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# G-NEWS

GORODISSKY & PARTNERS  
PATENT AND TRADEMARK  
ATTORNEYS IP LAWYERS  
INFORMATION BULLETIN

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# PROTECTION OF IP RIGHTS AT THE CUSTOMS BORDER OF UKRAINE. NEW DEVELOPMENTS

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The reform in the sphere of customs control recently initiated by the government of Ukraine has already brought the results: a new Customs Service of Ukraine has been created (previously, the customs were subordinated to the State Fiscal Service of Ukraine), and performing since December 8, 2019. According to the Statute

of the State Customs Service of Ukraine No. 227, approved by the Cabinet of Ministers of Ukraine of March 6, 2019, the Service's aim is to preserve the due balance between the customs control and lawful trade, and prevent violation of IP rights.

Several provisions to the Customs Code concerning movement of goods across the border that are important for the IP owners have also been updated (the changes took effect from November 14, 2019).

The abovementioned reform is aimed at insuring step-by-step fulfilment of obligations of Ukraine within the EU Association Agreement and WTO Agreement on Trade Facilitation. While the customs service is adapting its work to the recent amendments, it is worth looking to the amendments proper and analyze their effect on the protection of intellectual property rights when moving the goods across the customs border of Ukraine.

## NOVELTIES IN THE CUSTOMS LEGISLATION OF UKRAINE

**“Counterfeit” has been defined**

In order to simplify control and improve screening procedures used by the customs, the legislator has made a more accurate definition

of the “counterfeit goods”, and complemented the law with new definitions, such as “pirated goods” and “goods suspected of infringing intellectual property rights”.

The **counterfeit goods** are infringing IP rights if they are unlawfully labeled with:

- a trademark,
- a geographical indication,
- or are as well packages, labels, stickers, brochures, operation manuals, warranties or other documents of such nature, that are the subject of infringement of intellectual property rights to the trademark or geographical indication.

The goods fall into the category of counterfeit if:

- the designation on the goods is confusingly similar to a trademark, registered for the same kind of goods, or there is a possibility of confusion with such trademark;
- the goods contain the name, or the term, or are described by means of the name or the term protected by the geographical indication;
- packages, labels, stickers, brochures, operation manuals, warranties or other documents of such kind contain the designation, the name or the term, identical to the trademark or geographical indication protected in Ukraine, and can be used with regard to the same kind of goods as the protected trademark or geographical indication.

Pirated goods are the goods infringing copyright and/or related rights, or intellectual property rights to a registered industrial design in Ukraine, which are copies or contain copies manufactured without consent of the copyright or related rights holder or holder of intellectual property rights to the industrial design, or without consent of the person authorized by the right holder in the country of origin.

**Goods suspected of infringement of intellectual property rights are:**

- the goods with the features of infringement of copyright and related rights, intellectual property rights to the inventions, industrial designs, trademarks, geographical indications, plant varieties, topographies of integrated circuits, the rights under the supplementary protection certificates for the medicinal products and crop protection agents;
- apparatus, products or components, designated, produced or adapted mainly for insuring or simplifying circumvention of the technology,

device or component, which in usual mode of operation prevent or limit the actions that are not permitted by the copyright and related rights holder;

- any form or matrix specially designated or adapted for production of the goods infringing intellectual property rights.

According to the amendments, utility model is not the subject of the customs surveillance anymore.

## Suspicion is the ground for suspension of the goods

Suspicion of the customs of possible infringement of intellectual property rights is now the only ground for suspension of customs clearance of the goods, even if the right holder has not filed an application to protect his rights to the object of the intellectual property rights. The customs, in case of such suspicion, may suspend the customs clearance of the mentioned goods, except for perishable goods, at their discretion.

According to the former customs law, there was the list of exclusive grounds under which the customs authorities had the right to suspend a consignment at their own initiative.

## Early release of the goods suspended on suspicion of infringement of IP rights to the industrial design, plant variety or semiconductor products

According to the new rules, the customs is entrusted with additional powers of early customs clearance of the goods suspended on suspicion of infringement of the IP rights. By solicitation of the owner of the goods or an authorized person such release can be carried out by the customs before expiration of the suspension period, by decision of the customs office without prior recourse to the right holder under the following conditions:

- customs clearance has been suspended in respect of the goods containing such objects of intellectual property as industrial designs, plant varieties and semiconductor products;
- the customs authorities have no information on prohibition of actions by the respective state authorities in respect of such goods, or application of other measures to prevent their use;

- the declarant or the owner of the goods has provided the customs authority with the documentary confirmation of consent between the right holder and the owner of consignment on its early release;
- customs formalities necessary for release of such goods have been fulfilled.

The new grounds of early release of the goods are aimed at reducing the number of notifications from the customs to the right holders and respectively the reduction of the term for customs clearance of the goods in respect of which there are all necessary documents and no prohibitions.

## Principle of international exhaustion of rights

According to the legislative changes, the original goods, in particular the goods produced with consent of the right holder, or the goods produced by a person duly authorized by the right holder cannot be suspended on the basis of the customs Register or at the initiative of the customs, or if such goods are imported in international postal and express dispatches of small consignments of goods. Such goods cannot be destroyed on suspicion of infringement of intellectual property rights, and such measure as change in marking cannot be applied to such goods. Therefore, the legality of the parallel importation has been formalized at the legislative level. This means that the principle of exhaustion, which was formerly recognized only by court practice, is now applicable according to the law.

## Destruction of the goods at the border has become simpler

### 1. General provisions on destruction of the goods

The goods suspended on suspicion of infringement of intellectual property rights can be destructed under the customs surveillance without necessity to establish infringement of intellectual property rights. This procedure can be applied within 10 working days (or 3 working days for perishable goods) after receiving a notification on suspension of the goods and when all the cumulative conditions are fulfilled:

- the right holder informs the customs in writing of infringement of his intel-

lectual property rights and his intent to apply the procedure of destruction to such goods;

- the declarant provides the customs with a written consent of the owner of the goods regarding its destruction. Along with that, if during the above period the declarant does not send a written objection of the goods owner about its destruction to the customs, the customs authority should regard absence of such objection a tacit consent and is entitled to destruct the goods.

The right holder is entitled to obtain samples of the goods before its destruction for training purposes. Payment of expenses connected with destruction, storage, transportation, paperwork, and other expenses, are made at the cost of the right holder.

### 2. Peculiarities of suspension and destruction of the small consignments of the goods

Small consignments of goods suspected of infringement of IP rights can be destructed if:

- there is a suspicion that the goods are counterfeit or pirated;
- the goods are not perishable;
- information about the subject matter of intellectual property right protected according to the law, about the goods containing the said subject, and the consent of the right holder for destruction of small consignments of the goods, are entered in the customs Register.

A small consignment of goods to which the destruction procedure is applied, shall be the goods sent in one consignment from one sender in international mail, or in one shipment of the express-carrier from one sender in express-dispatches, in the number of no more than three pieces of each subcategory according to the Ukrainian Classifier of Goods for Foreign Economic Activity or which gross weight do not exceed two kilograms.

The customs shall inform the declarant of their intent to destruct the small consignment of the goods, and if the declarant within 10 days from the date of the respective notification does not provide a written objection of the goods owner regarding destruction of the goods, the customs can destruct the goods. If the declarant provides the consent of the owner, the right holder shall incur expenses connected with destruction, storage, transportation, paperwork and other related expenses.

The right holder has also the right to file within the abovementioned term a court decision or a decision of another competent authority banning destruction of the goods. In such case, if there is no infringement of the customs rules, the goods shall be duly cleared.

## Changes regarding expenses for storage of the goods at the customs warehouse

The goods suspected of infringement of intellectual property rights shall be stored at the customs warehouse starting from the next day after suspension of the customs clearance.

The right holder should pay expenses for storage of the goods at the customs warehouse, suspended on the basis of the Customs Register data, and at the initiative of the customs. The storage is paid starting from the next calendar day after placement of the goods in the warehouse. The right holder may request information about the amount of expected expenses, connected with storage. The right holder has the right to claim from the owner of the goods a compensation of expenses connected with storage of the goods, if the court establishes the fact of infringement of intellectual property rights of the right holder at the time of moving the goods across the customs border of Ukraine.

## Registration of IP rights in the Customs Register

The year 2020 will see a new procedure for registration of IP rights in the Customs Register of Ukraine, in particular with regard to the information required from the right holder. The scope of the required information will be somewhat extended, aimed to provide sufficient information to customs authorities for unaided determination of the original goods and their distinguishing features, in comparison with the counterfeits, without involvement of the right holder.

The State Customs Service of Ukraine already has a new functioning operational IT system for classification of the goods aimed at facilitating classification of the goods and streamlining the customs clearance of goods.

# QUARTERLY REVIEW OF NEWS IN LEGISLATION, COURT PRACTICE, AND ROSPATENT'S PRACTICE RELATED TO INTELLECTUAL PROPERTY

(JULY TO SEPTEMBER 2019)

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## LAWS AND DRAFT LAWS

### PROTECTION OF GEOGRAPHICAL INDICATIONS

On July 26, 2019, Law No. 230-FZ On Amendments to Part Four of the Civil Code of the Russian Federation and Articles 1 and 23.1 of the Federal Law On State Regulation of the Production and Circulation of Ethanol, Alcoholic and Alcohol-Containing Products

and on the Limitation of Alcoholic Products Consumption (Drinking) was published.

The law will enter into force on July 27, 2020.

The law introduces legal regulation of a new intellectual property right item — geographical indication. This item is actually close to an appellation of origin. It is also a means of individualization of goods and also serves to designate goods, which characteristics are related to its geographical origin. It differs from the appellation of origin in a less stringent requirement for a relation between the characteristics of the goods and their geographical



origin: if the appellation of origin is used for the goods, which properties are “solely or mainly” determined by their geographical origin, namely, natural or human factors of the relevant geographical location, the properties of the goods, for which the geographical indication is used, are related to the relevant geographical location “to a large extent” only.

The law also provides for a distinction between the geographical indication and the appellation of origin depending on whether all production stages of the goods are within the boundaries of the relevant geographical location. A requirement is introduced with regard to the appellation of origin so that the goods should be completely produced within the territory of a geographical location, which name is included in the appellation of origin, while in case of a geographical indication — at least one production stage of the goods, which determines their characteristics, shall be within the relevant geographical location.

