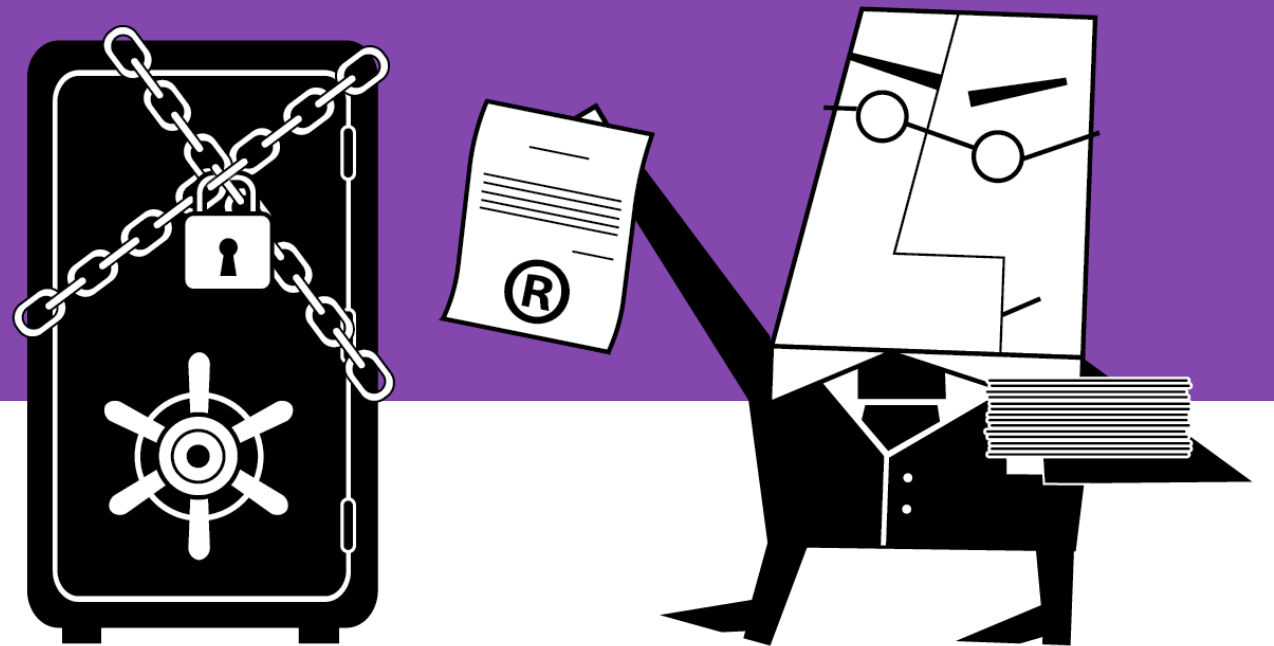


# PROTECTING YOUR IP



# About the practice



The year when the practice was established.



Valentina Orlova is an arbitrator of the Arbitration Centre on IP disputes.



Processes more than 3 requests from the IP Court every year.



Developed a specific procedure for using and protecting FIFA's intellectual property during the organising and staging of the 2018 World Cup in Russia.



Actively supports 'anti-piracy' measures.



Actively participates in refining legislation as part of working groups of Russia's Federation Council (the upper chamber of the Russian parliament), the Council of the Eurasian Economic Commission, the Russian Federal Intellectual Property Service (known in Russia by the abbreviation "Rospatent"), the Ministry of Economic Development, the Ministry of Sport, the Intellectual Property Court of the Russian Federation, and Rospatent's Public Council.



Implements over 200 projects every year.

## Key Clients of the Practice:



# About the practice

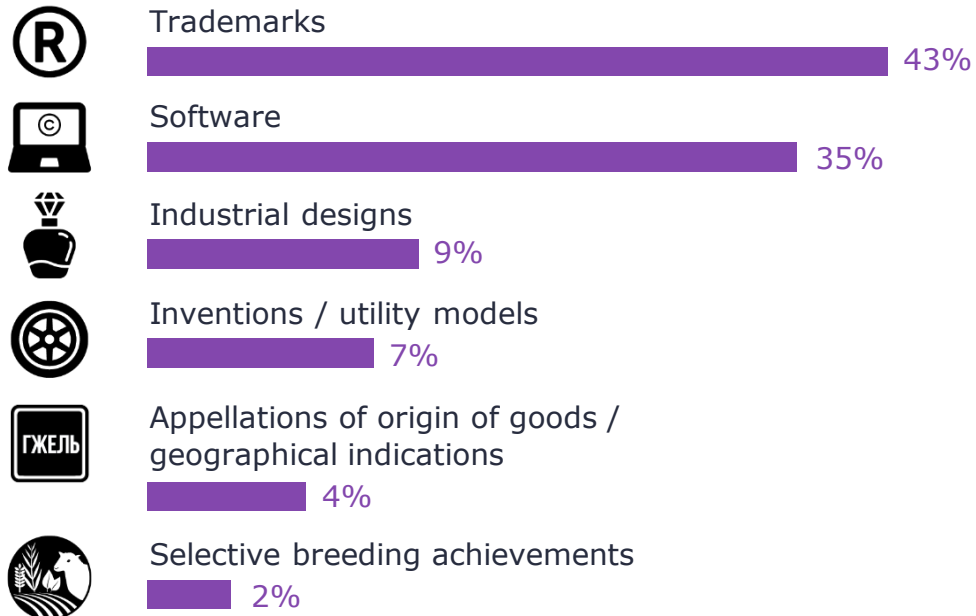
## Is a member of legal and business associations



