

Comment

Review

УДК: 347

DOI:10.17323/2713-2749.2023.2.142.157

Key Issues in the Intellectual Property Court Presidium Rulings



M.A. Kolzdorf¹, N.I. Kapryrina²

¹ Intellectual Property Court, 5/2 Ogorodnyy Proyezd, Moscow 127254, Russia

² MGIMO University, 76 Prospekt Vernadskogo, Moscow 119454, Russia

¹ mkolzdorf@hse.ru, ORCID: 0000-0003-3227-3348, Researcher ID: AAI-1625-2019,

² n.kapryrina@my.mgimo.ru, ORCID: 0000-0003-1276-1600, Researcher ID: AAQ-3784-2021,



Abstract

The comment reviews key positions in the rulings of the Presidium of the Russian Intellectual Property Court (IPC) issued between July and September 2022. The Chamber hears cassation appeals against the decisions of the IPC first instance and deals primarily, but not only, with matters of registration and validity of industrial property rights. Therefore, the review predominantly covers substantive requirements for patent and trademark protection, as well as procedural issues both in the administrative adjudicating mechanism at the Patent office (Rospatent) and at the IPC itself. The current review encompasses a variety of topics related to trademark Law, patent law and various procedural matters.



Keywords

bankruptcy; trademarks; appellations of origin; Paris Convention; descriptive sign; patent term extension; novelty; originality; industrial design; co-ownership of trademark; termination of protection; evaluation of evidence.

For citation: Kolzdorf M.A., Kapyrina N.I. (2023) Key Issues in the Intellectual Property Court Presidium Rulings. *Legal Issues in the Digital Age*, vol. 4, no. 2, pp. 142–175. DOI:10.17323/2713-2749.2023.2.142.157

I. Trademarks

1. Opposition Based on a Trademark whose Protection has been Terminated

IPC Presidium Resolution of 15 September 2022 in Case No. IPC-584/2021

When assessing signs for compliance with Para 6, Art. 1483 of the RF Civil Code, it is necessary to take into account also those trademarks whose term of protection has expired, but whose protection can be reinstated in accordance with the procedure provided for by Para 2, Art. 1491 of the Civil Code.

Rospatent refused to register a trademark in respect of part of the services filed in the application on the basis of Para 6, Art. 1483, the Russian Federation Civil Code because of the existence of an earlier trademark of a third party.

The applicant filed an opposition with Rospatent, in which it referred to the fact that the term of legal protection of the earlier trademark had expired.

Rospatent rejected this reasoning and dismissed the opposition.

Rospatent offered the following arguments: according to Para 2, Art. 1491, the Civil Code, the term of the exclusive right to a trademark may be extended for ten years at the request of the right holder submitted during the last year of validity of such a right. The validity term of the exclusive right to a trademark may be extended an unlimited number of times. At the request of the right holder, the latter may be granted six months after the expiry of the exclusive right to the trademark to file the said application for term extension. The right holder of the earlier trademark submitted to Rospatent a request to benefit from the six-month period for filing an application for extension of the validity of the trademark with additional materials (the proceedings on these materials have not yet been completed).

The first instance court concluded that Rospatent had lawfully compared the disputed sign to the earlier trademark, but cancelled Rospatent's decision due to the fact that the term of legal protection of the earlier trade-

mark had expired by the time of consideration of the case without the possibility of extending such protection.

The IPC Presidium upheld the first-instance court's ruling while stating the following.

At the time of Rospatent's contested decision it was possible to restore the legal protection of the earlier trademark in accordance with the procedure in Para 2, Art. 1491 of the Civil Code. This fact proved that Rospatent was obliged to take into account the trademark in question when checking the compliance of the applicant's sign with the legal requirements under Subpara 2, Para 6 of Art. 1483 of the Civil Code (i.e., Rospatent made a legit comparison.)

However, at the time the first instance court considered the case, this was no longer possible, which allowed the court to adopt the appropriate decision in connection with the loss of the possibility to restore legal protection of the earlier trademark.

2. Possibility of Misleading where there is no Risk of Confusion

IPC Presidium Resolution of 29 August 2022 in Case No. IPC-295/2021

Subpara 1, Para 3 and Subpara 2 Para 6, Art. 1483 of the RF Civil Code are independent grounds for refusal of state registration of a trademark or invalidation of the legal protection granted to a registered trademark.

