

NEWS

DECEMBER 2009, LONDON



«GORODISSKY AND PARTNERS» ARE CHOSEN AS THE WINNER OF THE «CORPORATE INTL MAGAZINE» PRACTICE FOR «BEST LAW FIRM IN RUSSIA FOR IP LEGAL PRACTICE 2009»

JANUARY 2010, KAZAN

Albert Ibragimov, Patent Attorney, Director (Gorodissky & Partners, Kazan), became a member of the Republican Group for Development of Nano Industry in Tatarstan Republic.

MARCH 15-16, 2010, MUNICH

Sergey Dorofeev, Partner (Gorodissky & Partners, Moscow), gave presentation on «Strategies of IP protection in Russia & Eurasia» at «Patente 2010 – Fachkongress».

MARCH 18, 2010, ST.PETERBURG



PHOTO: ILYA SVETLOV Ilya Svetlov, Patent Expert, Gorodissky & Partners (St.Petersburg), became a Doctor in physics and mathematics. The thesis theme is «Activated fullerene coatings for field emitters». Ilya specializes in patenting of inventions in the field of electronics, telecommunication, computers, including networks, audio-and video engineering. Our congratulations!

APRIL 11-14, 2010, SANDTON



PHOTO: SERGEY DOROFEEV Sergey Dorofeev, LES Russia international dele-gate, Partner, and Vladimir Biriulin, Partner (both of Gorodissky & Partners, Moscow), attended LESI 2010 Annual Conference. Sergey Dorofeev took part in the Meeting of international delegates where it was decided to hold LESI 2014 Conference in Moscow. Sergey Dorofeev also participated in the Workshop «Translation/transliteration of

Roman alphabet marks» with presentation «Roman alphabet based trademarks in Russia». Vladimir Biriulin gave a presentation on topic issues of IP protection in Russia at the Workshop «Doing business in Russia, Ukraine & Kazakhstan». The Conference gathered about 300 delegates from all over the world.

APRIL 13-15, 2010, EKATERINBURG & PERM

Gorodissky & Partners in association with Administrations of Ekaterinburg and Perm cities successfully held Seminars «Topic issues of IP protection» in Ekaterinburg and Perm. Issues related to registration, enforcement and management of IP rights in Russia and abroad were



PHOTO: AT THE SEMINAR highlighted by the leading patent and trademark attorneys and lawyers of the Moscow and Ekaterinburg offices of Gorodissky & Partners and invited speaker Mr. Joern Fischbeck, Partner (Winter, Brandl et al., Germany). The seminars gathered over 100 attendees – patent attorneys and IP councils, lawyers, designers, market experts, customs and law enforcement offices from Sverdlovsk, Chelyabinsk and Perm regions.

APRIL 20-23, 2010, MOSCOW

Valery Medvedev, Managing Partner, Natalia Stepanova, Partner, Senior lawyer, and Valery Lyzhin, Russian Trademark Attorney (all - Gorodissky & Partners, Moscow), gave presentations «LESI and LES Russia – your partners in commercialization and licensing of new technologies», «Copyright infringement on Internet» and «Topic issues of trademark protection» at the Workshops of the 3-rd All-Russia Forum «Intellectual Property – XXI Century».

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

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

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

614010, **PERM**, RUSSIA
Kirova str., 72, office 302
Phone: +7 (342) 212-16-46
Fax: +7 (342) 212-16-46
e-mail: gorodissky-perm@inbox.ru

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

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

01135, **KIEV**, UKRAINE
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

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

420107, **KAZAN**, RUSSIA
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

IP LAW FIRM GORODISSKY & PARTNERS INFORMATION BULLETIN

INFORMATION BULLETIN

**GORODISSKY
& PARTNERS**

#68

IN THIS ISSUE:

WHO IS MR. TIKHONENKO? page 1
OUR NEW PARTNERS page 3
FIRM'S NEWS page 4

#2 (68) 2010, MOSCOW, RUSSIA



7TH ANNUAL SEMINAR “OBTAINING AND ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS IN RUSSIA”

AUGUST 29 – SEPTEMBER 1,
2010, MOSCOW

DR. EVGENY ALEKSANDROV, SENIOR LAWYER, GORODISSKY & PARTNERS (MOSCOW)

JAPANESE SHOCK ABSORBERS AND RUSSIAN UTILITY MODEL PATENTS

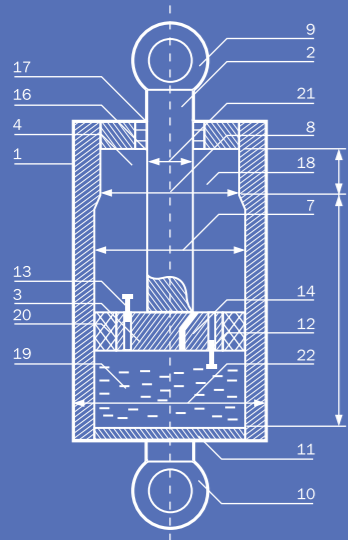
The Russian patent holder O. Tikhonenko made a claim against distributors selling original vehicle shock absorbers from Japan, USA and Germany (about 49 companies) concerning alleged infringement of his patent rights to the designs of shock absorbers. The amount of damages caused by Japanese company Kayaba, as assessed by the patent holder, was approximately \$30-32 million.