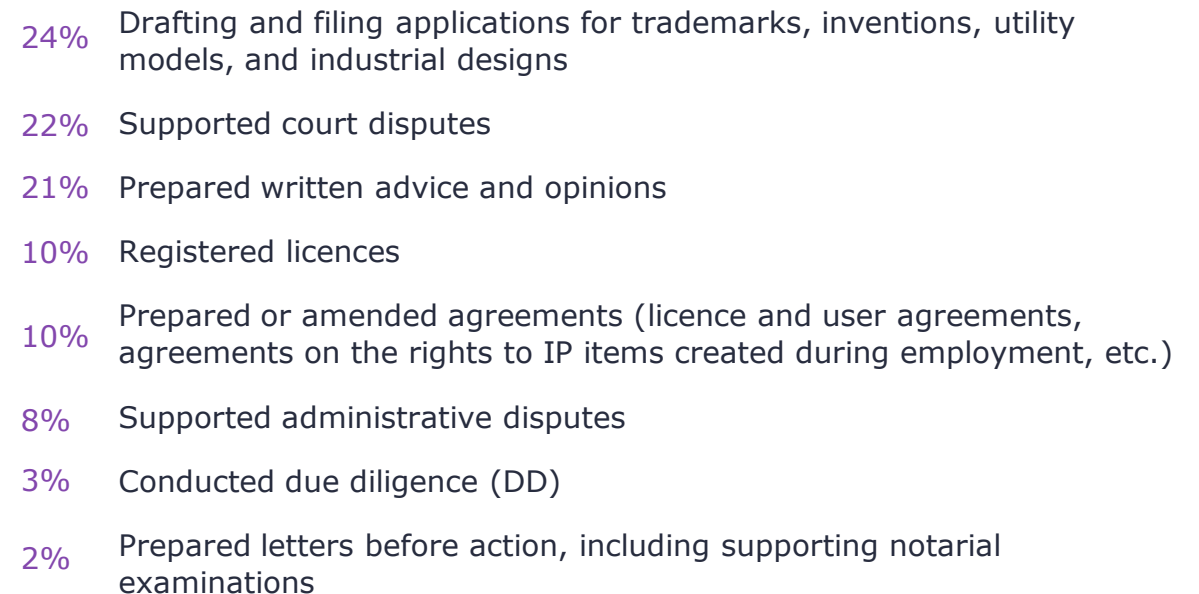
## Is rated as a leader in the field in key rankings of law firms



## Types of registered items



## Types of projects



# DISPUTE RESOLUTION IN THE AREA OF IP



# Disputes resolved under an administrative procedure

## **Registered trademarks of a distributor of the largest domestic and foreign manufacturers of medications and medical products**

The lawyers of the IP practice provided legal support to a major distribution company that supplies products of the most important domestic and foreign producers to 83 regions of Russia. The client filed three applications for the registration of trademarks to identify its services. However, following an expert examination, the regulator Rospatent at first denied the registration. The client had to initiate administrative proceedings in the Chamber of Patent Disputes. Thanks to the efforts of our specialists, Rospatent agreed that the client's trademarks had a distinctive capacity. The trademarks were successfully registered. The project is significant because, according to the general rule, our client's trademarks are potentially non-enforceable. However, since they were being intensively used on the priority date, the trademarks had gained distinctive capacity, which, according to the law, allows them to be registered.

## **Resolved a dispute relating to a patent being challenged**

The specialists from our IP Practice provided legal support to a major producer of specialised equipment for the mining and smelting sector. An objection was filed against the client's patent on the ground that it was not in line with the 'novelty' criterion of patentability. Pepeliaev Group's lawyers carried out a patent search that allowed a conclusion to be made that the objection was ungrounded and the sources mentioned do not relate to features of the client's invention. Our lawyers prepared a response to the objection and subsequently a supplement to it in accordance with an established procedure. The Patents Disputes Chamber rejected the objection to the client's patent. The head of Rospatent approved the decision.

## **Successfully defended a client against an accusation that it had illegally used a font on the product label**

Our client received a claim from a large company engaged in developing fonts. The claim concerned a violation of exclusive rights to a font that was used on labels affixed to mineral water that the client produced. The project involved developing a legal position and submitting a response to the claim. In addition, Pepeliaev Group's lawyers requested an expert opinion from the Russian Designers Association. Taking into account the document obtained, our specialists prepared a legal position with regard to the assertions and demands set out in the claim and responded to them. The company engaged in developing fonts never provided any feedback to the client after it received the response. Disputes over the use of fonts are quite rare in Russia. Moreover, the font in dispute has a very long history. Having exclusive rights to a digital version of the font (graphic files) does not mean that the rightholder has the same exclusive right to earlier versions of the font.