Another innovation in the law is a larger number of the scope of persons, who can obtain the right to protect such means of individualization. In addition to individuals and legal entities engaged in production of the goods designated by the geographical indication or the appellation of origin, the law provides for a possibility to register an appellation of origin or a geographical indication by associations of persons, who produce or commercialize the goods. At the same time, the persons included in such associations will obtain the right to use the appellations of origin or the geographical indications registered in the name of their association.

The law sets forth a procedure for registration and grant of the right to use the geographical indication, in particular, the requirements for an application for registration of a geographical indication. Also new requirements for an application for registration of an appellation of origin are introduced, in particular, the documents confirming famous character of such appellation with regard to the goods shall be attached to the application.

The law provides for a possibility to grant protection of the geographical indication for the goods originating from outside of the Russian Federation. For such geographical indications, in addition to the information provided for the Russian geographical indications, the applicant will have to confirm the compliance of the foreign geographical indication with the requirements set forth for the geographical indication by the Civil Code of Russia and his/her/its exclusive right to this geographical indication in the country of origin.

## GOVERNMENT ENACTMENTS AND DEPARTMENTAL ENACTMENTS

ORDER OF THE MINISTRY OF AGRICULTURE OF RUSSIA NO. 369 DATED JULY 1, 2019 APPROVED A LIST OF PLANT

VARIETIES AND ANIMAL BREEDS, FOR WHICH A PATENT MAY BE ISSUED. THE LIST INCLUDES 435 PLANT AND 53 ANIMAL VARIETIES.

## COURT PRACTICE

### 1. PATENTS

**JOINT AND SEVERAL LIABILITY FOR AN INFRINGEMENT OF AN EXCLUSIVE RIGHT MAY BE INCURRED ONLY IN CASE ONE INFRINGEMENT OF THE EXCLUSIVE RIGHT TO A PATENT OR A TRADE MARK IS COMMITTED THROUGH THE JOINT ACTIONS OF SEVERAL PERSONS; IT IS THE CASE WHEN SUCH PERSONS SHALL BE HELD JOINTLY AND SEVERALLY LIABLE TO THE RIGHT HOLDER (INTELLECTUAL PROPERTY RIGHTS COURT, RESOLUTION DATED SEPTEMBER 6, 2019 ON CASE No. A40-123813/2018)**

The Intellectual Property Rights Court considered a cassation appeal on case No. A40-123813/2018 upon a statement of claim filed by Pfizer Inc. against JSC “Pharmasyntez”, LLC “COSMOPHARM”, and LLC “Medresurs” for recovery of damages in the form of lost profit and compensation for the infringement of the exclusive right to the invention under patent of the Russian Federation No. 2114838.

The court of first instance dismissed the claim, having referred to the fact that the claimant missed the period of limitation. In doing so, the court proceeded from the fact that the claimant became aware of the infringement of its right and of proper defendants in the claim in 2014, when it conducted notarial inspection of the defendants’ websites and the government purchase website. In addition, the court considered the amount of damages to be recovered as unproved and rejected the claimant’s references to the joint liability of the defendants.

The court of appeal, while reconsidering the case agreed with the conclusions of the court of first instance.

The Intellectual Property Rights Court did not questioned the courts’ conclusion that the claimant missed the period of limitation.

The Intellectual Property Rights Court considered the claimant’s statement that it had no real opportunity to become aware of the infringement of the right before (i. e. in 2014) the specific actions were taken to supply medicines and that the relevant information was posted as an official publication of notices of performance of the relevant contract.

There are no documents, from which the claimant who is not a party to state contracts would have had the opportunity to become aware of the supplies of medicines earlier. These facts were not taken into account by the courts, when rendering the judicial acts being appealed.

The IP court believes that the decisions of the court of first instance and of the court of appeal were taken in violation of the provisions of substantive law, and the conclusions contained in those judicial acts do not correspond to the facts of the case and the evidence available in the case, for which reason these judicial acts cannot

be acknowledged as legal and shall be reversed, while the case shall be remanded to the court of first instance for re-examination.

The claimant's argument on the erroneous conclusion of the courts on the groundless application of joint and several liability to the defendants shall be rejected due to the following.

According to clause 6.1 of Article 1252 of the Civil Code, in case one infringement of the exclusive right to a result of intellectual property or means of individualization is committed through joint actions of several persons, such persons shall be held jointly and severally liable to the right holder.

The court of first instance found that the claimant did not submit evidence of joint infringement by the defendants of his exclusive right. On the contrary, the claimant identified the specific actions committed by each defendant individually, which resulted in the infringement of his rights. As the court of first instance pointed out, the defendants committed the infringing actions at different time intervals independently from each other.

These facts found by the court of first instance are sufficient to conclude that there are no grounds to hold the defendants jointly and severally liable in the case under consideration.

**THE INTELLECTUAL PROPERTY RIGHTS COURT UPHELD THE DECISION OF THE COURT OF FIRST INSTANCE THAT THE EVIDENCE AVAILABLE IN THE CASE DOES NOT CONFIRM THAT EACH FEATURE PROVIDED IN INDEPENDENT CLAIM 1 IS USED IN THE DEFENDANT'S PRODUCT AND THE EQUIVALENCE OF FEATURES IS DISPROVED (INTELLECTUAL PROPERTY RIGHTS COURT, RESOLUTION DATED SEPTEMBER 5, 2019 ON CASE No. A40-30260/2017)**

EKOMTEKH-TRADING LLC filed a claim with a commercial court against Ryazhsk Automotive Equipment Maintenance Plant OJSC and Zapchast-Komplekt LLC requesting the court to terminate the infringement of the patent for invention and to recover compensation.

The court of first instance dismissed the claims. The court commissioned an expert examination to find whether all features of independent claim 1 of the patent or equivalent features are used in the MKZ-5311 garbage removal truck. Having evaluated the expert's opinion, the court of first instance questioned the groundedness of this opinion and contradictions in the conclusions set out therein. At the same time, the court of first instance found that the expert concluded that the feature *"through holes in the end walls of a tank"* is equivalent to the feature *"the tank is connected with a gap under the bottom of the bin in its front part"* based on the assumption that the side holes in the side walls of the bin are drain holes, without having found out when inspecting the garbage removal truck whether the liquids would be drained through these holes.

The conclusions of the court of first instance regarding the expert opinion are sufficiently reasoned and supported by the court of appeal. At the same time, in its resolution, the court upheld the decision, where the court of first instance came to the conclusion that the evidence does not confirm that each feature provided in the inde-

pendent claim 1 of the summary of the invention is used in the defendant's product and the equivalence of the features is disproved.

The court of appeal upheld the decision of the court of first instance. At the same time, the court of appeal considered necessary to commission another expert examination in order to resolve uncertainty in comparing the features intrinsic to the product (MKZ-5311 garbage removal truck) and the features contained in the independent claim 1 of the summary of the disputed invention.

In the opinion presented to the court, another expert came to the conclusions that the features provided in independent claim 1 of the summary of the disputed invention i.e. *"the tank is hermetically connected to the bin under its bottom from the back of the bin and both side walls with a gap under the bottom of the bin in its front part"* and *"there are holes in the bottom of the back of the bins for connecting to a liquid collecting tank"* are not used in the MKZ-3511 garbage removal truck. The above conclusions were acknowledged by the court of appeal as grounded, the court of appeal did not see any contradictions in the expert's conclusions and acknowledged the opinion of the repeated expert examination as compliant with the provisions of the law.

As a court of cassation, the Intellectual Property Rights Court did not reevaluate the conclusions of the court of first instance and the court of appeal to that extent, since these conclusions are based on full and comprehensive examination of the facts and evidence on the case.

The Intellectual Property Rights Court did not accept the argument of the cassation appellant on the breach by the courts of the provision of clause 3 of Article 1358 of the Civil Code, since the courts, as a result of examining the cumulative evidence, came, among other things, to the conclusion that there are no equivalent features. The Intellectual Property Rights Court upheld the decision of the court of first instance and the court of appeal.

**A NOTICE TO AN EMPLOYER OF A POSSIBILITY TO OBTAIN A PATENT FOR SOME TECHNICAL SOLUTION WITHOUT DISCLOSING DETAILS IS NOT A NOTICE IN THE MEANING OF CLAUSE 4 OF ARTICLE 1370 OF THE CIVIL CODE OF RUSSIA (INTELLECTUAL PROPERTY RIGHTS COURT, DECISION DATED JULY 18, 2019 ON CASE No. SIP-97/2019)**

A company filed a claim with the Intellectual Property Rights Court for invalidation of patent for invention No. 2659528 entitled "Ferromanganese Inductive Remelt Method" in that part which concerns the indication of inventors as the patent holders and obligation of Rospatent to issue a new patent indicating the Company as the right holder.

In support of this argument, the Company pointed out that the invention is an employee's one, since, at the time of filing the application for registration of the disputed patent, the inventors were the Company's employees, and the invention was created as part of fulfilment of their employment duties using the employer's materials. According to the claimant, the inventors did not duly notify him of the creation of a patentable technical solution for which reason the Company was not able to exercise its right to obtain a patent for the employee's invention. The Intellectual Property Rights Court noted that the parties did not challenge the fact that the invention protected

by the disputed patent was created by its inventors as part of fulfilment of their employment duties, for which reason it is an employee's invention.

The Intellectual Property Rights Court notes that the purpose of the provision of Clause 4 of Article 1370 of the Civil Code is to define the procedure for accrual and transfer of rights to obtain a patent. At the same time, a notice to or a failure to notify the employer by an employee of the created invention has no legal effect for acknowledging it as an employee's one. Moreover, the negative consequences of the employee's failure to notify the employer of the creation of a patentable invention cannot be attributed to the employer.

The right to obtain a patent for an employee's invention, to which the defendants refer as a legal ground for their obtainment of the patent in their name, returns to an employee only if he/she fulfils the duty to duly notify the employer of the creation of a protectable technical solution.

In support of their position that the employer was duly notified of this fact, the defendants refer to the internal notes, in one of which one of the inventors informed the Company's General Director of their work on improving the technology used by the company.

The Defendants consider the provided message to the employer's representative as a notice of the creation of a patentable technical solution.

The court heard the Company's General Director as a witness, who said that he was not aware of the content of the patented technical solution and that the inventors did not inform him of the creation of a potentially protectable invention. As to the corporate records, the witness explained that he received and read them; however, from the content of those records, he could not conclude that they were about a new protectable invention.

