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GEOGRAPHICAL INDICATIONS

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Part IV of the Russian Civil Code regulates IP subject matters, which are defined as results of intellectual activities and means of individualization. The Civil Code ensures that intellectual property

is protected by law, and provides the explicit list of the results of intellectual activities and means of individualization, which may be protected as such: scientific, literary and artistic works; programs for computers; databases; performances; sound recordings; broadcasting and cable radio and television programs; inventions; utility models; industrial designs, plant varieties and animal breeds

integrated circuit layout-designs (topography); know-how; company names; trademarks and service marks; appellation of the origin of goods; commercial names.

Soon, the list of IP matters will be enlarged and “geographical indications” will become protectable.

Being, in a way, similar to appellations of origin of goods, geographical indications seem to be somewhat less complicated in terms of their properties and regulations thereof. The Federal Law introducing changes to Part IV of the Russian Civil Code in connection with the new IP subject matters is expected to come into force in Summer 2020. Provisions of the Civil Code, which now regulate appellations of origin of goods, will be completed to include conditions to govern geographical indications.

So, what do geographical indications have in common with appellations of origin of goods and what are the differences between these IP subject matters in terms of their prosecution and protection?

The Russian Civil Code currently reads that an appellation of origin of goods is a designation that represents or contains a modern or historical, official or unofficial, full or abbreviated name of the country, city or rural settlement, locality or other geographical object, or derived from such name and became known as a result of its use with respect to the goods special properties of which are exclusively or mainly determined by the natural conditions and/or human factors of a given geographical area.

According to the published Federal Law a geographical indication is a designation that identifies the good as originating from a certain territory, the quality, reputation and other characteristics of which are mainly connected with its geographical origin (properties of the good). It should be noted that in the Federal Law the legislators differentiate it that in terms of appellations of origin special properties » page 2

are *exclusively* determined by the natural conditions and/or human factors of a given geographical object, while for geographical indications special properties of the good are *mainly* connected with its geographical origin. This difference comes from the provision that regulates manufacturing requirements for the goods. In contrast to appellations of origin for which all stages of the manufacturing process that considerably influence creation of the special properties of the good must be carried out in a given geographical area, existence of at least one stage of production in a given geographical territory should be sufficient for geographical indications.

Further, the Federal Law foresees wider list of persons who may obtain the right for a geographical indication and an appellation of origin. Specifically, not only one or several citizens or legal entities, but also associations or other unions may obtain protection for a geographical indication or an appellation of origin. In case of successful registration of a geographical indication or an appellation of origin, the right to use one IP subject matter or another in connection with the goods, which possess special properties, is granted to each member of the association recorded in the State Registry of geographical indications and appellations of origin. Like appellations of origin disposing of the right for geographical indications is prohibited by law.

If an applicant seeks protection for a geographical indication, which allows to identify the good as originating from a foreign state, registration of such a geographical indication is permitted if this designation is protected as a geographical indication or other means of individualization in the country of origin of the good (provided that it meets the requirements of the Civil Code for geographical indications).

It is noteworthy that for appellations of origin the provision remains that the name of a geographical area located in a foreign state may be registered as an appellation of origin in Russia, if such name is protected in the country of origin specifically as the appellation of origin, and not as other means of individualization (for instance, as a geographical indication).

The necessity of having the registered appellation of origin in the country of origin of the good complicated the process of obtaining protection of this IP in Russia.

One of the recent cases concerns refusal of grant of protection for designation EMILIA filed back in 2014 to be registered as an appellation of origin for different kinds of wine. The refusal was based on the fact that the applicant (a group of 25 Italian companies) did not have a registered appellation of origin in Italy, thus the applied designation did not meet the requirements of the Russian Civil Code as regards appellations of origin.

The applicant appealed the refusal with the Chamber of Patent Disputes of the Russian Patent and Trademark Office arguing that though they did not have the registered appellation of origin in Italy, designation EMILIA was enjoyed protection a protected geographical indication. The applicant stated that the essence of the IP protected as the geographical indication in Italy corresponded to the definition of the appellation of origin of the Russian Civil Code. To strengthen its position the applicant referred to Lisbon agreement for the protection of appellations of origin and the legislation of the European Union, which provided for protection of tree types of geographical indications: protected designation of origin, protected geographical indication and traditional specialities guaranteed. The Chamber of Patent Disputes considered these arguments unconvincing and upheld the refusal of grant of protection. As a result of subsequent appealing of the decision of the Chamber of Patent Disputes with the IP Court, the case was returned to the Russian Patent and Trademark Office for reconsideration.

However, the second review of the applicant's appeal had the same outcome. Having analyzed all the submitted materials the Chamber of Patent Disputes came to the conclusion that it was a protected designation of origin, which could correspond to the essence of an appellation of origin as foreseen by the Russian Civil Code, while designation EMILIA was registered as the geographical indication, which was considered to be a separate IP that in its substance differed from an appellation of origin. Now that the Russian Civil Code will include such means of individualization as geographical indications, owners who previously did not succeed in registering their designations as appellations of origin in Russia will have another chance to try to obtain protection for geographical indications.

Moreover, when the Federal Law in connection with the discussed IP comes into effect, those parties, who might be facing problems with registering their designations as appellations of origin, will have the possibility to transform the application for the appellation of origin into the application for the geographical indication. This possibility will be available for registered appellations of origin too; reverse transformation – from a geographical indication to an appellation of origin, whether registered or pending, will be also foreseen by the Russian Civil Code.

What more could be of interest in connection with the changes to be introduced is the fact that special properties of the goods for which a geographical indication or an appellation of origin is registered will be published in the State Registry. Thus, any person may have the opportunity to test the good and to compare their experience with the identified special properties.

Judging from the proposed amendments, the legislators worked hard to promote both IP subject matters – geographical indications and appellations of origin. The changes provide less complicated requirements for geographical indications and somewhat easier prosecution for appellations of origin, reducing the terms for registration as well.

Geographical indications had a long way to join the group of means of individualization provided by the Russian Civil Code, but seem to arrive just in time. Now that consumers strive to purchase the products, which are authentic or probably unique, geographical indications along with appellations of origin will be serving businesses in Russia to meet this challenge being a guarantee that the goods has special properties the customer is looking for.