## **Settled a dispute over the protection of a label enforceable as a trademark**

The IP Practice's lawyers provided legal support to a major manufacturer of low-alcohol products in connection with the label it had used allegedly being confusingly similar to the label that another manufacturer of similar products had registered as a trademark. Our lawyers carried out a comparative analysis of the labels and did not come to a definite conclusion that the designs compared were confusingly similar. At the same time, in view of the aggregate of the corresponding elements and their composition Pepeliaev Group's lawyers deemed it necessary to recommend that the client should amend the label it was using. Under the agreement that was drawn up for the pre-trial settlement of the dispute, a new design for their product was developed and agreed. The work that was performed allowed the client to avoid a long and expensive process and to prevent reputational risks.

# Providing support in court disputes

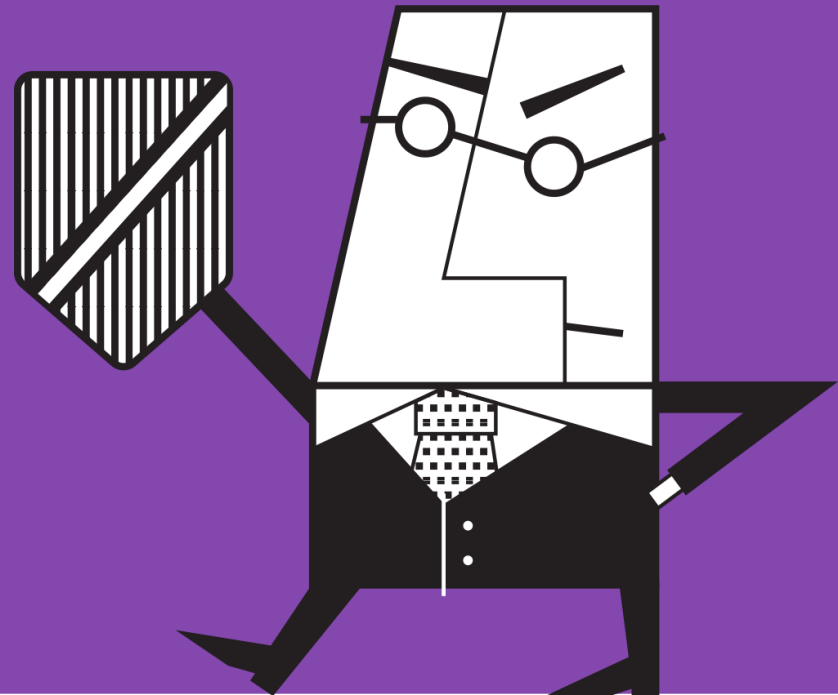
## **Represented Alibaba in court, which resulted in the company receiving a Russian domain name in the Russian part of the Internet**

Pepeliaev Group's lawyers represented Alibaba Group in a case whereby an individual had registered the alipay.ru domain name which was identical to "ALIPAY", one of Alibaba's trademarks. Our lawyers filed a well-grounded claim, represented the client in court hearings in the State Commercial Court for the Amur Region, and participated in negotiations with the infringer. The negotiations resulted in an amicable agreement under which the client received the domain name and monetary compensation. The court approved the amicable agreement. This project allowed ALIPAY, an escrow account-related services provider and the platform where around half of Internet payments are made in China, to obtain a domain name in the Russian part of the Internet.

## **Successfully settled a dispute to preserve the status of a well-known trademark**

The client owned a well-known trademark which it used intensively over a lengthy period. The client filed claims against the manufacturer of similar products that an exclusive right to such trademark was being violated. Taking account of the scope of the violation, a criminal case was initiated against the competitor. The infringer decided to seek to avoid liability by contesting the status of a well-known trademark. In this project, our IP Practice's lawyers proved in the IP Court that the trademark enjoyed legal protection in full compliance with the law. The trademark's general fame that had been proved earlier was confirmed by a new opinion survey as well as by the results of a linguistic examination. During the court proceedings, Pepeliaev Group's lawyers questioned the validity of several documents that the infringer had provided. Regardless of the opponent's and the administrative authority's cassation appeals, the Russian Supreme Court supported the decision of the IP Court and upheld the legal protection that had been granted to the well-known trademark.

