

Russian Civil Code Amendments and IP Registration

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On 14th of September 2011, an official publication of a draft bill introducing large-scale changes to Russian Civil Code became available in press and on the Internet. These changes affect almost every chapter in the Code, including those in part IV, devoted to intellectual property.

This article addresses on some of those introducing new rules of official registration, as they seem to be heavily influenced by international treaties and actual needs of holders and common public.

1.

Currently an official registration of an assignment is done by means of registering of a corresponding agreement or a contract; the same is true for registration of rights of usage of an IP object. Thus the parties to an agreement are obliged to present this agreement to the registrar (Rospatent) in a copy.

New amendments will make a registration of assignments (or permissions to use) possible apart from registration of an agreement. A written statement signed by both sides specifying kind of agreement, its parties, subject and a serial number of a certifying document will suffice. A possibility of a unilateral request is also provided in the draft – but such a request must be followed by one of the following documents:

- a notification about an assignment that is signed by both parties
- a notarized extract of a contract,
- a genuine copy of a contract.

In case of registration of a right to use for an IP object an application or its enclosure must also contain:

- contract's duration;
- territory on which a right of usage of an IP object is granted;
- permitted ways and means of usage of an IP object;
- a permission to sub-lease an IP object (only when granted);
- possibility of unilateral denunciation.

In case of demanded registration of a pledge of exclusive right(s) an application or its enclosure must also contain:

- pledge duration;
- limitations for a pledger on ways of use of an IP object or a right to dispose of it.

As before, official registration of assignment or other transferal of the right remains obligatory. Non-observance of this rule voids a change in ownership of an exclusive right as well as a pledge of this right or granting of use.

These changes will definitely lead to simplification of registration and its unification with active international agreements. One may notice a strong likeness of new rules and the rules set by article 11 of the Singapore treaty on the law of trademarks, the paragraph b) of which also does not require presenting of an original copy of the contract, and grants the right to the applicant to choose between a copy of the contract, an extract of the contract, an uncertified certificate of transfer signed by both the holder and the new owner or an uncertified transfer document signed by both the holder and the new owner. It is certain that these new rules will be much more suitable for domestic and foreign licensees, freeing them from necessity of submitting original documents that also must comply with registrar's internal rules, risking an unnecessary disclosure of contract terms and information non-related to rights transferal.

2.

For the first time in the Russian legislation the rule allowing the legal owner to make a public statement granting a general public a possibility to use freely a result of intellectual activity belonging to him on conditions defined and during term specified will be introduced. After such kind of statement is made any person will have the right to use this result on the specified conditions.

Today's legislation does not provide a direct possibility for disposal of the exclusive right in a similar way. Moreover, the general rule sets an obligatory written form of the license contract and the default lucrateness of any transfer of the exclusive right and right to use, thus not allowing granting a right of free use to general public.

Generally permissive civil law regulation allows drawing a conclusion on legitimacy of such actions as not forbidden directly, but in absence of special norms the order was represented by the separate rights disputable except for the computer programs and databases which can be distributed under a box license that can contain conditions of their free use. Modern Russian IP legislation when compared with previous Soviet rules gives obviously a bigger priority to the interests of the legal owner, rather than those of general public. However, contemporary worldwide trends to allow a wide circulation of IP objects on the basis of their free use demanded the necessary changes.

If the new amendments will pass unchanged, the only requirement for an author or other owner of IP object will be making a corresponding statement via an official site of federal authority. For those IP results that need official recognition and registration (by patenting or depositing) the necessary alterations in registration documents will be made by state authorities.

By default a period of free use will be set at five years and permission will be granted over the whole territory of Russia. The statement will be non-revocable and unchangeable through all the time initially granted. The owner of IP result will be denied an exercise of this right if there will be any active license contracts granting the right to use this result within the same limits. Also these rules will not be applicable to IP objects that may be used under an open license (it may be issued for be patented inventions and useful models, selection achievements).

When compared against Creative Commons licenses the amendments proposed seem to be more convenient for an owner of IP object as they will give him more flexibility in defining the conditions of usage. At the same time users will have to carefully study conditions that are individually set for each object and abide to them.

It is difficult to estimate now, how these new rules will get accepted. Undoubtedly, an interest in free granting and enjoyment of creations has finally ripened, especially considering a significant amount of writings, computer programs and musical compositions that are distributed freely by their authors. Still, only time may tell how practical such kind of permissions will be for owners and users and how large their usage will be.

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