QUARTERLY REVIEW OF ROSPATENT PRACTICE AND COURT PRACTICE RELATED TO INTELLECTUAL PROPERTY

(APRIL TO JUNE 2019)

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COURT PRACTICE

TRADE MARKS

THE MERE FACT OF DESIGNATION'S USE BEFORE THE FILING DATE OF APPLICATION FOR A TRADE MARK IS INSUFFICIENT TO CONCLUDE THAT THE DESIGNATION HAS NO DISTINCTIVENESS (INTELLECTUAL PROPERTY RIGHTS COURT, DECISION DATED APRIL 12, 2019 ON CASE No. SIP-791/2018)

Rospatent refused “Nathalie Droen” company to register the “SACRAL BODY ARCHITECTURE” trade mark under application No. 2016732397. Having disagreed with this decision, the company first tried to challenge it at the Chamber of Patent Disputes and, having been refused there too, turned to the Intellectual Property Rights Court (IP court).

The Rospatent' position consisted in that the distinctiveness of the claimed designation had been lost as a result of its widespread and long-term use by different manufacturers with regard to identical or homogeneous goods.

The review of publicly available information on the Internet confirms that the claimed designation reproduces the “SACRAL BODY ARCHITECTURE” name of the spiritual and physical self-perfection method created by Nathalie

Droen. At the same time, there is publicly available information on the Internet on the use of the disputed designation in the Russian Federation by other persons with regard to this method, in support of which Rospatent provided several links to the Internet sources using that designation, from which it appears that Nathalie Droen gave classes according to her method to the general public and had students and followers who continued promoting the SACRAL BODY ARCHITECTURE method both abroad and in Russia.

The company, in its turn, points out that the Internet sources cited by Rospatent are either administered from other countries, which does not confirm the designation's use in the Russian Federation, or it is impossible to identify the persons using that designation, or it is impossible to establish the date of posting the information on those websites.

Having considered the arguments of the parties, the court came to the conclusion that all sources provided by Rospatent, except for one, were irrelevant to the dispute. The mere fact of the designation's use by different persons before the filing date of the application for a trade mark is not sufficient to establish the associative bonds that arose or could arise among consumers in connection with that designation, and, accordingly, to conclude that the designation has no distinc-

tiveness. Moreover, the very duration of use by different persons of a particular designation before the filing date of the application for a trade mark does not evidence that there is no distinctiveness in this designation either. There is no evidence of widespread and long-term use of the designation by other persons for the same or similar goods and services (the method) before the filing date of the application in the files of the case.

On this basis, the court obliged Rospatent to reconsider Nathalie Droen company's appeal against the refusal to grant legal protection to the disputed designation.

WHILE REFUSING DISTINCTIVENESS IN ONE TRADE MARK, THE COURT INDIRECTLY RAISED DOUBTS ABOUT DISTINCTIVENESS OF ANOTHER MARK (PRESIDIUM OF THE INTELLECTUAL PROPERTY RIGHTS COURT, RESOLUTION DATED APRIL 18, 2019 ON CASE No. SIP-619/2018)

Rospatent refused Nevskaya Kosmetika company to register a three-dimensional designation as the trade mark under application No. 2016714726.



Designation under application for trade mark No. 2016714726

Rendering such decision, Rospatent considered that the designation under consideration had no distinctiveness, since due to its triviality and lack of originality the combination of yellow colour and white spots on a package and informative writings without any design was perceived not as means of individualization of goods of a certain manufacturer,

but rather like a regular package with the background, on which a consumer did not fixate when perceiving the mark. Thus, there are no features necessary and sufficient for consumers to remember it. Having disagreed with this Rospatent's decision, the company turned to the Intellectual Property Rights Court, but the court of first instance dismissed the claims stating that the unprotectable elements, in particular, the form of a package, which was driven solely by its functional purpose, took the dominant position in the claimed designation.

Under the company's cassation appeal, the case was referred to the Presidium of the Intellectual Property Rights Court, which came to the following conclusions.

When concluding about the dominant position of unprotectable elements (the form of a package) in the disputed designation, the court of first instance pointed out that the combination of yellow colour and white spots on the package was perceived not as means of individualization of goods of a certain manufacturer, but as a regular package with the background, and the court proceeded from the fact that a simple colour combination (location of spots and colour combination) was not a sufficient distinctive feature that made it possible to consider the claimed designation as having distinctiveness. However, the court left unattended the fact that the company had the exclusive right to the trade mark under certificate of the Russian Federation No. 638010.

This trade mark was granted legal protection, including with regard to those goods, for which legal protection

is claimed for the disputed designation (classes 3 and 5 according to ICGS). The trade mark is valid. By its decision, the court of first instance actually compromised the grant of legal protection to trade mark No. 638010, having acknowledged that it, in turn, had no distinctiveness.



Trade mark No. 638010

At the same time, the Presidium of the Intellectual Property Rights Court notes that the form of goods is not always the dominant element in three-dimensional trade marks. When analysing the three-dimensional designation,

it is necessary to evaluate the consumers' perception of the shape of goods, including whether the consumer pays attention to the shape of the goods, if it is traditional as such.

The court of first instance concluded that the disputed designation had no distinctiveness without taking into account the existing circumstances, confining itself to stating that the unprotectable elements took the dominant position in it.

On this basis, the Presidium of the Intellectual Property Rights Court concluded that it was necessary to reverse the appealed decision of the court of first instance and to remand the case for reconsideration to the Intellectual Property Rights Court as a court of first instance.

THE COURT REFUSED TO BRING THE ENTREPRENEUR TO ADMINISTRATIVE LIABILITY FOR THE SALE OF COUNTERFEIT GOODS DUE TO THE INSIGNIFICANCE OF THE ADMINISTRATIVE OFFENCE (RESOLUTION OF THE INTELLECTUAL PROPERTY RIGHTS COURT DATED MAY 17, 2019 ON CASE No. A56-107601/2018)

The Department of the Ministry of Internal Affairs of the Russian Federation for the North-Western Federal Circuit was conducting an inspection at the Baltiyskiy Railway Station of Saint Petersburg, during which it was found that the individual entrepreneur Zarifi Osman Torashi was offering for sale 3 perfumes under the "BURBERRY" designation priced at 1,000 Russian roubles each. This designation is confusingly similar to the trade marks under international registrations Nos. 733385 and 732879, the exclusive rights to which belong to foreign entity Burberry Limited, and the individual entrepreneur had no authorization to use these trade marks.