# COMBATING COUNTERFEITING





# Combating Counterfeiting

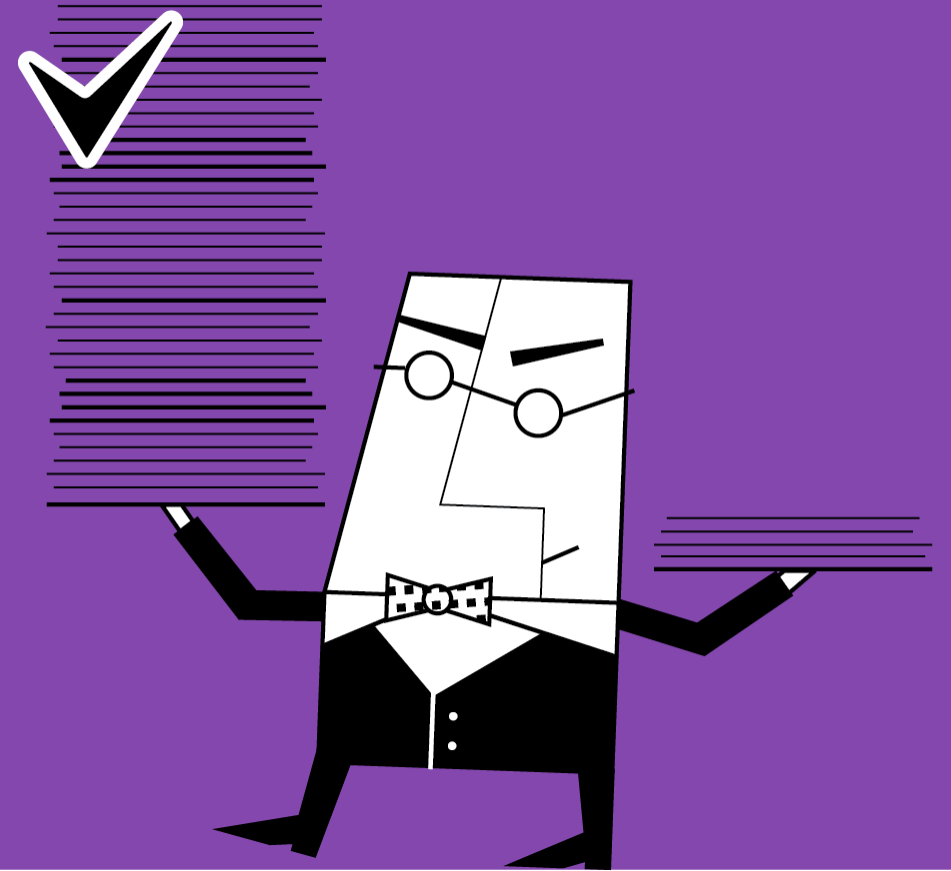
## **Supported a client in preventing a utility model (metal tiles) from being used illegally**

The client has been engaged in producing steel and metal structures for over 50 years, and has patented its inventions in many countries worldwide. After 20 years of successful activity in Russia, it discovered in one region of the country large batches of products using its utility model. Pepeliaev Group's lawyers engaged detectives and identified that not only was the infringer selling the products without the consent of the holder of the patent, but also of the manufacturer itself, to the use of the utility model. In this project sample purchases of counterfeit products were made and the necessary body of evidence was prepared which included comparative patent research. The counterfeit products were proved to use all the signs of the client's utility model. All of the above circumstances were listed in the statement of claim containing the claims against the two defendants who were the infringers. Evidence was also collected with regard to the protracted period of the violation and the substantial volumes of unlawfully manufactured products: many distributors sold them in 83 regions of Russia. As a result, both defendants were recognised as infringers of the exclusive right to the client's utility model and compensation for the violation was recovered from them.

## **Defended a pharmaceutical company in a case regarding the distribution of counterfeit products**

Pepeliaev Group's lawyers defended a large pharmaceutical company in an investigation into the distribution of counterfeit products. A group of individuals was selling other products (non-specialised and untested cheap substitutes and extraneous substances) under the cover of various medicines. In particular, our client's anti-cancer medicine was being counterfeited and supplied to hospitals. This project is valuable as the investigation has saved the health, and, probably, the lives of many people. The criminals have been sentenced to substantial and lengthy terms of imprisonment, which is almost never seen in cases featuring the rights to a trademark being violated. The project is also significant as articles 180(3) and 180(4) of the Russian Criminal Code (rights to a trademark being violated by a group of individuals) are applied very rarely in Russia (in around 10 cases a year). Articles 180 and 159 of the Russian Criminal Code were applied jointly, which is also quite uncommon.

# LEGAL CONSULTING IN IP



## **Provided support in the client's transactions with respect to the disposal of intellectual property rights**

The lawyers from our IP Practice implemented a set of measures for a major international logistics company in seven different jurisdictions with respect to seven trademarks. The above was caused by the upcoming liquidation of the client's subsidiary and the need to transfer its assets (including rights to trademarks) to another company. The liquidation was to be performed within a tight timeframe. We carried out a simultaneous disposal of the rights to the trademarks in the seven jurisdictions, and registered them with the national patent offices. Subsequently, the transfer of an exclusive right was registered in five jurisdictions (Russia, Lithuania, Latvia, Ukraine and Kazakhstan), and afterwards the registration of the changes with the national patent offices in two jurisdictions (Uzbekistan and Kyrgyzstan) was terminated. The project is important because within a tight timeframe legal activities were performed simultaneously in the seven jurisdictions given the substantial differences in the legal regulation. We offered the client an algorithm of actions for a successful transfer of assets during the company's liquidation. Pepeliaev Group's specialists also prepared sets of the necessary draft documents taking into account the national specific features of registering trademarks and the upcoming liquidation of the client's structure.