The provisions of Subpara 1, Para 3, Art. 1483 shall apply, among other cases, if one person has widely used a sign for a long period of time and it has been proven that the sign in the consumer's mind persistently associates with the person who used it, and another person has acquired the exclusive right to such a sign through its registration as a trademark.



Disputed trademark (unprotected elements: the shape of the package, the words "PELMENI", "PREMIUM QUALITY PRODUCT")

Two companies jointly engaged in the production of “pelmeni” (meat dumplings) filed an objection with Rospatent against the registration of the disputed trademark, also registered in respect of “pelmeni”. Rospatent invalidated the this trademark due to its non-compliance with the requirements of Subpara 1, Para 3, Art. 1483. The first instance court upheld this administrative decision, and the IPC Presidium upheld the court’s decision.

The court agreed with Rospatent’s decision that the disputed trademark itself does not carry any direct information that could mislead the consumer as to the manufacturer of the goods.

At the same time, the invalidity applicants have succeeded in proving that, due to their joint long and intensive production and sale of “pelmeni” in a tied black-coloured bag, this sign has become widely known among consumers. Due to such popularity, specific associations have risen in the minds of consumers before the priority date of the disputed trademark; hence, the disputed sign can be misleading for the consumer.

The first instance court rejected the rightholder’s argument that the presence of other elements in the disputed trademark, such as the applicant’s company name, which, in its opinion, occupies a dominant position, ensures compliance with the requirements of Subpara 1 Para 3, Art. 1483.

The IPC Presidium found these conclusions justified, emphasising that the comparison was made between the disputed trademark, on the one hand, and a long-standing and widely used sign, on the other, that, *inter alia*, had been established by a number of judicial acts that had entered into legal force and a decision of the antimonopoly authority.

In the course of the judicial review one question was particularly discussed: the possibility of recognising the disputed trademark as misleading in relation to a well-known sign when no likelihood of confusion under Subpara 2, Para 6, Art. 1483 of the Civil Code was found between the disputed trademark and the same well-known sign registered as a trademark. According to the case materials, the packaging shape used by the invalidity applicants had been registered as a trademark before the disputed trademark’s priority date, and during the examination of the disputed trademark Rospatent did not find any likelihood of confusion of the ‘junior’ trademark with the previously registered ‘senior’ trademark. Therefore that registration gave rise to a presumption of validity, as the absence of the likelihood of confusion between the two signs compared was now presumed.

In the course of cassation appeal, the IPC Presidium used its right to send enquiries to the scholars in accordance with the procedure provided

for by Part 1.1, Art. 16 of the RF Commercial Procedural Code, in order to obtain clarifications on the relationship between Subpara 1, Para 3, and Para 6, Art. 1483 of the Civil Code, specifically on the value of the presumption validity based on the absence of likelihood of confusion.

As a result, the IPC Presidium concluded that Subpara 1, Para 3 and Subpara 2, Para 6, Art. 1483 of the Civil Code are independent grounds for refusing to register a trademark and independent grounds for invalidating the granting of legal protection to an already registered trademark.

The provisions of Subpara 1, Para 3, Art. 1483 of the Civil Code shall also apply, among other situations, if one person has been widely using a sign for a long time and it has been proved that this sign creates in the consumer's mind a persistent associative link with the person who used it, and another person has acquired the exclusive right to such a sign through its registration as a trademark.

The IPC Presidium pointed out that in this particular case, the aforementioned presumption of validity could simply not be overcome, since the misleading element of the disputed trademark had been disclaimed.

In such a case, the fact that the mentioned element of the disputed trademark misleads consumers by virtue of the provisions of Subpara 1, Para 3, Art. 1483 of the Civil Code, allows to consider the entire trademark as misleading, on the one hand (without analysing other elements included in the trademark), while the disclamation of this element does not allow challenging its registration under the rules of Subpara 2, Para 6, Art. 1483 of the Civil Code, on the other hand.

Thus, the IPC Presidium recognised that in this case it was legitimate to apply Subpara 1, Para 3, Art. 1483 as an independent ground for invalidating the granting of legal protection to the disputed trademark.

3. Evaluation of Evidence Found on the Internet

IPC Presidium Resolution of 05 August 2022 in Case No. IPC-17/2022

It cannot be argued that consumers have developed certain associative links with a sign merely on the basis that an unknown person has entered some information into a free content encyclopaedia, without analysing the duration of the placement of such information on the Internet, the number of its views and citations, etc.

