

# IP LAW FIRM GORODISSKY & PARTNERS INFORMATION BULLETIN



INFORMATION BULLETIN



## #62

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Three IP specialists of Gorodissky & Partners  
– Valery Medvedev, Dr. Valery Djermakian  
and Dr. Natalia Radchenko,  
in 2009 are again included in European  
Legal Experts

VLADIMIR MESCHERYAKOV, COUNSEL, GORODISSKY & PARTNERS (MOSCOW)

## MR. RICCO VS. MAKHEEV

Two Russian manufacturers of mayonnaise sauce, namely, Kazansky Zhirovoy Kombinat, represented by GORODISSKY & Partners, and Essen Production AG, became involved in a dispute related to the exclusive right to a mayonnaise sauce, in which quail eggs were used. The dispute had the following peculiarity: each abovementioned entity had its own patent for the invention related to mayonnaise sauce comprising quail eggs. In view of said fact the holder of the patent with the later priority date (Essen Production AG) was released from the obligation to observe the exclusive right of the holder of the patent having the earlier priority date (Kazansky Zhirovoy Kombinat).



The dispute went on as follows. The suit for patent infringement, filed by Kazansky Zhirovoy Kombinat (the Plaintiff) to Essen Production AG (the Defendant), was satisfied by the Decision of the Kazan Arbitration (Commercial) Court as of Decem-

ber 17, 2008. The Decision recognized that the Defendant used his own patented invention; nevertheless such use suggested that simultaneously the invention having an earlier priority was used, the patent to which was held by the Plaintiff.

In his appeal the Defendant referred to the well-known Information Letter no. 122 as of December 13, 2007 (hereinafter referred to as -the Letter), issued by the Presidium of the Russian Federation High Arbitration (Commercial) Court, and the Defendant requested that abovementioned Decision should be cancelled in view of the Defendant's patent, which he used legally. The Letter reads that in case the holder of a patent to a utility model uses his utility model, and such use means that simultaneously another utility model is used, which is covered by the patent with an earlier priority date, the holder of said earlier priority patent may prohibit the use of his model by said second patent holder,



of cassation referred to the provisions of Article 1358 (3) and Article 1362 (2) of the Russian Civil Code. The first provision determines the situation when in the course of use of one patented invention or utility model another patented invention or another patented utility model is used simultaneously. The second provision states that in the situation of such patent

collision, the holder of the second protected patent having later priority may use his invention or utility model only upon the consent of the holder of the first patent with earlier priority. The Letter applies selectively the conclusion reading that the second patent needs to be invalidated in order to prohibit the holder from using his patent, i.e. the Letter mentions only «utility models», while the Decision of cassation refuses to apply such conclusion to «inventions».

...THE RIGHT HOLDER OF THE DESIGN WORK MAY PROHIBIT THE USE OF THE INDUSTRIAL DESIGN WITHOUT REFERENCE TO THE INVALIDATION OF THE INDUSTRIAL DESIGN PATENT

In this connection it should be noted that the problem of collision of exclusive rights has not received a system solution within the Russian IP legislation. The first attempt to provide such a solution was made in Article 1252 (6) of the Russian Civil Code. Nevertheless it was not a success. Said article of the Russian Civil Code refers only to the collision of

exclusive right to the means of individualization. In some cases (e.g. a trade name vs. a trademark), the exclusive right to a trademark needs to be invalidated first, and only after that the owner of the trade name may prohibit the trademark use, while in other cases (e.g. a trademark vs. a trade name) the trademark owner is entitled to prohibit the use of the trade name without such precondition. Said provisions of the Russian Civil Code do not contain said precondition requiring patent invalidation. In addition to these law norms abovementioned the Letter is applied, which states that in the collision of a patent and a utility model, the patent needs to be invalidated first. Moreover Item 24 of the Resolution no. 5/29 issued by the Plenums of the Russian Federation Supreme Court and High Arbitration Court on March 26, 2009, determines that in case of collision of the exclusive rights to a design work (a copyright subject) and

an industrial design (a patentable subject), the right holder of the design work may prohibit the use of the industrial design without reference to the invalidation of the industrial design patent. Therefore such lack of the uniform approach to said problem shows that the current law norms should be amended not through law interpretation in the course of law enforcement practice, but through amendments to be introduced into Article 1252 (6) of the Russian Civil Code.