Thus, it does not follow from the corporate records dated December 23, 2011 and dated December 27, 2011 that the employee authors notified the employer of the creation by them of a specific technical solution that may be granted legal protection as an invention. These internal notes do not contain any information on the name of such technical solution or its nature or its potential protectability (i. e., compliance with the criteria set forth by Article 1350 of the Civil Code of Russia).

As a result, the Intellectual Property Rights Court concluded that the defendants did not prove the fulfilment of their duty to notify the employer of the creation of a protectable invention. The message of a possibility to obtain a patent for some technical solution, which substance is not disclosed to the employer, as such does not evidence notifying the employer.

The Intellectual Property Rights Court satisfied the company's claims and invalidated patent No. 2659528 with regard to failure to indicate the Company therein as a patent holder and indication of the authors of the invention as the patent holders.

**REGISTRATION OF A MEDICINE  
AND MAXIMUM SALE PRICE  
FOR IT EVIDENCES PREPARA-  
TION FOR SALE OF THE MEDICINE,  
WHERE THE PATENTED SUBSTANCE  
IS USED, WHICH POSES A RISK  
OF INFRINGEMENT OF THE RIGHTS  
TO THE INVENTION (SUPREME COURT  
OF THE RUSSIAN FEDERATION,**

**RULING No. 305-ES19-8449  
DATED JULY 31, 2019 ON CASE  
No. A40-106405/2018)**

AstraZeneca UK Limited filed a claim with the Commercial Court of Moscow against Jodas Expoim LLC and the Ministry of Health of the Russian Federation, where it requested:

- To acknowledge the company's exclusive right to import into the Russian Federation, manufacture, use, offer for sale, sell, otherwise commercialize or store for these purposes the medicines containing Gefitinib;
- To compel the company to submit to the Ministry of Health a request for cancellation of the state registration of the Gefitinib medicine and an application for exclusion of the information on state registration of the producer's maximum sale price for the Gefitinib medicine from the State Register of Maximum Sale Prices;
- To compel the Ministry of Health to exclude Gefitinib from the Register of Medicines and to exclude the information on state registration of the producer's maximum sale price for Gefitinib from the State Register of Maximum Sale Prices;
- To prohibit the company from taking actions to register any medicine containing Gefitinib and maximum sale prices for the medicine containing Gefitinib in the Russian Federation before the expiry of the term of patent of the Russian Federation No. 2153495.

The court of first instance dismissed the claims.

The judgment of the court of first instance was reversed by the resolution of the court of appeal upheld by the Intellectual Property Rights Court; and the court satisfied the claimant's claims.

When reversing the decision of the court of first instance and partially satisfying the claims asserted by the company, the court of appeal was guided by the provisions of the Law On Medicines, Sub-clause 2 of Clause 1 of Article 1252, Clauses 2 and 4 of Article 1354, Clauses 1 and 3 of Article 1358 of the Civil Code and proceeded from the fact that the company had taken actions posing a risk of infringement of the company's rights to the patent. Namely, the court of appeal found that the Ministry of Health, upon the defendant's application, had registered Gefitinib, which contained the gefitinib chemical compound as the active substance, which was covered by the claims of the patent. Also, upon the application of Jodas Expoim LLC, the Ministry of Health of Russia registered the maximum sale prices for Gefitinib.

The court of appeal concluded that the company **had taken preparatory actions for using each feature of independent claim 1 of the claimant's patent**, since it is not allowed to commercialize the medicine without state registration of the medicine and state registration of the maximum sale prices for the same.

The court of appeal concluded that there were grounds to partially satisfy the claims: compelled the defendant to submit to the Ministry of Health an application for cancellation of state registration of Gefitinib and an application for exclusion of the information on state registration of the producer's maximum sale price for Gefitinib from the State Register of Maximum Sale Prices and prohibited the company from taking any actions aimed at registration of the medicine containing Gefitinib and the maximum sale prices for the medicine containing gefitinib in the Russian Federation before expiration date of patent No. 2153495. The Supreme Court, where the defendant filed a cassation appeal, concluded that there were no grounds, on which the cassation appeal may be considered.



**A CONCLUSION THAT THE UTILITY MODEL DOES NOT MEET THE PATENTABILITY CRITERION OF “NOVELTY” CANNOT BE MADE IF THE FEATURES INTRINSIC TO THE UTILITY MODEL ARE KNOWN FROM THE GROUP OF TECHNICAL SOLUTIONS IN THE AGGREGATE. FOR THIS CONCLUSION, IT IS NECESSARY THAT SUCH FEATURES ARE CONTAINED IN ONE OPPOSED ITEM (RESOLUTION OF THE PRESIDIUM OF THE INTELLECTUAL PROPERTY RIGHTS COURT DATED AUGUST 26, 2019 ON CASE No. SIP-505/2018).**

The Presidium of the Intellectual Property Rights Court in its Resolution dated August 26, 2019 on case No. SIP-505/2018, when considering the dispute over the dismissal of the statement of opposition against patent of the Russian Federation No. 104245 for a utility model, noted that the court of first instance had reasonably referred to the fact that one source may be used to interpret the features disclosed in another source.

However, the court of first instance had not taken into account that both such sources should describe the same item, but not a group of devices, although having the same purpose, but differing in various details and, accordingly, in their features intrinsic to them.

The conclusion that the utility model does not meet the patentability criterion of “novelty” cannot be made if the features intrinsic to the utility model are known from the group of technical solutions in the aggregate; for this conclusion, it is necessary that such features be contained in one opposed item.

## 2. TRADE MARKS

**THE CONSTITUTIONAL COURT RECOGNIZED THE PROVISIONS OF THE CIVIL CODE ON WELL-KNOWN TRADE MARKS (SUB-CLAUSE 3 OF CLAUSE 6 OF ARTICLE 1483 AND ARTICLE 1508) AS COMPLIANT WITH THE CONSTITUTION (RULING OF THE CONSTITUTIONAL COURT DATED SEPTEMBER 19, 2019 No. 2145-O)**

The Intellectual Property Rights Court (IPRC) requested the Constitutional Court to check the constitutionality of the following provisions of the Civil Code: **sub-clause 3 of Clause 6 of Article 1483 of the Civil Code** in accordance with which the designations identical or confusingly similar to the trade marks of other persons recognized as **well-known** trade marks with regard to similar goods **from the date earlier than the priority of the claimed designation** cannot be registered as trade marks; and **Article 1508 of the Civil Code**, pursuant to which, upon application of a person, who considers the designation used by him/her as a well-known trade mark in the Russian Federation, this designation may be recognized as such by a decision of Rospatent, if, as a result of active use, this designation has become widely known in the Russian Federation among the relevant consumers in relation to the applicant’s goods as on the date specified in the application. At the same time, the designation cannot be recognized as a well-known trade mark if it has become

widely known after the priority date of the identical or confusingly similar trade mark of another person registered for similar goods.

According to the Intellectual Property Rights Court, the challenged provisions, allowing the right holder to arbitrarily determine the date, from which his/her trade mark is to be recognized as well-known by a decision of Rospatent, do not meet constitutional requirements for intellectual property protection.

Refusing to accept the request filed by the Intellectual Property Rights Court for consideration, the Constitutional Court analysed the disputed provisions. In doing so, the Constitutional Court noted as follows.

By virtue of Clause 1 of Article 1508 of the Civil Code the priority of a well-known trade mark is set on the date independently specified by its right holder in the application for recognition of a trade mark (designation used as a trade mark) as well-known if, as on the specified date, the trade mark (designation) meets the criteria of being well-known.

The fame of a trade mark/designation is an actual fact and the procedure for recognizing such a trade mark (designation) as a well-known trade mark is intended to confirm or refute this fact but not its emergence.

**THE GOODS IMPORTED BY THE COMPANY WERE BOUGHT IN THE USA FROM AN AUTHORIZED SELLER AND ARE THE ORIGINAL PRODUCTS THAT BEAR “DR PEPPER EST. 1885” TRADE MARK LEGALLY APPLIED BY THE MANUFACTURER IN THE USA (INTELLECTUAL PROPERTY RIGHTS COURT, RESOLUTION DATED JULY 24, 2019 ON CASE No. A56-108238/2018).**

SintezResurs submitted a declaration to the customs for the goods containing “Dr Pepper Est. 1885” word designation, which, according to the representative of the owner of the trade mark in Russia, were imported into Russian Federation without permission of the right holder (certificates of the Russian Federation Nos. 535941, 535939, and 172741).

Based on that, the customs rendered a ruling with regard to the company on initiation of an administrative case under Part 1 of Article 14.10 of the Administrative Offences Code. It was found during administrative investigation, that the word designation placed on the goods submitted for customs clearance was confusingly similar to the trade marks under certificates of the Russian Federation Nos. 535941, 535939, and 172741.

The Baltic Customs filed a claim with the Commercial Court to bring SintezResurs to administrative liability under Part 1 of Article 14.10 of the Administrative Offences Code. The customs’ claim was dismissed by the decision of the court of first instance upheld by the resolution of the court of appeal.

By dismissing the asserted claim, the court of first instance proceeded from the fact that the goods imported by the company into the Russian Federation bore “Dr Pepper Est. 1885” trade mark owned by Dr Pepper/Seven Up, Inc. registered in the USA, which is not protected in the Russian Federation. Thus, the court of first instance concluded that there were no grounds for bringing the company to administrative liability for the import of goods into the Russian Federation without permission of European Refreshments



(Ireland), since, in this instance, there were no elements of an administrative offence, liability for which is provided for in Part 1 of Article 14.10 of the Administrative Offences Code.

The court of appeal supported the said conclusions of the court of first instance, having upheld the challenged decision.

Having considered a cassation appeal filed by the customs, the Intellectual Property Rights Court confirmed the correctness of the conclusions of the court of first instance and of the court of appeal.

The Intellectual Property Rights Court noted that the administrative liability set forth by Article 14.10 of the Administrative Offences Code for illegal use of another person's trade mark may apply **only if the goods contain illegal trade mark reproduction.**

Subject to Clause 8 of Resolution of the Plenum of the Supreme Commercial Court No. 11 dated February 17, 2011 On Certain Issues Related to Application of the Administrative Offences Code the illegal use of a trade mark (Part 1 of Article 14.10 of the Administrative Offences Code) shall mean, among other things, illegal placement of a trade mark on goods and subsequent import of such goods into the Russian Federation. This provision is intended to ensure protection from import of counterfeit goods individualized without the authorization of the right holder.