The patent holder did not receive a positive answer from the distributors and applied to law enforcement authorities for protection of his patent rights. In April 2009 distributors of shock absorbers were raided by the po-

lice in Novosibirsk, Vladivostok, Krasnoyarsk, Moscow and in other cities, and a large number of KYB shock absorbers manufactured by Kayaba was arrested as a result of the raids. Samples of arrested products

were sent to Rostest-Moskva, a Federal Public Agency for expert examination. Following the expertise, patent attorney V. Khoroshkevich, an examiner appointed by the Police, confirmed that the Japanese KYB shock absorbers had all design features of the patented utility models of O. Tikhonenko. Unfortunately, Gorodissky & Partners got involved in the dispute only after the genie had been let out of the bottle, and the administrative cases concerning infringement of patent rights had already been considered by law enforcement



The data obtained during the information search served as a basis for three objections against the issue of the above-referenced patents that Gorodissky & Partners patent attorneys filed with the Chamber of Patent Disputes of the Russian PTO due to non-compliance of the patented utility models with the criterion of novelty. After consideration of the objections all three patents were found null and void. By that moment, an administrative case stipulated by Part 2, Art. 7.12 of the Code of Administrative Offences of the Russian Federation had already been initiated and considered by the Zamoskvoretsky district court of Moscow following an action initiated by O.Tikhonenko with the Directorate of Economic Crimes under the Main Directorate for Internal Affairs of Moscow.

ACCORDING TO A DECISION OF THE FIRST INSTANCE COURT, THE MOTION FOR BRINGING AN OFFICER OF THE DISTRIBUTION COMPANY TO ADMINISTRATIVE LIABILITY WAS SUSTAINED. THE CASSATION INSTANCE LEFT THIS JUDGMENT UNALTERED

authorities and transferred to the court. Meanwhile, upon studying the case materials, Gorodissky & Partners experts found that the utility models patented by O.Tikhonenko in fact had not been used in the KYB shock absorbers. Besides, the information search indicated that the utility models of O.Tikhonenko were not novel. In this situation it was decided to turn to a classic procedure: to defend the client's distributor before the court in the case of infringement of patent rights and simultaneously challenge validity of the utility model patents. All three Russian patents Nos. 74602, 74603 и 74862 are designated as «Vehicle shock absorbers» and are as similar in their material parts as triplets. The description of each patent contains a figure, which is common to all these patents and which graphically illustrates the nature of the patented shock absorbers. According to the patent holder himself, he improved damping properties of the shock absorbers and the benefit of the invention was that the shock absorbers can better «withstand punch-through». The analysis of the claims of the utility models demonstrated that a distinction of the «invented» shock absorber is actually the presence of two portions with different diameters in a cylinder liner of the shock absorber which provides compression of the shock absorber piston when it moves within the portion having a smaller diameter, and transition of the piston from one cylinder portion to another causes change in the degree of damping. However, such a design of the shock absorbers patented by O.Tikhonenko is not novel and is anticipated by the US patent specification published as far back as in 1997.

According to a decision of the first instance court, the motion for bringing an officer of the distribution company to administrative liability was sustained. The cassation instance left this judgment unaltered. Nevertheless, Gorodissky & Partners lawyers succeeded to reverse the judg-

GORODISSKY & PARTNERS LAWYERS SUCCEEDED TO REVERSE THE JUDGMENT OF THE CASSATION INSTANCE COURT AND, SUBJECT TO THE SUPERVISORY PROCEDURE, RELEGATE THE CASE TO A NEW TRIAL BEFORE THE CASSATION INSTANCE

ment of the cassation instance court and, subject to the supervisory procedure, relegate the case to a new trial before the cassation instance. During the new consideration of the case a judge of the Moscow City Court examined all the facts pertinent to the case more thoroughly, cancelled the judgment concerning administrative responsibility and terminat-