On this basis, the Transport Directorate of the Ministry of Internal Affairs of the Russian Federation for the North-Western Federal Circuit seized the perfumes and filed a claim with the Commercial Court of Saint Petersburg and Leningrad Region to bring individual entrepreneur Zarifi Osman Torashi to administrative liability under part 2 of Article 14.10 of the Administrative Offences Code of Russia.

Dismissing the stated claims, the court of first instance considered that although the actions of the entrepreneur formally contained the elements of an administrative offence the violation itself did not have any dangerous threat to the protected public relations, because they did not cause significant harm to public interests, society, and state; therefore, the court concluded that the offence committed by the entrepreneur was insignificant, for which reason, in that situation, it was possible to apply the pro-

visions of Article 2.9 of the Administrative Offences Code to the disputed legal relations, thereby relieving the entrepreneur from administrative liability and announcing a verbal warning. Notwithstanding, the goods seized from the entrepreneur were acknowledged by the court as counterfeit and being subject to destruction.

The court of appeal and the Intellectual Property Rights Court supported the said conclusions, having upheld the decision of the court of first instance.

THE OWNER'S CONSENT TO REGISTRATION OF A TRADE MARK IS NOT A GROUND FOR ENTERING INTO A SETTLEMENT AGREEMENT WITH ROSPATENT (INTELLECTUAL PROPERTY RIGHTS COURT, DECISION DATED APRIL 5, 2019, CASE No. SIP-677/2018)

Istoki Baikala company sought to register the "Istoki Baikala" (Headwaters of Baikal) designation as a trade mark under application No. 2016727719, but Rospatent refused to register it stating that it was prohibited to register the trade marks identical or confusingly similar to natural heritage sites, which was Lake Baikal, if there was no consent of the owners or persons authorized by the owners.



Designation under application for trade mark
No. 2016727719

The company filed a claim with the Intellectual Property Rights Court appealing that Rospatent's decision. In the court, the company submitted letters of consent from Federal State Budget-Funded Institution Zapovednoe Podlemorye and Federal State Budget-Funded Institution Baikal National Nature Reserve, believing that those letters were the ground to enter into a settlement agreement. The court reasonably objected to that stating that settlement agreements were to be entered into between the parties to the dispute, which in that case were the Company and Rospatent. The letters of consent from Federal State Budget-Funded Institution Zapovednoe Podlemorye and Federal State Budget-Funded Institution Baikal National Nature Reserve did not mean a settlement of the dispute with Rospatent, since those institutions were not parties to the dispute. At the same time, the court concluded that those letters of consent were a sufficient and independent ground to reverse the Rospatent's decision dated June 27, 2018 and to compel it to reconsider the appeal dated March 02, 2018, which served as a basis for this authority to render the decision challenged in the court.

ROSPATENT CANNOT RECOGNIZE AN ELEMENT AS PROTECTABLE WHILE IT IS DISCLAIMED IN THE TRADE-MARK CERTIFICATE, AND VICE-VERSA, IN THE ABSENCE OF THE RIGHT HOLDER'S WILL (PRESIDIUM OF THE INTELLECTUAL PROPERTY RIGHTS COURT, RESOLUTION DATED JUNE 3, 2019 ON CASE No. SIP-735/2018).

Rospatent invalidated the "Iz Turakovo" (From Turakovo) trade mark under certificate of the Russian Federation No. 643269, registered in the name of Turakovo poultry farm. The ground for such decision was an appeal filed by another company, Cherkesskoe that owns the "TURA-

KOVSKIE" trade marks under certificates No. 208976 and No. 612787, which have earlier priority dates and are confusingly similar to the trade mark under consideration. It should be noted that the "IZ TURAKOVO" word element was claimed as unprotectable in the disputed trade mark. In its appeal, Cherkesskoe company stated that the disputed trade mark could not have been registered incorporating such element as unprotectable, since it took the dominant position in the trade mark.



Trade mark No. 643269

farm turned to the Intellectual Property Rights Court.

ТУРАКОВСКИЕ Тураковские

Trade mark No. 208976

Trade mark No. 612787

Having considered the files of the case, the court stated that Turakovo village, where the right holder of the disputed trade mark was located, was a little-known locality, for which reason it considered that the "IZ TURAKOVO" designation would be perceived by the consumer as fanciful, therefore the "IZ TURAKOVO" word element was not unprotectable. Moreover, the "IZ TURAKOVO" word element was dominant in the disputed trade mark, while the figurative element imitating a village farmstead served only as its background and decorative design. In the court's opinion, Rospatent could refuse incorporating the disputed word element in the trade mark as unprotectable, since, when considering the appeal, the administrative authority should establish protectability of the designation as a whole as well as its elements with regard to goods and services. Based on these facts, the court of first instance recognized Rospatent's decision as grounded and dismissed the claims of the poultry farm. But the poultry farm filed a cassation appeal against this court decision.

Having considered the cassation appeal, the Presidium of the Intellectual Property Rights Court stated that the trade mark under certificate of the Russian Federation No. 643269 had been registered in the State Register on January 26, 2018 specifically by indicating the "IZ TURAKOVO" word element as unprotectable, therefore, the conclusions of the court of first instance that the word element was incorporated in the trade mark as a protectable element did not correspond to the facts of the case. At the same time, all subsequent conclusions of the court of first instance about fanciful nature of the "IZ TURAKOVO" word element and its dominant position as well as the conclusions made based on the results of comparison of the disputed and opposed trade marks were also based on the fact that the element was protectable. Under such circumstances, the Presidium of the Intellectual Property Rights Court believes that the court of first instance incorrectly compared the disputed and opposed trade marks, since they should have been compared taking into account the fact that the "IZ TURAKOVO" word element was indicated in the registration of the disputed trade mark as a disclaimed element.

The Presidium of the Intellectual Property Rights Court separately pointed out that Rospatent was not entitled to change the scope of legal protection of the disputed

trade mark in some part of the registered designation without the right holder's will and that the scope of legal protection can only be changed on approval of the right holder who may file a request to make changes in the registered trade mark.

