



NEW DEPARTMENTAL REGULATIONS CONCERNING INTELLECTUAL PROPERTY

For the attention of the CEOs of companies that own exclusive rights to items of intellectual property

Pepeliaev Group advises that the regulator Rospatent has prepared a large package of departmental regulations in terms of protecting intellectual property.

The rules of the Russian Civil Code relating to the protection of intellectual rights (IP) have been extensively amended. In pursuance of these statutory provisions, Rospatent, the federal executive authority with responsibility for intellectual property, has prepared a large package of departmental regulations. In the second half of last year and at the start of this year, the majority of the new regulations underwent the procedure of being agreed between government departments and of being registered with the Russian Ministry of Justice. As things now stand, almost all of the documents that were prepared have been registered.

The registered documents have already come into force.

Main new developments

Particular attention should be paid to the regulatory legal acts that relate to trademarks. This is the area that has undergone the most radical reform.

Among the particular features worth noting in the updated legal regulation are the following :

- maximum timeframes have been established for carrying out an expert examination in relation to applications to register trademarks (18 months and 2 weeks), industrial designs (32 months and 2 weeks), and utility models (24 months);
- additional requirements for formulating application documents have been set;
- there is detailed regulation of the procedure for examining the materials of applications from other parties;
- Rospatent's actions are regulated in the context of publishing judicial decisions relating to particular IP items;
- the state service of registering a non-contractual assignment of an exclusive right is regulated.

Over the next two months, the following documents are expected:

- administrative regulations governing contractual disposals of exclusive rights. This procedure takes into account the conceptual change of a move away from registering contracts themselves and instead registering an assignment (grant) of rights. The draft document contains an exhaustive list of the factors

for compliance with which Rospatent will check documents it receives. It is proposed that the deadline will remain the same - i.e. 2 months, disregarding periods of correspondence;

- rules for challenges to decisions of an expert examination and for considering the relevant objections within Rospatent.

What to think about and what to do

In view of the amendments that have been made, all applicants for and owners of trademarks and other intellectual property should do as follows:

- when documenting new applications and petitions, comply with the new requirements for them, including submitting a written consent to the processing of personal data;
- timely file applications to extend the term of patents and certificates, as well as applications to amend registered contracts including with a view to extending the term of such contracts;
- file an application for registration with respect to any changes of the name of an applicant or owner, or its address;
- bear in mind that third parties have the opportunity to contact Rospatent with submissions against (opposition to) the registration of trademarks, so that a prompt response can be given to Rospatent refuting such submissions;
- be mindful of the opportunity to contact Rospatent on their own behalf in order to prevent other parties from registering 'competing' trademarks;
- take into account that registration procedures may be delayed at the initial stage when the new documents are initially applied, i.e. within the first three months after they come into force;
- keep tabs on (i) the acceptance of documents relating to the registration of a disposal of an exclusive right (on contractual grounds) and (ii) on the consideration of patent disputes under an administrative procedure; and if any changes are made to the relevant requirements and procedures, to overhaul business processes that relate to drafting contracts and contacting Rospatent with applications and objections.

Help from your adviser

The lawyers of Pepeliaev Group's IP and Trademarks Practice are ready to help find solutions to the above problems and to offer the following services:

- 1) compiling applications to register any intellectual property item in accordance with the new procedures;
- 2) providing support in compliance with the new requirements and deadlines when any legally significant actions are taken;
- 3) drawing up licence agreements, franchise agreements, disposal and pledge agreements that are in line with the new requirements of statute and departmental regulations, as well as documents that are necessary and sufficient for state registration purposes.

Our experience means that we can do the following successfully and as promptly as is possible:

(1) register:

- trademarks, inventions and industrial designs,
- a grant of a right to use intellectual property items based on licence agreements, franchise agreements and other types of agreements, a disposal or pledge of exclusive rights, and a non-contractual assignment of rights;

(2) ensure that your interests are safeguarded when any submissions or objections are examined within Rospatent.

Contact details



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