THE DISPUTE HAD THE FOLLOWING PECULIARITY: EACH ABOVEMENTIONED ENTITY HAD ITS OWN PATENT FOR THE INVENTION RELATED TO MAYONNAISE SAUCE COMPRISING QUAIL EGGS

only after the validity of said second patent has been challenged and the patent has been cancelled by the Russian PTO. The Defendant's appeal was satisfied by the Resolution of the Eleventh Arbitration (Commercial) Court of Appeals based on abovementioned the Letter only, and said Court applied the provisions of the the Letter to «inventions» (under this dispute) by analogy with «utility models» (mentioned in the the Letter).

The Plaintiff filed his cassation, and following said cassation the Decision of the Federal Arbitration (Commercial) Court of the Povolzhsky Region as of May 13, 2009 cancelled the Resolution of the Arbitration (Commercial) Court of Appeals and restored the Decision of the Kazan Arbitration (Commercial) Court. Said Decision of cassation stated that though the defendant owned his patent, this should not release him from the obligation to observe the Russian Federation Civil Code in respect of the Plaintiff. The Decision

ALEXANDER VASILETS, PARTNER, GORODISSKY AND PARTNERS (MOSCOW)

# NOVELS OF RUSSIAN LEGISLATION RELATING TO INDUSTRIAL DESIGNS



The «Administrative regulations for performing a state function of organizing receipt of design applications and consideration thereof, examination and grant of design patents of the Russian Federation according to the established procedure, by the Patent Office» (hereinafter referred to as the «Administrative Regulations») took effect on December 26, 2008 and superseded

the «Rules for drafting, filing and examination of a design patent application» (hereinafter referred to as the «Rules») that had

been in force since July 11, 2003. The Administrative Regulations comprise a number of essential amendments.

The most significant novel set forth in clause 9.6 is the possibility to file within one application a group of industrial designs forming a single creative concept, while one of the same determines an appearance of an article in general, and the other (others) determine an appearance of an independent part(s) thereof visible when in service. It should be noted that not all parts of an article can be filed in one application with the whole article. The above-mentioned clause 9.6 provides for the following condition: a whole article and an independent part(s) thereof should relate to one and the same sub-class of the ICID.



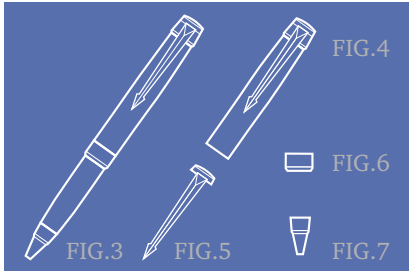
FIG.1



FIG.2

For example, a motor car (fig.1) and a headlight of a motor car (fig.2) cannot be filed within one application, since they relate to different ICID sub-classes, more specifically, the motor car relates to sub-class 08 of Class 12, while the headlight relates to sub-class 06 of Class 26.

However, a pen (fig. 3), a cap for a pen (fig. 4), a clip of a pen (fig. 5), a lower end element of a pen (fig. 6) and a bush of a pen (fig. 7) relate to one and the same sub-class 06 of Class 19 and,



consequently, may be filed within one application. An applicant had had to file 5 separate applications for a pen (fig. 3), a cap for a pen (fig. 4), a clip of a pen (fig. 5), a lower end element of a pen (fig. 6) and a bush of a pen (fig. 7), before the Administrative Regulations took effect, now one

application is sufficient. Another provision of clause 9.6 is that an independent part of an article should be visible when in service. For example, a printer and a cartridge for a printer (fig. 8) arranged inside the printer and invisible when the printer is operated cannot be filed within one application. If an applicant desires



FIG.8

to obtain legal protection for a cartridge as a design, a separate application for said cartridge has to be filed. Therefore, the requirement of unity of a design set forth in clause 9.6 has become more flexible and closer to design law of the European Union, according to which

all designs within one application should relate to one and the same ICID class. The amendment to the requirement of unity of a design allows applicants to save money, since filing separate applications for a whole article and a separate part thereof results in greater expenditures than filing a single application.

