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G-NEWS

INFORMATION BULLETIN
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Merry Christmas and Happy New Year!

BACK-UP YOUR BRAND: DEALING WITH NEW THREATS FOR TRADEMARKS IN RUSSIA

Following the current political situations and the sanctions imposed on Russia some Western companies decided to re-consider their trading and other business activities in Russia, and in some cases announced total termination, winding down or suspension of business in Russia starting from 2022.

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Taking advantage of the moment, some market players, acting in bad faith, are attempting to register famous brands or their imitations in their own name without consent of the real owners of those brands. In some cases bad faith applications are filed for mirror imitation such as

Application No. 2022746075, now refused

Application No. 2022723177, now withdrawn

Application No. 2022724293, now withdrawn

In others applications are filed for the creative imitation of the famous brands featuring high level of stylizations such as

Application No. 2022720003, now refused

Application No. 2022719552, now refused

Application No. 2022720127, now refused

Bad faith applications are normally filed without consent of the true owner and in most cases are rejected because of association with famous brands.
Totally over the last 2 years hundreds of applications have been filed by local persons to register different imitations of famous brands. The mere fact of filing an application does not guarantee that the mark will get registered.
The point is that the Russian PTO conducts examination on both absolute and relative grounds and, in particular, is supposed to refuse applications if these are filed for the marks which are confusingly similar to the prior third parties' marks existing on the Register in respect of similar goods. Therefore, in most cases obvious copycats of famous marks are rejected during examination based on similarity grounds as well as misleading as to the commercial origin of goods. In some cases bad faith applicants make up their mind to voluntarily withdraw their applications like it was with the case with McDonald's where the Russian company specializing on productions of canned vegetables initially filed an application to register "Uncle Vanya"

copycat and then decided to give up the application. In some cases the local business comes up with a better idea of re-branding in that it launches replacement brands that are fairly distinct from the original brands to eliminate confusion. For example, instead of McDonalds a new local brand which

could be translated as "Tasty and that's it" was born to replace the original one.
The existence of prior rights in confusingly similar signs should pose an obstacle to the acceptance and registration of third parties' bad faith applications featuring imitations of true owners' brands.
However, the prior right should be valid to be cited against a bad faith application and trademark squatters in some cases initiate non-use cancellation actions against cited trademarks in order to remove obstacles and get their own registration.
To retain validity a trademark must be used in Russia in accordance with the adopted use requirements.
In particular, in Russia a trademark registration becomes vulnerable to cancellation for non-use three years after the registration date.
It means that after expiration of this grace period any interested third party is entitled to file a cancellation action against trademark registration on the ground of non-use. It may be assumed that for those brands who left the Russian market in 2022 the three year period of continuous non-use expires very soon – in 2025.
The non-use cancellation action starts with a pre-trial letter in which the interested person suggests that the brand owner should either voluntary assign its brand to the plaintiff or renounce its trademark. If no reply is received within two months the interested person may initiate a non-use cancellation actions before the IP Court which shall institute legal proceedings if all formal requirements are met. At that the legal interest in pursuing the cancellation action has to be documentarily proved.
The burden of proof lies with the defendant (brand owner) in the cancellation proceedings. That means that the cancellation action can be based on mere presumption that the mark has not been used in Russia for the last three years and it is a trademark owner to prove otherwise in order to retain the registration in force and defeat the cancellation action.

According to the Russian use requirements a trademark is considered as having been used if it has been used by the brand owner itself, his recorded licensee, or any other person under the brand owner's control. In case the branded goods enter the Russian market using parallel (grey) import channels the brand owner may not be able to control how its brand is used in Russia and such use may be deemed improper as not being in compliance with use requirements.

In this regard it should be noted that the Russian Ministry of Industry and Trade issued Order No. 2701 in March 2022, legalizing the import

of certain goods into Russia without the owner's consent (also known as the "List of goods allowed for parallel import," or "the List") in an effort to prevent a shortage of goods made by foreign manufacturers in response to the termination of business by some foreign brands on the Russian market. The Ministry of Industry and Trade makes it clear that this process entails the import of authentic products via alternative supply routes rather than the authorization of counterfeit goods.

The list of brands that are eligible for parallel import includes dozens of different products, including cars and spare parts, electronics and household appliances, clothing and shoes, cosmetics, furniture, paper and cardboard, industrial equipment and materials, and may be changed depending on the decision of the brand owners to remain or resume trading in Russia. If the brand owner wishes his trademark or product to be excluded from the List, it is necessary to confirm that the brand owner has decided to remain on the Russian market, and suppliers of imported products will maintain their logistics and supply products to the Russian market.

Although the use of a trademark is obligatory the Russian law provides for some circumstances which may be treated as excusable reasons for non-use. These are circumstances which are beyond of control of a trademark owner such as force-majeure circumstances, personal health of a trademark owner and unpredicted political decisions. These circumstances may be used as a defense to defeat the cancellation action.

However, the Russian authorities are unlikely to accept an excuse for non-use if the trademark use was suspended because the owner voluntarily withdrew from the Russian market. The same applies to the sanctions imposed on Russia by some of the foreign states – the mere reference to such sanctions should not be deemed a good reason for non-use and may not be used as a defense in the non-use cancellation proceedings because there is no local law prohibiting the foreign trademark owner from using its trademark in Russia.

Therefore it would be strongly recommendable to ensure that the documents attesting to the use of the brand (s) in Russia by the brand owner himself, or any other person under its control for registered goods and services for the previous three years are accessible and prepared for examination by the relevant authority and any interested party in the event that the cancellation action is brought.

Non-usage of a trademark could put this trademark at serious risk of being attacked by squatters, who are now very active. They are attempting to revoke protection of globally recognized brands whose owners do not utilize them in Russia by filing cancellation actions for non-use so as to pave the way for their bad faith applications for identical or confusingly similar marks to proceed to acceptance without being provisionally refused based on similarity grounds.

To be on the safe side, in the event when the current registration is not properly used in Russia and could be removed from the Register for non-use, and to stop a potential third party's application for a similar mark from being accepted on the grounds of similarity, it makes sense to consider filing new back-up application (s) if the business has in fact ceased trading activities on the Russian market. However, it should be kept in mind that the so-called "double" registration is prohibited in Russia, therefore it will be prudent and worthwhile in the circumstances to consider re-filing for a trademark that would be slightly different from the registered trademark or for the same mark covering an amended list of goods/services to avoid the duplication issue.
It should be noted that there is no obstacles for foreign companies to continue filing applications for any registrable IP subject-matters, including patents, trademarks, designs and other since Russia is a member-state to many International Treaties in the IP sphere and equally protects the IP rights of domestic and foreign companies. The present article gives just a general idea as to how the IP related issues in connection with the current political situation in the world could be resolved to better safeguard the brand owners' interests in Russia. However, each particular case requires specific legal approach and brand protection strategy development should take into consideration the best practices and IP solutions.

OVERVIEW OF NEWS IN THE FIELD OF INTELLECTUAL PROPERTY (RUSSIA, CIS)

(March to August 2024)

LAWS AND DRAFT LAWS

Amendments were made to Article 180 of the Criminal Code of the Russian Federation on liability for the illegal use of means of individualization (Federal Law of 06.04.2024 № 79-FZ)

A law was adopted aimed at further humanization of criminal legislation and liberalization of criminal liability for crimes of an economic nature in order to exclude excessive criminal law impact on entrepreneurs — Federal Law of 06.04.2024 № 79-FZ) "On Amendments to the Criminal Code of the Russian Federation and the Criminal Procedure Code of the Russian Federation" (Article 180 of the Criminal Code of the Russian Federation).

In particular, amendments were made to Article 180 of the Criminal Code of the Russian Federation on liability for the illegal use of means of individualization:

- the amount of damage that serves as the basis for criminal liability was increased from 250 thousand rubles to 400 thousand rubles;
- the multiplicity of the violation remains a separate independent ground for criminal liability;
- Part two of Article 180, which **provided for criminal liability for the illegal use of warning labeling in relation to unregistered trademark or appellation of origin, was excluded!**
- a lower threshold for the fine was established, calculated as the amount of the convicted person's income ("in the amount of wages or other income for a period of **one** to two years").

The law entered into force on April 17, 2024.

The threshold for large and especially large scale illegal act, for which liability is provided under Article 146 of the Criminal Code of the Russian Federation, has been increased (Federal Law of 12.06.2024 № 133-FZ)

The threshold for a large or especially large illegal act, for which liability is provided under Article 146 of the Criminal Code of the Russian Federation, has been increased to the cost of counterfeit copies of works or rights to use in the amount of 500 thousand rubles (large amount) and up to 2 million rubles (especially large amount).

Federal Law of 12.06.2024 № 133-FZ "On Amendments to the Criminal Code of the Russian Federation" entered into force on June 26, 2024.