## **Structured a transaction from the standpoint of intellectual property rights**

The specialists from our IP Practice ensured legal support for a large pharmaceutical company planning to conclude transactions to produce a medical product in the territory of a third party. A long chain of international licence and sublicense agreements and specific changes in the structure of licensees that took place during the validity period of the above agreements also made the situation even more complicated. Pepeliaev Group's lawyers analysed the content of the documents and determined the scope of rights granted to the third party with a view to organising the production. Moreover, owing to changes in the structure of the licensees, we needed to carry out an additional analysis to determine who was to pay the royalty. Our specialists provided recommendations to the client on how to structure the transaction and emphasised that the client should subsequently preserve continuity while changing the structure of licensees when licence relationships are structured at the international level.

## Devised a strategy for using marks intended for identifying a housing project

The client's trademarks protecting the name of a housing project were being considered by the examiner of the patent office. A major developer of residential housing engaged Pepeliaev Group's lawyers to prepare strategic guidelines with a list of activities that can be applied for the protection of trademarks on the Internet (with respect to domain names and websites) In particular, this concerned websites that our client's bad-faith competitors had already used and might potentially use to unlawfully obtain information about potential buyers of the client's real estate. The devising of strategic guidelines was complicated by the trademarks still being examined by Rospatent when the client submitted its request. The fate of the trademarks was unclear. The client's trademarks have now been registered and the client is implementing the strategy we proposed.

## Preparing a strategy for partners to distribute and use rights to intellectual property assets when a world congress is held

In the near future Russia will be hosting a world congress. Participants of the congress will include a major Russian state mining company and its international partners.

The client has requested Pepeliaev Group's lawyers to develop a registration strategy for intellectual property assets and a strategy for distributing rights to such assets and for the partners organising the event to use such rights. When working on the project, our IP Practice's specialists drew the client's attention to several factors. In particular, the partners operating within Russia do not have rights to the trademarks that they proposed to use when the congress is held. The strategy that our lawyers have developed is aimed at clearly distributing the rights to intellectual property assets between the partners and at holding the congress successfully.

# Preparing legal opinions

## **Prepared a legal opinion on the procedure and conditions for trademarks to be used without a licence agreement being concluded with the rightholder**

Our IP Practice's lawyers prepared a legal opinion for the client containing recommendations on how to use trademarks that had been previously applied based on a licence agreement with the rightholder, which had expired by the time the client sent its request. Since the British rightholder proposed granting the rights to use the trademarks via an intermediary, our lawyers developed a step-by-step action plan for granting the rights to use the trademarks based on the applicable provisions of current legislation. Moreover, our lawyers prepared the necessary agreements containing conditions and deadlines that suited the client.

## **Advised a manufacturer of cosmetic products on how to calculate a royalty**

Pepeliaev Group's lawyers prepared a legal opinion for a manufacturer of cosmetic products containing an analysis of the provisions of licence agreements, including those in force with respect to another state, as well as the provisions of a supply agreement. Moreover, our lawyers provided recommendations on how to calculate the royalty. Our specialists concluded that there were specific risks for the client if it used data on the circulation of products labelled with the trademarks in another state when calculating the royalty under a licence agreement applicable to a different territory. Our IP Practice lawyers jointly with the specialists from the tax practice proposed other options to resolve the issue concerning the royalty.

# Drafting documents governing intellectual property relationships within the company

## **Developed documents governing relationships within a holding company with respect to the creation and usage of IP assets**

Our lawyers advised the client regarding an agreement with an employee who had developed software. Following the advice, the client instructed Pepeliaev Group's lawyers to draft a list of documents necessary for resolving all the issues relating to the creation, acquisition, usage and commercialisation of IP assets inside the holding company. We developed the IP policy of the company based on the list that had been drawn up. We created a detailed document which subsequently served as a basis for several more draft documents, in particular Regulations on Know-how and Regulations on the Company's IP Assets Created by Employees.

## **Developed documents relating to R&D activities with the involvement of the company's employees and third-party specialists**

Our IP Practice's lawyers analysed draft agreements for R&D work of counterparties of a major metals company. The analysis that we carried out demonstrated that the agreements needed to be amended and that supporting agreements both with the company's employees and with third-party specialists needed to be prepared. The agreements needed to be prepared and subsequently signed because disputes needed to be settled over who held the rights to the IP assets that were highly likely to be created when the R&D activities were performed. The specialists of our IP Practice drafted the relevant agreements as well as the company's internal documents relating to the creation of IP assets by employees (software, inventions and utility models).

