP ATTORNEYS AND LAWYERS

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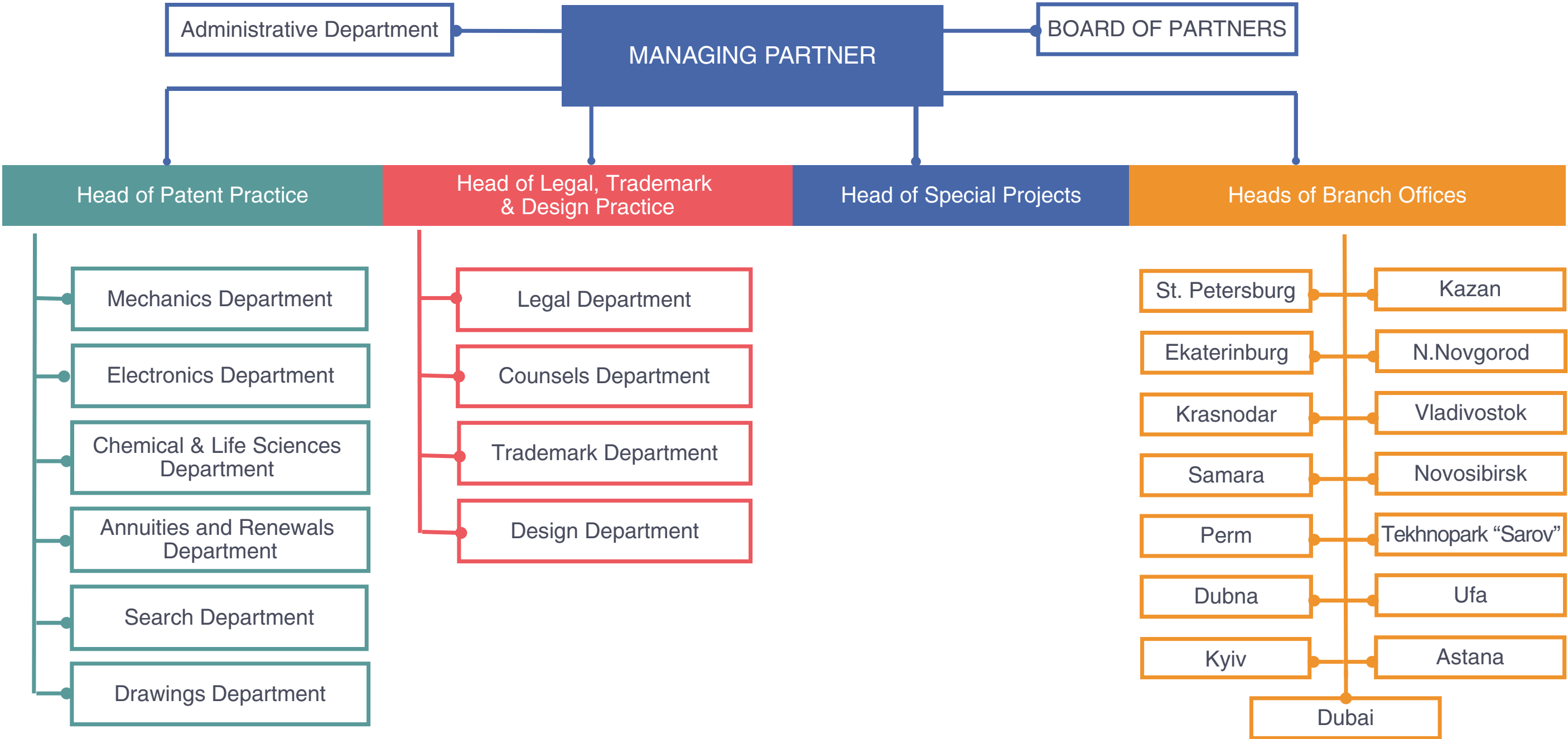
Age, years