"Mirrors" of pirate sites will be blocked faster (Federal Law of 22.06.2024 № 158-FZ)

Federal Law of 22.06.2024 № 158-FZ "On Amendments to the Federal Law "On Information, Information Technologies and the Protection of Information" and Articles 11 and 15 of the Federal Law "On the Activities of Foreign Persons in the Information and Telecommunications Network "Internet" in the Territory of the Russian Federation" (in part specifying the procedure for restricting access to information distributed in violation of copyright and related rights; Article 156-1 of the Law on Information).
From October 1, 2024, the powers to make a decision on recognizing a site as a copy of a site blocked for violations of copyright or related rights have been transferred from the Ministry of Digital Development to Roskomnadzor. Corresponding amendments were made to Article 156-1 of the law "On Information, Information Technologies and the Protection of Information".
The amendment will make it faster to restrict access to "mirrors". Now, the Ministry of Digital Development makes a decision on recognizing a site as a copy of a prohibited site, then the information is transferred to Roskomnadzor, and only after that the latter sends the telecom operator a requirement to restrict access to the site.
In addition, the amendments allow the obligation to stop issuing information about the "mirror" site in the search results to be extended to all search engine operators, and not only to those that distribute advertising aimed at Russian consumers.
The new order entered into force on October 1, 2024.

The procedure for using objects of rights, the authors or other right holders of which are unknown (so-called "orphan" works) and the examination of trademarks with religious symbols has been regulated (Federal Law of 22.07.2024 № 190-FZ)

Amendments were made to Part IV of the Civil Code, which establish the procedure for using so-called "orphan" works, that is, works whose protection period has presumably not yet expired, but permission to use them cannot be obtained, since their author or other right holder is unknown.
A person wishing to use such a work must take the measures specified in the law to find the right holder. Then you need to contact an accredited collective rights management organization (CRMO), which will post information about the search for the author (right holder) on its website. If the author (right holder) is not identified within 90 working days, the CRMO may issue a non-exclusive paid license for the work to the interested party.
Until the right holder is found, remuneration for the use of the "orphan" work will be credited to a nominal account opened in a Russian bank, the owner of which is the CRMO.
In addition to regulating legal relations in relation to "orphan" works, Law № 190-FZ also contains a new provision on trademark protection.
Namely, paragraph 1 of Article 1499 of the Civil Code of the Russian Federation has been supplemented with the following paragraph:
"The specifics of the examination of the applied designation with religious symbolism (semantics) are established by the federal executive body carrying out normative legal regulation in the field of intellectual property."
Currently, a draft of the corresponding order of the Ministry of Economic Development is being prepared for adoption (posted on the portal of draft regulatory legal acts, ID: 149408). It provides that when examining such applications, Rospatent will request the opinion of the Interreligious Council of Russia on the possibility or impossibility of registering the applied designation with religious symbolism (semantics) as a trademark. The conclusion of the Interreligious Council will be taken into account when considering the application.
The law entered into force on October 21, 2024.

The powers of the police to suppress administrative offenses related to the circulation of counterfeit goods are being limited (Federal Law of 22.07.2024 № 192-FZ)

The Code of Administrative Offenses (CAO) has been amended to eliminate the duplication of powers of the police and supervisory authorities in proceedings on administrative offenses. **The police will not deal with administrative offenses, the consideration of which is within the competence of supervisory authorities.**
Thus, according to the law, from paragraph 1 of part 2 of Article 28.3 of the CAO, which defines the powers of officials of internal affairs bodies to draw up a protocol on offenses, the mention of Article 14.10 of the CAO, establishing liability for the illegal use of means of individualization of goods, works or services, has been excluded.
At the same time, the powers of customs authorities and consumer protection supervisory authorities (Rospotrebnadzor) to initiate cases and draw up a protocol on an administrative offense provided for in Article 14.10 of the CAO are preserved.
The law entered into force on October 21, 2024.

State duty rates have been increased (Federal Law of 08.08.2024 № 259-FZ)

The rates of duties on cases considered by the Supreme Court of the Russian Federation, courts of general jurisdiction, justices of the peace, and arbitration courts have been increased. As stated in the explanatory note to the relevant draft law, the amount of duties has been increased in order to reduce the workload on the judicial system and to suppress abuses by unscrupulous participants in disputes.
For lawsuits to an arbitration court up to 100 thousand rubles, the amount of duty will increase 2.5–5 times, and for large lawsuits, the duty is set depending on the claim amount. For example, with a claim amount of 1 million rubles, the duty will be 55 thousand rubles (before the change — 23 thousand rubles); with a claim amount of 5 million rubles, the duty will be 175 thousand rubles (before the change — 48 thousand rubles).
To challenge a decision of Rospatent in the IP Court now costs 10 thousand rubles for an individual and 50 thousand rubles for a legal entity (previously 300 and 3000 rubles, respectively). To file an appeal to an arbitration court costs — 10,000 rubles for individuals and 30,000 rubles for legal entities; an appeal — 20,000 rubles and 50,000 rubles, respectively; and to complain to the Supreme Court — 30,000 rubles and 80,000 rubles.
New state duty rates came into effect on September 9, 2024.

The Supreme Court provided explanations on the procedure for considering a person's claim for reimbursement of expenses incurred in resolving a dispute in Rospatent in accordance with the first paragraph of paragraph 2 of Article 1248 of the Civil Code of the Russian Federation ("Review of Judicial Practice of the Supreme Court of the Russian Federation № 1 (2024)", (approved by the Presidium of the Supreme Court of the Russian Federation on 29.05.2024)

Based on the second paragraph of paragraph 2 of Article 1248 of the Civil Code of the Russian Federation, the expenses for the dispute considered in an administrative procedure in Rospatent incurred by the party in whose favor Rospatent made the decision, are to be reimbursed by the other party to the dispute. This rule also defines the composition of such expenses.
If Rospatent refuses to satisfy the objection to the patent, trademark, appellation of origin or GI, the decision is considered to be made in favor of the right holder. In this case, his expenses are to be reimbursed.
If there is a dispute concerning the reimbursement of such expenses, including their composition and amount, the party's claim for reimbursement of the relevant expenses is subject to consideration by the arbitration court in compliance with the general rules of territorial jurisdiction in the order of claim proceedings, based on the principles of necessity, reasonableness and proportionality.
Judicial acts of arbitration courts of the constituent entities of the Russian Federation, arbitration courts of appeal in the case of reimbursement of expenses are appealed in cassation proceedings to the Intellectual Property Court (hereinafter referred to as the IP Court).
The party making a claim for reimbursement of expenses must prove the fact of their incurring, as well as the link between the incurred expenses and the dispute considered by Rospatent with its participation.
If Rospatent partially satisfies the objection, then the court issues a decision on the reimbursement of expenses in proportion to the amount of satisfied claims. At the same time, the court takes into account the extent to which the formula of the contested patent is preserved in the new patent (how many points of the formula of the patent proposed by the applicant are preserved) and in relation to what number of goods (services) the legal protection of the trademark is preserved.
The party to the dispute who disagrees with the decision of Rospatent made on the objection may challenge this decision in the IP Court. If, when considering the application for reimbursement of expenses, the court becomes aware of the challenge of the corresponding decision of Rospatent, proceedings on the case of reimbursement of expenses shall be suspended until the entry into force of the judicial act of the IP Court on the legality of the challenged decision.
If the IP Court recognizes the decision of Rospatent and makes a legal decision, the dispute is considered resolved in favor of the party that challenged this decision in court. Consequently, based on the universality of the legislator's will and the principle of equality, the expenses that this party incurred in connection with the consideration of the dispute with its participation in Rospatent are subject to reimbursement, taking into account the second paragraph of paragraph 2 of Article 1248 of the Civil Code of the Russian Federation and the rules set out above.
A court decision on reimbursement of expenses that has entered into legal force, made before the Intellectual Property Court recognizes the decision of Rospatent as illegal, may be reviewed in accordance with the rules for considering an application for review of a judicial act based on new or newly discovered circumstances.

The President of the Russian Federation established the procedure for acquiring exclusive rights from persons from unfriendly countries (Presidential Decree of the Russian Federation of 20.05.2024 № 430)

Starting from May 20, 2024, in order to acquire exclusive rights to certain objects of intellectual property from persons in unfriendly countries under an alienation agreement, it is necessary to obtain permission from the Government Commission for Control over Foreign Investment. It has the right to issue a document at the request of the acquirer (for example, a resident), the right holder, or their representatives.
The procedure for issuing permission is established by the Rules approved by Government Decree of 06.02.2024 № 295 (as amended on 20.07.2024).
The provisions of the Decree do not apply:
- to transactions to acquire rights to works of science, literature and art, to results of performing activities (performances), to phonograms, to broadcast communications of organizations of broadcasting or cable broadcasting;
- to transactions where the amount of the acquirer's obligations does not exceed 15 million rubles or the equivalent amount in foreign currency.