Thus, the conclusion of the court of first instance that at the stage of consideration of the appeal Rospatent should establish protectability of the designation as a whole and that of its elements, regardless of in which capacity the elements incorporated in the trade mark were registered (i. e., in fact, may on its own recognize the element indicated as protectable in the registration of the trade mark as unprotectable, and vice versa) does not comply with the applicable norms of substantive law. Based on the foregoing, the Intellectual Property Rights Court concluded that there were grounds to satisfy the cassation appeal and to reverse the decision of the court of first instance.

ROSPATENT'S PRACTICE

TRADE MARKS

IF THE DESIGNATIONS UNDER COMPARISON ARE SIMILAR AT FIRST SIGHT, DIFFERENCES IN DETAILS DO NOT PLAY MAJOR ROLE IN DETERMINING THEIR SIMILARITY (DECISION OF ROSPATENT (CHAMBER OF PATENT DISPUTES) DATED APRIL 15, 2019)

Rospatent refused to register the designation under application No. 2017702038 as a trade mark, as this designation is confusingly similar to the mark already registered under certificate No. 435342 with regard to similar goods.



Designation under application for trade mark
No. 2017702038



Trade mark No. 435342

Having considered the applicant's appeal against such decision of the expert examination panel, the Chamber of Patent Disputes came to the following conclusions.

When determining similarity of figurative designations, the most important factor is the first impression from comparison of the designations: if the first impression of the designations under comparison is their similarity, but further analysis shows any distinction between the designations due to the differences in their separate elements, it is advisable to follow the first impression, when evaluating the similarity between the designations. The difference in details should not play a major role, since it should be taken into account that the consumer usually follows general impressions about the mark seen earlier, which are often vague.

The chamber notes that in the opposed trademark under certificate No. 435342 the silhouette of a cow is large, takes the central position in the composition, and is located in a contrasting semicircle. Under such circumstances, the silhouette of a cow captures the focus of consumers

and therefore it is an important element of the mark. Thus, in this case, it should be stated that the external form of the silhouettes under comparison is identical, namely: the direction of the image (the head at the right and the tail at the left), the kind of horns, tail, ears, body, and legs, i. e., all parts of the shown silhouettes, match.

The semantic meaning of the images under comparison should be also recognized as similar, since in both cases the silhouette of a cow, having the relevant semantic meaning, is shown.

The word elements present in the designations under comparison are insufficient to form a very different impression that can make consumers remember the images differently. On this basis, the panel of the Chamber for Patent Disputes supported the Rospatent's decision.

THE IMAGE OF THE PPSH-41 SHPAGIN SUBMACHINE GUN IS NOT CAPABLE OF CREATING AN IDEA IN CONSUMERS' MINDS OF A CERTAIN PERSON PRODUCING GOODS (DECISION OF ROSPATENT (CHAMBER OF PATENT DISPUTES) DATED APRIL 15, 2019).

Dialma company filed application No. 2017719051 for registration of the designation



Designation under application for trade mark
No. 2017719051

being a realistic image of the PPSH-41 Shpagin Submachine Gun and the "Weapon of Victory" words as a trade mark. Rospatent refused to register it because, in particular, the applicant did not submit a written consent

of the Shpagin's heirs to use the PPSH-41 image as a trade mark. Thus, the claimed designation cannot be registered, since, from the Rospatent's standpoint, it is capable to pass a consumer off with regard to a manufacturer of goods or a person providing services.

The applicant appealed the decision at the Chamber for Patent Disputes and noted that it carried out its activities together with G. S. Shpagin's Scientific and Technical Heritage Preservation and Promotion Contribution Fund and was one of its founders. The second founder of the Fund and the sole founder of the applicant is N. B. Shpagina, the granddaughter of the famous designer G. S. Shpagin.

The panel of the Chamber of Patent Disputes agreed with this argument and also noted that there was no information in the challenged decision evidencing that the image of the PPSH-41 Shpagin Submachine Gun could create an idea in consumers' minds of a certain person producing goods of the claimed classes according to ICGS or on a certain person providing services of the claimed class according to ICGS.

Thus, the panel believes that the claimed designation does not create untrue ideas on the source of origin of the claimed goods and services, which are not consistent with the facts.

It should be also noted that, when considering the appeal, the panel also took into consideration the fact that the applicant had the exclusive right to a similar trade mark under certificate No. 706116.

Under these circumstances, the panel did not find any grounds to recognize the claimed designation as non-compliant with the requirements of sub-clause 1 of clause 3

of Article 1483 of the Civil Code of Russia. Thus, the trade mark under application No. 2017719051 may be registered as a trade mark in the applicant's name.

THE VISUAL CRITERION FOR SIMILARITY OF DESIGNATIONS IS NOT ALWAYS RECOGNIZED AS DETERMINING FACTOR; SOMETIMES THE FACTORS OF PHONETIC AND SEMANTIC SIMILARITY PREVAIL (DECISION OF ROSPATENT (CHAMBER OF PATENT DISPUTES) DATED APRIL 29, 2019)

Krasnyy Oktyabr PJSC filed an appeal against granting legal protection to "KOROVKA IZ VKUSNYAEVO" (A COW FROM VKUSNYAEVO) under certificate No. 668538 issued in the name of Chelny Kholod OJSC.



Trade mark No. 668538

The appeal was based on the fact that the disputed trade mark under certificate No. 668538 was confusingly similar to the trade marks of Krasnyy Oktyabr under certificates Nos. 152452, 199900, 360768, 387797, 476747, 486279, 511541, and 511542 having earlier priority dates and registered with regard to similar goods. Having studied the documents on file, the Chamber of Patent Disputes decided that the fact that there was a phonetically and semantically identical "KOROVKA" word element in the trade marks under consideration resulted in their association with each other in general.

The phonetic similarity of the "KOROVKA IZ VKUSNYAEVO" word element of the disputed trade mark and the "KOROVKA" trade marks was due, in particular, to inclusion of one designation in the other one.

