

## Russia: Civil Code Amendments to Impact IP Regulations

By Tatyana Kulikova, *PETOSEVIC Russia, Russia*

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Russia has recently adopted a set of Civil Code amendments, which will enter into force on October 1, 2014.

Below is the summary of main IP-related amendments:

A request for the state registration of an assignment, license or pledge substitutes the registration of an assignment/license/pledge agreement. In this sense, the Russian legislation will be brought in line with the Singapore Treaty on the Law of Trademarks. It will be possible to file a request and supplement it with either a notification signed by both parties or a copy/extract of the agreement (Art. 1232).

If the exclusive license is granted, the licensor has no right to use an IP right in the same way as granted to a licensee unless otherwise agreed on in the license agreement (Art. 1236).

Under current regulations, the IP owner does not need to prove the fault of the infringer in civil proceedings. In administrative proceedings, it depends on the case and the court, while in criminal proceedings there is a need to prove fault in all circumstances. Under the amendments, the IP owner will have to prove the fault of an infringer, particularly physical persons. Legal entities and individual entrepreneurs will be liable for IP infringement, even if their fault is not proven, unless the infringement arises as a result of vis major (Art. 1250).

The scope of protection for industrial designs will be based on their images, and not on the list of their essential features (Art. 1358).

The term of validity of a patent for an industrial design will be reduced to 5 years from the current 15 years. It can be further extended, in increments of 5 years, but it cannot exceed 25 years (Art. 1363). The Russian PTO will conduct substantive examination of utility model applications, instead of using the current utility model registration system (Art. 1390).

In terms of patent infringement, the amendments stipulate monetary compensation for the damages in the amount of EUR 198 – EUR 99,000 (USD 276 – USD 138,000) or double the amount of potential royalties. Currently, the patent holder can claim the compensation for damages on the basis of patent rights infringement, which is hard to prove (Art. 1406.1).

Registration of a trademark in respect of the similar goods and services is prohibited if it contains company name, trade name or commercial designation of another person (Art. 1483). Currently, a third party is entitled to base its cancellation action on the company name right, whereas the examiners at the Russian PTO cannot use that provision during the trademark examination. As soon as the new version of the Civil Code comes into effect, the examiners at the Russian PTO will be able to issue office actions or decisions on the basis of prior company names, trade names or commercial designations.

Observations are officially mentioned in the new version of the Russian Civil Code. According to Art. 1493, any person can file an observation in relation to any published trademark application before the issuance of the final decision.

The term for filing an appeal against a decision in a trademark application grant procedure will be 4 months from the date of its issuance, instead of 3 months from the date of its receipt, as the law currently prescribes (Art. 1500).

***For more information, please contact:***



Tatyana Kulikova  
Director of Russia Office, Trademark Attorney  
PETOSEVIC Russia  
[tatyana.kulikova@petosevic.com](mailto:tatyana.kulikova@petosevic.com)  
[www.petosevic.com](http://www.petosevic.com)