With Gorodissky, years



# FIRM'S STRUCTURE



# FIRM'S BRANCH OFFICES



# OUR PROFESSIONAL PRINCIPLES

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 **Quality**

 **Competence**

 **Liability**

 **Efficiency**

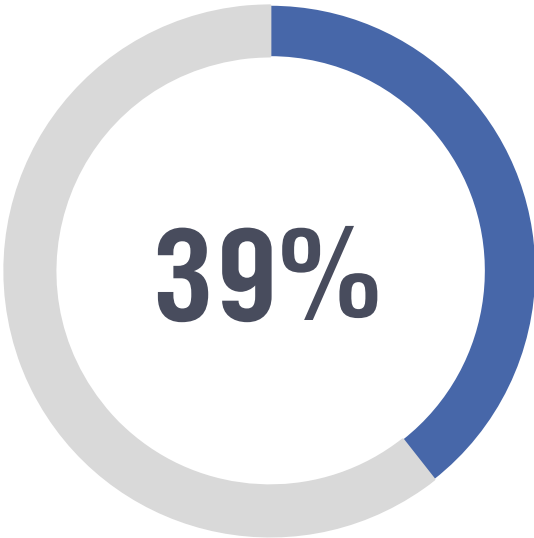
 **Proactivity**

 **Integrity**

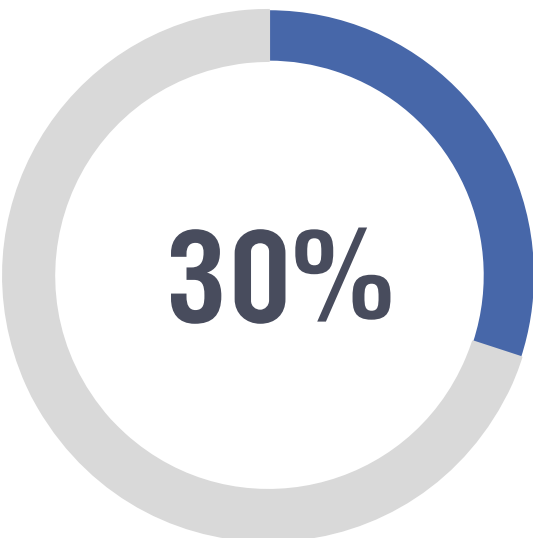


# FIRM'S SHARE\* ON THE RUSSIAN MARKET IN 2022

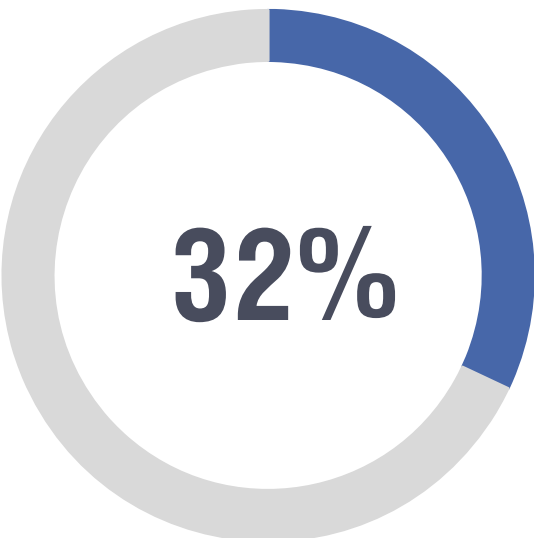
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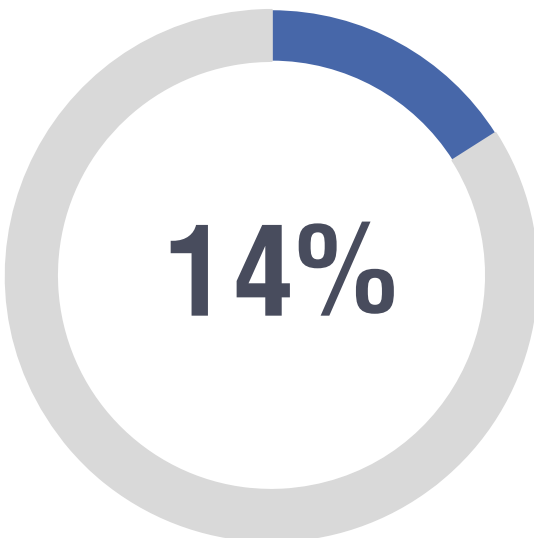
RU patent applications



