

# Key IP-related issues of Russia's WTO Accession

**Intellectual Property Rights: recent trends, court  
practices, problems and solutions**

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# AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS (TRIPS)

*(Uruguay round of negotiations, April 15, 1994.)*

- TRIPS significance to IPR protection
- Mechanism for resolution of disputes related to the subject matter of the TRIPS Agreement between Member countries.



## TRIPS: GENERAL PRINCIPLES

- Introduction of analogous [i.e. as envisaged by TRIPS] or broader scope of IP protection by Member countries
- Compliance with provisions of the Paris Convention for the Protection of Industrial Property (Articles 1-12, 19), Berne Convention for the Protection of Literary and Artistic Works (Articles 1-21, excluding 6-bis)
- National treatment regime (Each Member shall accord to the nationals of other Members treatment no less favorable than that it accords to its own nationals with regard to the protection of intellectual property)



## RUSSIA WTO ACCESSION

- 18 years of negotiations (WTO accession application filed on June 1993)
- Accession Package approved by the Eighth WTO Ministerial Conference (December 2011)
- Protocol on the Accession of the Russian Federation (December 2011)
- Report of the working party on the accession of the Russian Federation to the World Trade Organization November 17, 2011
- Russian Government Resolution (№564 of June 7, 2012 ) On introduction to State Duma for ratification of the Protocol on Accession of the Russian Federation to the Marrakesh Agreement Establishing the World Trade Organization of April 15, 1994



## RUSSIA WTO ACCESSION. REPORT OF THE WORKING PARTY. OUTSTANDING ISSUES (1)

- limitations of exclusive rights, Art. 1229.5 of the Civil Code (copyrights, trademarks, patents)
- Activities of collecting societies (non-contract administration)
- Technical protection measures
- Burdensome requirements for well-known trademarks
- Priority of Geographical Indicators over trademarks at the stage of registration
- Russian definition of GIs is very limited (must be linked to an actual geographical place), not in line with Article 22 of TRIPS
- Difference in patent filing fees – Promise to make equal as of the accession date (without transition period)
- Compulsory licensing provisions (patents)

## RUSSIA WTO ACCESSION. REPORT OF THE WORKING PARTY. OUTSTANDING ISSUES (1)

- Exclusions from patentability – terms “societal interests, principles of humanity and morale” of Article 1349 of the Civil Code is not equal to “*ordre public* protection of morality, protection of human, animal or plant life or health, environment”
- Data exclusivity / transparency of registration process – Article 18.6 of the Law on Circulation of Medicines comes into force as of coming into force of the Accession Protocol
- Insignificant amount of judgments on confiscation and destruction of machinery used for infringing activities
- Domination of administrative proceedings over criminal proceedings (low fines, no deterrent effect)
- Unavailability of customs ex-officio measures
- Insignificant criminal penalties (suspended sentences, small amount of cases resulted in criminal sentences to infringers)
- Increase of criminal thresholds



## IPR PROTECTION. COMPLIANCE WITH TRIPS

### Article 43. Evidence

The judicial authorities **shall have the authority**, where a party has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of its claims which lies in the control of the opposing party, **to order that this evidence be produced by the opposing party**, subject in appropriate cases to conditions which ensure the protection of confidential information

### Russian law

Limited options for getting evidence from defendants in arbitrazh / civil process



## ARTICLE 42. Fair and equitable procedures

Members shall make available to right holders civil judicial procedures concerning the enforcement of any intellectual property right covered by this Agreement. Defendants shall have the right to written notice which is timely and contains sufficient detail, including the basis of the claims. Parties shall be allowed to be represented by independent legal counsel, and procedures shall not impose overly burdensome requirements concerning mandatory personal appearances. All parties to such procedures shall be duly entitled to substantiate their claims and to present all relevant evidence.

The procedure shall provide a means to identify and protect confidential information, unless this would be contrary to existing constitutional requirements.

### **Russian law**

Lack of specific mechanisms in Arbitrazh/Civil proceedings.





## ARTICLE 47. Right of information

Members may provide that the judicial authorities shall have the authority, unless this would be out of proportion to the seriousness of the infringement, to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or services and of their channels of distribution.

Not mandatory

### **HOWEVER**

Correlates with the enforceability of Article 45 of TRIPS, setting forth a right to request adequate compensation



## ARTICLE 50. Provisional Measures

The judicial authorities shall have the authority to order prompt and effective provisional measures:

- to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance;
- to preserve relevant evidence in regard to the alleged infringement.

### **Russian law**

Issues with protection from unfinished “planned” infringement of IPR (preservation of evidence with respect to planned infringements)

Issues with availability of provisional measures in civil/arbitrazh proceedings



## ARTICLE 61. Criminal Procedures

- Members shall provide for criminal procedures and penalties to be applied at least in cases of willful trademark counterfeiting or copyright piracy **on a commercial scale**

### Russian law

### Damage threshold issues



# Thank you.

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