The appeal was based on the fact that the disputed trade mark under certificate No. 668538 was confusingly similar to the trade marks of Krasnyy Oktyabr under certificates Nos. 152452, 199900, 360768, 387797, 476747, 486279, 511541, and 511542 having earlier

mined, first of all, by the "KOROVKA" noun, on which there is a logical stress in the "KOROVKA IZ VKUSNYAEVO" phrase, which evidences that there is semantic similarity to the opposed series of trade marks united by the "KOROVKA" element. The "IZ" preposition and the "VKUSNYAEVO" word element characterize the "KOROVKA" word and do not significantly change the semantic meaning of the phrase under consideration.

From the point of view of the visual similarity criterion, there are some graphic differences in the trade marks under comparison due to additional elements in such trade marks. However, it should be noted that the disputed trade mark contains a stylized image of the cow's head with a chamomile in its teeth, causing similar associations with the images of a cow in the Krasnyy Oktyabr's trade marks, which enhances the similarity of the marks under comparison.

At the same time, the role of the visual criterion cannot be acknowledged as determinant, since, in this case, the factors of phonetic and semantic similarity, which ensure the association of the designations under comparison with each other, are decisive.

Thus, the disputed trade mark and the trade marks are similar in general, despite some differences. On this basis, the panel invalidated the grant of legal protection to the "KOROVKA IZ VKUSNYAEVO" trade mark with regard to a number of goods, such as ice cream, caramel, sorbet, and frozen yoghurt.

ROSPATENT CONFIRMED THAT THE DESIGNATION INCORPORATING A SURNAME IS SOCIALLY IMPORTANT, EVEN THOUGH THE SURNAME DOES NOT BELONG TO A REAL PERSON (DECISION OF ROSPATENT (CHAMBER OF PATENT DISPUTES) MAY 27, 2019)

Rospatent considered an appeal filed by Intellect i Pravo LLC against the decision refusing to register the "PSEVDONIM PLATOV" (ALIAS NAME PLATOV) trade mark under application No. 2017731294 and supported the appeal.

Refusing the applicant to register it, Rospatent noted that this designation contradicted the public interests. The point is that, during a visit to the Sirius educational centre in Sochi, Russian President Vladimir Putin, when answering questions from its students, told that he had used the alias name Platov during his studies at the intelligence school. Moreover, the facts relating to the biography of the head of the state nationally elected in the Russian Federation are important not only for his personal reputation, but also for formation of a public opinion and influence on the political sphere in the state headed by him, i. e., they also relate to the public interests.

It follows that the above alias name inextricably associated with the head of the state, Russian President Vladimir Putin, and brought to the public knowledge before the filing date of the application under consideration acquired the status of a socially important name, which should be used in the Russian Federation under enhanced control of the public.

Therefore, there is no way that such designation can be, in fact, a means of individualization of goods and services of a private person for its use in business activities, i. e., for deriving profit. This would imply giving such person unreasonable advantages over other market actors and using the reputation of the head of the state and of the Russian Federation headed by him for private



Trade mark No. 152452

**КОРОВКА
KOROVKA**

Trade mark No. 199900

КОРОВКА



Trade mark No. 387797

Trade mark No. 360768



Trade mark No. 476747



Trade mark No. 486279



Trade mark No. 511541



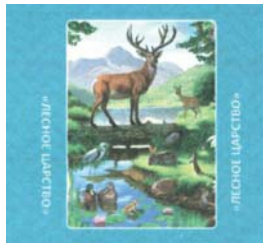
Trade mark No. 511542

The semantic meaning of the disputed trade mark is deter-

business purposes without their express consent, which could damage their reputation and, as a result, cause dissatisfaction of the public. It is obvious that this contradicts public interests connected both with the principles of equality of all market actors and with respect of the citizens of the Russian Federation to the head of the state. These facts lead to the conclusion that the claimed “PSEVDONIM PLATOV” designation contradicts the public interests and cannot be registered as a trade mark.

THE “LESNOE TSARSTVO” (FOREST KINGDOM) WITH A DEER AND “МИШКА КОСОЛАПЫ” (CLUMSY BEAR) WITH BEARS DESIGNATIONS ARE NOT SIMILAR TO EACH OTHER (DECISION OF ROSPATENT (CHAMBER OF PATENT DISPUTES) DATED JUNE 04, 2019)

Lakond and Co filed an appeal with the Chamber of Patent Disputes against the Rospatent’s decision to refuse registration of the “LESNOE TSARSTVO” designation under application No. 2018711209 as a trade mark.

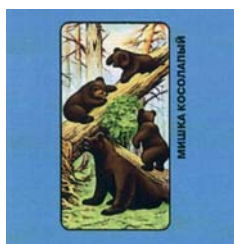


Designation under application for trade mark No. 2018711209

The claimed designation is a combination of the word combination “LESNOE TSARSTVO” and stylized images of animals — a deer, a roe deer, a hare, a hedgehog, ducks, a heron, a frog, and a groundhog located against the background of mountains, river, and forest.

Based on the results of expert examination of this designation, Rospatent came to the conclusion that it was confusingly similar to a number of trade marks previously registered for similar goods.

The opposed marks are wrappers of sweets consisting of the “МИШКА КОСОЛАПЫЙ/МИШКА КОСОЛАПЫ” word designation and a stylized image of bears in the forest located against the background of a rhomb or rectangle.



“МИШКА КОСОЛАПЫ” trade marks

Having conducted a comparative analysis of the claimed designation and the opposed marks, the panel of the Chamber of Patent Disputes came to the conclusion that they were not confusingly similar, since they were not associated with each other in general for the following reasons. The combined designations under comparison contain different word elements “LESNOE TSARSTVO” and “МИШКА КОСОЛАПЫЙ/МИШКА КОСОЛАПЫ” as well as “Krasnyy

Oktyabr”; therefore, they differ in phonetic and semantic characteristics.

The main figurative elements of the designations under comparison also differ significantly, since they show different animals — in one case it is a deer with branching horns, a heron, a roe deer, a hare, a hedgehog and ducks on the background of ponds and in another case there are images of a bear and three cubs on the background of a fallen tree.

As to similar composition design of the claimed designation and the trade mark as well as their similar background colour, where the word and figurative elements are located, these factors are related to the secondary characteristics of similarity and do not significantly influence similarity of the designations in general.