Eurasian patent applications



RU design applications



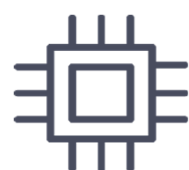
RU trademark applications

\*New IP cases of foreign applicants



# NEW CASES\* OF THE FIRM ON THE RUSSIAN MARKET IN 2022

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5638

applications for inventions and utility models



232

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



1405

applications for trademarks



57

Licensing, franchising, assignments and security agreements



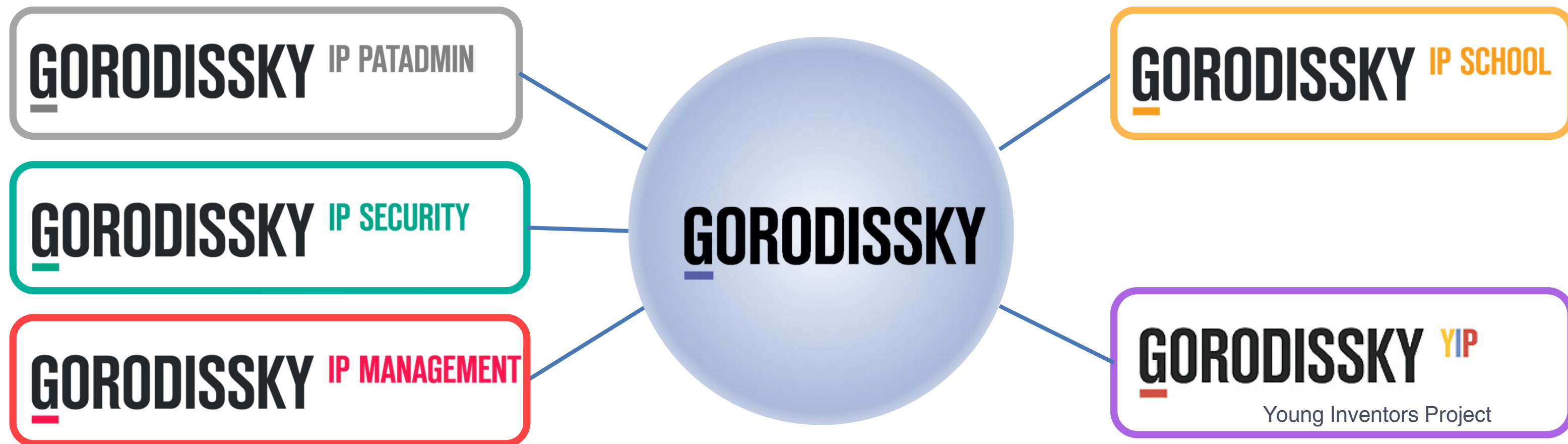
505

applications for designs

\*Foreign and national clients

# PROJECTS

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# OUR PUBLICATIONS

LEGAL & ADVOCACY  
Gorodissky & Partners

## Mastroianni Elicits Associations Unexpected by the Applicant

A Swiss company named BGRP GmbH obtained the international SARTORIA MASTROIANNI for Classes 03, 18 and 25 to extend regis-



The Russian patent office refused registration. It explained that the word element SARTORIA does not have distinguishing capability in respect of the claimed goods while inclusion of a famous name of MASTROIANNI will mislead consumers in respect of the manufacturer of goods. It should be noted that the name of MARCELLO MASTROIANNI is indeed widely known in Russia, especially after distribution in Russia of the Italian motion picture Divorce, Italian Style. The film featuring Marcello Mastroianni, indeed enjoyed crazy popularity in Russia and the actor is still remembered well. So the name of that great actor would produce an awkward impression on the Russian people in relation to clothing.

