

IP LAW FIRM GORODISSKY & PARTNERS INFORMATION BULLETIN

GORODISSKY & PARTNERS
50 years
1959-2009
ГОРОДИССКИЙ И ПАРТНЕРС

 GORODISSKY
& PARTNERS

#58

BLACK PEARLS, page 1

GORODISSKY & PARTNERS AT THE INTA MEETING, page 2

OFFICIAL FEES CHANGED, page 3

OUR NEW PATENT ATTORNEY, page 3

FIRM'S NEWS, page 4

#1 (58) 2009, MOSCOW, RUSSIA



GORODISSKY & PARTNERS LAUNCHED A NEW OFFICE IN PERM CITY

614019 PERM, Komsomolsky prosp., 70A
Phone: +7 (342)215- 58-35, Fax: +7 (342) 215-58-34
E-mail: gorodissky-perm@inbox.ru



OKSANA TSEPOVA, RUSSIAN TRADEMARK ATTORNEY, GORODISSKY & PARTNERS (SAMARA)

PASSIONS OF PEARLS

What can a registration of a trademark confusingly similar to a previously registered trademark bring about? Is it a cause to celebrate, when such registration has been obtained? In April 2007 a famous Russian Kalina company of Ekaterinburg city filed a claim against a major chocolate sweets producer from Samara city.



The ground of action was the allegation that a chocolate sweets producer - Samarskiy Konditer company infringed a CHYORNIY ZHEMCHUG (rendered as «Black Pearls») trademark (certificate № 304922), legal protection of which included producing confectionery and chocolate sweets.

Kalina was the holder of the trade-

mark right in question with the priority date of July 28, 2004. The plaintiff demanded that the Samara company cease infringing its mark, that it undertakes to make public the matter at the company's own expense, and that it pays damages of 1 000 000 roubles (about 30.000 US dollars).

It should be noted that Samarskiy

Konditer company has been supplying customers for over 8 years and is one of the largest producers of confectionery in Samara city and the Samara region with an annual sales turnover of some hundreds of millions of roubles.

Indeed, our client Samarskiy Konditer had been using the Chyorniy Zhemchug designation on its confectionery packaging, but this was in the belief that such use was fully legal.

In the beginning of 2004, our client approached our office with the task of registering the Chyorniy Zhemchug designation which it had been using on its confectionery. A preliminary search revealed a CHYORNAYA ZHEMCHUZHINA



(meaning «A Black Pearl») trademark (certificate №176966), registered on behalf of May company (Moscow) with a priority of November 19, 1997, covering goods and services relating to Classes 29, 30, 31, 32 & 44 of the Nice

household chemicals and perfumery producer?» The answer to this question may be found in the statement of claim of Kalina that turned up on the table of the Samarskiy Konditer management almost immediately after said trademark had been published in the Russian Official Register on May 25, 2006.

other, not word combinations that were known phrases. The similarity of the first words of the designations «Chyorniy» and «Chyornaya» were alleged not to materially contribute to any similarity of the designations as a whole. Furthermore, the word «zhemchuzhina» («a pearl») could have completely different meanings, as in, for example, «the Nordic pearl» or «the pearl of the Orient» etc. At the sitting of the Board of the Chamber which considered the filed objection, we asked the following question: «Why does Kalina use the graphic element of one black pearl next to the «Chyorniy

ONE WOULD LIKE TO BELIEVE THAT REGISTRATIONS LIKE THE ONE DESCRIBED ARE ONLY ISOLATED INCIDENTS, AND THAT THE SWEET TASTE OF JUSTICE, LIKE THE SWEET TASTE OF CHYORNAYA ZHEMCHUZHINA CONFECTIONERY ITSELF, WILL PREVAIL. ALL THE MORE SO AS THE CHYORNAYA ZHEMCHUZHINA TRADEMARK HAS TRULY BECOME THE MOST «PRECIOUS» AMONG 20 TRADEMARKS OF SAMARSKIY KONDITER.

International Classification of Goods and Services (ICGS). The CHYORNIY ZHEMCHUG designation was determined to be confusingly similar to the revealed trademark, which in fact interfered with further progress of the application on behalf of Samarskiy Konditer.

Our advice to the client was to hold negotiations with May company which owned the CHYORNAYA ZHEMCHUZHINA trademark, and in 2005, as a result of a partial assignment, Samarskiy Konditer became the legal holder of the right to the CHYORNAYA ZHEMCHUZHINA trademark (certificate № 289344) in class 30.