In addition, the Decree regulates the procedure for fulfilling monetary obligations under such transactions by transferring funds to a special ruble account of type "O", including obligations under transactions that were concluded before the Decree came into force, but monetary obligations under which were not fully or partially fulfilled.

GOVERNMENT ACTS AND DEPARTMENTAL ACTS

The procedure for making decisions on the use of inventions, utility models and industrial designs in the interests of the state and citizens has been clarified (Government Decree of the Russian Federation of 27.03.2024 № 380)

Pursuant to Presidential Decree of the Russian Federation of 15.02.2024 № 122, the Government adopted a resolution "On the Subcommission on Issues of Using Inventions, Utility Models and Industrial Designs to Ensure the Economic Security of the Russian Federation under the Government Commission on Economic Development and Integration", which approved the Regulations on the Subcommission and the Rules for Preparing Subcommission Decisions on the Use of Inventions, Utility Models and Industrial Designs without the consent of patent holders, with notification thereof to them as soon as possible and with the payment of proportionate compensation to them.

The tasks of the subcommission are to consider applications for the use of inventions, utility models, industrial designs without the consent of patent holders, with notification thereof to them as soon as possible and with the payment of proportionate compensation to them. Applications may be submitted by Russian legal entities in whose authorized (share) capital the share of direct or indirect (through third parties) participation of the Russian Federation, constituent entities of the Russian Federation, municipalities and (or) citizens of the Russian Federation exceeds 75 percent, as well as the preparation of decisions on the use of the results of intellectual activity.

To prepare decisions, the subcommission, among other things, considers the conclusions of federal executive bodies submitted by the authorized body, considers draft decisions made by the Government of the Russian Federation in case of extreme necessity related to ensuring the defense and security of the state, protecting the life and health of citizens, in accordance with Article 1360 of the Civil Code, submitted by the authorized body, provides recommendations to legal entities, if necessary, including on the forms of documents submitted to the subcommission.

The resolution also amended the Methodology for determining the amount of compensation paid to the patent holder when making a decision on the use of his inventions, utility models and industrial designs without his consent. In particular, the provision on zero compensation paid to a patent holder from an unfriendly country has been canceled. However, the Methodology has been supplemented with a provision according to which, in the case of a patent holder from an unfriendly country, compensation is paid to him to a special ruble account of type "O".

Amendments have been made to the list of goods allowed for parallel import (Order of the Ministry of Industry and Trade of Russia dated 05.07.2024 № 3028)

By order of the Ministry of Industry and Trade, amendments were made to the list of goods (groups of goods) in relation to which the provisions of Articles 1252, 1254, paragraph 5 of Article 1286.1, Articles 1301, 1311, 1406.1, subparagraph 1 of Article 1446, Articles 1472, 1515 and 1537 of the Civil Code do not apply if these goods are original and are placed on the market outside of the Russian Federation by right holders or with their consent.

Many groups of goods have been supplemented with the trademarks HYUNDAI, KIA and VALEO. Parallel import of HARLEY-DAVIDSON brand motorcycles is also allowed.

The date of entry into force of the amendments is 11.09.2024, with the exception of those amendments that will enter into force on 10.03.2025.

Amendments have been made to the Requirements for applications and the Rules for their consideration in order to consider applications for inventions and utility models in the field of information technology (Order of the Ministry of Economic Development of Russia dated 15.03.2024 № 148)

By order of the Ministry of Economic Development, amendments were made to the regulatory legal acts regulating the preparation and consideration of applications for the issuance of a patent for an invention and a utility model.

In particular, the Requirements for documents of the application for the issuance of a patent for an invention and the Requirements for documents of the application for the issuance of a patent for a utility model, as well as the Rules for preparing, filing and considering an application for an invention and the Rules for filing, preparing and considering an application for a utility model have been supplemented with provisions relating to inventions and utility models in the field of information technology (IT).

Inventions (utility models) in the field of IT are understood to mean technical solutions that are characterized by the use of programmable multifunctional means, in particular computer devices, information and telecommunication networks, at least one of the features of which is implemented using software, as well as technical solutions relating to machine-readable information carriers containing a computer program or data, the form or content of which is intended for the operation of programmable multifunctional means. Special regulation has also been introduced in relation to technical solutions based on artificial intelligence.

In relation to such inventions (utility models), signs by which they can be characterized are specially formulated, it is indicated in which cases the result obtained from such solutions is recognized as technical.

Rospatent will not publish information about a number of persons in the official bulletin at their request (Government Decree of the Russian Federation of 02.09.2024 № 1209)

From September 30, 2024, applicants, right holders and parties to agreements on the disposal of exclusive rights to certain objects of intellectual property can submit an application to Rospatent requesting that information about them not be published in the official bulletin of Rospatent.

The application can be submitted in relation to inventions, utility models, industrial designs, trademarks, computer programs, databases and topologies of integrated circuits. At the same time, this information will still be reflected in the corresponding registers kept by Rospatent.

The new procedure will be in effect until December 31, 2025.

DISPUTES ON THE GRANTING AND TERMINATION OF PROTECTION

Rospatent is not entitled to change the reasons for the objection on the basis of clause 45 of the Rules for considering disputes in Rospatent (decision of the Presidium of the IP Court of 16.08.2024 in case № SIP-1302/2023)

The Intellectual Property Court considered and granted the application of LLC "ROMANGRUP" to declare invalid

clause 45 of the Rules for considering and resolving disputes in an administrative procedure by the federal executive body for intellectual property, approved by the orders of the Ministry of Education and Science and the Ministry of Economic Development of Russia dated 30.04.2020 № 644/261, in part concerning the possibility of identifying and taking into account by members of the board the grounds for declaring invalid the granting of legal protection to an already protected object at the stage of considering an objection against granting legal protection to such an object.
The Presidium of the IP Court established that this rule does not comply with the provisions of Articles 1398, 1512, 1513, 1535 of the Civil Code of the Russian Federation, which have greater legal force, since challenging the validity of a patent or trademark registration is only possible by filing corresponding objections by third parties.
The Civil Code of the Russian Federation does not provide Rospatent with any other opportunity, outside the framework of the submitted objection, to verify the patentability of a registered trademark or invention. Rospatent is not entitled to independently formulate and consider grounds for declaring a patent or trademark registration invalid. Therefore, Rospatent is not entitled to identify and evaluate any new grounds not disclosed in the objection.
The IP Court declared clause 45 of the Rules invalid in the relevant part.

An earlier application for an invention by another applicant is not included in the prior art when analyzing the novelty of the invention according to a later application if the applications have the same inventors and the later application is filed within the validity period of the 6-month novelty grace period (decision of the IP Court of July 5, 2024 in case № SIP-1078/2023)

In application for invention № 2022124555, Rospatent, citing clause 2 of Article 1350 of the Civil Code of the Russian Federation, included application № 2022104157 of another applicant, which had an earlier priority date, in the prior art, and the patent was refused for the later application.
The applicant appealed the refusal to the Intellectual Property Court (case № SIP-1078/2023), citing Rospatent's incorrect application of substantive law. The applicant insisted that since the composition of the inventors in the application under consideration and in the application opposed to it coincide, then the information about the invention disclosed in the earlier application was received from the authors of the invention under consideration. The applicant indicated that the date of disclosure of information in relation to the application opposed to it should be considered the date of publication of the patent issued for it (the application itself was not published). And since the later application was filed within the 6-month "author's grace period", disclosure of the invention in such an earlier application should not affect the patentability of the claimed invention.
The Intellectual Property Court agreed with the applicant and pointed out the following.
Based on the provisions of clause 3 of Article 1350 of the Civil Code of the Russian Federation, the publication of the description of the invention to the patent issued for the application, in which the composition of the applicants and (or) inventors at least partially coincides with the composition of the applicants and (or) inventors of the claimed invention, is not a circumstance that prevents the recognition of patentability of the claimed invention, provided that the application for the issuance of a patent for this invention is filed with Rospatent within six months from the date of publication of the description of the invention to the patent.
Rospatent's position that the applicant in the application opposed to it is a different person does not negate the fact that the inventors of the inventions in the application opposed to it and the disputed application are the same persons.
The court overturned the decision of Rospatent to refuse to grant a patent citing an earlier application and ordered Rospatent to continue consideration of application № 2022124555.