# DRAFTING CONTRACTS FOR THE DISPOSAL OF RIGHTS TO VARIOUS ITEMS OF IP



# Drafting contracts for the disposal of rights to various items of IP

## **Drew up a commercial concession agreement**

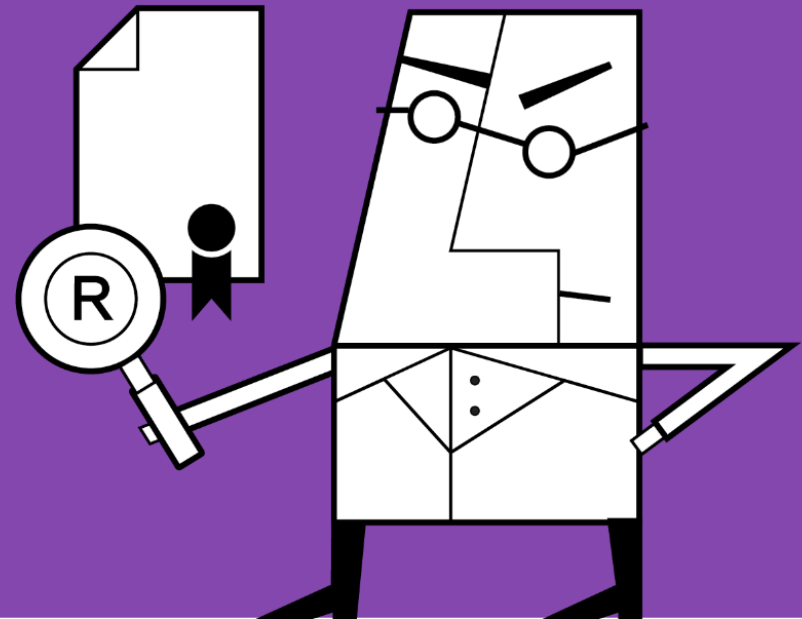
Our IP Practice's lawyers drafted a commercial concession agreement for a Russian branch of a major tyre manufacturer. Under such document, the client could grant to other companies rights to use trademarks, software and know-how owned by the parent company and used by the Russian branch based on relevant licence agreements. When drafting the commercial concession agreement our lawyers took into account the regulatory specifics of relationships associated with agreements of this type. In particular, they paid special attention to the provisions of the agreement aimed at preventing violations of antitrust legislation. Our lawyers also took account of the specifics of the rights to various IP assets which were granted under the licence agreements, the boundaries of which were not allowed to be crossed.

## **Licence agreements for the use of industrial designs**

In connection with a restructuring of a major US international manufacturer of consumer goods, the client needed to simultaneously terminate the existing licence agreement and immediately conclude a new one with a different counterparty which would provide for different conditions for calculating the royalty. The licence was granted simultaneously for industrial designs and some other IP assets. Our IP Practice's lawyers drafted an agreement to terminate the licence agreement. Our lawyers also drafted a new licence agreement for a significant number of IP assets of different types. The above agreement included updated provisions that related to the calculation of the royalty, were in line with the client's financial interests and complied with the requirements of Russian tax legislation.



# PROVIDING LEGAL SUPPORT DURING THE STATE REGISTRATION OF IP ITEMS



# Providing Legal Support during the State Registration of IP Items

## **Prepared and supported the registration of amendments made to a licence agreement that had been registered previously**

Our IP Practice lawyers drafted an agreement for the client to amend a licence agreement that had been registered previously. It was required to introduce 20 additional inventions and two industrial designs into the agreement. The project was unique because the methods of using the licensed assets were significantly different. This fact was to be clearly specified. Also, different patented items had different protection periods. In addition, we needed to ensure the timely payment of annual patent fees to make sure that all patents were valid when Rospatent was considering the registration application. Otherwise, the patent office could, based on the current regulations, have denied the registration of the changes. Our specialists analysed the planned amendments, proposed that the client should adjust them, drafted an agreement to make the amendments and checked whether all of the patents were valid.

## **Had an invention patented in the area of providing mobile telephone communications services**

The client turned to our IP Practice's lawyers to have its invention patented. The invention consisted of a method of authenticating and identifying a user in a mobile network and a method of remotely registering a user in such network. Pepeliaev Group's patent attorneys carried out research to identify possible obstacles to having the above technical solution patented. In addition, a formula for and a description of the invention were prepared in close cooperation with the authors of the invention. Our lawyers conducted a thorough patent search and meticulously prepared materials for the application, which allowed them to have the client's invention registered within the shortest possible period of time.

# REGISTERING IP ITEMS ABROAD



# Registering IP Items abroad

## Registered two trademarks in eight countries under an international procedure

Pepeliaev Group won a public tender regarding the need for two trademarks to be enforced in eight foreign countries. The trademarks belonged to a research institute of a major public joint stock company. Pepeliaev Group's patent attorneys managed to register the trademark in all of the selected jurisdictions. In several countries legal protection was granted only for a part of the goods and services. This was due to the substance of the trademarks, i.e. the verbal elements they contained. The project was complicated primarily owing to differences in approaches to the procedures and conditions of registration in the eight jurisdictions. Moreover, the patent authorities of several countries had sent notifications of their preliminary refusal to register the trademark owing to the descriptive nature of one of the verbal elements of the trademark. Patent authorities are very stringent about registering such marks as trademarks, and considerable efforts are needed to collect documents confirming that the applicants have actively used such marks and that consumers associate these marks specifically with the applicants. To this end, our lawyers submitted to the foreign patent authorities a large volume of documents, which confirmed that the trademark had gained a distinctive capacity. The registration procedure lasted almost two years.