At the same time, assessment **whether the designation is legally applied to the goods is based on the law of the country of origin of the goods.**

Hence, if the designation registered as a trade mark in the country of origin of goods is applied in the country of origin of goods by the right holder of such a trade mark or upon his/her/its consent, the goods bearing this designation cannot be deemed to contain illegal trade mark reproduction.

**REGARDING ACKNOWLEDGEMENT  
OF ACTIONS TO ACQUIRE AND USE  
THE EXCLUSIVE RIGHT TO THE “DURO-  
STONE ДЮРОСТОН” TRADE MARK  
AS ABUSE OF RIGHT AND AN ACT  
OF UNFAIR COMPETITION (PRESI-  
DIUM OF THE INTELLECTUAL PRO-  
PERTY RIGHTS COURT, RESOLUTION  
DATED JULY 25, 2019 ON CASE  
No. SIP-458/2018)**

Four firms, including a company from Germany and three Russian companies, filed claims with the Intellectual Property Rights Court against three Russian firms to recognize their actions to register and use a trade mark under certificate of the Russian Federation No. 358553.

The claims are satisfied by the decision of the Intellectual Property Rights Court. The court recognized the actions of three Russian firms to acquire and use the exclusive right to the trade mark under Certificate No. 358553 as unfair competition.

The Intellectual Property Rights Court found that the actual extensive supplies of the goods marked with the “DUROSTONE” designation to the Russian Federation for the period from January 2003 to October 2006 were confirmed by the files submitted by the claimant and by the information provided by the Russian Customs pursuant to which Rochling was the manufacturer and consignor of the goods imported into the Russian Federation during the disputed period.

## ДЮРОСТОН DUROSTONE

Trade Mark No. 358553

Rochling became aware that trade mark under certificate of the Russian Federation No. 358553 (priority date: November 01, 2006) was registered in the name of one of the defendants.

Later, the trade mark was assigned twice to the second and third defendants (successively).

In support of the stated claims, the claimants specified that the first owner of the trade mark was one of the first distributors of the products by Rochling in the Russian Federation; correspondence with the company on behalf of the Russian company was conducted by its General Director.

The claimants believed that the actions of the first owner of the disputed trade mark to register the mark were an abuse of right, and their joint actions with another defendant to acquire and use the disputed trade mark were an act of unfair competition by a group of persons.

The court found that, at the time of filing the application for registration of the disputed trade mark, the General Director of the first defendant was aware of the activities of Rochling and of the use by that company of the “DUROSTONE” designation in the Russian Federation.

Under such circumstances, the court concluded that the defendants' concerted conduct evidenced that there is unfair competition in their actions against the competitor Rochling.

Having disagreed with the decision of the court of first instance, the defendants filed cassation appeals with the Presidium of the Intellectual Property Rights Court. Considering the cassation appeals, the Presidium of the Intellectual Property Rights Court noted that, when resolving the issue of good faith of acquiring the exclusive right to a trade mark, both facts related to the acquisition of the exclusive right as such and the subsequent conduct of the right holder, evidencing the purpose of such acquisition, should be examined. In such a case, the bad faith of the right holder should be established during the period preceding the application for registration of the designation as a trade mark.

Being guided by the provisions of Paragraph 2 of Article 10.bis of the Paris Convention, the court may classify dishonesty a person's conduct, when acquiring the exclusive right to a trade mark, taking into account the subjective criteria for such conduct, since the court evaluates all facts of a particular case in the aggregate and in interrelation. One of the facts that may evidence the unfair conduct of the person who registered the trade mark may be that this person was or should have been aware that, at the time of filing the application for registration of the designation as a trade mark, third parties (a third party) legally used the relevant designation to individualize their manufactured goods or provided services without registration as a trade mark and that such a designation became known among consumers.

During consideration of this case, the court of first instance found that Rochling was using the “DUROSTONE” designation at least since 1975. The products marked with the “DUROSTONE” designation were commercialized by the company in the Russian Federation since 2003, which is confirmed by the files of the case and by the information from the Federal Customs Service of Russia on imported goods, consignor, consignees, name of goods, their quantity.

At the same time, the Presidium of the Intellectual Property Rights Court noted that the court of first instance reasonably took into consideration that, after registration of the disputed trade mark, its owner filed claims against counterparties of Rochling in the Russian Federation requesting the court to prohibit the use of the disputed trade mark and entered the information on the disputed trade mark in the Customs IP Register in order not to allow import into the Russian Federation of the goods of the foreign entity marked with the disputed designation. Taking into consideration the cumulative facts found by the court of first instance circumstance, the Presidium of the Intellectual Property Rights Court agreed with the court's conclusion that there was unfair competition against the competitor Rochling in the defendants' actions, for which reason the stated claims were lawfully satisfied.

**THE USE OF THE WORD “ДИСКАТОР” HAD THE MEANING WITH REGARD TO THE KIND OF GOODS, WHILE THE GOODS WERE NOT MARKED WITH THE DISPUTED DESIGNATION (INTELLECTUAL PROPERTY RIGHTS COURT, RESOLUTION DATED AUGUST 16, 2019, CASE No. A65-1102/2019).**

The owner of the trade mark “Дискатор” (a “disk harrow” in English) filed a claim with the commercial court to terminate illegal use of its trade mark and to recover a compensation of 500,000 Russian roubles.

In support of its claims, the claimant pointed out that, on the defendant's official website on the Internet at <http://pk-agromaster.ru/diskator>, the defendant posted advertisements and offers for sale of the goods, namely, the information on disk harrows produced and sold by the defendant with the trade mark owned by the claimant under Certificate No. 258908.

# Дискатор

Trade Mark No. 258908

The “Дискатор” word mark under Certificate No. 258908 was registered with regard to the goods of Class 7 according to the ICGS: “harrows; cultivators

(machines); tractor-drawn cultivators; ploughs”.

The stated claims were dismissed by the decision of the court of first instance upheld by the court of appeal. In support of the defendant's actual activities aimed at advertising and selling disk harrows by posting the relevant information on the website owned by the defendant on the Internet at [www.pk-agromaster.ru](http://www.pk-agromaster.ru), the a notarial examination report was submitted.

By dismissing the asserted claims, the court of first instance pointed out that the word “Дискатор” is used as a common designation for disk units of various types used for tilling; the “Дискатор” term is a commonly used word describing a certain type of agricultural tillage machinery. Hence, the court of first instance came to the conclusion that the word “Дискатор” was used by the defendant to name the category of agricultural goods offered for sale, namely, disk harrows of various manufacturers, but not as a trade mark of the claimant, for which reason, in this case, the goods of the claimant and of the defendant were impossible to be confused, and no evidence of other uses of the trade mark was submitted to the court.

Acting as a court of cassation, the Intellectual Property Rights Court considered the arguments of the courts to be legal, grounded, and compliant with the facts of the case.

Pursuant to Clause 2 of Article 1484 of the Civil Code, the exclusive right to a trade mark may be used to individualize goods, works, or services, with regard to which the trade mark is registered.

In the meaning of the said provision, a verbal reference of another person's trade mark is not a use of such trade mark.

In order to recover compensation from the defendant, the claimant had to prove that the defendant used the trade mark under Certificate No. 258908 by one or more ways provided for by Clause 2 of Article 1484 of the Civil Code. However, as found by the courts and follows from the files of the case, there is no evidence of the defendant's use, in its activities, of the designation confusingly similar to the claimant's trade mark when marking products or in the documents and advertising.

These conclusions of the courts are consistent with the clarifications contained in Clause 157 of the Resolution of the Plenum of the Supreme Court No. 10 dated April 23, 2019 “On Application of Part IV of the Civil Code, in accordance with which the use of the words (including common nouns) registered as word marks is not a use of the trade mark, if such words are used in their common meaning and not to individualize certain goods, works, or services (including those listed in Clause 2 of Article 1484 of the Civil Code), for example, in written publications or speeches.

The claimant's argument that the courts did not apply the Law on Advertising, since all information posted on the defendant's website is an advertisement of the goods produced by it, was rejected by the Intellectual Property Rights Court, because, as follows from the documents on file, the defendant offered the tillage machinery (otherwise called “Disk Harrow”) for sale. In this case, the use of the word “Дискатор” had the meaning with regard to the type of goods, while the goods were not marked with the disputed designation.

Thus, the court of the first instance and the court of appeal came to the grounded conclusion that there were no legal grounds to satisfy the asserted claims.

**EXPORT OF THE GOODS FROM THE RUSSIAN FEDERATION CONSTITUTES OFFENCE PROVIDED FOR BY PART 1 OF ARTICLE 14.10 OF THE ADMINISTRATIVE OFFENCES CODE (INTELLECTUAL PROPERTY RIGHTS COURT, RESOLUTION DATED AUGUST 22, 2019, CASE No. A56-98284/2018).**

A customs declaration for the goods to be placed under the customs procedure of export (into Uzbekistan) was submitted to the customs of the Saint Petersburg. In particular, for the goods “packaging material in reels for wrapping confectionery products”. It was found during the customs inspection that the goods represented labels for the “KARA-KUM” candies in the amount of 50 reels, similar to trade mark No. 2210036.

Following complaint of the owner of trade mark No. 221036, the customs drew up a report on administrative offence and remanded the case to the Commercial Court of Saint Petersburg Region.

The court of first instance satisfied the customs' complaint and fined the exporter for 50,000 Roubles confiscating the counterfeit goods. In doing so, the court proceeded from the fact that the designation placed on the goods to be exported was confusingly similar to trade mark

No. 221036; no authorization to use the trade mark was granted to the exporter.

The court of appeal reversed the decision of the court of first instance, refused to bring the exporter to administrative liability, and ruled to return the seized goods to him for further customs clearance. In doing so, the court of appeal proceeded from the fact that the prohibition to use another person's trade mark without the right holder's permission applies only to the Russian Federation, where the disputed trade mark is granted relevant protection; in the case under consideration, legal protection for the "KARA-KUM" trade mark was granted in the Russian Federation, while wrapping material (not confectionery) was exported from the Russian Federation to Uzbekistan; the exporter did not seek to commercialize the goods in the Russian Federation; when filling out the declaration, the exporter did not indicate the name of the trade mark being protected, since it did not export confectionery ("KARA-KUM" candies) but the packaging material in rolls with no name. No legal protection was granted to "KARA-KUM" trade mark with regard to the printing products (wrapping items); the exporter did not produce or commercialize the confectionery in the Russian Federation. When considering the right holder's cassation appeal, the Intellectual Property Rights Court came to the following conclusions.