Due to the incorrect indication of the patent holder, the patent can be challenged by any person who has become aware of such a violation (decision of the IP Court of March 7, 2024 in case № SIP-793/2023)

Russian patent № 175176 for a utility model "Windshield Wiper Drive" was issued on application № 2017115093, filed on 04.27.2017, indicating A.A. Ageev as the author and LLC "Zavod "AVTOPRIBOR" as the patent holder.
A lawsuit was filed with the IP Court to declare patent № 175176 invalid due to the incorrect indication of the patent holder.
The plaintiff provided evidence that the disputed utility model was created by A.A. Ageev in 2013 as part of his job duties during his employment at OJSC "Zavod "Avtopribor" (hereinafter referred to as the Factory; declared bankrupt and liquidated in 2021) and was used by the Factory in 2014 in the production of windshield wiper drives. In particular, from the records in Ageev's work book, it follows that he worked as an engineer at OJSC "Zavod "Avtopribor" from 2002 to 2015, and then moved to work for the Defendant.
Defendant 2 — author A.A. Ageev — confirmed the creation of the corresponding technical solution during his work at the Factory and expressed the opinion that the Defendant could not be the patent holder of the disputed utility model. Ageev also indicated that he did not have special knowledge in the field of intellectual property at the time of obtaining the disputed patent, and therefore could not assess the Defendant's actions.
The court concluded that the evidence available in the materials of the case in their totality and mutual connection, the explanations of A.A. Ageev himself, not refuted by the Defendant, confirm that the disputed technical solution, patented as a utility model under Russian patent № 175176, was created by A.A. Ageev in the period from 2013 to 2014, that is, before his transfer to work for the Defendant.
No evidence was presented of the existence of any grounds provided for by law for the emergence or transfer to the Defendant of the right to obtain a patent for the disputed utility model, and the Defendant did not make such arguments.
The court concluded that there are no legal grounds for indicating the Defendant as the patent holder in the disputed patent.
The Defendant's reference to the Plaintiff's lack of interest in challenging the disputed patent cannot be taken into

account. The legislation explicitly provides for the right of any person who has become aware of violations to demand that a patent for a utility model be declared invalid, including on grounds related to the incorrect indication of the author and patent holder of the utility model. Such a person is not required to confirm that he has a private interest in having the patent declared invalid. In the absence of his own claims to authorship and/or patent ownership, such a person may demand that such a patent be declared invalid in its entirety, which follows from subparagraph 5 of paragraph 1 of Article 1398 of the Civil Code of the Russian Federation.
The court granted the plaintiff's claims and declared patent № 175176 for a utility model invalid in its entirety.

Abusive expressions cannot be registered as a trademark (decision of Rospatent (PPS) of 12.03.2024 on application № 2022737232)

Application № 2022737232

Rospatent has made a decision to refuse state registration as a trademark of the designation under application № 2022737232 in relation to all claimed goods and services in classes 03, 09, 25, 37 of the International Classification of Goods and Services.
Registration was refused on the basis of subparagraph 2 of paragraph 3 of Article 1483 of the Code, which does not allow state registration as trademarks of designations that constitute or contain elements that contradict public interests, the principles of humanity and morality.
Having considered the applicant's objection to the decision to refuse registration, the board of the patent dispute chamber agreed with the examination, noting that the main elements in the claimed designation that attract the attention of consumers are the verbal elements "YADRENA WASH", which are perceived as transliteration in Latin letters of the phrase "yadrena vosh", which, according to the phraseological dictionary of the Russian literary language, is an abusive expression of reprimanding someone, dissatisfaction with someone/something. In this regard, the verbal elements "YADRENA WASH" are perceived as negative and indecent.
Regarding the applicant's opinion that the word "WASH" in English means "washing, to wash, to rinse, to wash off", and, therefore, the designation "YADRENA WASH" will be associated with the consumer with washing something, the board noted that despite the fact that the word "WASH" is a lexical unit of the English language, having the given meanings, **in combination with the element "YADRENA" the verbal elements of the claimed designation will be perceived in the minds of consumers as the vulgar expression "yadrena vosh".**
The board of the patent dispute chamber considered that the claimed designation has features that contradict public interests, the principles of morality, in connection with which its registration as a trademark will contradict the requirements of subparagraph 2 of paragraph 3 of Article 1483 of the Civil Code of the Russian Federation.

Referring an objection for reconsideration after signing and sending the decision is illegal (decision of the IP Court of August 5, 2024 in case № SIP-285/2024)

Application № 2022744531

The company applied for registration of the designation under application № 2022744531 in relation to a wide range of goods in classes 25, 29, 30, 32 and services in classes 35, 43 of the International Classification of Goods and Services.
On 08.05.2023, Rospatent made a decision to refuse state registration of the designation under application № 2022744531 as a trademark due to non-compliance with the requirements of paragraph 6 of Article 1483 of the Civil Code of the Russian Federation.
On 18.09.2023, the company filed an objection to the said decision, upon consideration of which Rospatent found the arguments set forth in it convincing and on 28.12.2023 made a decision to grant the objection, revoked the decision of 08.05.2023 and registered the claimed designation as a trademark. This decision was sent to the company along with a cover letter.
Later, Rospatent informed the company that, on the basis of the resolution of the head of Rospatent, the company's objection was referred for reconsideration.
Considering such actions of Rospatent illegal, the company appealed to the Intellectual Property Court with a statement to declare the actions of Rospatent illegal.
In court, Rospatent explained its actions by a technical failure of the automated system, as a result of which the decision of Rospatent was mistakenly signed with an electronic digital signature and automatically sent to the applicant by e-mail. Upon detection of this error, the applicant was notified of the reconsideration of the objection on the basis of the resolution of the head of Rospatent in accordance with clause 53 of the Rules.
The court found that the resolution of the deputy head of Rospatent on the need for Rospatent to reconsider is dated 01.26.2024, i.e. after the decision of 12.28.2023 was made.
The court noted that the current legislation does not empower Rospatent with the authority to declare a decision made by it as a result of considering an objection invalid, as well as to appoint a reconsideration of the objection, the decision on which has already entered into force.
The court rejected Rospatent's argument that the draft decision of 12.28.2023 was signed with an electronic digital signature and automatically sent to the applicant by e-mail as a result of a technical failure of the automated system that occurred. Evidence that there was a technical malfunction in Rospatent's automated system, which led to the signing of the draft decision of 12.28.2023 with an electronic digital signature, was not presented to the case file.
Taking into account the foregoing, the court found the referral of the objection of 18.09.2023 for reconsideration to be illegal.

Cascade filing of divided applications is legal (Resolution of the Supreme Court of the Russian Federation of 17.06.2024 in case № SIP-570/2022 and Resolution of the Supreme Court of the Russian Federation of 17.06.2024 in case № SIP-552/2022)

In June, the Supreme Court of the Russian Federation made decisions on two cases (SIP-552/2022 and SIP-570/2022) on challenging the validity of patents for inventions granted as a result of the sequential (cascade) division of applications for inventions from the originally filed application.

In these cases, Rospatent retained the priority of the very first application for the subsequent divided application, despite the fact that by the time this divided application was filed, a patent had already been issued for the original application, but the examination for the previous divided application was still in progress.
The fact is that if this were not allowed, and if only the very first application remained the original for all divided applications, then after the completion of its consideration (issuance of a patent, recognition as withdrawn or exhaustion of the possibility of challenging the refusal), subsequent divided applications would no longer inherit the priority of the original application, and the issuance of a patent for most subsequent divided applications would become impossible. After all, the priority for the divided application then would have to be established based on the date of its actual filing with Rospatent, and the inventions claimed in them would not meet the requirement of "novelty" — they would be opposed by information from the very first application, which would already be published by the time most divided applications were filed. It was on this interpretation of the concept of "original application" that the person who filed the objection to the patents issued for subsequent divided applications insisted.
Nevertheless, Rospatent retained the priority of the very first application for the subsequent divided application, despite the fact that by the time this divided application was filed, a patent had already been issued for the original application, but the examination for the previous divided application was still in progress.
The dispute in these cases arose precisely on the issue of whether cascade division of applications should be allowed, or whether all divided applications, in order to retain the priority of the original (parent, original) application, should be filed while the parent application is still under consideration.
When considering the dispute in the Intellectual Property Court, the court first agreed with Rospatent's position on the admissibility of cascade division. However, the Presidium of the IP Court took a different position and declared cascade division with priority retention illegal. According to the Presidium, only the very first application is the original for the purposes of filing divided applications in accordance with clause 4 of Article 1381 of the Civil Code of the Russian Federation. Neither Rospatent nor the patent holder agreed with this and appealed to the Supreme Court with an appeal.
In its June Resolutions, the Supreme Court overturned the resolution of the Presidium of the IP Court and upheld the resolution of the first instance IP Court, thereby confirming the correctness of Rospatent. Each divided application may act as the original application for filing a subsequent divided application. At the same time, all divided applications inherit the filing date and priority date of the very first (parent) application.