## Filed applications on behalf of Rosatom to have patents granted for inventions abroad

Pepeliaev Group won a public tender regarding the filing of an application seeking to have atomic energy patents granted for nine inventions in three jurisdictions, Argentina, Bangladesh and Jordan, based on applications that had been filed in Russia. The basis for filing the applications was inventions identified during a special IP audit conducted with respect to the Rosatom state corporation. The inventions included a new steam generator for a reactor plant and pressurised water reactors. Subsequently, Pepeliaev Group won another public tender of Rosatom to file an application seeking to be granted atomic energy patents for another nine inventions in 15 European jurisdictions based on the applications filed in Russia. Such inventions included a liquid metal reactor. The simplified patent system based on the Patent Cooperation Treaty does not apply in Argentina, Bangladesh and Jordan. Therefore, the project not only required knowledge of the patent provisions of the Paris Convention, but also solid organisational efforts to coordinate the activities of patent attorneys in various countries. We filed 27 patent applications for inventions within only two months. The European countries are contracting parties to the Patent Cooperation Treaty. However, the application must be validated individually in each country. Therefore, we had to act in 18 jurisdictions simultaneously, which meant that over 100 applications had to be prepared at the validation stage.

# Partner



## Valentina Orlova

Partner  
Head of IP and Trademark Practice Patent Attorney  
Patent Expert  
Doctor of Laws

[v.orlova@pgplaw.ru](mailto:v.orlova@pgplaw.ru)

Valentina provides clients with assistance in relation to rights to software programs, databases, patent law items, selective breeding achievements, trademarks, trade names, and commercial designations.

Within the scope of the advice she provides, she formulates strategies to protect intellectual property of our client companies, while she issues recommendations as to how to protect know-how, establish a trade secret regime, and allocate rights to the results of intellectual activity. In addition, she advises on the content of agreements which concern intellectual property.



Valentina Orlova



Valentina Orlova

## WHAT THEY SAY

Every year, Valentina is awarded the IP Star rating for trademarks - the highest award of Managing Intellectual Property. She is recognised as one of the best experts in Russia (Gold) in the individual rating of the World Trademark Review – 1000.

# About the firm

A leading Russian law firm offering the full range of legal services.

## Lawyers

160



Our lawyers include  
3 Doctors of Laws  
and 19 PhDs in Law.



## Clients

2000



## Office

8

Moscow  
St Petersburg  
Nizhnekamsk  
Krasnoyarsk  
Vladivostok  
Beijing  
Shanghai  
Dubai

## Ratings



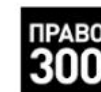
CHAMBERS  
EUROPE

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IFLR1000

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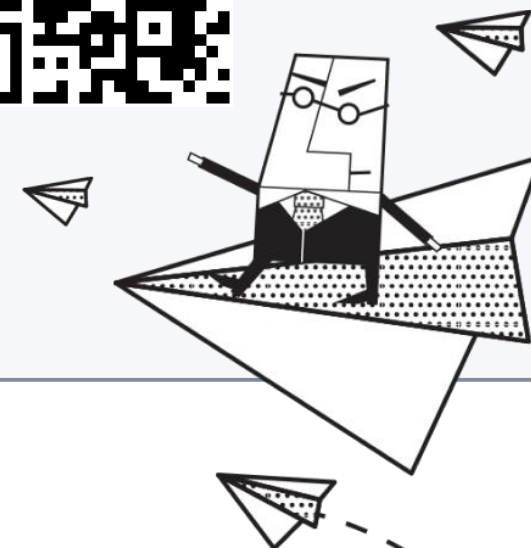
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# Services