Pursuant to the legal position contained in Clause 10 of Resolution of the Plenum of the Supreme Commercial Court No. 11 dated February 17, 2011 "On Certain Issues Related to Application of the Administrative Offences Code", the competence of the customs authorities in protection of intellectual property rights includes checking goods that are or were under customs control. However, the courts should take into account that the customs have the said powers with regard to the goods, not only those imported into the Russian Federation, but also those exported, since in both cases the goods are transported through the customs border.

In the case under consideration, the exported goods were under customs procedures, which predetermines the competence of the customs authorities in protection of intellectual property rights. At the same time, the infringement — placement of the designation similar to the trade mark on the goods — was committed in the Russian Federation.

The Intellectual Property Rights Court also disagreed with the conclusion of the court of appeal that placement of the designation similar to the trade mark on the wrapping material could not be recognized as illegal use of this trade mark, since the said trade mark was not registered for the printing products.

Taking into account the functional purpose of the disputed product (for wrapping "KARA-KUM" candies, including for their identification by the consumer), the complementarity of the "candy" goods and packaging for them, their joint sale to the end consumer, the conclusion of the court of first instance on similarity of these goods should be acknowledged as grounded, since these goods may be regarded by the consumers as coming from the same source.

As a result, the Intellectual Property Rights Court reversed the resolution of the court of appeal and upheld the decision of the court of first instance as legal and grounded.

### **3. COPYRIGHT AND ALLIED RIGHTS**

**THE CLAIMANT FILED A STATEMENT OF CLAIM WITH THE COMMERCIAL COURT AGAINST THE DEFENDANT TO RECOVER COMPENSATION FOR COPYRIGHT INFRINGEMENT AND TO PROHIBIT USE OF THE RESULTS OF INTELLECTUAL ACTIVITY AS PART OF ARCHITECTURAL SOLUTIONS (INTELLECTUAL PROPERTY RIGHTS COURT, RESOLUTION DATED JULY 12, 2019 ON CASE No. A60-55640/2018).**

By the decision of the commercial court of first instance upheld by the court of appeal, the stated claims were dismissed.

In its cassation appeal, the defendant pointed out that the courts incorrectly interpreted the meaning of the terms "Design Documents" and the "Basic Design Stage", for which reason the courts made an erroneous conclusion that the design documents included in the "Architectural Solutions" section of the "Detailed Design Documents" stage were not subject to copyright protection.

By upholding the decisions of the court of first instance and of the court of appeal, the Intellectual Property Rights Court (court of cassation) stated as follows.

The architectural solutions constitute a component of the design documents (Part 12 of Article 48 of the Urban Development Code of the Russian Federation).

A copyrighted item is not the documents for construction as a whole, but only an architectural project, i. e. the architectural part of the documents, where an architectural solution is expressed.

Taking into account the specific features of architectural activities consisting in a two-step architectural solution implementation procedure, the law provided for two forms of its objectification (existence): both as a work of architecture, urban development, and garden art and as designs, drawings, images, and layouts (Paragraph 9 of Clause 1 of Article 1259 of the Civil Code). They are also protected by copyright.

The courts found that the subject matter of the contract dated July 05, 2017 entered into between the claimant and the defendant was the documents of the Basic Design stage and of the Detailed Design Documents stage.

The Detailed Design Documents are derived from the design documents; the detailed design documents do not contain any new architectural solutions, but detail the architectural solutions of the Basic Design stage.

Thus, in this case, the item subject to legal protection is the documents containing architectural solutions.

The contract between the designer and the customer expressly stipulated that the exclusive right to the documents executed under the contract shall be transferred to the customer by the designer in full and shall include, among other things, the right to use and to practically implement the documents in construction without limiting the number of reproductions, to reproduce the documents an unlimited number of times, to distribute the documents in any way, and to revise the documents for use at other facilities.

The courts noted that the exclusive copyright to the disputed architectural solutions passed to the defendant upon



delivery and acceptance of the documents at the Basic Design stage.

At the same time, upon entry into the contract, the claimant was notified of the purposes, for which these documents were prepared, and that it would further be transferred to a municipal customer under a municipal contract. Under such circumstances, based on the fact that the actual transfer to the defendant of the exclusive right to the design and detail design documents prepared by the claimant under the contract was established, there are no grounds to conclude that the defendant unlawfully used those documents. In this regard, the courts reasonably dismissed the claims.

**IS A FIRST AID INSTRUCTION A COPYRIGHTED WORK? (INTELLECTUAL PROPERTY RIGHTS COURT, RESOLUTION DATED JULY 22, 2019, CASE No. A40-137145/2017)**

The court considered a dispute over the distributed publication of the work being Instructions for First Aid in case of Industrial Accidents. The exclusive right to the Instructions are owned by the publishing company based on the agreement entered into with its authors.

The court of first instance satisfied the claimant's claim and acknowledged that the defendant had illegally used the Instructions.

In the defendant's opinion, the Instructions were not created by creative work. It was issued as a regulation by Order of Rostekhnadzor (Federal Environmental, Industrial and Nuclear Supervision Service) dated April 06, 2012 No. 233 "On Approval of Certification (Knowledge Test) Areas for Chiefs and Specialists of the Entities Supervised by the Federal Environmental, Industrial and Nuclear Supervision Service". Thus, being a regulation, the Instruction under Sub-Clause 1 of Clause 6 of Article 1259 of the Civil Code is not a copyrightable work.

The court of first instance found that the disputed Instruction was not accepted by Rostekhnadzor as a binding document, and a reference to it in the Order is a reference to a source of information that the relevant specialists should be familiar with during certification. Moreover, the court lawfully noted that the reference to the Instruction in the Order dated April 06, 2012 No. 233 did not give it the attributes of a regulation.

The court examined whether the Instruction originated from a state authority and found that RAO UES of Russia Open Joint-Stock Company, which approved the Instruction, was not a state authority and did not have the powers to publish regulatory documents, for which reason there are no grounds to argue that the disputed document refers to official documents of state authorities.

The courts came to a reasonable conclusion that the disputed Instruction, in spite of the defendant's arguments, is protected by copyright and is subject to protection in accordance with the provisions of the civil law.

The courts also found that the Instruction is provided with original illustrations that cannot be considered as part of a binding document, for which reasons the illustrations in the Instruction are protected by copyright and the exclusive right to them are also recognized as owned by the claimant.

**THE CONCLUSION OF THE COURT OF FIRST INSTANCE THAT THE CLAIMANT DID NOT OBTAIN THE EXCLU-**

**SIVE RIGHT TO TOY FURNITURE SETS OF THE SYLVANIAN FAMILIES SERIES, SINCE IT DID NOT OBTAIN A PATENT FOR AN INDUSTRIAL DESIGN, IS BASED ON MISUNDERSTANDING OF THE LEGAL NORMS, SINCE, TO PROTECT COPYRIGHT FOR WORKS OWNED BY THE CLAIMANT, IT IS NOT REQUIRED TO OBTAIN A PATENT FOR AN INDUSTRIAL DESIGN (INTELLECTUAL PROPERTY RIGHTS COURT, RESOLUTION DATED JULY 25, 2019, CASE No. A40-105646/2017)**

EPOCH COMPANY, LTD, Japan, filed a claim with court to protect the exclusive right to design works — toy furniture sets of the Sylvanian Families series.

The existence of the claimant's exclusive right to these items is confirmed, in the claimant's opinion, in particular, by the invention certificates for the works and by the published photos of products in the claimant's catalogues. In turn, according to the claimant, the defendants imported, offered for sale, and sold the goods, where the said copyrighted items were used without the right holder's authorization.

This fact was recorded by the claimant by purchasing the disputed goods, on which packages TNG LLC was indicated as the supplier and the authorized entity, in the online store [www.abtoys.ru](http://www.abtoys.ru), which administrator is one of the co-defendants.

By dismissing the stated claims, the court of first instance proceeded from the fact that the design of toy furniture sets may only be classified as industrial designs, but not as works, since, in the opinion of the court of first instance, a perceptual unity of the disputed goods may not be separated from their design to classify it as an independent item subject to protection of the exclusive right. In this regard, the court considered that the appearance of the disputed toy furniture sets should be classified as industrial designs, but since the claimant provided no evidence of state registration of the disputed toy furniture sets as industrial designs, the court of first instance concluded that the claimant did not obtain the exclusive right to the industrial design being the toy furniture sets. Also, in the opinion of the court of first instance, the claimant did not prove that it had copyright to the disputed design of the toy furniture sets.

Generally supporting the decision of the court of first instance, the court of appeal also pointed out that it was impossible to identify the seller of the goods from the submitted documents and, therefore, to find whether they were illegally commercialized.

Thus, the court concluded that the claimant's claims against the defendants should be dismissed.

The Intellectual Property Rights Court (court of cassation) disagreed with the conclusion of the court of first instance that the design of the toy furniture sets may only be classified as industrial designs, but not as copyrightable works. The Intellectual Property Rights Court notes that, by virtue of Clause 1 of Article 1259 of the Civil Code, design works are protected by copyright.

In this regard, the Intellectual Property Rights Court recognized the conclusion of the court of first instance, i.e. that the claimant should obtain a patent for an industrial design to protect its design for the toy furniture sets of the Sylvanian Families series as erroneous, since the right of choice how to protect its rights is a sole power of the right holder.



As to the conclusion of the court of first instance stating that the claimant did not prove that it had copyright to the disputed design, the Intellectual Property Rights Court noted that, in the cases on copyright protection, the defendant should prove that he complies with the requirements of law when using the works, and the claimant should confirm his actual ownership of copyright or the right to its protection and actual use of these rights by the defendant. In this instance, it is necessary to proceed from the authorship presumption. In particular, if there is no evidence to the contrary, the author of the work shall be deemed the person indicated as the author on the original work or on its copy. Taking into account that the company's right of authorship and the exclusive right to the design of the toy furniture sets of the Sylvanian Families series are not challenged by the defendants the Intellectual Property Rights Court agreed with the claimant's argument in the cassation appeal that the conclusions of the court of first instance to the contrary are not consistent with the facts of the case and the evidence submitted in their support. As a result, the Intellectual Property Rights Court reversed the decision of the court of first instance and the resolution of the court of appeal and remanded the case to the court of first instance for a new consideration.