Yet one more novel of the Administrative Regulations, set forth in sub-clause 3 of clause 9.8.2 is the possibility to apply a dotted line to depict in a picture of an article those parts (elements) of the appearance thereof that do not determine its major aesthetic and (or) ergonomic specific aspects (inessential features of a design), or where an applicant does not seek legal protection for such parts.

Fig.9 shows a picture of a bottle made entirely in solid lines, while fig. 10 features a part of a bottle, for which legal protection is not sought by an applicant and which is shown in dotted lines. Dotted lines are widely used in USA to designate parts (elements) of an appearance, regarding which no legal protection is claimed. However, pursuant to the US law an application should not comprise a list of essential features. On the contrary, a list of essential features is an integral part of a design application. We tend to believe that a list is an efficient means to determine which



FIG.9



FIG.10

features are essential and which are not. Thus dotted lines do not seem to be crucial. We kindly recommend that applicants should rather pay more attention to a list of essential features than use dotted lines in pictures of an article, in order to ensure optimal scope of protection.

Besides the Administrative Regulations, the «Statute on Official Patent

Fees» (hereinafter referred to as the «Statute») entered into force in December 2008 and superseded the Statute that had been effective since August 1993.

According to with the new Statute, an applicant has to pay two Official Fees instead of one: the Fee for registration of a design application and making a decision according to results of a formal examination and the Fee for examining a design application and making a decision as a result of such examination. The Fee for filing an application had included examination cost, before the new Statute became valid. In case that an unfavourable decision had been taken by the Russian Patent Office during a formal examination, an applicant could not return the money paid for a substantive examination. Now an applicant has such an opportunity, which is counted among advantages of the new Statute.

Pursuant to the new Statute, prescribed Fees should be paid for each claim of a list of essential features beyond one claim. The Fees were previously paid for each claim beyond the fifth claim. This amendment to the Statute will cause increase in applicant's costs. Since the Administrative Regulations permit to include both a whole article and an independent part(s) thereof in one application, the examination fees will grow by a certain amount for each design out of those forming a group (whole and a part) beyond one design, and the Fees for amendments to a design application will rise by a certain amount for each new claim in a list of essential features forming a group.

In addition, the new Statute establishes a Fee for extending a period for filing a design application, when convention priority is claimed.

Both the Administrative Regulations and the Statute are important regulatory documents that will determine a system of legal protection of designs within the following years in Russia. In our opinion, the aforementioned regulatory documents are a significant step forward to harmonization of the Russian law with legislations of other countries, in particular, European Union.

# OUR NEW PARTNER

## VALERIA NAZAROVA

RUSSIAN TRADEMARK ATTORNEY



Graduated from the Lensovet Technological Institute (St.Petersburg) in 1978 as a process engineer. Started her career in 1984 as an engineer at the Izhora plant (St.Petersburg).

From 1984 till 1997 worked at the Leningrad Institute of Cinema Engineers (St.Petersburg), Leningrad Center of Scientific-and-Technical Information (St.Petersburg) and advertizing agency «Respect» (St.Petersburg). From 1997 till 2000 worked at IP firm «Lev Klimentko SPb» (St.Petersburg).

In 2000 joined «Gorodissky & Partners» (St.Petersburg).

Specializes in registration of trademarks of domestic applicants in the Russian Federation.

Speaks English. Leisure – travelling.

