

IP LAW FIRM GORODISSKY & PARTNERS INFORMATION BULLETIN

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#60

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WE ARE No1 IN RUSSIA AGAIN!



In 2008 IP law firm Gorodissky & Partners was acknowledged the leading Russia firm on patents and trademarks for the 10th consecutive year (MIP World IP Survey)

IRINA ROGAL, PARTNER, TRADEMARK ATTORNEY, GORODISSKY & PARTNERS (MOSCOW)

NAPOLEON: A NEW SONG ABOUT AN OLD DESIGNATION

Business practice shows that the manufacturers of so-called «marketable goods» are eager to use designations that have already been about and which have gained popularity as product names.



When such names are used for similar goods, the products easily achieve a good position on the market, because consumers are familiar with the name, and from the very beginning the name gives rise to positive emotions. Nevertheless, it is not easy to obtain a trademark registration for such

a designation, because in such a case absolute ground may be applied and the mark will be rejected. Usually, Office Actions are justified, but in some cases a careful analysis will lead to arguments sufficient to overcome an Examiner's objection, resulting in the granting of the trademark registration for the

goods and services of interest to an applicant.

The case discussed in the article is that of the mark NAPOLEON, for which Russkaya Prodovolstvennaya Kompaniya (Russian Food Company), Kirov city, filed a trademark application in respect of all the goods in Class 30. Here it needs to be noted that Napoleon in Russia is a name for a very popular, even famous, type of cakes – custard slice or mille-feuilles.

The registration was granted, but within a limited scope of protection – cereal preparations, condiments, and some pastries, including pizzas. However, all types of confectionery and some of pastries were rejected, in particular cakes.

THE CASE DISCUSSED IN THE ARTICLE IS THAT OF THE MARK **NAPOLEON**, FOR WHICH RUSSKAYA PRODOVOLSTVENNAYA KOM-PANYA (RUSSIAN FOOD COMPANY), KIROV CITY, FILED A TRADE-MARK APPLICATION IN RESPECT OF ALL THE GOODS IN CLASS 30

The Examiner referred to the fact that the designation **NAPOLEON** was a generic term in respect of certain cakes, so it was unprotectable. Also, an absolute ground objection was used in the conclusion where it was stated that in respect of the other rejected goods said designation was misleading.

The applicant as a manufacturer of pastries, mainly cookies, pastilles, waffles, gingerbread, sweets, etc., was interested in registering the said designation in respect of those particular goods which had been rejected.

Therefore, upon receipt of the Office Action, the Russian Food Company requested **GORODISSKY & PARTNERS** to prepare a report on the feasibility of opposition.

The analysis of the Action revealed that it contained some conflicting approaches to the selection of allowed goods, e.g. pizzas were allowed while cakes were rejected, and some of the goods were

rejected without any grounds; moreover, the Examiner's argument that consumers might be misled in respect of confectionery products other than cakes, such as gingerbread, waffles, cookies and pastilles, seemed questionable.

HERE IT NEEDS TO BE NOTED THAT **NAPOLEON** IN RUSSIA IS A NAME FOR A VERY POPULAR, EVEN FAMOUS, TYPE OF CAKES – CUSTARD SLICE OR MILLE-FEUILLES

Nevertheless, the Office Action of Reject was based on broad absolute grounds, leaving little hope of success to our client. When the client considered our report he decided to oppose the Office Action of Reject, so we drafted an Appeal and filed it with the Chamber of Patent Disputes.

The arguments of the Appeal could be summarized as follows:

– the designation **NAPOLEON** was descriptive only in respect of certain cakes; – therefore relative to the other goods (such as cookies, waffles, gingerbread, sweets) the trademark was of imaginative character, not containing any false information about the goods or its manufacturer;

– the designation **NAPOLEON** could not mislead consumers in respect of other pastries (such as cookies, waffles, gingerbread, sweets), excluding certain cakes;

– products such as cookies, waffles, gingerbread and toffees present an independent group of products; they are

produced following quite different formulations, and the packaging always mentions the type of product which prevents any possibility of confusion with mille-feuilles.

Having considered the Appeal the Chamber of Patent Disputes accepted our arguments, noting that the word **NAPOLEON** in respect of goods in Class 30 might be associated by consumers with one type of cake only, while in respect of all other goods in Class 30 it was an imaginative word.

The Chamber of Patent Disputes allowed the registration of the trademark **NAPOLEON** for all the goods of interest to our client.

WE ARE GLAD TO ADVISE OUR COLLEAGUES AND CLIENTS THAT MORE OUR IP PROFESSIONALS SUCCESSFULLY PASSED THE EXAMS AND BECAME RUSSIAN PATENT ATTORNEYS!