**THE CONCLUSION OF THE COURT OF APPEAL TO THE EFFECT THAT SOFTWARE TRANSFER IS CONFIRMED BY CERTIFICATES OF EQUIPMENT TRANSFER AND ACCEPTANCE BY THE DEFENDANT TO THE CLAIMANT FOR TEMPORARY USE WAS MADE WITHOUT CONSIDERING THAT THESE CONFIRM DOCUMENT TRANSFER OF HARDWARE TO THE CLAIMANT BUT NOT INSTALLATION OF SOFTWARE THEREON (INTELLECTUAL PROPERTY RIGHTS COURT, RESOLUTION DATED JULY 11, 2019 CASE No. A40-241345/2018)**

Integrit LLC filed a claim with the commercial court against Telecom Networks LLC to collect a debt under a licence agreement in the amount of 3.5 mln. Russian roubles and interest for use of another person's monetary assets in the amount of 284,270 Russian roubles. The asserted claims were satisfied by the decision of the court of first instance upheld by the resolution of the court of appeal. Having considered the cassation appeal filed by the defendant, the Intellectual Property Rights Court concluded that there are grounds to satisfy it. The claimant (the licensor) and the defendant (the licensee) entered into the licence agreement for the right to use the "Media Data Processing Library with the Function of a Videoconferencing Group Terminal" software. Pursuant to the agreement, the licensor shall grant a licence for the right to use the software, and the licensee shall pay for the licence the amount of 4.5 mln Russian roubles. The fee should be paid in accordance with the payment schedule agreed by the parties. As on the date of the case consideration, only 1 mln Russian roubles was paid by the licensee. In support of the claim, the claimant referred to the fact that the defendant had not performed the obligations to repay debts in the total amount of 3.5 mln Russian roubles. By satisfying the claims, the court of first instance proceeded from the fact that the licensor had performed

the contractual obligations and transferred the licence to the licensee and from the defendant's non-fulfilment of the duty to pay the licence fee in the amount of 3.5 mln. Russian roubles.

The court of appeal acknowledged these conclusions of the court of first instance as legal and grounded and rejected the defendant's argument contained in the appeal that the software had not been transferred by the claimant to the defendant and had not been installed by the claimant on the defendant's hardware.

The defendant filed a cassation appeal with the Intellectual Property Rights Court. The court stated that the appealed judicial acts contained just general conclusions of the courts without reflecting the examination and evaluation of the evidence submitted by the parties and without specifying the reasons why the courts made their conclusions.

Thus, in particular, the conclusion on the software transfer by the claimant to the defendant was made, first of all, based on the explanations of the claimant's representative at the court hearing, who asserted that such a transfer had actually occurred.

However, the court of appeal did not evaluate the defendant's argument that there were no documents confirming such a transfer in the case, while, pursuant to the licence agreement, the software should be transferred under the transfer and acceptance document, which was not drawn up by the parties.

The court's reference to the existence of a working correspondence between the parties was made in general terms without examining the content of such correspondence and without examining the employment duties and powers of the parties' employees.

The defendant's use of the claimant's software to perform works under other agreements was confirmed by the court of appeal without evaluating the relevant evidence.

In addition, the conclusion of the court of appeal that software transfer is confirmed by reports of equipment acceptance and transfer by the defendant to the claimant for temporary use was made without considering that **these reports confirm transfer of hardware to the claimant, but not installation of software thereon**. The resolution of the court of appeal contains no grounds showing which circumstances confirm installation of the software. The Intellectual Property Rights Court reversed the decision of the court of first instance and the resolution of the court of appeal and remanded the case to the court of first instance for a new consideration.

#### **4. Know-How**

**THE PERSON CREATING A RESULT OF INTELLECTUAL ACTIVITY IS THE AUTHOR OF THIS RESULT. KNOW-HOW IS A PROTECTABLE RESULT OF INTELLECTUAL ACTIVITY, WHICH HAS ITS AUTHOR(S) (RESOLUTION OF THE NINTH COMMERCIAL COURT OF APPEAL DATED JULY 17, 2019 No. 09AP-24080/2019 ON CASE No. A40-274664/18).**

NII Stali JSC and the Ministry of Industry and Trade of Russia entered into state contracts for development works, in pursuance of which the results of intellectual activity protected as know-how were created and trans-

ferred to the state customer. According to the terms and conditions of the contracts, the contractor assumed, in case a protectable result is created, the obligation to pay an incentive fee to the author(s), according to the terms and conditions of the agreement entered into by and between the contractor and the author(s). However, no incentive fee payment agreements were entered into; no incentive fees were paid to the authors of the results of intellectual activity.

The claimant's argument that Chapter 75 of the Civil Code of Russia does not determine the right of authorship for know-how, since Article 1466 of the Civil Code of Russia provides for only the holder of know-how, is acknowledged by the court to be groundless.

The provisions of Article 1228 of the Civil Code stipulate that the person, through whose creative work the result of intellectual property is created, is the author of such result. Moreover, the rules of this provision apply equally to all results of intellectual property and do not provide for any exceptions.

Therefore, the person, through whose creative work any result of intellectual property is created, including that protected as know-how, is the author of such result.

Pursuant to Clause 1 of Article 1470 of the Civil Code, the exclusive right to know-how created by an employee due to fulfilment of his/her employment duties or a certain task of the employer is owned by the employer. Thus, from a literal interpretation of the provisions of the civil legislation, it follows that know-how is created by a particular employee. Under such circumstances, know-how, like any other result of intellectual activity, is created by the author (a group of authors) who has relevant liability. Therefore, the author (the group of authors), who created know-how, is entitled to receive a fee.

# ROSPATENT'S PRACTICE

## 1. PATENTS

### INDUSTRIAL DESIGN VERSUS TRADE MARK (DECISION OF ROSPATENT (CHAMBER FOR PATENT DISPUTES) DATED AUGUST 19, 2019)

Rospatent considered a statement of opposition against patent No. 102909 for a group of industrial designs "Packing Sheet for Food Products (5 versions)" (priority date: July 07, 2016).



Version 1



Version 2



Version 3



Version 4



Version 5

The statement of opposition bases its claims on non-compliance of Variants 3 to 5 with the "originality" patentability criterion and with the condition set forth by Sub-Clause 2 of Clause 5 of Article 1352 of the Civil Code, since they mislead consumers of the product.

The statement of opposition contains references to trade marks Nos. 542905 and 546184 (priority date: October 16, 2013):



Trade Mark No 542905



Trade Mark No 546184

Considering the statement of opposition, the panel noted as follows.

The appearances of products under comparison and images of trade marks have the following common features:

- They are made as a rectangle;
- There are alternating multi-coloured vertical stripes;
- There is at least one image of a dumpling.

It should also be noted that packages in options 3 to 5 under the challenged patent are registered with regard to packages for dumplings like the opposed trade marks. However, the appearances of packages in options 3 to 5 under the challenged patent have the following differences from the trade marks:

- The text "BAMBUSHKI (БАМБУШКИ)" on the package and the "BULMENI (БУЛЬМЕНИ)" word element in the trade mark are associated with different words and have different phonetics;
- The text "BAMBUSHKI" is written in three lines, while the "BULMENI" word element is written in two lines;
- There is an image of a plate with dumplings in the central lower part of the package;
- The images of dumplings in the central upper part of the package are made as animated characters close to human beings.

Taking into account the differences identified, the panel concluded that there is no steady associative relation between industrial design variants 3 to 5 under the challenged patent and the trade marks, which could result in a consumer attributing the goods to one and the same manufacturer. Therefore, the industrial design variants for the challenged patent do not contain identical images of the opposed trade marks, do not produce the same general impression on the consumer as the images of these

marks do, and, therefore, do not mislead the consumer as to the manufacturer of the goods.

Patent of the Russian Federation for industrial design No. 102909 was upheld.

## 2. TRADE MARKS

### **IVASPIRIN V. ASPIRIN (DECISION OF ROSPATENT (CHAMBER FOR PATENT DISPUTES) DATED JULY 19, 2019)**

The applicant under application for registration of trade mark No. 2018714224 filed an appeal against the decision to refuse registration of “**IvAspirin (ИвАспирин)**” trade mark with regard to the goods of Class 05 according to the ICGS being “anti-febrile medicine”.



Trade Mark No 2018714224

The refusal to register the designation was explained, among other things, by the fact that the claimed designation is confusingly similar

to a series of trade marks containing “АСПИРИН”, “ASPIRIN” word elements that were previously granted legal protection in the Russian Federation with an earlier priority in the name of another person with regard to similar goods of Class 05 according to the ICGS.

Having considered the appeal filed by the applicant, the panel noted as follows.

“**IvAspirin**” word element is a coined word not contained in the dictionary and reference literature.

In accordance with the arguments given in the official action of rejection, the claimed designation is similar to a series of the trade marks owned by another person. The series of the opposed marks is based on “ASPIRIN” / “АСПИРИН” word elements. In the “ASPIRIN” / “АСПИРИН” word elements of some marks from the series, the first letter “A” is made in a larger font as compared to the other letters. There is also such a feature in the word “**IvAspirin**” of the claimed designation, visually highlighting part of the word “-Aspirin” from it, which has phonetic identity with “ASPIRIN” and “АСПИРИН” word elements included in the opposed marks.

Thus, the claimed designation containing the dominant “**IvAspirin**” word element, which includes the word “Aspirin” forming a series of the opposed marks, despite individual visual differences, evokes similar associations with the opposed marks, which makes it possible to acknowledge it as confusingly similar to these marks. Moreover, the panel took into account famous character, reputation, and duration of stay of “Aspirin” medicine on the Russian market. In accordance with the foregoing, the Panel upheld the decision to refuse registration.

**THE PANEL TOOK INTO ACCOUNT THE SUBMITTED LETTER OF CONSENT DUE TO THE LACK OF GROUNDS FOR CONCLUDING WHETHER IT IS POSSIBLE TO MISLEAD CONSUMERS (DECISION OF ROSPATENT (CHAMBER OF PATENT DISPUTES) DATED JULY 19, 2019)**

Rospatent (Chamber of Patent Disputes) considered an appeal against the decision on state registration of the trade mark under application No. 2017740116.



Trade Mark No 2017740116

The trade mark was registered with regard to all goods in Classes 19 and 20 according to the ICGS.

At the same time, the expert examination found confusing similarity of the claimed

designation and the Walcom marks under international registration No. 635082 and under international registration No. 614799, which were previously granted legal protection in Russia in the name of WALMEC S.P.A., Italy, with regard to similar goods in class 06.