On this basis, the designations under comparison are acknowledged by the panel as dissimilar, therefore, there is no fundamental possibility for a consumer to have an idea that the claimed goods are owned by one manufacturer if they are marked with the designations under comparison, and there is no reason to refuse registration of the “LESNOE TSARSTVO” designation as a trade mark.

THE “MINI MAXI” AND “MINI M MAX” DESIGNATIONS ARE NOT SIMILAR DUE TO THE DIFFERENCE IN THE IMAGES FORMED (DECISION OF ROSPATENT (CHAMBER OF PATENT DISPUTES) DATED MAY 14, 2019)

Rospatent refused to register the “MINI MAXI S Lyubovyyu k Detyam” (MINI MAXI With Love for Children) trade mark under application No. 2017703856 due to its similarity to the “Modnyy MINI M Max” (Fashionable MINI M Max) mark previously registered under certificate No. 411234. The applicant filed an appeal against this decision with the Chamber of Patent Disputes.

Mini Maxi
С любовью к детям

Модный
MINI M MAX

Designation under application for trade mark No. 2017703856

Trade mark No. 411234

Considering this dispute, the panel noted that the most powerful, original element ensuring the semantic meaning of the designation as a whole in the claimed designation was the “S Lyubovyyu k Detyam” element, while the perception of the opposed trade mark started with the unprotectable “Modnyy” element, which, together with the weak “Mini m Max” elements, contributed to form another composition differing from the claimed designation in its composite design and semantic connotation.

Despite the affinity in sounding and the same semantic meaning of the “MINI”, “MAXI”/“Mini m Max” elements, the designations under comparison have phonetic differences due to the “Modnyy”/“S Lyubovyyu k Detyam” elements.

The semantic meaning laid down in the designations under comparison differs, since the claimed designation contains an image of affection, love for children, while the opposed trade mark is not directly related to children and forms an image of fashionable clothes to fit every taste. The visual differences of the designations under comparison are achieved due to the different visual impression formed by the use of a different font, when writing word elements,

as well as due to the different composition arrangement of word elements in space.

Thus, taking into account all above features, the panel came to the conclusion that there is no similarity between the designations under comparison and that the goods bearing these designations would not be confused by a consumer in stream of commerce.

IAM v. I AM

An appeal was filed with the Chamber of Patent Disputes against granting legal protection to the “IAM Academy” trade mark under certificate No. 685586.

**IAM
ACADEMY**

Trade mark No. 685586

It was noted in the appeal that “IAM ACADEMY” word designation of the disputed trade mark is not a set phrase which has a meaning other than the words of which it consists and the expert examination of which should be conducted without dividing it into words.

I am

Trade mark No. 410731

The person who filed the appeal had a previously registered “I am” and “I AM STUDIO” marks under certificates No. 410731 and No. 654642, which are similar to the disputed trade mark. Besides that,

I AM STUDIO

Trade mark No. 654642

The panel of the Chamber of Patent Disputes considered the appeal and noted that the “IAM” word element consisted of solid English words, while, when written with a space between “I” and “AM” elements, it should be translated as “I” pronoun.

In addition, the disputed trade mark and the opposed trade mark are formed in the same way — the first position is taken by the “IAM”/“I AM” elements and the second one is taken by the “ACADEMY”/“STUDIO” elements, which are the generic names of a company (“academy”/“studio” in English). The similarity of marks is also enhanced by the fact that the word elements are made of the letters of the same alphabet.

Thus, the panel concluded that, despite some differences, the designations under comparison were associated with each other and the disputed trade mark could be perceived by consumers as a chain of trademarks owned by the person who filed the appeal. On this basis, the disputed mark was cancelled with regard to those goods that were common for it and for the opposed marks.

THE DESIGNATION MAY CHARACTERIZE OR EVALUATE SERVICES IF IT, DIRECTLY AND WITHOUT SECOND-GUESSING, INDICATES THE TYPE, QUALITY, PROPERTY, OR PURPOSE (DECISION DATED APRIL 10, 2019 OF THE CHAMBER OF PATENT DISPUTES OF ROSPATENT UNDER APPLICATION No. 2017700941)

Rospatent refused to register the “MAFIASUSHI” designation under application No. 2017700941 as a trade mark, referring to the fact that, in the opinion of the ex-

aminer, it contradicted public interests and the principles of humanity.

MAFIASUSHI

Designation under application for trade mark No. 2017700941

The Rospatent’s decision was based on three theses:

- The claimed designation is just a combination of two words “MAFIA” and “SUSHI”;
- The “SUSHI” word element has no distinctiveness, since it indicates a certain type of goods;
- The claimed designation includes the “MAFIA” word element, which is the name of the criminal gang using blackmailing, violence, and murder.

The panel of the Chamber of Patent Disputes considered the applicant’s appeal against this Rospatent’s decision and noted that the designation might characterize or evaluate services if it, directly and without second-guessing, indicated the type, quality, property, or purpose, including those of laudatory character.

The “MAFIASUSHI” designation in the form as claimed as a trade mark is not capable to be unambiguously perceived as the name of a type of goods, since there is no such type of goods as “MAFIASUSHI” in nature.

Despite the fact that the claimed designation contains the “MAFIA” element, the meaning of the “mafia” word as the name of a criminal gang is not the only one: it has an ironic meaning as a “company, gathering”.

Thus, taking into account the semantics of all elements, the claimed designation can, for example, create the following image for a consumer: a company, gathering that is united by common interests related to sushi. In general, the claimed designation is capable of causing associations with the Japanese cuisine, manufacturing of sushi, etc., but not with the secret criminal Sicilian gang.

The panel also considers it necessary to point out that the issue of referring the “mafia” word to abusive or offensive vocabulary has already been analysed by court instances (case No. A71-10996/2011). The courts concluded that this word was not perceived as abusive, offensive or obscene, when used for marking, in particular, cafe’s services.

The panel also took into account that the applicant owned the “MAFIAFOOD” trade mark under certificate No. 668484, which evidenced the applicant’s good faith and intent to expand the number of trade marks containing the “MAFIA” word element.

MAFIAFOOD

Trade mark No. 668484

Thus, the panel has reason to believe that registration of the claimed designation in the applicant’s name will not contradict the public interests and the humanity principles and will not cause any negative attitude in the society.

