

# SUCCESSING IN IP: RUSSIA ACCEDES



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Russia became a member of the World Trade Organization (WTO) in December 2011 after 18 years of negotiations. WTO director general Pascal Lamy hailed Russia's membership as a "win-win deal" for both Russia and its present and future trading partners. Commentators predict big things for the country's economy as WTO accession comes into effect and trade barriers are removed.

Russia is an attractive market for many foreign companies. Big companies are increasing their patent filings, and brands are not far behind. With WTO accession, these companies are expected to increase their presences in Russia, particularly when they can obtain effective protection for their inventions and brands.

The country's intellectual property (IP) legislation is harmonised with international norms to a high degree. Russia is a signatory to the Patent Cooperation Treaty (PCT), while its trademark legislation, which was modernised in 2008, is compliant with the Trade-Related Aspects of IP (TRIPS) and Singapore agreements.

It is important that foreign companies are aware of how their inventions and brands can be protected in Russia and how traditional obstacles can be overcome, so that they can enjoy the fruits of their labours in a market that is set to blossom.

## Patent protection

Foreign companies planning to file patent applications in Russia have several avenues to choose from. The Federal Service for Intellectual Property (Rospatent) accepts direct applications and PCT applications. Foreign companies will find that Rospatent grants patents more quickly than offices such as the European Patent Office (EPO). At the EPO, an applicant may have to wait five years or more for a patent to be granted, while Rospatent's first office action on a patent application is within a year.

As foreign companies can choose to take the PCT route when filing a patent application, the common hurdles that are associated with conflicting national office filing policies are removed. Foreign applicants should try to base their applications on the PCT application, as PCT applications are drafted under the same regulations.

A third route that foreign companies can take is to file applications at the Eurasian Patent Office (EAPO). This office grants patent protection in Armenia, Azerbaijan, Belorussia, Kazakhstan, Kyrgyzstan, Moldova, Russia, Tajikistan and Turkmenistan, all signatories to the Eurasian Patent Convention.

Filing at the EAPO is effective for patent applicants that are seeking patent protection in at least two countries in the Eurasian area. It requires only a single application, a single translation into the Russian language, and it is much quicker than Rospatent in most technical fields. In areas such as pharmaceuticals and biology, Rospatent and the EAPO have similar prosecution times, but in areas such as physics and electricity, the EAPO is much quicker. It also offers accelerated examinations, so it is possible to get a patent within six to seven months of filing an application.

## Patent translations

Foreign applicants still struggle with patent translations in Russia. The most common mistake they make is obtaining translations from translators who are not patent specialists. If the patent application translator is not a patent specialist, the translation's quality will probably be poor. Therefore, it is important for foreign applicants to ensure that their patent applications are translated by patent experts who can confidently and accurately translate technical terms and phrases.

Foreign applicants seeking protection in Russia also face difficulties when they translate patent applications which originate from their

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“ IT IS IMPORTANT TO FIND GOOD SPECIALIST PATENT TRANSLATORS WHO CAN TRANSLATE DIRECTLY FROM ONE LANGUAGE TO ANOTHER. ”

home countries. For example, a Chinese application, which was originally in the Chinese language, would be translated into English before reaching a Russian patent specialist for a final translation into Russian. It is very difficult to understand the meaning of a sentence in this situation, or even the substance of an invention, because two translations can cause words or technical terms, literally, to be lost in translation. Unfortunately, this is not always avoidable. It is important to find good specialist patent translators who can translate directly from one language to another, particularly when difficult languages such as Chinese and Russian are involved.

In light of these problems, it is important to check all translations, no matter who prepares them. Each and every patent application, before filing, must be checked by a native language-speaking patent attorney. This is the only way to avoid serious mistakes in translations. Of course, this is more expensive, but when an examination begins,

the applicant would lose much more if Rospatent's first official request were to improve the translation.

## Trademark protection

As in many jurisdictions, Russian trademarks must be registered in relation to a specified list of goods and services. Any word, design, three-dimensional design, or combination of these can be protected as a trademark in Russia.