Trade Mark No 635082

Considering the appeal, the Panel noted as follows. The main strong element of the claimed designation, which ensures its individualizing ability, is the “**VALCOMP**” word element. The dominant element of the opposed trade marks is the “**WALCOM**” word element.

The similarity of the claimed designation and the opposed trade marks is based on the phonetic similarity of the word elements of “**VALCOMP**” and “**WALCOM**” designations under consideration.

The “**VALCOMP**” and “**WALCOM**” word elements under comparison have no lexical meaning, since no translation of these words from any wide-spread European language is found, therefore, the semantic criterion of similarity is not used.

The applicant received a letter of consent from the right holder of the opposed international registrations to the registration of the trade mark under application No. 2017740116 with regard to the goods in Class 06 according to the ICGS.

Registration of the designation confusingly similar to any trade mark shall be allowed upon a consent of the right holder, provided that such registration will not mislead consumers.

When determining probability of misleading consumers, the panel relied on the following information.

The applicant is a French holding company manufacturing doors, shutters, gates, sliding systems, and furniture. The company owns enterprises and representative offices in different countries of the world (<https://www.mansion.com/en/aboutus/mansion-in-the-world/>). A graphic element of the claimed designation is posted on the website to individualize the right holder, including offering interior sliding doors for sale.

In turn, the opposed trade marks are associated with paint equipment (paint sprayers, paint delivery tanks, accessories for painting works at <https://walmec-shop.ru/products>).

At the same time, the designations under comparison cannot be recognized as identical, in particular, the word element (“**VALCOMP**” and “**WALCOM**” are not identical). The opposed trade marks are not well-known or collective. Thus, the obstacles for registration of the claimed designation as a trade mark with regard to the claimed goods of Class 06 according to the ICGS were overcome by the applicant.

**THE “MYOFASCIAL TRAINING” WORD ELEMENT IS A CHARACTERISTIC OF GOODS (SERVICES) AND INDICATES THEIR PROPERTIES AND PURPOSE (DECISION OF ROSPATENT (CHAMBER FOR PATENT DISPUTES) DATED AUGUST 16, 2019 UNDER INTERNATIONAL REGISTRATION No. 1388402)**

The Chamber of Patent Disputes considered an appeal against Rospatent’s decision to refuse registration



of “**Slings Myofascial Training**” mark under international registration No. 1388402 with regard to the goods and services in Classes 16 and 41 according to the ICGS. The official action of rejection states that the “Slings” word element denoting a certain type of goods is false for all goods of Class 16 according to the ICGS, while the “Myofascial Training” word element is a characteristic of the goods (services) and indicates their properties and purpose, for which reason the mark under international registration cannot be granted legal protection in the Russian Federation.

During examination of the appeal, the panel of the Chamber of Patent Disputes found that, under international registration No. 1388402, protection is claimed for the following goods and services in Class 16: paper, cardboard, etc.; and in Class 41: education; training; entertainments; sports and cultural events; training, namely, training courses on pedagogy of movement.

The appeal asserts that the “**Slings Myofascial Training**” designation is coined and is used to individualize the training and drilling concept developed by the applicant.

The analysis of the mark conducted by the panel showed that the word elements included in it are lexical units of the English language (see <https://www.translate.ru>; <https://www.lingvolive.com>):

- “Slings” is used in the plural and is derived from “sling” meaning belt, rope; bandage;
- “Training” means education, upbringing, drill;
- “Myofascial” means an inextricably entwined structure of muscular and connective tissue. However, the word “myofascial” is not a coined word and is used in medicine and physiotherapy to denote various body pathologies and methods of their treatment, for example, “myofascial syndrome” (a neurological pathology characterized by involuntary muscle contraction and intense pain); “myofascial release” (a set of exercises that simultaneously affects muscles and important connective tissues).

The “myofascial training” phrase has an intelligible meaning and is perceived as a descriptive characteristic, and, therefore, refers to non-protectable elements under clause 1 of Article 1483 of the Code.

The panel further noted widespread use of the word “Slings” to denote a specific sports rope exercise equipment that allows training using the athlete’s own weight:



The concept of “sling therapy” is also known (see, for example, <https://noalone.ru>), where belts (slings) are used for weight training and strengthening the muscles of people suffering from locomotory disorders. Thus, the “Slings” word is an indication of the type of goods classified as sports equipment, i. e. goods in Class 28. But for the goods in Class 16, the “Slings Myofascial Training” mark contains false indication of the type of goods

and thereby may mislead the consumer in accordance with the requirements of Clause 3 (1) of Article 1483 of the Civil Code.

Evaluating all facts in the aggregate, the panel came to the conclusion that the mark under international registration No. 1388402 does not comply with the requirements of Clauses 1 (3) and 3 (1) of Article 1483 of the Code and that there are no grounds to satisfy the appeal.

**THE CHALLENGED TRADE MARK MISLEADS CONSUMERS, SINCE IT CONTAINS THE NAME OF THE “NINJA WARRIOR” SHOW KNOWN IN RUSSIA, THE COPYRIGHT OF WHICH BELONGS TO THE PERSON FILING THE OPPOSITION (DECISION OF ROSPATENT (CHAMBER FOR PATENT DISPUTES) DATED AUGUST 15, 2019)**

Tokyo Broadcasting System Television Inc., Japan, filed an opposition with Rospatent to registration of the “Russian Ninja Warrior” trade mark (No. 618321) with priority dated May 05, 2016 in the name of Raduga LLC, Russia, with regard to the services of Class 41 according to the ICGS. The mark was later assigned to the Estonian company MOTAN BALTIC OÜ.

**RUSSIAN  
NINJA  
WARRIOR**

It follows from the materials of the opposition that the person filing the opposition saw infringement of its exclusive rights to the “NINJA WAR-

RIOR” designation being the name of the world-known show and entertainment television program.

In the opinion of Tokyo Broadcasting System Television, the challenged trade mark misleads the consumer, since it contains the name of the “NINJA WARRIOR” show known in the Russian Federation and all over the world, the copyright to which belongs to the person filing an opposition, i. e. violates the requirements of Clause 3(1) of Article 143 of the Civil Code.

As confirmation of the familiarity of the “NINJA WARRIOR” show to the Russian audience, numerous materials were submitted along with the opposition. And to support ownership of copyright to the show, the program’s script,



where its name “NINJA WARRIOR”, copyright symbol “©”, date of 2007, and a reference to the person filing an opposition (TBS — TOKYO BROADCASTING SYSTEM TELEVISION, INC., Japan), was submitted.

The panel also took into account that, when launching localized versions of the “NINJA WARRIOR” show in other countries, a standard method of adding the name of the country to the show’s name was used.



An active discussion of the NINJA WARRIOR show in the social media prior to the priority date of the challenged trade mark evidences that it became known to the Russian audience as on the date of its priority. Thus, the aggregate materials submitted by the person filing an opposition make it possible to conclude that the Russian audience and users of the Internet and social media were aware of the show, which name includes the “NINJA WARRIOR” phrase, and that this show was created by the person filing the opposition — Tokyo Broadcasting System Television Inc., a Japanese broadcasting company.

Accordingly, the challenged trade mark is capable of misleading the consumer as to the person providing the services in class 41 related to holding and arranging sports shows and associated services related to entertainment and leisure activities.


The panel did not consider the opposition’s arguments that registration and use of the trade mark under certificate No. 618321 are an abuse of right and unfair competition specifying that they fall within the competence of the anti-monopoly service.

Taking into account the foregoing, the panel concluded that there were grounds to satisfy the opposition and to invalidate the grant of legal protection to the trade mark under certificate No. 618321 with regard to the services of class 41 according to the ICGS.

### 3. WELL-KNOWN TRADE MARKS

During the period from July to September, Rospatent recognized the following trade mark as well-known:

Trade Mark	ZARA
Right Holder	INDUSTRIA DE DISEÑO TEXTIL, S.A. (Spain)
Goods/Services	Clothing, shoes (class 25 according to the ICGS)
Date of Becoming Well-Known	January 01, 2016



During the same period, Rospatent refused to recognize “Rollton” (РОЛЛТОН) (applicant: Saneco Limited, Cyprus, Rospatent’s decision dated August 14, 2019) and “MILDRONAT (МИЛДРОНАТ)” (applicant: AS Grindeks, Latvia, Rospatent’s decision dated July 30, 2019) as well-known trade marks, since, the fame of the designations among consumers was not doubted by Rospatent, in Rospatent’s opinion, the applicants failed to prove that consumers associated these designations exactly with the applicants.

### 4. APPELLATIONS OF ORIGIN

During the period from July to September, Rospatent registered the following appellations of origin:

Number in the Register of Appellations of Origin	Appellation of Origin	Goods
207	KUBAN EARLY POTATOES	Early potatoes
208	SOL-ILETSKY WATERMELONS	Watermelons
209	ABASHEVO TOY	Toys, souvenirs
210	KALMYK DOMBRA	Musical instrument
211	KONAKOVO FAIENCE	Faience articles
212	UINSKY HONEY	Honey
213	BELYOVSKY MARSHMALLOW	Marshmallow
214	BELYOVSKY FRUIT JELLY	Fruit jelly
215	GORYACHIV KLYUCH, WELLBORE 934	Mineral water
216	KOMI-PERMYAK POSIKUNCHIKI (PIES) WITH HORSETAIL FERTILE STEMS	Pastries
217	GORNO-ALTAYSK RED DEER	Red deer
218	OLYUTORSKAYA HERRING	Herring

# NEWS

## **1 OCTOBER 2019// VLADIVOSTOK**

Seminar “Some aspects of protection and security of intellectual property for successful business development”, Vladivostok

Gorodissky & Partners held the seventh seminar in a series of seminars dedicated to the Gorodissky & Partners 60th anniversary of the practice. At the seminar “Some aspects of protection and enforcement of intellectual property for successful business development”, held in Vladivostok, IP attorneys and lawyers of the firm spoke about the intricacies of trademark registration and the firm’s experience in combating counterfeit in China. Also, the most important case studies on anti-counterfeiting and privacy rules were in the focus.

## **3 OCTOBER 2019// NOVOSIBIRSK**

Seminar “Novosibirsk customs and lawyers”

Denis Titov, Regional Director (Gorodissky & Partners, Novosibirsk), made a presentation “Counterfeiting measures in large companies. Actions to prevent counterfeiting and work with the consequences of smuggling products” at the seminar “Novosibirsk customs and lawyers” organized with Gorodissky & Partners support.

