



RUSSIAN FEDERATION PATENT PROCEDURES AND FILING REQUIREMENTS

In the Russian Federation, patents of invention, utility models and industrial designs have been available since passage of the 1992 *Patent Act*. As a member of the Paris Convention, the Patent Cooperation Treaty and the Eurasian Patent Convention, Russia receives patent applications and provides patent protection to Russian and foreign nationals.

Gowlings provides patent services in Russia for filing of national applications, Paris Convention applications and PCT applications. We also coordinate similar services in other member countries of the Commonwealth of Independent States (CIS).

Application Requirements

In order to file a patent application in Russia, a foreign national must submit to the Russian Patent Office (Rospatent) an application for patent containing the following documentation:

Paris Convention Application

1. full name and address of applicant and inventor(s)
2. one copy of the abstract, specifications, drawings (if any) and claims on A4 paper
3. certified copy of priority application within three months of the filing date

4. translation of full specification is required within two months
5. assignment, if any

PCT Application

1. full name and address of applicant and inventor(s)
2. one copy of the abstract, specification drawings (if any) and claims on A4 paper
3. translation of full specification is required within two months

Application Procedure

Our Moscow office will receive and file the necessary documentation and arrange for payment of the filing fees. Excess claims fees are payable for more than 25 claims. Translations can also be prepared and filed within two months of the filing date.

Examination Procedure

A request for examination must be filed within three years of the effective filing date (the actual Russian filing date or, in PCT cases, the PCT application date). The three-year deadline for requesting examination is absolute and cannot be extended, except possibly in a “force majeure” situation.

Fees for examination are based on the number of independent claims. Consideration should be given to limiting the number of independent claims to minimize fees. A Russian examiner will check for novelty and inventive subject matter, citing foreign and Russian prior art. Copies of Russian prior art can be obtained and translated. A response is normally due within four months of the office action.

Extension and Reinstatement Time Limits

The time limit for filing a response to an office action can be extended, subject to payment of extension fees. The missed time limit can be reinstated where the applicant can furnish a valid excuse and pays any appropriate fees, but only within 12 months of the expiration date of the time limit.

Grant Fees

Following notice of allowance, grant fees must be paid within three months, together with accumulated maintenance fees, which are deferred from the third year until the date of grant. The patent grant will be forwarded approximately four months after payment of the issue fees. The term of a Russian patent is 20 years from the date of filing.

Maintenance Fees

Maintenance fees are payable annually within the two months preceding the anniversary date of filing. A maintenance fee that has not been paid in the appropriate time period may be paid in the six-month grace period thereafter, with a 50 per cent penalty.

Appeals

Should an application be rejected at any stage of examination, the applicant has six months within

which to appeal the decision to the Patent Disputes Chamber of Rospatent.

Assignments

Any change in the patent ownership must be recorded at Rospatent. After a patent grant, any assignment must be apostilled in accordance with the Hague Convention or legalized by the local Russian consulate.

Licences

Licences of Russian patents must be recorded at Rospatent. Licences must also be apostilled.

Working

If a patent is not worked in Russia, it is subject to compulsory licence after four years of non-working.

Infringement Actions

All disputes relating to infringement of Russian patent rights are tried in the Russian Courts in accordance to the legislation of the Russian Federation. The legal staff at Gowlings is experienced in, and prepared to handle such litigation proceedings.

RUSSIAN FEDERATION TRADE-MARK PROCEDURES AND FILING REQUIREMENTS

The Russian Federation is a “first-to-register” country, where evidence of using a trade-mark that has not been properly registered with Rospatent, neither provides any protection itself, nor establishes any priority.

Gowlings provides trade-mark services in Russia for filing of trade-mark applications. We also coordinate similar services in other member countries of the CIS.

Required Documents

A trade-mark application filed with the Rospatent must include the following:

1. full legal name and address of the applicant
2. list of goods and/or services for which the trade-mark is to be registered, grouped in accordance with the International Classification of Goods and Services
3. trade-mark depiction and description
4. five black and white prints of the mark (*When submitting an application for a colour-specific trade-mark, five colour prints of the mark should be provided.*)
5. should a convention priority be claimed, a certified copy of the priority application filed in a member state must be filed within three months after the filing in Russia

Power of Attorney

Rospatent no longer requires the filing of a Power of Attorney. However, in cases of reasonable doubt, the Examiner reserves the right to request a document evidencing our powers to represent the client. Therefore, as a precaution, we recommend that the clients provide us with a Power of Attorney on behalf of the applicant. The executed Power of Attorney does not need legalization.