ELENA KONDAKOVA,
RUSSIAN PATENT ATTORNEY
CHEMISTRY, MEDICINE AND BIOTECHNOLOGY DEPARTMENT
GORODISSKY & PARTNERS (MOSCOW)



Graduated from the Moscow Lomonosov State Academy of Fine Chemical Technology as a biotechnologist, specializing in molecular and cell biotechnology.

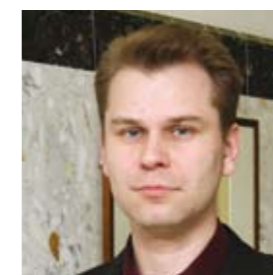
Started her career as a researcher in the Research Institute of Genetics and Selection of Industrial Microorganisms and in the Research Center "Bioengineering" of the Russian Academy of Science.

From 2001 till 2005 worked as an examiner in the Russian PTO.

In 2005 joined Gorodissky & Partners. Specializes in patenting of inventions in the fields of biotechnology, biochemistry, molecular biology and medicine.

Speaks English.
Leisure – literature.

ALEXANDER KUREPIN,
RUSSIAN PATENT ATTORNEY
MECHANICS DEPARTMENT
GORODISSKY & PARTNERS (MOSCOW)



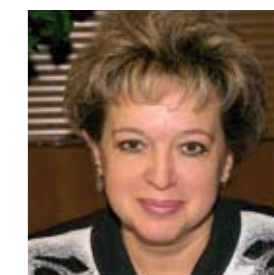
Graduated from the Russian State Tsiolkovsky Technology University (Moscow), master of engineering and technology, and from the Russian Institute of Intellectual Property (Moscow).

In 2000-2004 worked as an examiner in the Russian PTO and in the Chamber of Patent Disputes.

In 2004 joined Gorodissky & Partners, where focuses on patenting of inventions and utility models in the field of construction, mining, apparatus and general engineering.

Speaks German.
Leisure – sports.

ELENA BAIKOVSKAYA,
RUSSIAN PATENT ATTORNEY
GORODISSKY & PARTNERS (EKATERINBURG)



Graduated from the Kirov Urals Polytechnic Institute in 1982, engineer-technologist, then – from the Higher State Courses of post graduate education on patenting and inventions (Moscow, 1988) and from the Institute of Industrial Property and Innovations (Moscow, 1992).

Started her carrier at the Urals plant for transport machinery (Ekaterinburg) as an engineer-technologist, then as a Head of Patent and Technical information bureau.

In 1997 Elena was awarded the title "The best patent specialist of the Russian Ministry of defense industry". In 2007 joined Gorodissky & Partners (Ekaterinburg).

In 2009 was accredited in the Center of judicial examination of the Russian Ministry of Justice as a forensic expert on inventions, utility models and trademarks.

Elena focuses on patenting inventions, utility models and industrial designs, trademark registration of Russian clients, counseling on IP protection issues.

Leisure – literature, music, theatre.

NIKOLAY BOGDANOV, COUNSEL, GORODISSKY & PARTNERS (MOSCOW)

NEW RUSSIAN LAW ON PATENT ATTORNEYS



On March 31, 2009 the Law "On Patent Attorneys" (the Law) entered into force in Russia. The Law governs relations associated with the professional activity of patent attorneys on the territory of Russia; sets forth patent attorneys requirements; establishes the procedure of certification and registration of patent attorneys and also defines patent

attorneys' rights, responsibilities, and their liability.

Particularly, the Law provides that Russian patent attorneys are individuals registered in the corresponding Register of the Russian PTO. At that, it is a Russian citizen residing in the Russian Federation who has obtained a higher education and has at least 4 years of experience and practice in the IP field and who has successfully passed the exams at the Russian PTO who may enjoy the right to be registered as a Russian patent attorney in this jurisdiction.

According to the Law, the title "patent attorney" may be used only by the persons who are actually enjoying such status, employers of those persons, as well as public associations or self-governing organizations of patent attorneys.

The Law obliges patent attorneys and their employers contracted with a client for rendering of services (performance of works) related to patent attorney's activity to keep confidentiality in respect of the information obtained in the due course

of fulfillment of their obligations and do not divulge any data contained in the documents received from the client without a written consent of the client.

Pursuant to the Law a patent attorney represents clients' interests before the Russian PTO on the bases of a Power of Attorney issued by the client, which does not need to be notarized. The Law describes situations when a patent attorney should not be entitled to accept a client's instructions. Namely, when an attorney, being an employee at the Russian PTO, took part in consideration of the case which is the subject of the instructions; or if he/she has already consulted or represented the persons conflicting with the interests of the commissioning person unless both parties have agreed to that.