Rospatent rejected the application for the sign “White Hand” in respect of a broad list of goods of ICGS Classes 5, 32, and services of ICGS Classes 35, 39, and then rejected the applicant’s objection against this decision. The IPC recognised the last decision of Rospatent invalid due to its non-compliance with the requirements of Subpara 2, Para 3 of Art. 1483. The IPC Presidium upheld the first instance court’s ruling.

When considering the objection, Rospatent pointed out that the experts, based on information from Wikipedia and one literary source, saw in the applied verbal sign a reference to the name of a number of terrorist organisations that were active in foreign countries (Serbia, Guatemala) at the beginning and in the second half of the 20th century. In doing so, Rospatent noted that the applicant had not provided any documents refuting that information and rejected the argument that there was no such banned terrorist organisation in the Russian Federation, pointing out that such a socio-political phenomenon as terrorism had no geographical boundaries or time frames.

The first instance court pointed out that this decision was unlawful because Rospatent had not analysed the associative links arising in the consumer’s mind upon seeing the sign. The mere fact of mentioning the sign ‘White Hand’ as the name of a terrorist organisation is not a basis for applying the provisions of Subpara 2, Para 3, Art. 1483 of the Civil Code: to do so, the relevant associations arising in the consumer’s mind and the nature of their perception of the sign must be assessed.

The IPC Presidium reminded that in order to assess the sign for its compliance with the norms of Subpara 2, Para 3, Art. 1483 of the Civil Code, it is necessary to take into account how consumers perceive this sign in each specific case, based on the sign’s semantic meaning and taking into account all relevant factors on a case-by-case basis.

The IPC Presidium then supported the position of Rospatent that propaganda of terrorism and registration as a trademark of a sign reproducing the name of a terrorist organisation and perceived as such by the Russian consumer was unacceptable.

At the same time, the IPC Presidium noted that Rospatent’s conclusion based only on information from an encyclopaedia such as Wikipedia, from other Internet sources referring to it, and from a literary publication of approximately the same year of publication as the application filing date, does not correspond to the expected level of legal motivation, especially

since Rospatent has broad powers to involve a wide range of sources and information at different stages of sign evaluation to motivate its decisions.

The IPC Presidium reminded that the activities and decisions of a public body should inspire the confidence of citizens, society and organisations.

4. Co-ownership of Trademarks under International Registration

IPC Presidium Resolution of 27 July 2022 in Case No. IPC-281/2021

In view of the provisions of Art. 6 quinquies (B) of the Paris Convention, the granting of legal protection in the Russian Federation to a trademark registered under international registration cannot be recognised invalid on the grounds of its inconsistency with the norms of Art. 1478, Civil Code (due to the fact two legal entities are the right holders of the trademark).

An individual entrepreneur applied to Rospatent with an objection against the granting of legal protection to a trademark under an international registration. Initially the registration was in the name of one foreign legal entity, but years later the international registry was amended, and two foreign legal entities became the right holders. Rospatent refused to grant the objection, following which the individual entrepreneur appealed to the IPC. The first instance court dismissed the claims, and the cassation court upheld this ruling.

In rejecting the claims, the first instance court drew attention to the admissibility of co-ownership of a trademark under an international registration in the case of its registration as such in the country of origin, which is directly evidenced by the rules of the Paris Convention.

The IPC Presidium also noted that under Art. 6.quinquies (B) of the Paris Convention, trademarks falling under this Article of the Convention may be refused registration or invalidated only in the following cases:

where the signs may infringe rights acquired by third parties in the country where protection is claimed;

if the signs have no distinctive character or consist exclusively of signs or indications which may serve, in trade, to indicate the kind, quality, quantity, intended purpose, value, place of origin of the goods or the time of production, or which have become customary in the current language or

in the bona fide and established commercial practices of the trade of the country where protection is claimed;

if the signs are contrary to morality or public policy and, in particular, of such a nature as to deceive the public.

Article 10.bis of the Paris Convention provides for the invalidation of the granting of legal protection to a trademark if its registration constitutes an act of unfair competition.

Under the Paris Convention, there are no other grounds for refusal to grant legal protection to trademarks under international registrations.

In accordance with the meaning of the above norms of international law, the granting of legal protection to a trademark under international registration in the Russian Federation may be refused only on the grounds expressly mentioned in the said legal norms.

Thus, the IPC Presidium agreed with the conclusion of the first instance court that the granting of legal protection in the Russian Federation to the contested internationally registered trademark cannot be invalidated on the grounds of its inconsistency with the norms of Art. 1478 of the Civil Code (due to the fact that the right holders of the trademark are two legal entities).