Application Procedure

The application must be prepared in Russian and should be submitted together with confirmation of the official fee payment. Documents submitted with the application can be in any language, however, a Russian translation of the relevant documents must be provided within two months of the date of filing the application.

Expert Examination

The trade-mark application is subject to a two-step examination process. At the formal stage, which takes one month to complete, Rospatent reviews the contents of the application and the accompanying documents to ensure that they are in proper format. Should Rospatent request additional documents, they must be submitted within two months. When all necessary documents are received, an Official Filing Receipt is issued.

At the substantive stage of the examination process, Rospatent examines the application to determine whether the mark is registrable pursuant to Russian trade-mark law (distinctiveness, non-confusion with prior similar trade-mark registrations, etc.), and determines the priority date, in the event it was not determined at the formal examination stage.

In practice, substantive examination can take as long as 12 months. When the substantive examination stage is completed, the applicant will receive notice of Rospatent's decision.

Appeal

Should the application be rejected at either stage of expert examination, the applicant has three months within which to appeal the decision to the Patent Disputes Chamber. The applicant also has the right to request copies of the documents and other materials on which the Examiner made a determination, provided the request is made within one month of the receipt of the notice of Rospatent's decision. The decision of the Patent Disputes Chamber can be further appealed in Court.

Registration

If the trade-mark is approved for registration, the registration fee must be paid within two months

after the receipt of the official notice. The trade-mark will be officially registered in the State Register of Trade-marks within one month of the payment of the fee, and the Certificate of Registration will usually issue within one month of registration. A registered trade-mark must be published in the Official Bulletin within one month of registration.

Cancellation Procedures

Once the trade-mark is published in the Official Bulletin, cancellation proceedings can be brought against the registration by third parties. Should the grounds for the cancellation of the registration be the existence of a confusingly similar, previously registered trade-mark, a third party has the right to file a cancellation request with the Dispute Chamber within five years after publication. Cancellation proceedings brought on the grounds of a lack of distinctiveness, descriptiveness or corporate dissolution of the owner, can be brought at any time.

Term of Validity

Initially, a trade-mark registration is valid for 10 years, running from the initial filing date with Rospatent. It comes up for renewal during the final year of its current registration. Upon payment of the renewal fee, the registration is valid for a further 10 years. There is a six-month grace period during which renewal is still possible, subject to an additional fee.

A trade-mark registration can be invalidated at the request of third parties on the basis of non-use for the preceding three years. In order to preserve the registration, trade-mark holders must then provide evidence of use.

Amendments

Any changes to a trade-mark owner's name or address, the associated wares/services, or non-substantive changes to the trade-mark as used, must be registered with Rospatent in order to be valid in Russia. On payment of the appropriate fee, such amendments are recorded in the State Register of Trade-marks and published in the Official Bulletin.

Licensing and Assignment

Licensing and assignment agreements must comply with Russian trade-mark law which sets both mandatory terms and guidelines. To be valid in Russia, such agreements must be registered with Rospatent. When registering a trade-mark licence and assignment, the following documents must be submitted:

1. duly legalized Licensing/Assignment Agreement
2. confirmation of the official fee payment
3. Powers of Attorney signed by the parties and duly legalized

Please note that:

- i. Licence/Assignment Agreement must list specific trade-mark registrations under licence/assignment
- ii. only registered/legally protected in Russia trade-marks are subject to licensing
- iii. both valid pending applications/registrations can be assigned in Russia

- iv. the list of goods and services specified in the Licence/Assignment Agreement must comply with the one included in the relevant registrations

Licensing Agreements must specify the territory (Russia or a specific area within its borders) and term of the Licence. Licensing Agreements must also contain a clause that requires the licensee to produce goods and services of a quality not lower than that of the licensor, and must provide a licensor with a mechanism for exercising quality control in relation to the use of the licensed trade-marks.

Franchise agreements are legal only if entered into by legal entities or duly registered private entrepreneurs, and must also be registered with Rospatent.

Infringement Actions

All disputes relating to infringement of Russian trade-mark rights are tried in the Russian Courts in accordance to the legislation of the Russian Federation. The legal staff at Gowlings is experienced in, and prepared to handle such litigation proceedings.

The information set out in this document is provided for general purposes only and is not to be taken as legal advice. Never disregard or fail to seek legal advice based on this material.

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