A Russian vodka producer has been denied the right to use the appellation of origin "Russkaya Vodka" (Resolution of the Presidium of the IP Court of May 30, 2024 in case № SIP-589/2023)

Russian LLC "J.J. Whitley Distillery" (hereinafter referred to as the Company) applied to Rospatent with application № 2021762195 for the grant of exclusive rights to the previously registered name of origin of goods "RUSSKAYA VODKA" for the goods "vodka". The application materials include conclusions from the authorized body, according to which the vodka produced by the applicant, J.J. WHITLEY ARTISANAL VODKA and J.J. WHITLEY ARTISINAL, meets the special properties indicated in the State Register of Geographical Indications and Names of Origin of Goods of the Russian Federation (hereinafter referred to as the State Register), for the goods "vodka", for which the appellation of origin under № 65 is registered.
Subsequently, the same authorized body sent an appeal to Rospatent, in which it pointed to the possible negative consequences of granting exclusive rights to the appellation of origin "RUSSKAYA VODKA" to a company affiliated with a British alcoholic beverage producer, as well as insurmountable obstacles that will arise for Russian producers when registering the named designation in the UK.

Trademark № 808565

JJ WHITLEY

Trademark № 800380

In addition, attention was drawn to the possibility of misleading consumers when simultaneously using the appellation of origin "Russkaya Vodka" and trademarks № 808565 and № 800380 , containing the designation "J.J. Whitley", identical to the company name of the British company.
Rospatent refused to grant the Company exclusive rights to the previously registered name of origin of goods "RUSSKAYA VODKA" due to its ability to mislead the consumer regarding the goods or its manufacturer (subparagraph 5 of paragraph 2 of Article 1525 of the Civil Code of the Russian Federation).
Disagreeing with the decision of Rospatent, the company appealed to the Intellectual Property Court with a statement to declare the refusal invalid.
The court of first instance agreed with the conclusion of Rospatent, and the Company filed an appeal with the Presidium of the IP Court. The Presidium of the IP Court came to the following conclusions.
According to the law, any person who, within the boundaries of the same geographical object, produces goods that have the special properties indicated in the State Register, has the right to apply for the grant of exclusive rights to the previously registered appellation of origin.
The basis for granting exclusive rights to a previously registered appellation of origin is the confirmation by the person of the production of goods within a certain geographical object and possessing special properties.
Thus, taking into account the goals of granting exclusive rights to an already registered appellation of origin, the basis for such granting is primarily the production by the applicant of a certain product with special properties related exclusively to the natural conditions and (or) human factors characteristic of the corresponding geo-

graphical object, and meeting the requirements of the provisions of paragraph 1 of Article 1516 of the Civil Code of the Russian Federation.

Verification for compliance of the designation with the requirements of paragraph 2 of Article 1516 of the Civil Code of the Russian Federation is carried out when filing an application for the initial registration of the name of origin of goods as a designation in relation to goods that have special properties. Paragraph 19 of the Rules, which defines the procedure for conducting an examination of the claimed designation, including for a previously registered name of origin of goods, and, in fact, does not establish differences between the procedures for the initial examination of the designation itself and the examination of the grant of rights to an already protected designation, cannot contradict the provisions of civil legislation, which have greater legal force.

According to Article 12 of the Civil Code of the Russian Federation, when considering disputes related to the protection of civil rights, the court does not apply a normative act that contradicts the law, regardless of whether this act is recognized as invalid (fourth paragraph of paragraph 9 of the resolution of the Plenum of the Supreme Court of the Russian Federation of 23.06.2015 № 25).

Based on the foregoing, the Presidium of the IP Court considered the interpretation by the court of first instance of the provisions of subparagraph 5 of paragraph 2 of Article 1516 of the Civil Code of the Russian Federation and the conclusions made by it on the possibility of misleading consumers by granting the company the right to a previously registered name of origin of goods on the basis of the specified norms to be unreasonable.

At the same time, the Presidium of the IP Court came to the conclusion that the erroneous interpretation of the norms of substantive law in this case did not lead to the adoption of an incorrect decision.

According to paragraph 1 of Article 10 of the Civil Code of the Russian Federation, the exercise of civil rights solely with the intention of causing harm to another person, actions in circumvention of the law for an unlawful purpose, as well as other knowingly unfair exercise of civil rights (abuse of right) are not allowed.

The factual circumstances established by the court of first instance do not indicate that the use of the appellation of origin "RUSSKAYA VODKA" together with trademarks is capable of misleading consumers, but that the actions of the Company related to acquiring exclusive rights to a previously registered appellation of origin are unfair and capable of leading to a ban on other Russian producers from using such a designation in the territory of other states and, as the court of first instance correctly pointed out, discrediting the goods and devaluing this name of origin of goods in foreign markets.

Thus, the Presidium of the IP Court noted, the court of first instance established the factual circumstances, but applied the wrong rule of law to them. Nevertheless, the Presidium of the IP Court left the decision of the court of first instance unchanged.

The company filed a cassation appeal to the Supreme Court of the Russian Federation, but its request to review the decision of the IP Court was denied (Resolution of the Supreme Court of the Russian Federation of 30.08.2024 № 300-ES24-16003).

DISPUTES ON VIOLATION OF EXCLUSIVE RIGHTS

Dispute over the violation of 25 trademarks belonging to three companies (Chanel, Christian Dior, World Brand Marks) by one defendant. The IP Court ordered the court of first instance to reconsider the amount of compensation

Chanel SARL (Geneva, Switzerland), Parfums Christian Dior (Paris, France) and World Branding Mark S.A. (Geneva, Switzerland) filed a lawsuit against an individual entrepreneur (IE) for compensation in the amount of 650,000 rubles for violating their exclusive rights to trademarks.

The IE sold counterfeit goods marked with the plaintiffs' trademarks. 10 of the marks used on the counterfeit goods belong to Chanel SARL, 13 marks belong to Parfums Christian Dior and 2 marks belong to World Branding Marks S.A. The plaintiffs asked to recover 50 thousand rubles for each infringed mark of Chanel SARL and 10 thousand rubles for each infringed mark of Christian Dior and World Branding Mark S.A.

The court of first instance established the fact of infringement, but recovered from the IE in favor of each of the plaintiffs 10 thousand rubles; a total of 30 thousand rubles. At the same time, the court of first instance, guided by paragraph 33 of the Review of Judicial Practice in Cases Related to the Resolution of Disputes on the Protection of Intellectual Property, approved by the Presidium of the Supreme Court of the Russian Federation on September 23, 2015, and paragraph 68 of the resolution of the Plenum of the Supreme Court of the Russian Federation of April 23, 2019 № 10, considered that the trademarks of each of the plaintiffs form a series of related marks, united by common elements — the trade name of the right holders, and, therefore, the violation of rights to several such trademarks constitutes a single violation.

The plaintiffs appealed this decision first to the court of appeal, and then to the Intellectual Property Court, which did not agree with the approach described by the lower courts.

The IP Court noted that a series of trademarks means three or more trademarks belonging to one right holder, based on one element (verbal, figurative or combined). To conclude that the element forms a series of trademarks belonging to one manufacturer, it is necessary that such a dominant element be repeated in all trademarks. Taking into account the distribution of the burden of proof in this category of cases, it is the defendant who must prove that the trademarks in respect of which the claim is filed actually establish the protection of the same designation in different variations, have differences that do not change the essence of the trademark, and regardless of the variation of the reproduction of the designation, in the eyes of consumers, are perceived as one designation, which retains its recognizability.

The court drew attention to the fact that the protected trademarks are trademarks of different types: verbal, figurative, volumetric, combined. The conclusion of the lower courts about the connection of the trademarks of each right holder by one dominant element — the name of this right

holder is not motivated, and, therefore, the final conclusion about the number of violations committed by the defendant is also incorrect, and, as a consequence, the amount of compensation.
The IP Court overturned the decisions of the lower courts and remanded the case for reconsideration to the court of first instance.

An affidavit in itself does not prove the fact of ownership of exclusive rights to the disputed work (Resolution of the Supreme Court of the Russian Federation of 15.08.2024 № 302-ЭС24-3009 in case № А33-19084/2022)