INDEED, AS WAS MENTIONED BY THE APPLICANT, THERE ARE MANY PEOPLE IN ITALY AND OTHER COUNTRIES NAMED MASTROIANNI AND THEREFORE REGISTRATION WAS PROBABLY ALLOWED...

contributes to the perception of the designation as a whole and guides the consumer in the direction of goods and services. In addition to this, the applicant provided a number of other arguments which on sober examination, do not hold water.

40 EXECUTIVE GLOBAL • Productivity, Strategy, Profitability

# GORODISSKY



March 18 2022

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

On 4 March 2022, the Kommersant Publishing House published an article which stated that the Russian authorities are urgently preparing measures to support the economy due to ongoing sanctions pressure. The article suggested that one such measure could be the abolition of criminal and administrative liability for the use of pirated software from countries that support sanctions against Russia. 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 use of foreign software would instantly make it free.

It is difficult for Russian IT products to compete with "free" software.

proposals for a law to waive responsibility for the use of pirated software from countries that support sanctions against Russia. This has resulted in speculation on the Internet that IP piracy is gaining traction in Russia.

Maltsev at Gorodissky & Partners by telephone (+7 495) 780 0000. The website can be accessed at www.gorodissky.com.

Ministry of Digital Development (the text of the letter is in Russian)

## ロシアでのビジネス中止後のブランド管理



ゴロディスキー・パートナーズ  
パートナー、ロシア特許弁護士、法律・商標・知的財産部長  
エウゲニー・アレクサンドロフ

ゴロディスキー・パートナーズ  
ロシア・ユーラシア商標・食料・飲料  
アリーナ・グレーブナ



### ブランドスクワッターの増加

この数か月、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高い。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完了し、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たこともある。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「Uncle Vanya」の商標とマクドナルドの商標



する「ロシアンフィールド」の特許庁に「Uncle Vanya」の商標はマクドナルドの有名なロゴと似ており、公衆の場で混同される。しかし、商標出願から数日後、改めて出願したものだとマクドナルドに対するリスクは、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。



これは、問題が大きくなる。ほとんどの場合、商標出願は、その結果がどうなるかは不明である。

### ロシア特許庁での審査

ロシアの法律では、ロシアの商標が含まれているか否かを決定し、公開する義務がある。商標として登録可能なかどうかの判断は、商標が複製または模倣された場合に拒絶される最も明白な理由の一つである。ロシアで先行して

### 最近のロシア知財実務

## ロシアで「非友好国」の知的財産権保護されないのか



著者：黒瀬  
Vladimir Gorodissky

### A. ロシアにおける最近の知的財産問題

ロシアのウクライナ侵攻後、日本の知的財産関係者の間で、ロシアの「非友好国」の企業による賠償請求は権利濫用であるという漠然とした不安が広がっているように思われる。

- Peppa Pig判決 (キエフ仲裁裁判所、2022年3月3日判決、Case A28-2021) 「非友好国」の企業による賠償請求は権利濫用である。
- 法令第299号 (2022年3月6日公布) 政府が強制実施承諾した場合に、実施権者が特許権者に支払うべき対価は「非友好国」の特許権者に対しては支払わなくてもよい。

Peppa Pig判決の趣旨を紹介するロシア弁護士であるウラジミール・ピリユクは、まずは不安が生じている要因について整理し、ロシアの現在の知的財産権の状況を確認する。