Since the word combinations CHYORNIY ZHEMCHUG and CHYORNAYA ZHEMCHUZHINA are related and interchangeable designations, Samarskiy Konditer used both names on its products. The existence of the CHYORNIY ZHEMCHUG word trademark registration (certificate № 304922), granted to the famous perfumery manufacturer Kalina, became known to us from the received statement of claim of Kalina. The list of goods covered by the trademark included foodstuffs, in particular confectionery and chocolate sweets. This trademark had a priority date of July 28, 2004, which is almost 7 years later than the priority of the above CHYORNAYA ZHEMCHUZHINA trademarks.

Now a question arises: «How, and above all, for what purpose was the CHYORNIY ZHEMCHUG trademark registered in connection with confectionery in the name of the company, which is well-known throughout the country as a



In May 2007 Gorodissky & Partners filed an objection with the Chamber of Patent Disputes of the Russian Patent Office (the Chamber) against the legal protection of the CHYORNIY ZHEMCHUG trademark (certificate № 304922) with respect to goods and services relating to Classes 29, 30, 31, 32 & 44. In this objection we asked the Chamber to cease protection of the aforesaid trademark on the grounds that it had been registered in violation of the requirements established by art. 7 (1) of the Russian Trademark Law, the mark being confusingly similar to the earlier CHYORNAYA ZHEMCHUZHINA trademarks (certificates № 176966, and № 289344) covering similar goods and services. In addition to the semantic argument, the objection documents contained numerous materials from dictionaries and reference books, as well as from other sources proving interchangeability of the compared word combinations. Specific similarity of the discussed phrases was also shown - they embody one and the same sensory and visual image of black pearls, which is the rarest, most unique and precious kind of pearls. But Kalina, in reply to the objection, argued that the trademarks under consideration consisted of separate words semantically unconnected with each

Zhemchug» word combination, and not a beautiful black girl, who would more readily be associated with, for example, «The Pearl of Africa», when Kalina applies its trademarks on perfumery and household chemicals?» The Kalina representative could find no answer to our question...

The Chamber accepted our objection, and in May 2007 issued a Decision of early termination of legal protection of the CHYORNIY ZHEMCHUG trademark (certificate № 304922) with respect to the goods and services specified in the objection.

One would like to believe that registrations like the one described above are only isolated incidents, and that the sweet taste of justice, like the sweet taste of CHYORNAYA ZHEMCHUZHINA confectionery itself, will prevail. All the more so as the CHYORNAYA ZHEMCHUZHINA trademark has truly become the most «precious» among 20 trademarks of Samarskiy Konditer.

NIKOLAY BOGDANOV, PARTNER, COUNSEL, GORODISSKY & PARTNERS (MOSCOW)

NEW STATUTE ON OFFICIAL PATENT FEES

BY VIRTUE OF DECREE № 941 DATED DECEMBER 10, 2008 THE GOVERNMENT OF THE RUSSIAN FEDERATION RATIFIED A NEW «STATUTE ON PATENT AND OTHER FEES FOR LEGALLY RELEVANT ACTIONS RELATING TO A PATENT OF AN INVENTION, A UTILITY MODEL, A DESIGN, STATE REGISTRATION OF A TRADE MARK AND A SERVICE MARK, STATE REGISTRATION AND GRANT OF THE EXCLUSIVE RIGHT TO AN APPELLATION OF ORIGIN, AS WELL AS TO STATE REGISTRATION OF TRANSFER OF THE EXCLUSIVE RIGHT TO ANY OTHER PERSON AND AGREEMENTS OF DISPOSITION OF SAID RIGHTS» (STATUTE).

mark owner or an appellation of origin owner, or recognition of trade mark registration activities as an act of unfair competition, have grown 3-5 fold. The new Statute retained a «double scale» of fees relating to the patenting of inventions, utility models and designs. The fees for non-residents are some 4.5 times as much as compared to the amount residents have to pay. Yet the fees relating to the patenting of inventions, utility models and designs for residents have almost doubled in



The new Statute has taken into account the amendments connected with entry into force of Part IV of the Civil Code of the Russian Federation.

The new Statute was published on December 22, 2008 and took effect on December 30, 2008.

The Decree of the Government on approval of the Statute comprises no transitional provisions, but one may conclude from the regulations of the previously effective Statute, and the new one, that the amount of the prescribed fees for any action is determined by the date of filing an appropriate document or an application, petition, request or objection.

All Official fees are established and collected in roubles only.

As before, fees pertaining to trade marks and appellations of origin have been harmonized with regard to all persons. At the same time, previous fees connected with trade marks and appellations of origin have been largely retained. A number of fees, though (for example, for filing and examining an application, considering objections and requests), have been increased by approximately 20%-25 %, and some of them, in particular, those for introducing amendments in an application, considering a request for cessation of legal protection in the case of winding-up (termination of business activities) of a trade

absolute terms. The reason for such an increase in the fees for filing and examining an application for a group of designs is that additional fees are now collected for each design above one (earlier it was above five).