THIS ADMINISTRATIVE CASE APPEARED TO BE SO REMARKABLE, BECAUSE IT INVOLVED OPINIONS OF THE EXPERT PANEL AND THE PATENT ATTORNEY ABOUT THE USE OF THE DESIGN FEATURES OF THE PATENTED SHOCK ABSORBERS IN REAL DESIGNS OF THE JAPANESE SHOCK ABSORBERS WHICH HAD BEEN MARKETED IN RUSSIA FOR SEVERAL DECADES

ed the administrative proceedings. This administrative case appeared to be so remarkable, because it involved opinions of the expert panel and the patent attorney about the use of the design features of the patented shock absorbers in real designs of the Japanese shock absorbers which had been marketed in

Russia for several decades. The examination report issued by the expert panel stated that the tested shock absorbers had portions with different diameters, which varied between 17.2 μm and 50.2 μm in different shock absorbers. Neither the measurement report, nor the patent attorney's opinion analyzed and reflected the fact that said size deviations were within the technologically standardized tolerances for shock absorber liners – from 5 to 80 μm (Russian Standard 24643-81: Basic norms of interchangeability. Tolerances of form and position. Numerical values). This gave rise to paradoxical conclusions: after studying the Japanese shock absorbers of the absolutely identical design, which are merely arranged in different positions in a vehicle (on the right and on the left), though, the experts concluded that the right shock absorbers used the utility models, while the left shock absorbers were lacking them. Guided by the results of the examination obtained by the police, the first instance court erroneously regarded the fact of the administrative offence stipulated by Part 2, Art. 7.12 of the Code of Administrative Offences and punishable by an administrative fine. Luckily for the distributors the patents were cancelled and his further attempts to threaten the business of bona fide dealers of vehicle shock absorbers were finally halted. In the light of the current Russian laws concerning utility model patents, many patent

MEET OUR NEW PARTNERS

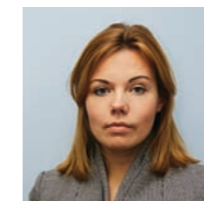
We are pleased to inform that, Viktor Gorshkov, Russian and Eurasian Patent Attorney, Natalia Stepanova, Senior Lawyer, Vladimir Trey, Russian Trademark Attorney, Alexey Kratyuk, Russian Trademark Attorney became new partners of «Gorodissky & Partners».

VIKTOR GORSHKOV
RUSSIAN PATENT ATTORNEY
EURASIAN PATENT ATTORNEY



Graduated from Moscow Technical University of Communications and Informatics in 1983 as an engineer of automatic telephone stations, then - from Central Institute of Intellectual Property (Moscow). From 1987 till 1989 worked as an examiner in the Russian Patent Office. From 1989 till 1998 worked in the major IP firm. In 1998 joined «Gorodissky & Partners». Specializes in patents in the fields of metallurgy, transport, machine engineering and construction, as well as testing and measuring instruments. Speaks English. Leisure – sports.

NATALIA STEPANOVA
SENIOR LAWYER



Graduated from Moscow State University in 1999 as a lawyer. In 1998 got a training course in IP Department of EVERSHEDES Law Firm, London (Great Britain). In 1999 joined «Gorodissky & Partners». Counsels on all aspects of intellectual property including copyrights and neighboring rights, patents, trademarks, company names and other IP subject-matters. Advising on IP rights transfer issues, due diligence and enforcement throughout Russia, CIS and the Baltic states. Assists with IP enforcement and anti-piracy, handles all kinds of IP infringement cases before the courts and administrative bodies. Natalia delivers presentations at conferences and seminars of enforcement of IP rights. Speaks English. Leisure – psychology, literature, jazz, tennis.

VLADIMIR TREY
RUSSIAN TRADEMARK ATTORNEY



Graduated from Moscow State Linguistic University in 2000 as a linguist, in 2004 - from the law faculty of the Russian State Institute of Intellectual Property as a lawyer. In 1999 joined «Gorodissky & Partners». Specializes in trademarks, in particular trademark proceedings in Russia and CIS and Baltic states, also under Madrid Treaty on International Trademark Registration and Madrid Protocol. Vladimir is a regular speaker at conferences and seminars of enforcement of IP rights. Speaks English and German. Leisure – sports, driving, modern music and photography.

ALEXEY KRATYUK
RUSSIAN TRADEMARK ATTORNEY



Graduated from Moscow State Aviation University in 1998 as a radio-technique engineer, then – from the Russian State Institute of Intellectual Property in 2002 as a lawyer. In 1998 joined «Gorodissky & Partners». Specializes in trademarks and appellations of origin of goods, in particular trademark proceedings in Russia, CIS and Baltic states, gives presentations at conferences and seminars of enforcement of IP rights. Speaks English. Leisure – economy, policy and computing.