5. Methodology for Comparing a Trademark and an Appellation of Origin

IPC Presidium Resolution of 22 July 2022 in Case No. SIP-1042/2021

For the purposes of Para 7, Art. 1483 of the Civil Code, the trademark (the sign applied for registration) is to be subjected to comparison with account of its strong and weak elements and the appellation of origin taken as a whole,.

Rospatent refused to register the sign ‘Palazzo di Parma’ with respect to a broad list of ICGS Class 29 goods and to satisfy the applicant’s objection, despite the voluntary reduction of the list of goods. The first instance court, on the contrary, recognised the designation as fancy and cancelled Rospatent’s decision due to the violation of the provision of Subpara 1, Para 3, Art. 1483 of the Civil Code. The court also disagreed with Rospatent’s conclusion that the sign does not comply with the provisions of Para 7, Art. 1483.

In particular, the first instance court did not agree with the conclusion that the applied-for sign and the earlier appellation of origin 'PROSCIUTTO DI PARMA' have a common strong element 'DI PARMA' / 'di Parma'. The Court stated that the subject of comparative analysis to establish similarity on the semantic criterion should be the verbal elements 'Palazzo' of the disputed designation and 'PROSCIUTTO' of the earlier appellation of origin, which have no phonetic and semantic similarity. Taking this into account, the court ordered Rospatent to register the contested sign.

The IPC Presidium, in its turn, decided to change the first instance court's decision and passed a new court order obliging Rospatent to reconsider the objection against the refusal to grant legal protection to the trademark, with account of the legal positions set out in the ruling.

Firstly, the IPC Presidium rejected Rospatent's claim that the court decision did not comply with the requirements of Subpara 1, Para 3, Art. 1483. The decision of Rospatent was rightly recognised invalid because the circumstances regarding the probable associative links with the sign applied for registration in relation to each product (group of products) had not been investigated in detail.

Secondly, the IPC Presidium noted that, in general, it is a methodological error to look for strong and weak elements in an appellation of origin, since such a means of individualisation is granted legal protection if the sign as a whole has become known in relation to specific goods.

Accordingly, the IPC Presidium clarified that for the purposes of Para 7, Art. 1483 of the Civil Code, a trademark (a sign applied for registration) is subject to comparison with account of its strong and weak elements and the appellation of origin as a whole.

6. Termination of Trademark Protection in case of Right Holder's Bankruptcy

IPC Presidium Resolution of 21 July 2022 in Case No. SIP-1172/2021

If the right holder has voluntarily terminated his/her activity as an individual entrepreneur, but at the time when a third party files an application for early termination of the legal protection of a trademark, bankruptcy proceedings have already been initiated against this right holder, the interests of such third party shall be satisfied not at Rospatent by considering the said application, but by purchasing the trademark at auction as part of bankruptcy proceedings.

A company filed an application with Rospatent for early termination of the legal protection of a trademark due to the termination of the right holder's activities as an individual entrepreneur.

Rospatent refused to satisfy the objection because at the time the application was filed, a debt restructuring procedure had been introduced against the right holder. Consequently, all the assets of this person constitute the bankruptcy estate, the disposal of which is carried out as part of the bankruptcy case.

The first instance court upheld Rospatent's decision.

The company has filed a cassation appeal. The company pointed out that it follows from the clarifications of Para 175 of the Resolution of the Plenum of the Supreme Court of the Russian Federation No. 10 of 23 April 2019 'On the Application of Part Four of the Civil Code of the Russian Federation', that the exclusive right to a trademark is included in the estate to be sold for the purposes of satisfying the property claims of creditors only when an individual entrepreneur ceases to operate against his/her will, i.e. in the event of a bankruptcy. In this case, according to the company's opinion, the right holder stopped their business activities at their own will; therefore, the legal protection of the disputed trademark should be terminated.

The company pointed to important violations of the application assessment procedure, arguing that it was the task of Rospatent to perform early termination of legal protection of trademarks, and that Rospatent failed to do so.

The IPC Presidium did not agree with the arguments for the following reasons.

According to Part 1, Art. 45 of the Russian Federation Constitution, everyone is guaranteed the protection of his or her rights. A company is not the only person to whom such protection is guaranteed; it is guaranteed to everyone, including those whose interests contradict those of the company.

In the context of early termination of the legal protection of a trademark, it is the not duty of Rospatent to automatically terminate such protection at the request of any person, but to consider the merits of the issue and terminate the legal protection only if there are grounds therefore (and there are no obstacles thereto).