Carte Blanche Greetings Limited (UK) filed a lawsuit against three individual entrepreneurs and an organization for compensation for violating exclusive copyright to 2 images of a character from the Blue Nose Friends Characters series in the total amount of 2,880,000 rubles.
The court of first instance and the court of appeal established the fact of copyright infringement, but recovered from the defendants compensation in the total amount of 360,000 rubles. The Intellectual Property Court upheld the decisions of the lower courts. At the same time, the courts of three instances accepted from the plaintiff as confirmation of his ownership of exclusive rights a notarized affidavit (written testimony under oath) of the company's financial director, John Anthony Willis.
In response to the defendants' objections regarding the lack of proof of the company's ownership of exclusive rights to the disputed work, the courts indicated that the materials of the case do not indicate that the right holder of exclusive rights to the work named in the affidavit is another person.
The Supreme Court, where the defendants who disagreed with the decisions made appealed, noted the following.
The initial subject of copyright is a citizen (natural person), who acquires the entire complex of exclusive property and personal non-property rights. Any other persons, in order to prove their rights, must provide evidence of the transfer to them of the property copyright initially arising with the author (the presence of the entire chain of agreements or other legal grounds that determine the transfer of such rights from the author).
The affidavit submitted by the plaintiff does not contain information about the history and date of creation of the disputed image of the Blue Nose Friends character, there is no information about the specific author, employment contracts and other agreements or other legal grounds that determine the transfer of any rights from the author. This document only indicates that the Company considers itself to be the holder of exclusive rights to the image of the character.
The courts should have established and assessed the circumstances of the creation of the work (the emergence of copyright with a specific person) and the transfer of exclusive rights to it to the plaintiff from the original right holder (author of the work) on general grounds of proof, which was not done.
The affidavit submitted by the plaintiff in itself, in the absence of agreements (other agreements and evidence), cannot serve as sufficient grounds for establishing the fact of ownership of exclusive rights to the work in respect of which the claim is filed, since it does not disclose the author, the circumstances of the transfer of exclusive rights to the object of copyright, methods and conditions of its use.
The Supreme Court also drew attention to the fact that the statement of claim does not contain a reference to the norms of applicable law governing the procedure for the emergence, transfer, and protection of copyrights and exclusive rights in the country of origin of the Company.
The Supreme Court noted that the court is not entitled by its actions to place any of the parties in a privileged position, as well as to diminish the rights of one of the parties. Taking into account the purpose pursued by the plaintiff when applying to the court for the protection of the violated right, taking into account the grounds for the stated claim, the Supreme Court considered that without examining the circumstances described above, it is impossible to conclude that there are or are not grounds for granting the claim, and in case of such grounds — about the amount of compensation.
The Supreme Court overturned the acts of the lower courts and remanded the case for reconsideration to the court of first instance.

ROSPATENT PRACTICE

1. Well-Known Trademarks

From March to August 2024, Rospatent recognized the following marks as well-known:

NUMBER IN THE LIST	260
MARK	
RIGHT HOLDER	Sberbank PJSC
GOODS/SERVICES	36 – banking services
DATE OF WELL-KNOWN STATUS	01.01.2024
NUMBER IN THE LIST	261
MARK	
RIGHT HOLDER	Bashkirskaya Sodovaya Companiya JSC
GOODS/SERVICES	30 – food soda
DATE OF WELL-KNOWN STATUS	01.01.2020

NUMBER IN THE LIST	262*
MARK	СПОРТМАСТЕР
RIGHT HOLDER	Sport And Fashion Management Pte. Ltd. (Singapore)
GOODS/SERVICES	35 – sales promotion for third parties of goods for sports, tourism and outdoor recreation, including sales promotion of clothing, headwear, footwear, backpacks, bags and accessories thereto, goods and equipment for water sports; services of stores and online stores for wholesale and retail sale of goods for sports, tourism and outdoor recreation, including the sale of clothing, headwear, footwear, backpacks, bags and accessories thereto, goods and equipment for water sports; services of sports stores for retail and wholesale sales of goods for sports, tourism and outdoor recreation, clothing, headwear, footwear, backpacks, bags and accessories thereto, goods and equipment for water sports, including trade in these goods over the Internet; promotion of sports goods and services of sports stores and online stores through sponsorship of sporting events
DATE OF WELL-KNOWN STATUS	17.07.2017

*The designation has been recognized as a well-known trademark of Sport And Fashion Management Pte. Ltd. (Singapore) by the decision of the IP Court of 06.12.2023 in case № SIP-647/2023, left in force by the resolution of the Presidium of the IP Court of 01.04.2024.

During the same period, Rospatent refused to recognize the following designations as well-known marks:

Старый Мельник — the designation used as a trademark for beer, in the name of JSC "AB InBev Efes". As a basis for the refusal, Rospatent indicated that the submitted documents (including the results of a consumer survey) cannot indicate that the designation "STARY MELNIK" has a sufficiently high level of awareness in relation to the applicant;

ЮБИЛЕЙНОЕ
Trademark № 126030

— trademark № 126030, owned by LLC "Mondelez Rus", in relation to the goods "cookies". Rospatent refused the applicant to recognize the designation as a well-known mark (decision of 31.05.2024 case № 2023B02395), indicating that the materials submitted by the applicant are not sufficient to recognize the trademark "YUBILEINOE" under certificate № 126030 as well-known as of 31.05.2009 in the name of the Applicant, since the board did not establish from the submitted materials on 31.05.2009 the fact of a stable associative link between the designated designation "YUBILEINOE" under trademark № 126030 and the Applicant LLC "Mondelez Rus". In addition, the documents submitted by the applicant contain a reference to OJSC "Bolshevik", which contributes to strengthening the association of the designation "YUBILEINOE" with OJSC "Bolshevik", as the manufacturer of "Yubileinoe" cookies, and not with the Applicant;

2GIS — a verbal designation used by LLC "DublGIS" for the services "providing a business directory via the global computer network", "providing information on travel routes", "providing online geographical maps" and "providing search tools". Rospatent's refusal notes that it is impossible to establish the high awareness of the claimed designation "2GIS" in relation to the specified services for the requested date of 01.01.2021 from the materials submitted by the applicant. The board's conclusion notes that the fact of using the designation in relation to the services for which its well-known status is being requested, in itself, does not indicate that the designation has acquired the status of a well-known trademark;

ЦЕЗАРЬ — in the name of individual entrepreneur Yuri Gusev. Rospatent justified the refusal by the fact that the evidence submitted by the applicant does not confirm the wide awareness of the claimed designation for the requested date — 15.01.2017, and also does not confirm that the claimed designation is associated exclusively with the applicant in the minds of ordinary consumers.

2. Names of Origin of Goods and Geographical Indications

From March to August 2024, Rospatent registered 15 geographical indications (GI) and one appellation of origin:

Number in the Register of GI and NPO	GI/appellation of origin	Goods
337 (GI)	MINERAL'NAYA VODA "DARASUN"	mineral drinking therapeutic-table water
338 (GI)	SAKHSKIE GRYAZI	healing mud
339 (GI)	BRYANSKAYA MALINA	raspberry
340 (GI)	PODSOLNECHNOE MASLO STAVROPOL'YA	sunflower oil
341 (GI)	PEL'MENI "AMUR"	dumplings (culinary dish)
342 (GI)	TUVINSKIY EGIL (IGIL)	musical instrument
343 (GI)	RASSKAZOVSKIY TRIKOTAZH	knitted goods
344 (GI)	YAKUTSKIY KHOMUS	khomus (musical instrument)
345 (GI)	SERNURSKIY KOZIY SYR	semi-hard cheese
346 (GI)	TYUMENSKIY KOVYOR	carpets and carpet products
347 (GI)	BASHKIRSKAYA PUKHOVAYA SHAL' (DEBET SHAWL)	down shawl
348 (GI)	MELITOPOL'SKAYA CHERESHNYA	cherry
349 (GI)	MORDOVSKIY SIDR	traditional cider, fruit cider
350 (GI)	MSTERSKAYA VYSHIVKA	fabric products with embroidery of artistic-decorative and utilitarian purposes
351 (GI)	FITOCHAI KHAKASII	herbal teas, flower teas, herbal teas
352 (AOG)	UDMURTSKIE PEREPECHI	perepechi (pastries with filling)

INTELLECTUAL PROPERTY NEWS OF THE EURASIAN ECONOMIC UNION AND NEIGHBORING COUNTRIES

1. Uzbekistan

Uzbekistan joins the Hague System for the International Registration of Industrial Designs

On June 5, 2024, the Law of the Republic of Uzbekistan № ZRU-929 "On the Accession of the Republic of Uzbekistan to the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (Geneva, July 2, 1999)" was signed.
Accession is carried out with a number of statements:
• the prescribed fee for the designation is replaced by an individual fee for the designation of the Republic of Uzbekistan;
• postponement of the publication of information about the industrial design is not provided;
• the requirement of unity of invention is applied to the designs included in one application;
• no entry in the international register regarding the change of the right holder shall be valid until the patent office of Uzbekistan receives documents on the transfer of rights;
• the term of protection is 5 years and may be repeatedly extended for five years, but not more than 15 years from the date of international registration;
• the time limit for the office to submit the application to WIPO will be 6 months instead of one month;
• the deadline for the office to prepare a notification of refusal to grant protection will be 12 months;
• the effect of international registration in Uzbekistan starts from the date of submission by the office to WIPO of a notification of the granting of protection.
The Geneva Act of the Hague Agreement will enter into force in respect of Uzbekistan three months after the deposit of the instrument of accession with the Director General of WIPO.

Uzbekistan joins the Singapore Treaty on the Law of Trademarks (STLT)

On August 13, the Law of the Republic of Uzbekistan № ZRU-941 "On the Ratification of the Singapore Treaty on the Law of Trademarks (Singapore, March 27, 2006)" was signed.
The following reservation was adopted along with the ratification:
"The Republic of Uzbekistan declares that, notwithstanding paragraph 2 of Article 19 STLT, it requires the registration of a license as a condition for granting the licensee, in accordance with the legislation of the Republic of Uzbekistan, any right to participate in proceedings in connection with the infringement of rights initiated on the initiative of the holder, or to obtain compensation through such proceedings for damage caused as a result of such infringement of the right to a sign that is the subject of the license."