# NEWS

## MAY 22-29, 2009 // TOKYO, SHANZHEN, GUANGZHOU, SEOUL

Gorodissky & Partners held another series of seminars on the Russian IP legislation and enforcement thereof revealing latest amendments and proposed changes which took place in Japan, China and South Korea. The leading experts of Gorodissky & Partners – Vladimir Biriulin, Partner, Yury Kuznetsov, Partner, Vladimir Trey, Trademark attorney, and invited speaker – Dmitry Rogozhin, Head of Department, Eurasian Patent Office, delivered their presentations at the Seminars. Each seminar gathered about 100 attendees and caused much interest.



PHOTO: THE SEMINAR IN SHANZHEN (MAY 25, 2009)

In Seoul the seminars were held for a number of South Korean corporate clients.

Gorodissky & Partners thanks all the co-organizers of the seminars – JETRO (Japan), Chinese Association on economic and technical cooperation between China and Europe, Russian Trade Representations in Japan and China.

## JUNE 5, 2009 // SAMARA

The Samara branch office of Gorodissky & Partners was awarded a Diploma for "Great contribution to the development of the national business activity and conscientious work for the sake of the Samara land" by the Samara Chamber of Commerce and Industry at the Function on the occasion of the All-Russia Day of Manufacturer and Entrepreneur.

## JUNE 25, 2009 // SAMARA

Galina Skrebkova, Partner, Tatiana Vernigoira, Lawyer, and Oksana Tsepova, Patent Attorney, (all of Gorodissky & Partners, Samara) and Viktor Gorshkov, Patent Attorney (Gorodissky & Partners, Moscow), gave presentations at seminar "IP issues in nano industry" held by the Samara State Technical University.

Over 60 patent attorneys and agents representing the Samara firms, companies and educational institutions participated in the Seminar.

## JUNE 22, 2009 // EKATERINBURG



Gorodissky & Partners Ekaterinburg office was awarded a Grateful Letter by the police authority of the Sverdlovskaya region for «the contribution to fighting with counterfeiting and to IPR's protection at the territory of the Sverdlovskaya region».

## JUNE 24-27, 2009 // VILNIUS

Trademark Attorneys Yulia Pakhomova and Vadim Shipilov (Gorodissky & Partners, Moscow) attended the ECTA 28th Annual Conference in Vilnius.

## JUNE 27 – JULY 02, 2009 // MUNICH

Elena Nazina, Partner, Patent Attorney, Elena Kondakova, Patent Attorney (both of Gorodissky & Partners, Moscow) attended the seminar "Life Science IP" held by Hoffmann-Eitle. Topical issues on peculiarities of pharma and chemistry inventions protection; different approaches to protection of thereof in the US and Europe were discussed, much attention was paid to further use of pharma patents. The Seminar gathered more than 100 attendees both from pharmaceutical companies and patent firms.

## JULY 2-11, 2009 // MUNICH

Dr. Vitaly Shyshayev, Trademark Attorney, Natalia Ablogina, Lawyer (both of Gorodissky & Partners, Moscow), and Oksana Tsepova, Trademark Attorney (Gorodissky & Partners, Samara), attended the Annual Training IP Seminar held by Boehmert & Boehmert. Topical issues on peculiarities of registration and protection of IP rights in EU were discussed. The Seminar gathered attendees from many countries of Europe and Asia.

## JULY 16, 2009 // MOSCOW

Vladimir Mescheriakov, Counsel, Gorodissky & Partners (Moscow) took part in IP Conference "Rights on intellectual work results and on means of individualization" held by the Russian Corporate Counsel Association and the Russian Chamber of Commerce and Industry together with law firm Lovells.

The main topic of the Conference was Conception of improving of Part IV of the Russian Civil Code.

Prominent Russian civil and IP lawyers, state officials, managers of industrial companies and R&D centers attended the Conference and took active part in the discussion.

Their opinions would be summarized and submitted to the Council on codification and improvement of civil legislation under the President of the Russian Federation.

## JULY 24, 2009 // EKATERINBURG

Traditional sports festival was held by the Ekaterinburg office of Gorodissky & Partners on the occasion of the 8th anniversary of the office.

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