## **17 OCTOBER 2019// MOSCOW**

IV International conference “IP rights protection”

Dmitry Rusakov, Brand protection group leader (Gorodissky & Partners, Moscow), made a presentation on



PHOTO: DMITRIY RUSAKOV, HEAD OF BRAND PROTECTION GROUP (GORODISSKY & PARTNERS, MOSCOW)

“Brand protection in digital” at the IV International conference “IP rights protection” organized by the Business Way Forum in the International Trade Centre.

## **23 OCTOBER–26 OCTOBER 2019// JAKARTA**

Russian students won two gold medals from the International Exhibition for Young Inventors (IEYI)



PHOTO: RUSSIAN TEAM AT THE INTERNATIONAL EXHIBITION FOR YOUNG INVENTORS IN JAKARTA

Law Firm Gorodissky & Partners has once again sponsored the participation of the Russian delegation in the International Exhibition of Young Inventors (IEYI), which was held from October 23 to 26, in Jakarta, Indonesia. For the third year in a row, throughout the history of participation of the Russian delegation in this exhibition, Yuri Kuznetsov, Partner of Gorodissky & Partners, joined the international jury of the competition.

In total, 120 projects from 11 countries took part in the competition. Among them are 12 Russian projects that were selected at the All-Russian qualifying contest. Students from Russia won two gold medals at the 15th International Exhibition for Young Inventors (IEYI).

## **31 OCTOBER 2019// ST. PETERSBURG**

Practical Legal Conference for Business “Employee and Employer-2019”

Victor Stankovsky, Partner, Regional Director, Russian & Eurasian Patent Attorney (Gorodissky & Partners, Saint Petersburg), made a presentation “Remuneration of an employee for service invention.

Patent Law. Court practice” at the first Practical Legal Conference for Business “Employee and Employer-2019”

organized by the business online newspaper “Novy prospect” in conjunction with the Faculty of Law, St. Petersburg State University in St. Petersburg.

## **12 NOVEMBER–13 NOVEMBER 2019// KAZAN**

III International Forum «Intellectual Property and Economy of Russian Regions»

The firm’s delegation took part

in the III International Forum “Intellectual Property and the Economy of the Regions of Russia”, held in Kazan.

As part of the professional program, Albert Ibragimov, Partner, Regional Director, Russian and Eurasian Patent Attorney (Gorodissky & Partners, Kazan) took part in the round



PHOTO: ALBERT IBRAGIMOV, PARTNER, REGIONAL DIRECTOR, RUSSIAN AND EURASIAN PATENT ATTORNEY (GORODISSKY & PARTNERS, KAZAN)

table “Strategy for the development of intellectual property in the Russian Federation. The development of the intellectual property market in the regions of Russia”, during which a discussion was held on the implementation of the “IP Market Development Program in the Republic of Tatarstan”.





PHOTO: ATTENDEES OF THE SEMINAR "INTELLECTUAL PROPERTY AND ISSUES IN THE FIELD OF COMMERCIALIZATION OF MEDICAL DEVICES"

Also at the round table "Import — export of technology. The practice of foreign protection of intellectual property and interaction between companies. LES International — professional communications of specialists in the field of trade and technology transfer", moderated by Albert Ibragimov, Partner, Regional Director, Russian and Eurasian Patent Attorney (Gorodissky & Partners, Kazan), Sergey Dorofeev, Partner, Russian and Eurasian Patent Attorney (Gorodissky & Partners, Moscow), Anton Khomyakov, PhD., Russian Patent Attorney and Ramzan Khusainov, Senior Lawyer, Russian Trademark Attorney (both — from Gorodissky & Partners, Kazan) made reports. Among the participants of the round table were heads and representatives of large companies in the region (Tatneft, Nefis-Bioprodukt) and universities (KFU, KNITU).

#### **14 NOVEMBER 2019// ST. PETERSBURG**

St. Petersburg International Innovation Forum

Gorodissky & Partners Law Firm took part in the St. Petersburg International Innovation Forum 2019. In the frames of the Forum the X Interregional Intellectual Property Exchange took place, where Victor Stankovsky, Partner, Regional Director, Russian & Eurasian Patent Attorney lectured about the patenting strategy of Russian inventions abroad.

In addition, Gorodissky & Partners, with the support of the St. Petersburg SBI "Center for Entrepreneurship Development and Support", organized a seminar "Legal Protection of Intellectual Property Abroad. School of the exporter". Speakers at the Seminar were: Vladimir Shestakov, Head of St. Petersburg SBI export Centre "Center for Entrepreneurship

Development and Support", Anatoly Polikarpov, Director of the Directorate of Patenting and Intellectual Property Protection of PJSC "NPK United Wagon Company", Olga Koteneva, Patent Attorney in PJSC "Techpribor", Dmitry Yakovlev, Patent Attorney in Gorodissky & Partners, St. Petersburg. Victor Stankovsky, Partner, Regional Director, Russian & Eurasian Patent Attorney, Gorodissky & Partners, St. Petersburg.

#### **19 NOVEMBER 2019// MOSCOW**

Seminar "Intellectual property and issues in the field of commercialization of medical devices" Law firm Gorodissky & Partners in its Moscow office held the seminar "Intellectual property and issues in the field of commercialization of medical devices" for the Association of International Medical Device Manufacturers. Dmitry Rusakov, Brand Protection Group Leader, Anton Melnikov, LL.M., Senior Lawyer, Ilya Goryachev, Senior Lawyer (all from Gorodissky & Partners, Moscow) told the audience about the problems of grey import, ways to identify and combat illegal sales of medical devices on the Internet, the nuances of licensing and advertising of medical devices.



PHOTO: PRESENTATION OF VALERY MEDVEDEV AT THE SEMINAR "IP RIGHTS DISPOSAL: RESULTS OF 2019"

#### **20 NOVEMBER 2019// BRUSSEL**

IAPP Europe Data Protection Congress 2019

Stanislav Rumyantsev, Ph.D., CIPP/E, Senior Lawyer, Sergey Medvedev Ph.D., LL.M, Partner (both from Gorodissky & Partners, Moscow), took part in the IAPP Europe Data Protection Congress 2019, where Stanislav Rumyantsev made a presentation "Global GDPR Compliance Challenges: Case of Russia".

#### **25 NOVEMBER 2019// PERM**

Seminar "Intellectual property and Russian export"

Gorodissky & Partners Law Firm held the final seminar of a series of events dedicated to the 60th anniversary of the practice. In the framework of the seminar "Intellectual Property and Russian Export" held in Perm, lawyers and patent attorneys from the Moscow and Perm offices of the company spoke about the intricacies of registration and protection of trademarks and industrial designs, modern strategies for protecting inventions in Russia and abroad, legal aspects of advertising export services, on the mechanisms for exporting intellectual property rights, and on the role that is given to intellectual property rights in modern realities. The seminar was held with the support of the Center for Export Support of the Perm Region of the Fund "Regional Center of Engineering" and brought together more than 100 participants: mainly representatives of export-oriented enterprises of the Perm Region.

#### **27 NOVEMBER 2019// EKATERINBURG**

Franchising. Regions. Ural-2019

Valery Narezchny, Ph.D., Counsel (Gorodissky & Partners, Moscow), will make a presentation "Franchising: Tax and

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Antitrust Aspects” at the forum “Franchising. Regions. Ural-2019” organized by the Russian Franchising Association in Ekaterinburg.

## **28 NOVEMBER–29 NOVEMBER 2019// AMSTERDAM**

Intellectual Property Protection for Plant Innovation 2019  
Sergey Abubakirov, Partner, Russian and Eurasian Patent Attorney, Oleg Sorokin, Russian and Eurasian Patent Attorney, (both from Gorodissky&Partners, Moscow), took part in the Conference “Intellectual Property Protection for Plant Innovation 2019” organized by the Forum Institute in Amsterdam, Netherlands.

At the conference were discussed issues of digitalization of the system of international protection of new plant and animal varieties, violation of rights in the field of selection achievements, development of international legislation on selection achievements and others.

The conference gathered over 50 people.

## **29 NOVEMBER 2019// MOSCOW**

Seminar “How to avoid violation of third party IP rights in the course of exporting and advertising goods and services”

Ilya Goryachev, Senior Lawyer, (Gorodissky & Partners, Moscow), gave presentation at the Seminar “How to avoid violation of third party IP rights in the course of exporting and advertising goods and services”, held in the frames of training program “Legal protection of IP assets abroad” of the Moscow School of Exporters’ cycle of seminars.

## **5 DECEMBER 2019// MOSCOW**

Gorodissky & Partners is included in the first tier group of the Pravo.ru-300 rating on intellectual property  
Gorodissky & Partners took part in the awarding ceremony for the leaders of the law firms annual rating Pravo.ru-300. According to the results of the vote, the firm is included into the first tier group of the federal ranking on intellectual property in 2019.



## **12 DECEMBER 2019// MOSCOW**

LES Russia Seminar “IP Rights Disposal: results of 2019”

Sergey Medvedev, Ph.D., LL.M., Partner, Member of LES Russia (Gorodissky&Partners, Moscow), made a presentation “Pledge in IP” at LES Russia seminar “IP Rights Disposal: results of 2019” held by LES Russia in the Moscow office of Gorodissky & Partners.



**PHOTO: ATTENDEES OF THE TRAINING PROGRAM “INFORMATION INTELLIGENCE AS A CONDITION FOR THE SUCCESSFUL ENFORCEMENT AND PROTECTION OF IP ABROAD”**

## **18 OCTOBER–13 DECEMBER// MOSCOW**

Training program “Information intelligence as a condition for the successful enforcement and protection of IP abroad”

Leading specialists of Gorodissky & Partners held seven dedicated seminars: “Information intelligence as a condition for the successful enforcement and protection of IP abroad”, “Patenting inventions abroad: why, where and how”, “Legal protection of industrial designs abroad”, “Legal protection of trademarks for export goods and services”, “How to avoid violation of third party IP rights in the course of exporting and advertising goods and services”, “Export of intellectual property rights: the basic agreements, key terms & conditions”, and “Franchising legal basics”, all of which were organized in the frames of the training program “Legal protection of IP subject matters abroad” of joint seminars cycle of the Moscow School of Export and GORODISSKY IP SCHOOL. Participants learned about legal regulation of intellectual property issues in the export of goods and services.



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