2. Turkmenistan

Turkmenistan joins the Eurasian system for the protection of industrial designs

On July 13, 2024, the Law of Turkmenistan "On Accession to the Protocol on the Protection of Industrial Designs to the Eurasian Patent Convention of September 9, 1994" was signed.
The Protocol will enter into force in respect of Turkmenistan three months after the deposit of the instrument of accession with the depositary (Director General of WIPO).

3. Georgia

Georgia improves trademark protection legislation

On March 8, 2024, amendments to the Law of Georgia "On Trademarks" entered into force, aimed at harmonizing Georgian legislation in the field of trademark protection with the relevant legislation of the European Union.
The corresponding Law of Georgia of 21.02.2024 № 4048-XIV "On Amendments to the Law "On Trademarks" was published on the website of the Georgian Patent Office.

4. Kazakhstan

The President of Kazakhstan signed a law on the ratification of the Protocol to TRIPS

On May 20, 2024, the Law of the Republic of Kazakhstan № 85-VIII ZRK "On the Ratification of the Protocol Amending the Agreement on Trade-Related Aspects of Intellectual Property Rights (Geneva, December 6, 2005)" was signed.
The application of the Protocol will allow Kazakhstan to issue compulsory licenses for the use of patented inventions for the purposes of producing and exporting medicines, as provided for in the additional Article 31bis of the TRIPS Agreement.

NEWS

22–23 AUGUST 2024

20TH CHINA INTELLECTUAL PROPERTY& INNOVATION SUMMIT

Vitaly Shishaev, Trademark Attorney (Gorodissky & Partners, Moscow) spoke on «Brand protection strategy in Russia and how to deal with Chinese brands» at the 20th China Intellectual Property& Innovation Summit, held in Shenzhen (China).
Russian delegation held a number

of meetings with Chinese colleagues. More than 400 specialists took part in the summit this year.

10 SEPTEMBER 2024

SEMINAR "PROTECTION OF NEW DEVELOPMENTS IN RUSSIA AND ABROAD. TRENDS AND REALITIES"

Yuri Kuznetsov, Partner, Russian & Eurasian Patent Attorney, Head of Patent Practice, Sergey Dorofeev, Partner, Russian & Eurasian Patent Attorney, Vladimir Bashkirov, Russian & Eurasian Design Attorney, Head of Patent Research Department, Alexander Budkin, Patent Search Expert and Valery Narezhny, Ph.D., Counsel

(all – Gorodissky & Partners, Moscow) hosted a seminar "Protection of new developments in Russia and abroad. Trends and realities" in Nizhniy Novgorod.
The seminar was devoted to the complex legal protection of intellectual assets and included two round tables: 'Information and legal support of innovation activity' and 'Legal, procedural and tax bases of formation of successful strategy of protection of scientific and technical developments'

12–13 SEPTEMBER 2024

SCIENTIFIC AND PRACTICAL CONFERENCE 'STRATEGY OF INTELLECTUAL PROPERTY DEVELOPMENT IN THE RUSSIAN FEDERATION'

Yuri Kuznetsov, Partner, Russian & Eurasian Patent Attorney, Head of Patent Practice (Gorodissky & Partners, Moscow) spoke at the plenary session on 'The Modern Role of Intellectual Property in Business' at the Scientific and Practical Conference 'Strategy of Intellectual Property Development in the Russian Federation', organised by the Government of the Chuvash Republic, Chuvash State University n.a. I.N. Ulyanov and Gorodissky & Partners law firm.
On the conference grounds, young inventors presented their projects:

"Chess simulator for attention concentration, sound anatomical model with electrodes", "Virtual assistant for memorizing difficult words", "unmanned" peat miner" and others.
On the second day of the conference the specialists of Gorodissky & Partners: Yuri Kuznetsov, Partner, Russian & Eurasian Patent Attorney, Head of Patent Practice, Sergey Dorofeev, Partner, Russian & Eurasian Patent Attorney, Vladimir Bashkirov, Russian & Eurasian Design Attorney, Head of Patent Research Department, Alexander Budkin, Patent Search Expert, and Valery Narezhny, Ph.D., Counsel (all – Gorodissky & Partners, Moscow) hosted two roundtables: 'Information and legal support of innovation activity' and 'Legal, procedural and tax bases of formation of successful strategy of protection of scientific and technical developments'.

14 SEPTEMBER 2024

INTERNATIONAL CONFERENCE "IP EURASIA/IP CHINA'24: INNOVATION SPACE"

Valery Medvedev, Managing Partner, Patent & Trademark Attorney (Gorodissky & Partners, Moscow) moderated a plenary session "Eurasian patent system: advantages for Chinese companies" within the framework of the International Conference "IP Eurasia/IP China'24: Innovation Space" organized by Eurasian Patent Organization.

The plenary session was attended by: Li Xin, Director of Dalian International Strategic Research Center for Intellectual Property Protection, Eduard Shablin, President, Assembly of Eurasian Patent Attorneys (AEPP), Partner, Patentica and Sergey Zuikov, Managing Partner, Zuikov & Partners. On the conference premises a number of meetings with foreign partners took place, in particular Valery h held a meeting with representatives of the All-China Patent Attorneys Association led by Mr. Zeng Fanfu, Deputy Secretary General, to discuss more active professional cooperation between the All-China Patent Attorneys Association, the Russian Chamber of Patent Attorneys and the Assembly of Eurasian Patent Attorneys.

24 SEPTEMBER 2024

ONLINE CONFERENCE "IT. LAW. SECURITY. ONLINE. 2024"
Stanislav Rumyantsev, Ph.D., CIPP/E, Senior Lawyer, (Gorodissky & Partners, Moscow) spoke on "Employee liability in case of personal data leakage: Top 5 tips for employers", at the Online conference "IT. Law. Security. Online. 2024".
The conference brought together more than 600 participants.

24 SEPTEMBER 2024

PRAVO.RU CONFERENCE "INFORMATION AND PERSONAL DATA PROTECTION – 2024"
Valery Narezhny, Ph.D., Counsel (Gorodissky & Partners, Moscow) took part in the conference "Information and personal data protection – 2024", organized by Pravo.ru.
Valery presented the report "Server Access: Cross-Border Data Transfer. Unanswered questions: assessment, notifications, operators".
The conference was attended by more than 100 specialists in the field of personal data protection.

25 SEPTEMBER 2024

16TH INTERNATIONAL CONFERENCE "WHAT'S HAPPENING IN THE PHARMACEUTICAL MARKET?"
Sergey Vasiliev, Partner, Ph.D., Trademark Attorney (Gorodissky & Partners, Moscow) spoke at the session "Intellectual Property: How Can the Market Keep the Balance of Interests?" at the 16th International Conference "What's Happening in the Pharmaceutical Market?" held in Moscow.

27 SEPTEMBER 2024

RUSSIAN BIOTECHNOLOGY FORUM OPENBIO-2024
Yuri Kuznetsov, Partner, Russian Patent Attorney, Eurasian Patent & Design Attorney, Head of Patent Practice, Vladimir Bashkirov, Russian Patent Attorney, Eurasian Design Attorney (both – Gorodissky & Partners, Moscow) and Natalia Nikolaeva, Partner, Trademark Attorney, Regional Director (Gorodissky & Partners, Novosibirsk) held a round table "Copyright and ownership: from intellectual property creation to rights ownership" within the framework of the Russian Biotechnology Forum OpenBio-2024, which took place in Koltsovo science city (Novosibirsk).
Gorodissky & Partners Consultation Center operated in the Forum exhibition area. Our experts provided the personal consultations on intellectual property protection issues, demonstrated the possibilities of searching for patent information in available databases and presented a mobile application for patent and trademark management Gorodissky IP Mobile.

7 OCTOBER 2024

IV ANNUAL PATENT CONGRESS – 2024
The lV Annual Patent Congress of the Russian National AIPPI Group was held in the Chamber of Commerce and Industry of the Russian Federation.
Vladimir Biriulin, Member of the AIPPI Russian National Group Bureau, Partner, Russian Patent Attorney (Gorodissky & Partners, Moscow) took part in the Opening Ceremony of the IV Annual Patent Congress – 2024.
Sergey Medvedev, Ph.D., LL.M., Partner, Trademark & Design Attorney, (Gorodissky & Partners, Moscow, Dubai) spoke about the peculiarities of trust management of exclusive rights.
Alina Grechikhina, Russian Trademark & Design Attorney, Eurasian Design Attorney (Gorodissky & Partners, Moscow), spoke at the round table "Trademarks and Other Means of Individualization" on "Unprotected Elements: Obstacles in Registration of Designations and Scope of Legal Protection of Trademarks".
In the session "IP Disputes" spoke: Anton Bankovskiy, Ph.D., Counsel, Russian Patent Attorney (Gorodissky & Partners, Moscow) on the topic "Compulsory licenses at the present stage in Russia – trends, practice, expectations".
Anton Melnikov, LL.M., Senior Lawyer (Gorodissky & Partners, Moscow) on "Unfair Competition with the Use of Other People's Intellectual Property".