It is specified by the Law that a principal can lodge a complaint against the patent attorney with the Appeals Commission in case the patent attorney is acting against the Russian law. As a result of consideration of the complaint, the Appeals Commission may pass a notice to the patent attorney, or advise the Russian PTO to bring an action before a court claiming suspension of the patent attorney's activity for a period of up to 1 year, or exclusion of the patent attorney from the said Register for a period of up to 3 years. Moreover, the Law provides that a patent attorney shall be liable under and in accordance with the Russian law for the damages caused to the clients.

NEWS

APRIL 15-17, 2009, MOSCOW

7th Annual IP Seminar «Strategies for Protection and Managing of Company's Intellectual Property» was successfully held by Gorodissky & Partners in its Moscow office. 39 attendees representing Russian state-owned and private companies, R&D Centers and universities, foreign companies as well as IP attorneys and lawyers from 16 Russian cities participated in the Seminar.



PHOTO: (FROM LEFT TO RIGHT): VLADIMIR MESCHERIAKOV, COUNSEL, DR. VALERY DJERMAKIAN, COUNSEL, DR. ANATOLY PAVLOVSKY, SENIOR PARTNER, SERGEY DOROFEEV, PARTNER (ALL OF GORODISSKY & PARTNERS, MOSCOW)

Among the speakers, apart from patent/trademark attorneys and lawyers of the Moscow, Krasnodar and Kazan offices of Gorodissky & Partners, there was an invited expert Dr. Thomas Westphal, (Glawe, Delfs, Moll, Germany) who gave a presentation on «Foreign view: Being Patent owner – how to survive at the crisis time?» The program covered legislation issues and enforcement practice with the emphasis on the experience of Gorodissky & Partners professionals gained after Part IV of the Civil Code entered in force in January 2008.

JANUARY 29, 2009, KAZAN

Ruslan Sitdikov, Lawyer (Gorodissky & Partners, Kazan), gave a presentation on «Specifics of IP protection under financial crisis» at the Seminar for CEO's of HR, legal and financial departments of major industrial companies of Tatarstan Republic held by the Republican Ministry of trade and industry.

FEBRUARY 2009, EKATERINBURG

Gorodissky & Partners (Ekaterinburg) ranked among the 10 top law firms in Ekaterinburg the 3rd running year (according to the rating of the leading business magazine of the Urals region «Delovoy kvartal /Business quarter», # 5, 2009).

FEBRUARY 20, 2009, MOSCOW

Counsels Vladimir Mescheriakov, Dr. Valery Djermakian and Dr. Natalia Radchenko, Patent Attorneys Valentin Kirillov and Alexander Kurepin (all of Gorodissky & Partners, Moscow), Partner, Patent Attorney Viktor Stankovsky, (Gorodissky & Partners, St. Petersburg), were accredited in the Center of judicial examination of the Russian Ministry of Justice as forensic experts on inventions, utility models and trademarks.

MARCH 16-18, 2009, KALININGRAD

Viktor Stankovsky, Partner, Patent Attorney (Gorodissky & Partners, St. Petersburg), gave a presentation on «Parallel Import» at the regional seminar held by the North-West Customs «Protection of IP rights by Customs: problems, ways of development». Over 50 officers from Federal and regional Customs, law enforcement authorities, judges, lawyers and patent attorneys attended the Seminar.

MARCH, 2009, MOSCOW



New book «Patent law according to Civil Code of the Russian Federation: paragraph-to-paragraph commentary, enforcement practice, reflections» by Dr. Valery Djermakian, Counsel (Gorodissky & Partners, Moscow), is published. In this book Dr. Djermakian analyses top-ic issues of legal protection of inventions, utility models and designs supported by real court cases. The book is meant for patent attorneys, agents, examiners, IP lawyers and inventors.

MARCH 31, 2009, WEISSACH (GERMANY)

Sergey Dorofeev and Alexander Vasilets, Partners, Patent Attorneys (Gorodissky & Partners, Moscow), gave presentations on «Prosecution, Enforcement of & Licensing of Inventions in RU & EA» and «Russian Design Patent – Feel the Difference» (respectively) at LES Germany Working Group Automotive held at Porsche AG Development Centre.

APRIL 17, 2009, MOSCOW

Tatiana Vernigora, Lawyer, Patent attorney (Gorodissky & Partners, Samara), was accredited in the Center of judicial examination of the Russian Ministry of Justice as a forensic expert on trademarks, service marks and appellations of origin of goods.

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