It should be evident that the new patent fees for non-residents are derived from the conversion of the previous fees in US dollars into roubles, according to the exchange rate of 27 roubles for one US dollar. Thus, taking into consideration fluctuations of the exchange rate, one may state that fees for non-residents have actually been lowered to some extent. Besides, a non-resident applicant from a State member of the Paris Convention included in the list of States published by WIPO, where the Gross National Product is below 3000 US dollars per capita, pays 25% of the fee established for non-residents. The above provision applies to several fees (pertaining to patents, utility models and designs).

Also, the new Statute now fixes many payments previously paid according to tariffs set by the Russian PTO, in particular in connection with procedures for international applications of the Patent Cooperation Treaty, Madrid System, as well as with patent searches, etc.

What is significant is that, according to the new Statute, fees may be paid both by the applicants as well as by their representatives (patent and trademark attorneys).

DR. ELENA LUBYAKO, RUSSIAN PATENT ATTORNEY, EXPERT



Graduated from the Moscow State Lomonosov Academy of Fine Chemical Technology as a chemist specialized in synthesis of biologically active compounds, then – from Russian State Institute of Intellectual Property (Moscow). Holds a Doctor degree in law.

Started her career as a researcher in Shemyakin and Ovchinnikov Institute of Bioorganic Chemistry (Moscow), then for a few years worked as an examiner in the Russian Patent Office. In 2005 joined «Gorodissky & Partners».

Specializes in patents in the fields of organic chemistry, medicine, biologically active substances, pharmaceuticals. Speaks English. Leisure – knitting.

WE ARE GLAD TO INFORM OUR COLLEAGUES AND CLIENTS THAT ELENA LUBYAKO, SENIOR EXPERT OF THE CHEMISTRY, MEDICINE AND BIOTECHNOLOGY DEPARTMENT, SUCCESSFULLY PASSED THE EXAM AND BECAME RUSSIAN PATENT ATTORNEY!

131ST INTA ANNUAL MEETING



THE TEAM OF 10 LEADING PROFESSIONALS FROM GORODISSKY & PARTNERS MOSCOW AND ST. PETERSBURG OFFICES IS GOING TO TAKE PART AT THE 131ST INTA ANNUAL MEETING ON MAY 16-20, 2009 IN SEATTLE AND WILL BE GLAD TO SEE OUR FOREIGN ASSOCIATES AND FRIENDS:

– at «Gorodissky & Partners» Open Day with refreshments and snacks on May 17, 2009 from 1 p.m. to 5 p.m.
– in our Hospitality Suite which will be open for scheduled meetings and discussions on May 18-19, 2009 from 9 a.m. to 5 p.m.

Please contact us in advance in case of your interest. Venue: Sheraton Seattle Hotel and Tower (Jefferson room).

NEWS

GORODISSKY & PARTNERS SCHOLARSHIPS

Four Gorodissky & Partners scholarships were granted to students of the Russian State Institute of Intellectual Property for 2008-2009 academic year. The scholarships are granted annually to distinguished students upon recommendation of the Institute.

NOVEMBER 2-4, 2008, GURGAON, NEW DELHI

Vladimir Biriulin, Partner, Sergey Dorofeev, Partner, and Alexander Nesterov, Trademark Attorney (all of Gorodissky & Partners, Moscow), were among the speakers at the First BRIC (Brazil, Russia, India, China) IP Forum dedicated to common aspects of IP issues and peculiarities faced by IP specialists in emerging markets. They gave



PHOTO: (FROM LEFT TO RIGHT): VLADIMIR BIRIULIN, GORODISSKY & PARTNERS (RUSSIA), VIDYA SAGAR, REMFRY&SAGAR (INDIA), RANA GOSEIN, DANIEL ADVOGADOS (BRAZIL)

their presentations on «Infringement of intellectual property rights in Russia», «Drafting and construing patent claims in Russia and

Eurasia» and «Licenses, non-use, well-known marks in Russia». Remfry & Sagar (India) hosted the Forum. Among the co-organizers were also Daniel Advogados (Brazil), CCPIT (China). The Forum gathered about 60 attendees from India, Germany, Italy, Great Britain, USA and other countries.

ILLUSTRATED BOOKS FOR WEAK-EYED CHILDREN

3 years running Gorodissky & Partners keeps participating in the charity programme «Books for Gifts». This year 10 more weak-eyed children received from the firm illustrated embossed books as New Year gifts.