8–9 OCTOBER 2024

XXVIII INTERNATIONAL SCIENTIFIC AND PRACTICAL CONFERENCE "INTELLECTUAL PROPERTY – THE BASIS OF INNOVATION ECONOMY. PRIORITIES AND MECHANISMS OF SCIENTIFIC AND TECHNOLOGICAL DEVELOPMENT"
Gorodissky & Partners was a partner of the XXVIII International Scientific and Practical Conference "Intellectual Property – the Basis of Innovative Economy. Priorities and Mechanisms of Scientific and Technological Development", where Andrey Rogov, Head of the Computer Systems Department (Gorodissky & Partners, Moscow) took part in the round table "Digital Transformation of Intellectual Property Management" with the report "Modern Digital Services in the Field of Intellectual Property" and presented e-services

Gorodissky IP Patadmin, Gorodissky IP Security, Gorodissky IP Mobile.

9–10 OCTOBER 2024

22ND ANNUAL SEMINAR "INTELLECTUAL PROPERTY PROTECTION STRATEGIES FOR SUCCESSFUL COMPANY DEVELOPMENT"

The 22nd annual seminar 'Intellectual Property Protection Strategies for Successful Company Development' was

successfully completed in Moscow. More than 100 IP specialists participated in the seminar both in person and online.

Presentations were made by 28 professionals of Gorodissky & Partners from Moscow, St. Petersburg and Novosibirsk.

The seminar was opened by Valery Medvedev, Managing Partner of Gorodissky & Partners, with a speech dedicated to the anniversary of Gorodissky & Partners – '65 years on the IP market – traditions, experience and modernity'.

The first day of the seminar included thematic sessions devoted to inventions, artificial intelligence and current trends in pharma patenting.

The second day of the seminar was devoted to trademarks and industrial designs, software protection, advertising regulation, franchising, online enforcement and anti-counterfeiting, data protection and privacy.

16 OCTOBER 2024

IPPEOPLE INTELLECTUAL PROPERTY CONFERENCE

Daria Markovtseva, Russian & Eurasian Design Attorney and Larisa Shapran, Trademark Attorney (both – Gorodissky & Partners, Moscow) took part at the IPPeople Intellectual Property Conference.

Daria Markovtseva made a presentation "Industrial designs in a digital environment: how to guard the graphical user interface?", Larisa Shapran reported on "Descriptive trademarks: lack of creativity or a smart tactic?"

16 OCTOBER 2024

SEMINAR "LEGAL PROTECTION OF DESIGNS. DEVELOPMENT OF LEGAL PROTECTION SYSTEM OF INDUSTRIAL DESIGNS IN THE EURASIAN REGION"

Alisa Mukhamedjanova-Aksenova, Russian & Eurasian Design Attorney (Gorodissky & Partners, Moscow) took part in the round table 'Industrial Design in the Eurasian Region: Industrial Designs with Trademarks and Designs in the Digital Environment. Country Experience' at the seminar "Legal Protection of Designs. Development of Legal Protection System of Industrial Designs in the Eurasian Region" organized in Ashgabat by the Eurasian Patent Organization and the State Intellectual Property Service of the Ministry of Finance and Economy of Turkmenistan.

16 OCTOBER 2024

ITSEC 2024 CONFERENCE – PERSONAL DATA IN 2025: NEW REQUIREMENTS AND TOOLS

Valery Narezhny, Ph.D., Counsel (Gorodissky & Partners, Moscow) made a presentation on 'Cross-border transfer of personal data. Unanswered questions' at the conference 'Personal data in 2025: new requirements and tools' within the framework of the ITSEC 2024 Forum.

The conference had over 100 attendees in a face-to-face format, and speaker presentations were also available online.

17 OCTOBER 2024

WEBINAR "TRADEMARK NON-USE CANCELLATION ACTIONS IN RUSSIA – REGULATIONS, COURT PRACTICE, TRENDS"

Sergey Medvedev, Ph.D., LL.M., Partner, Trademark & Design Attorney (Gorodissky & Partners, Moscow, Dubai), Anton Bankovskiy, Ph.D., Counsel, Trademark Attorney, and Evgeniya Smolnikova, Trademark Attorney, Senior Lawyer (both – Gorodissky & Partners, Moscow), held a webinar "Trademark Non-use Cancellation Actions – Regulations, Court Practice, Trends".

The webinar devoted to various legal and practical issues related to cancellation of trademarks due to non-use in Russia.

20–21 OCTOBER 2024

2024 AIPPI WORLD CONGRESS

Delegation of Gorodissky & Partners law firm took part in the 2024 AIPPI World Congress in Hangzhou, China.

31 OCTOBER 2024

MEETING OF THE IP COMMITTEE OF THE FRANCO-RUSSIAN CHAMBER OF COMMERCE AND INDUSTRY

Anna Degtyareva, Lawyer and Dmitry Rusakov, Head of Brand Protection Group (both of Gorodissky & Partners, Moscow) spoke about trademark protection and anti-counterfeiting on the Internet at the meeting of the Intellectual Property Committee of the Franco-Russian Chamber of Commerce and Industry (CCI France Russie).

1 NOVEMBER 2024

DATA PROTECTION IN THE RUSSIAN FEDERATION: OVERVIEW // PRACTICAL LAW BY THOMSON REUTERS

Practical Law by Thomson Reuters published a Country Q&A Data Protection in the Russian Federation: Overview by Sergey Medvedev, Ph.D., LL.M., Partner (Gorodissky & Partners, Moscow, Dubai) and Stanislav Rumyantsev, Ph.D., CIPP/E, Senior Lawyer (Gorodissky & Partners, Moscow).

This Q&A guide gives a high-level overview of the data protection laws, regulations, and principles in the Russian Federation, including the main obligations and processing requirements for data controllers (operators), data processors, and other third parties. It also covers data subject rights, the supervisory authority's enforce-

NEWS

ment powers, and potential sanctions and remedies. It briefly covers rules applicable to cookies and spam.

1 NOVEMBER 2024

DATA PROTECTION AUTHORITY REGISTRATION AND DATA PROTECTION OFFICER REQUIREMENTS FOR DATA CONTROLLERS: RUSSIAN FEDERATION // PRACTICAL LAW BY THOMSON REUTERS

Practical Law by Thomson Reuters published a Country Q&A Data Protection Authority Registration and Data Protection Officer Requirements for Data Controllers: Russian Federation by Sergey Medvedev, Ph.D., LL.M., Partner (Gorodissky & Partners, Moscow, Dubai) and Stanislav Rumyantsev, Ph.D., CIPP/E, Senior Lawyer (Gorodissky & Partners, Moscow).
A Q&A discussing obligations for private-sector data controllers in the Russian Federation to notify, register with, or obtain authorization from the data protection authority under the Russian Federation's comprehensive data protection law before processing personal data. It also discusses any requirements for data controllers to appoint a data protection officer (DPO) and any applicable notification or registration obligations relating to DPO appointments.

8 NOVEMBER 2024

LEGAL COMMITTEE MEETING OF THE ASSOCIATION OF EUROPEAN BUSINESSES

Anna Degtyareva, Lawyer (Gorodissky & Partners, Moscow) spoke on 'Protection of Exclusive Rights on Marketplaces' at the Legal Committee meeting of the Association of European Businesses.

12 NOVEMBER 2024

BUSINESS BREAKFAST 'SERVICE RIAS: LEGAL AND PRACTICAL RECOMMENDATIONS'

Sergey Vasiliev, Partner, Ph.D., Trademark Attorney and Valery Narezhny, Ph.D., Counsel (both – Gorodissky & Partners, Moscow) successfully held a Business Breakfast 'Service RIAs: Legal and Practical Recommendations'. Our experts discussed the most actual and practical issues related to the turnover of proprietary RIA and shared interesting cases from their own practice.
The business breakfast aroused great interest and ended with a fruitful discussion.

21–22 NOVEMBER 2024

CHINA INTELLECTUAL PROPERTY AND INNOVATION SUMMIT CIPIS 2024

Yuri Kuznetsov, Partner, Russian Patent Attorney, Eurasian Patent & Design Attorney, Head of Patent Practice and Alexey Zhurov, Russian and Eurasian Patent Attorney (both – Gorodissky & Partners, Moscow) spoke on 'Comparison of approaches of Russian and Eurasian patent offices to the examination of inventions in the field of AI and pharmaceuticals' during China Intellectual Property and Innovation Summit CIPIS 2024.

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