THE COLOUR LAYOUT ITSELF CANNOT BE ACKNOWLEDGED AS AN INDIVIDUALIZING ELEMENT OF THE TRADE MARK (DECISION DATED APRIL 10, 2019 OF THE CHAMBER OF PATENT DISPUTES OF ROSPATENT UNDER APPLICATION No. 2017751930)

A designation under application No. 2017751930 was filed with Rospatent for registration as a trade mark with regard to umbrellas and sun umbrellas. This three-dimensional designation is an umbrella, which dome is painted as a slice of kiwi made in a combination of black, green, light green and brown colours.

Rospatent refused to register this designation, reasoning it with the fact that the claimed designation was a realistic image of goods, for which it was claimed, therefore, it had no distinctiveness. Besides that, this design of an umbrella is a variant of a usual umbrella design, it does not differ significantly from simple, common forms of these goods or from the forms expected by a consumer, which is confirmed by the use of similar umbrella designs by various manufacturers.

The applicant disagreed with this decision and filed an appeal with the Chamber of Patent Disputes. The panel of the Chamber noted that granting the exclusive right to goods of a common shape to one person would infringe the right to use such design with regard to similar goods by other parties on the market.

The dome of the claimed umbrella in the form of a slice of kiwi is a colour layout of the claimed designation; however, the colour layout of an umbrella does not change the impression from the presented umbrella as from an umbrella and cannot be recognized as an individualizing element of a trade mark.



Designation under application for trade mark No. 2017751930

However, the appeal did not prove that at the priority date of the application, consumers identified umbrellas with a picture in the form of a slice of a kiwi with the applicant only.

Thus, the panel concluded that the claimed designation contained no elements that allowed the consumer to identify the applicant's goods. Moreover, the colour layout is not unique for the claimed goods: umbrellas, which domes have green, light green, grey-brown-black colour combination, are offered for sale on the Internet. Based on the foregoing, the panel decided that the claimed designation could not be registered as a trade mark due to the fact that it had no distinctiveness.

NEWS

7–8 SEPTEMBER 2019 // EREVAN

Tatiana Pogrebinskaya, Ph.D., Counsel, Russian Trademark Attorney (Gorodissky & Partners, Moscow), took part in the IPRC's 3rd International Conference on Intellectual Property (Yerevan, Armenia) where gave a presentation on "Countering the spread of counterfeiting in the field of folk art crafts in Russia".

The focus was on issues related to the fight against counterfeiting and illegal import of goods with violation of rights of intellectual property and means of individualization, as well as possible methods of struggle, including through improving the legislative framework and law enforcement practice.

More than 40 lawyers and patent attorneys from 8 countries (Armenia, Belarus, Georgia, Kazakhstan, Latvia, Russia, Uzbekistan and Ukraine) attended the conference.

The conference was organized by the Intellectual Property Rights Center of Armenia (IPRC) and the Knyazyan & Partners IP Law Firm.

9 SEPTEMBER 2019 // NUR-SULTAN

Valery Medvedev, Managing Partner, Patent Attorney and Yury Kuznetsov, Partner, Head of Patent Practice, Russian & Eurasian Patent Attorney (both from Gorodissky & Partners, Moscow), took part in the diplomatic conference dedicated to the 25th anniversary of the Eurasian Patent Convention and adoption of the Protocol on protection of the Industrial Designs. One of the central events was the award cere-



PHOTO: VALERY MEDVEDEV

mony of the Eurasian Prize in the field of invention where Gorodissky & Partners received the award as the best patent attorney firm. From its part, Gorodissky & Partners awarded valuable prizes to all the EAPO prize-winning children in the field of invention.

11-12 SEPTEMBER 2019// MOSCOW

In connection with the 60th anniversary of its practice Gorodissky & Partners hosted the 10th annual Seminar. The seminar was successfully held in Moscow office and was dedicated to the current IP legislation in Russia, as well as a comparative analysis of Russian, Eurasian, European, US and Chinese IP practices.

The program consisted of three sessions: Patents, Trademarks and Legal aspects. The round tables on “Building relationship with external IP agents from in-house IP heads view”, “Design and trademark strategies in auto industry”, “Brand promotion strategy on domestic and international markets from a legal perspective”, “Geographical indications in wine industry”, with participation of the foreign co-speakers aroused great interest and lively discussions among the participants. Admittedly, the professional program of the Seminar was very practical. Topical issues of patent practice, such as “Hidden state of art – navigating through Russian-language information resources”, “Features of the Eurasian and national patent systems”, as well as “Strategies of patent protection for pharmaceutical compositions in Russia and in Eurasian countries”, were highlighted by patent attorneys of Gorodissky & Partners and the experts from the Eurasian



PHOTO: 10TH ANNUAL SEMINAR ATTENDEES

Patent Office. In their parts, the firm’s lawyers disclosed enforcement and litigation strategies, strategies for fighting IP rights infringements on the Internet, features of licensing and franchising in that country and the nuances of “legal cleanups” of advertising materials and data protection in Russia. Among the invited speakers were representatives of the EAPO, Canon Europe Ltd., Alfa Laval Corporate AB, Ericsson, Studio Torta, J.P.Karsenty & Associed, Olshan, Frome, Wolosky, Valea, Unitalen and Gvaramadze Patent Bureau, whom we thank for vivid presentations and active participation in the Seminar discussions. The Seminar gathered over 45 IP attorneys and lawyers from Europe,

USA, China, India, Japan and other countries and ended with a Reception in the luxurious halls of the State Historical Museum, a partner of which Gorodissky & Partners is.

17 SEPTEMBER 2019// NOVOSIBIRSK

Leading specialists – Yury Kuznetsov, Partner, Head of Patent Practice, Russian & Eurasian Patent Attorney, Vladimir Trey, Partner, Russian Patent Attorney, Valery Narezhny, Ph.D., Counsel, Stanislav Rumyantsev, Ph.D., CIPP/E, Senior Lawyer (all from Gorodissky & Partners, Moscow), Natalia Nikolaeva, Partner, Russian Patent Attorney, Denis Titov, Regional Direc-



PHOTO: YURI KUZNETSOV

tor, Natalia Tikhonova, Lawyer (all from Gorodissky & Partners, Novosibirsk), Dmitry Yakovlev, Russian & Eurasian Patent Attorney (Gorodissky & Partners, St.Petersburg) and Denis Bessonov, Ph.D., Head of Revision, Audit and Methodological Support Department in Ural Federal University (Ekaterinburg), spoke at the sixth Seminar from the series dedicated to the Gorodissky & Partners 60th anniversary “Some aspects of protection and security of intellectual property for successful business development”.