NOVEMBER 6, 2008, USA

«Patent claim interpretation. Global edition» (Editor in chief – Edward D. Manzo, Attorney at Law, Cook Alex Ltd.) was released for distribution. The 2008 book covers 22 countries. Valery Medvedev, Managing Partner, and Dr. Valery Djermaakian, Counsel (editor) (both of Gorodissky & Partners, Moscow) contributed to Chapter 15 – Russia. On November 18, 2008, Sergey Dorofeev, Partner (Gorodissky & Partners, Moscow), together with some other contributors to the book from Australia, China and Netherlands participated in the internet web-cast on patent claim interpretation which lasted for about 90 minutes and involved audience from the U.S. and Europe.

NOVEMBER 18-21, 2008, THE MOSCOW REGION

Vladimir Mescheriakov, Counsel (Gorodissky & Partners, Moscow), gave a presentation «Main IP issues not settled by Chapter IV of the Russian Civil Code» at the XIV Conference «330 days with Chapter IV of the Russian Civil Code» of the Association of Russian Patent Attorneys. Topic issues relating to patent attorneys activity under the new legislation were considered, including legal and methodological aspects thereof, cooperation with the Russian PTO, defending IP rights in courts and administrative bodies, etc. Attorneys and lawyers from the Russian regions as well as from Germany, Ukraine, Belarus, Kazakhstan and other countries attended the conference.

NOVEMBER 26-27, 2008, EKATERINBURG

Gorodissky & Partners together with Administration of Sverdlovsk region held VI Annual IP Conference «Intellectual Property: from reliable protection to effective management». Attorneys and lawyers from Gorodissky & Partners Moscow, St. Petersburg and Ekaterinburg offices headed by Valery Medvedev, Managing Partner, were the speakers. Boris Simonov, Head of the Russian PTO, and his Deputy Alexander Korchagin, were also among the speakers. This year Conference gathered more than 270 attendees: managers of companies, senior officials, lawyers, patent specialists from Sverdlovsk, Chelyabinsk, Orenburg, Novosibirsk, Tyumen, Kurgan, Yaroslavl regions, Perm territory and Udmurt Republic.

NOVEMBER 27, 2008, KAZAN

IP seminar «Topic issues of IP protection today» was held by Gorodissky & Partners in Kazan. Main speakers were Valery Medvedev, Managing Partner, Sergey Dudushkin, Senior Partner, Vladimir Biriulin, Partner (all of Gorodissky & Partners, Moscow), Albert Ibragimov, Director, Patent attorney (Gorodissky & Partners, Kazan). Officers of Tatarstan Republican ministries and offices, CEO's of regional companies, firms and R & D centers, Chamber of Commerce and Industry, other non-governmental organizations, mass-media were among the attendees.

GORODISSKY & PARTNERS HEAD OFFICE

129090, **MOSCOW**, Russia
B. Spasskaya str., 25, bldg. 3
Phone: +7(495) 937-61-16 / 61-09
Fax: +7(495) 937-61-04 / 61-23
e-mail: pat@gorodissky.ru
www.gorodissky.com

BRANCH OFFICES (RUSSIA)

197046, **ST. PETERSBURG**
Kamennooostrovsky prosp., 1/3, of. 30
Phone: +7(812) 327-50-56
Fax: +7(812) 324-74-65
e-mail: patent@gorodissky.spb.ru

350000, **KRASNODAR**
Krasnoarmeiskaya str., 91
Phone: +7(861) 210-08-66
Fax: +7(861) 210-08-65
e-mail: gorodissky@mail23.ru

620026, **EKATERINBURG**
Kuibysheva str., 44, office 311
Phone: +7(343) 359-63-83
Fax: +7(343) 359-63-84
e-mail: gorodissky-ural@wtc-ural.ru

603000, **N. NOVGOROD**
Kostina str., 4, office 400
Phone: +7(831) 278-69-78
Fax: +7(831) 430-73-39
e-mail: gorodissky@sandy.ru

443096, **SAMARA**
Ossipenko str., 11, offices 410-412
Phone: +7(846) 270-26-12
Fax: +7(846) 270-26-13
e-mail: gorodissky@sama.ru

420107, **KAZAN**
Peterburgskaya str., 50, bldg. 5,
office 104 A
Phone: +7(843) 247-22-44
Fax: +7(843) 570-54-25
e-mail: kazan@gorodissky.ru

614010, **PERM**
Komsomolsky prosp., 70 A,
Phone: 7 (342) 215-58-35
Fax: +7 (342) 215-58-34
e-mail: gorodissky-perm@inbox.ru

BRANCH OFFICE (UKRAINE)

01135, **KIEV**
V. Chornovola str., 25, office 3
Phone: +380(44) 501-18-71
Fax: +380(44) 279-68-96
e-mail: office@gorodissky.ua
www.gorodissky.ua