ロシアのウクライナ侵攻に対して、米国をはじめとする多くの国々がロシアに対して経済制裁を課している。ロシア政府は、この他国からの経済制裁に対する対抗措置として多額の資金を支出している。この「対抗措置法」において、法令299号の他に知的財産権保護に関係する規定は見当たらないが、外国企業から知的財産権の侵害で提訴されたロシア企業が、その抗弁として、次に述べる法令79号を根拠に、「非友好国」の企業である原告が侵害訴訟を提起することは「権利濫用」であると主張する事例がいくつか見られる。

- 弁護士 黒瀬IPマネジメント
- ロシア弁護士 Gorodissky & Partners

# Trademark Lawyer

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New Brands 2022  
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## Damages or compensation. The choice to make for infringement in Russia

Aug 4, 2022



# Unity of invention in the light of PCT, EAPC and Russian Law

Sergey Kalachev, Deputy Head of the Chemical & Life Sciences Department at Gorodissky & Partners, reviews the differing regulations of the PCT, Eurasian and Russian law to provide an overview of which lends best to which type of application.

The Patent Cooperation Treaty (PCT) and the Regulations is a flexible structure, providing vast opportunities to applicants for obtaining legal protection for inventions in many countries via a most convenient, economical, and efficient way. According to Article 27 of the PCT, no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those



under the PCT Regulations or the national legislation, which differ to some extent.

According to Rule 13.2 of the PCT Regulations, in case of a group of inventions, the requirement of unity of invention is fulfilled only when there is technical relationship between the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

According to the Russian patent regulations, the unity of invention requirement is considered to be complied with in respect to a claimed group of inventions if a set of claims characterizes a group of inventions interrelated to each other as follows:

- one of which is intended to obtain (produce) another one;
- one of which is intended for implementing another one;



# LEXOLOGY

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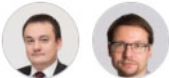
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## True or False? Design Protection in Russia and Eurasia

Gorodissky & Partners

View In Analytics



# GORODISSKY

European Union, Russia September 22 2022

National design application

An international design application

Eurasian design application

Based on numerous publications in the media one may conclude that the IP rights of foreign companies are no longer protected in Russia. This is not the case. Of course, the situation in the market is changing, but the IP rights of foreign companies are still protected in Russia.



# REGULAR PUBLICATIONS

IN THIS ISSUE:

RECENT DEVELOPMENTS IN REGULATION OF ON-LINE ADVERTISING  
IN RUSSIA, page 1  
IP NEWS OVERVIEW, page 3  
FIRM NEWS, page 12

## GORODISSKY

INTELLECTUAL PROPERTY TM  
MOSCOW / ST. PETERSBURG / DUBAI / KRASNODAR  
KATERSBURG / N. NOVOSIBIRSK / SAROV  
TECHNOPARK / SAMARA / KAZAN / PERM / VLADIVOSTOK  
UFA / KIEV / ASTANA / DUBAI

# G-NEWS

INFORMATION BULLETIN  
#152 (1) 2023



«Goroditsky & Partners» expands its international presence and enters the Middle East market —

THE FIRM'S NEW OFFICE  
IN DUBAI HAS OPENED  
ON APRIL 6, 2023

## RECENT DEVELOPMENTS IN REGULATION OF ON-LINE ADVERTISING IN RUSSIA

Ilya Goryachev  
Senior Lawyer  
Goroditsky & Partners (Moscow)



The Russian advertising regulatory landscape have seen significant developments over the recent months, following introduction of new requirements for on-line advertising. Starting from September 01, 2022 new article 18.1 of the Federal Law of March 13, 2006 N38-FZ became effective. Under this legislative novelty, new compliance obligations for advertising participants arose.