The Seminar took place in the frames of Gorodissky IP School — the firm’s educational project.

18 SEPTEMBER 2019// NEW YORK

Ilya Goryachev, Senior Lawyer (Gorodissky & Partners, Moscow), spoke at the panel on the “Successful practi-



PHOTO: ILYA GORYACHEV

cal strategies to adopt in cross-border litigation” at MIP’s 4th Life Sciences Forum held in New York on September 18, 2019.

The session highlighted the particular problems posed by litigation in a cross-border context, and considered the strategies necessary to address and overcome these problems.

18-19 SEPTEMBER 2019// MOSCOW

Sergey Medvedev, Ph.D., LL.M, Partner (Gorodissky&Partners, Moscow), gave a presentation within the Franchising School program at the BUYBRAND Expo 2019 held in Moscow.

Sergey spoke about the legal and practical aspects of franchising, including the features of the relationship between the franchisor and the user, the obligations and responsibilities of the parties to the contract, antitrust issues and restrictions on the rights of the parties, financial issues and the use of the provided IP objects, and features of state registration of the right to use IP objects. Sergey also acquainted the audience with the most important recent court decisions in this area. In conclusion, Sergey answered additional questions and analyzed specific cases and situations of the participants. The event was attended by over 50 people, including lawyers and business representatives specializing in business development based on the franchising model.

18-20 SEPTEMBER 2019// NOVOSIBIRSK

Natalia Nikolaeva, Partner, Lead Lawyer, Trademark Attorney (Gorodissky & Partners, Novosibirsk), attended the VII International Forum of Technological Development Technoprom-2019. Natalia took part in the discussion on the use of recommendations of the Ministry of Economic Development of the Russian Federation for managing IP rights and in the round table on “Intellectual property of scientific and educational institutions — the foundation of the innovative development of the region”. The forum was organized by the Ministry of Economic Development of the Russian Federation, Russian PTO, the Ministry of Science and Innovation Policy of Novosibirsk Region and SPSTL SB RAS.

NEWS

24 SEPTEMBER 2019 // HELSINKI

Stanislav Rumyantsev, Ph.D., CIPP/E, Senior Lawyer, and Sergey Medvedev, Ph.D., LL.M, Partner (both from Gorodissky & Partners, Moscow) spoke on “E-commerce: Russian Privacy Rules v. GDPR” and “New Anti-Piracy Enforcement Strategies and Practices in Russia” at the seminar “Internet Business in Russia: Main Requirements and Risks according to legislation” organized by the Finnish-Russian trade chamber in Helsinki (Finland). The seminar, gathered about 20 participants, members of the Finnish-Russian trade chamber and received a high recognition of the audience.

25 SEPTEMBER 2019 // NAKHODKA

Nikolay Ptitsyn, Regional Director, Trademark Attorney, Daria Kaygorodova, Paralegal (both from Gorodissky & Partners, Vladivostok), made presentations on counterfeit good detection at the training seminar for Nakhodka customs officers which was organized by the Far Eastern Customs Administration in Nakhodka. The participants also discussed the capabilities of the customs authorities in identifying counterfeit goods that passed customs clearance and entered into civilian turnover. At the end of the event, customs officers asked questions of interest to them. The training aroused great interest among the participants.

26-27 SEPTEMBER 2019 // MOSCOW

Sergey Medvedev, Ph.D., LL.M., Partner, Stanislav Rumyantsev, Ph.D., CIPP/E, Senior Lawyer (both from Gorodissky & Partners, Moscow), made presentations on “Personal data on the Internet: an asset or business risk?” and “Protect your website: problems and solutions” at the International Conference “E-Commerce: Legal aspects” held by the Business Way Forum. The following questions were highlighted at the conference: managing the risks connected with online contracts, preventing fraud with electronic payments, using big data in e-commerce and others.

26-27 SEPTEMBER 2019 // NIZHNY NOVGOROD

Valery Medvedev, Managing Partner, Russian & Eurasian Patent Attorney (Gorodissky & Partners, Moscow),



PHOTO: VALERY MEDVEDEV

made a presentation on “Modern role of IP in business” at the International Digital Summit 2019 held in Nizhny Novgorod. Plenary session “National strategy of intellectual property management” was attended by such prominent figures as Gleb Nikitin, Governor of Nizhny Novgorod region, Aleksey Dmitrienko, member of the economic policy Committee of the Federation Council of the Russian Federation,

Andrey Kashevarov, Deputy head, Federal Antimonopoly service, Lyubov Kiri, Deputy head of the Federal service for intellectual property, Emil Mammadov, Vice-President of the Eurasian patent office (EAPO) and many others.

27 SEPTEMBER 2019 // NIZHNY NOVGOROD

Sergey Dorofeev, Partner, Russian & Eurasian Patent Attorney, Vladimir Mescheryakov, Counsel, Valery Narezhny, Ph.D., Counsel, Maxim Gorbachev, Russian & Eurasian Patent Attorney, Tatiana Pogrebinskaya, Ph.D., Counsel, Trademark Attorney (all from Gorodissky & Partners, Moscow), Albert Ibragimov, Partner, Regional Director, Russian & Eurasian Patent Attorney (Gorodissky & Partners, Kazan), made a series of presentations at the seminar “Development of national intellectual fund. Features of patenting in Russia and abroad” which was organized by Gorodissky & Partners in conjunction with the Scientific and Educational Centre of the Nizhny Novgorod region and Nizhny Novgorod State Technical University n.a. Rostislav Alexeev, and supported by the Ministry of Information Technologies of the Nizhny Novgorod region and the Ministry of Education, Science and Youth Policy of the Nizhny Novgorod region. Gorodissky & Partners’ patent attorneys and lawyers took part in a series of round tables: “Intellectual property as one of the most important business assets”, “Long-term development strategy of the Russian Federation in the field of intellectual property. Revival, preservation and development of folk art crafts”, “Staff trainings for work with IP”.



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