Tax advice & tax disputes



Administrative law defence of business



Banking and finance practice



Bankruptcy



Family and inheritance law



Employment and migration law



Customs law and foreign trade regulation



Currency regulation and currency control



International litigation and arbitration



Corporate law / M&A



Antitrust regulation



Dispute resolution and mediation



Criminal law defence of business



Legal protection of information



Real estate & construction



Intellectual property and trademarks



Environment



Telecommunications, media and IT



Digital group



Life sciences

# Geographical coverage

## Chinese Desk

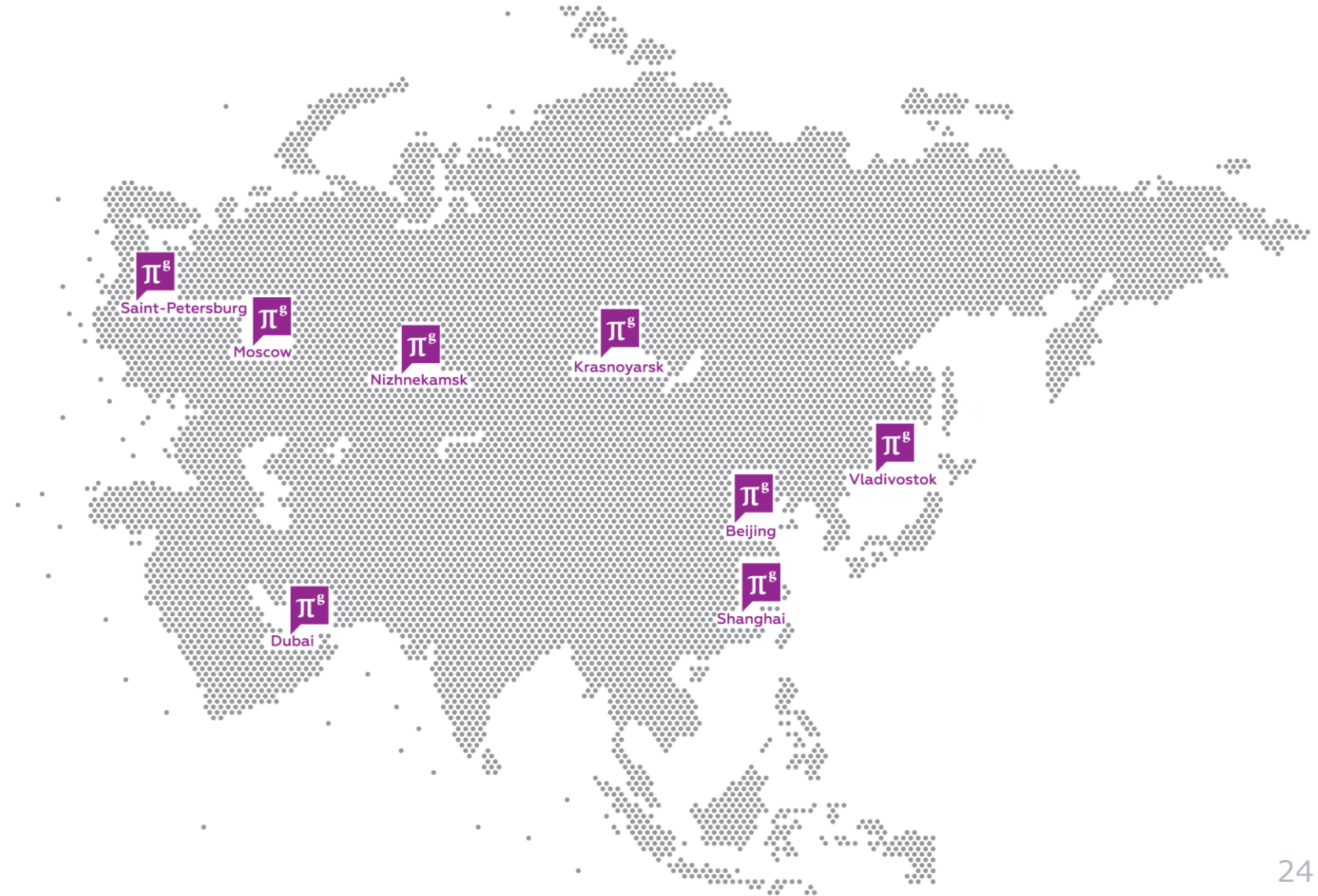
- Representative offices in Beijing and Shanghai.
- Support for Chinese investors in Russia and for Russian investors in China.
- We have strategic partners on the Chinese market.
- Comprehensive legal support.

## Korean Desk

- Legal advice to Korean companies in Russia and to Russian investors in Korea.

## Middle East Desk

- PG TAX Consultancy LLC provides services on tax structuring and tax consultancy in UAE and GCC.





# Contacts

## **Moscow**

E: [info@pgplaw.ru](mailto:info@pgplaw.ru)

Tel.: +7 (495) 767-00-07

## **St Petersburg**

E: [spb@pgplaw.ru](mailto:spb@pgplaw.ru)

Tel.: +7 (812) 640-60-10

## **Tatarstan, Nizhnekamsk**

E: [rt@pgplaw.ru](mailto:rt@pgplaw.ru)

Tel.: +7 (495) 767-00-07

## **Krasnoyarsk**

E: [krs@pgplaw.ru](mailto:krs@pgplaw.ru)

Tel.: +7 (391) 277-73-00

## **Vladivostok**

E: [vld@pgplaw.ru](mailto:vld@pgplaw.ru)

Tel.: +7 (4232) 65-93-55

## **Dubai**

E: [info@pgplaw.ae](mailto:info@pgplaw.ae)

Tel.: +971 54 417 3060

## **Beijing**

E: [bj@pgplaw.ru](mailto:bj@pgplaw.ru)

Tel.: +86 (10) 8441 8770

## **Shanghai**

E: [sh@pgplaw.ru](mailto:sh@pgplaw.ru)

Tel.: +86 (21) 6329 3923, ext. 807

**[www.pgplaw.ru](http://www.pgplaw.ru)**