» page 2

## IP NEWS OVERVIEW: RUSSIA & CIS

(September 2022 to February 2023)

LAWS AND DRAFT LAWS	3
GOVERNMENT ENACTMENTS AND DEPARTMENTAL ENACTMENTS	5
DISPUTES OVER GRANTING AND TERMINATION OF PROTECTION	6
DISPUTES OVER INFRINGEMENT OF THE EXCLUSIVE RIGHT	8
OTHER DISPUTES	9
ROSPATENT PRACTICE	9
1. WELL-KNOWN TRADEMARKS	9
2. APPEALS OF ORIGIN OF GOODS AND GEOGRAPHICAL INDICATIONS	10
INTELLECTUAL PROPERTY NEWS OF THE EURASIAN ECONOMIC UNION AND NEIGHBORING COUNTRIES	10
1. EAPO AND EAEU	10
2. BELARUS	10
3. KYRGYZSTAN	11

### LAWS AND DRAFT LAWS

#### ADDITIONAL GROUND FOR CHALLENGING A PATENT EXTENSION FOR AN INVENTION RELATED TO A MEDICINAL PRODUCT, PESTICIDE, OR AGROCHEMICAL

On October 7, 2022, the Law on Amendments to Article 1363 of Part IV of the Civil Code (No. 386-FZ) was issued. Clause 2 of Article 1363 of the Civil Code provides for the conditions for the patent extension for an invention related to a medicinal product, pesticide, or agrochemical, as well as granting an additional patent for an extended period. The adopted law provides for the introduction of additional ground for challenging the patent extension and for challenging the effect of the additional patent granted in case of such extension. In accordance with the new version of Clause 5 of Article 1363 of the Civil Code, the patent extension and the corresponding additional patent may be invalidated in case of violation of the conditions provided for in Clause 2 of Article 1363 of the Civil Code. The extension and the additional patent may be challenged by filing an appeal with Rospatent. During the entire extended validity period, an appeal may be filed by any person, and after

the expiration of this period — by an interested person.

The new law provisions apply to additional patents issued both before and after the law's entry into force, as well as to the patents extended before January 1, 2015, when the patents were to be extended without issuing an additional patent.

The law entered into force on October 18, 2022.

#### THE LAW ON CUSTOMS REGULATION HAS BEEN AMENDED TO ALLOW ENTERING GEOGRAPHICAL INDICATIONS IN THE CUSTOMS REGISTER OF INTELLECTUAL PROPERTY SUBJECT MATTERS

On December 5, Federal Law No. 488-FZ dated December 5, 2022 On Amendments to Articles 327 and 334 of the Federal Law on Customs Regulation in the Russian Federation and on Amendments to Certain Legislative Acts of the Russian Federation was published. In accordance with the amendments, geographical indications protected in Russia can be included in the customs register of intellectual property subject matters (TROIS) at the request of the right holder. Before the law was amended, such a procedure had been carried out only in respect of subject matters of copyright and related rights, trademarks and appellations of origin of goods.



# FIRM'S CONFERENCES, SEMINARS AND WEBINARS

February 2023



11th World Intellectual Property Forum, Bangalore

February 2023



Global Intellectual Property Convention 2023, Goa

November 2022



Patent Congress AIPPI, Moscow

October 2022



IN'HUB, Novosibirsk

September 2022



IP Eurasia, Moscow

November 2021



Lexology & Gorodissky Webinar "New regional systems: protecting trademarks and designs in the Eurasian states"

# FIRM'S MEMBERSHIP

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# FIRM RANKINGS

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## INTERNATIONAL RANKINGS

Top positions in:



## NATIONAL RANKINGS



- Among the best in nominations "Intellectual Property (Consulting)", "Intellectual Property (Litigation)" and "Intellectual Property (Registration)"
- 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 2015-2022 (Statistics report, Russian PTO)





# INDIVIDUAL RANKINGSS

Best Lawyers

MIP IP STARS



WWL



- 18 IP attorneys and lawyers of Gorodissky & Partners were included in The Best Lawyers™ on «Intellectual Property» & «Litigation»
- Sergey Medvedev, Ph.D., LLM, 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 Rumyantsev 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 Rumyantsev, Senior Lawyer is named in Who's Who Legal Data
- 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»

# FIRM CERTIFICATIONS

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



# FIRM'S HEADQUARTERS

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