Well-known foreign brands that are planning to file trademarks in Russia should be aware that designations may not be registered as trademarks if they do not have a distinguishing capacity or they consist of non-protectable elements.

However, Russia does provide well-known trademark protection, through legislation that is identical to the TRIPS Agreement's protection of well-known trademarks. If a mark has non-protectable elements but is used intensively over a long period of time before registration—intensively enough to acquire a distinguishing capacity—it may be able to be registered as a trademark in Russia. This carries a heavy burden of proof, however. Marketing information, such as the budget that was allocated to promoting a mark in the Russian market, or the volume of items that bear a mark, can be used as evidence. If a mark does not have inherent distinctive capacity but gained it during its use, it might be protectable in Russia.

When filing trademark applications, local Russian applicants try to cover as many goods and services in a particular class as possible, but foreign applicants prefer to be more specific. Foreign applicants do not have to do this. They tend to be worried about cancellation actions on non-use grounds and they think that if they narrow the list of goods and services in which a trademark is valid, they can easily prove use in a cancellation action. What foreign applicants do not realise is that if they face cancellation

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actions, they can simply narrow the list of goods and services during the cancellation action, so they can take advantage of broader protection in Russia early on and prevent similar and identical trademarks.

Foreign brand owners should follow the three-application rule when filing trademark applications in Russia, to protect their brands as fully as possible. The first application should cover a mark as it is supposed to be used in Russia. This means that an applicant should include the word and design in its application, as it should be used in Russia. The second application should contain just the wording, focusing on the exact lettering of the word that the applicant wants to protect. This will help the applicant to have a broader scope of rights to protect its brand in relation not only to identical, but to similar trademarks. The third application should be a translation of the word into Russian. Of course, the Russian word sounds different from the English word, and when courts are comparing trademarks to find out if they are similar, the phonetic issue is the most decisive. However, the meaning of the word is very important too, and meaning can be lost when a word is translated into Russian if a direct translation does not exist.

## IP enforcement

Foreign IP owners will be pleased to know that Russia will introduce a specialised court for IP rights, by March 2013 at the latest. As a part of Russia's civil court system, the Court for Intellectual Property Rights will take over from Rospatent's Patent Dispute Chamber and it will consider cases concerning all IP rights. It is not clear who will lead the court, but it will have 30 specialised judges.

Foreign IP owners will be pleased to note that the new court will be independent of Rospatent and the Patent Dispute Chamber. Currently, a refusal of a patent needs to be confirmed by the head of Rospatent. If a decision is appealed against, and subsequently overturned by the chamber, the refusal decision would be returned to the head of Rospatent for confirmation, even when the decision is contrary to the first one. Hopefully, the new independent Court for IP Rights will rectify this situation.

In cases of patent infringement, foreign patent owners have the option of enforcing their rights in administrative, criminal, or civil proceedings in Russia. When deciding on a proceeding for patent enforcement, it is important to analyse each case separately. Criminal proceedings are, perhaps, too severe for patent infringement cases. It is also difficult to prove wilful infringement and whether the use

of a patent is lawful or not. Administrative proceedings are very fast. A patent owner must approach the police and produce the relevant documents, and if the police decide that they want to proceed, they can work on stopping an infringer's activity. They have effective powers, including freezing an infringer's bank accounts. However, a patent owner must push the police to help as they have a lot of things to deal with and patent infringement cases are not necessarily a priority.

Civil proceedings are not as fast. It can take months for a case to be decided, but the civil route is much more objective than administrative proceedings as it allows both sides to produce evidence. If an infringement needs to be stopped quickly, it is better to go to the police. If the situation is more complicated, then it's better to use civil proceedings.

The most effective way of enforcing trademark rights is through customs. Putting a trademark on a customs register means that customs will monitor the import of goods that bear that particular trademark. Customs will inform a trademark owner's Russian representative if a shipment of counterfeit goods is crossing the Russian border.

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