Thus, the key question in this dispute is whether there were really no grounds for early termination of the legal protection of the disputed trade-

mark and whether Rospatent was able to establish this (which includes the actions which, in the company's opinion, violate the procedure).

As directly follows from the said Para 175 of Resolution No. 10, the Supreme Court considers only three of all possible cases involving individual entrepreneurs: 1) voluntary cessation of business activities without any operations with the trademark, 2) voluntary cessation of business activities with subsequent transfer of the trademark to a legal entity or individual entrepreneur (or where the right holder obtains a new status of an individual entrepreneur), and 3) forced termination of business activities (including bankruptcy).

The Supreme Court does not consider the case of a voluntary cessation of business operations followed by bankruptcy.

From this point of view, both the purpose of the legislative regulation and the substance of the Supreme Court's clarifications need to be clarified so as to determine whether they can apply by analogy to the situation in the present case.

The IPC Presidium drew attention to the legal position stated in the Supreme Court's ruling of 21 March 2018 No. 306-ES17-19720: in addition to the provisions of the Civil Code, which give legal grounds to strip the right holder of the exclusive right to a trademark, one should also take into account the special norms of the Bankruptcy Law, which are aimed at protecting the rights and legitimate interests of creditors of the bankrupt right holder. Therefore, to achieve a balance between the interests of the person wishing to use the trademark and the creditors interested in the fullest satisfaction of their claims at the expense of the debtor's property, the trademark must be purchased at an auction for a fair price.

The essence of the legislative regulation laid down in Subpara 4, Para 1, Art. 1514 of the Civil Code is that in order to secure the interest of a particular person who is not the holder of a trademark, protection for a sign that is no longer used in business operations must be discontinued (no justification of such interest is required).

According to the logic of the Supreme Court, this interest is to be protected unless an interest that is more important for the law and order is identified (the interest of the legally compliant right holder in the second case described by the Supreme Court or the interest of creditors in the third case).

The situation considered in this case is essentially a compilation of the second and third situations considered by the Supreme Court. Namely,

business operations were ceased on a voluntary basis, but at the time the application for early termination of the legal protection of the disputed trademark was filed, the arbitration court ruled that a procedure for restructuring the individual's debts should be introduced in respect of the right holder. The individual was later declared insolvent (bankrupt).

In that situation, both Rospatent and the first instance court focused on the legitimate interest of the creditors, seeking to satisfy their claims at the expense of the debtor's property.

The company's interest in the trademark in such a situation may be protected in different way, namely, by purchasing the trademark at an auction for a fair price.

7. Descriptive Nature of a Sign

IPC Presidium Resolution of 20 July 2022 in Case No. SIP-1044/2021

The characteristics of a goods that prevent registration of a sign on the basis of the provision of Subpara 3, Para 1, Art. 1483 of the Civil Code include the intended result of the use of goods for the purpose specified.



Disputed sign

Rospatent refused to register the disputed sign, citing, in particular, non-compliance with the requirements of Subpara 3, Para 1, Art. 1483 of the Civil Code, since the verbal elements 'Mouse Death' indicating the purpose (to cause death to rodents, i.e., mice) and properties (destroying rodents, i.e., mice) of the goods in question.

The first instance court overturned the decision of Rospatent, which rejected the applicant's objection, and concluded that the disputed verbal elements should be protected. In the opinion of the court, this element is fancy and not descriptive in respect of ICGS Class 5 goods, as it does not directly

indicate the property and purpose of the goods, nor does it indicate the type of goods, the name of raw materials or materials from which ICGS Class 5 goods are made, nor does it contain any definition of a animal poison.

In overturning the decision of the court of first instance, the IPC Presidium stated that the substantive law had been applied incorrectly: the court had unjustifiably narrowed the content of Subpara 3, Para 1, Art. 1483 of the Civil Code.

Pursuant to this norm, signs consisting only of elements characterising goods, including those indicating their type, quality, quantity, property, purpose, value, as well as the time, place and method of their production or sale, cannot be registered as trademarks.

The “properties of the goods” and “purpose of the goods” mentioned in this norm are only examples of possible characteristics of the goods. The wording “including”, from the point of view of the Russian language, clearly means that the list of possible characteristics of the goods is not exhaustive.

Such characteristics may also include the intended result of using the product for the purpose specified (in the case under review, the cessation of activity of a rodent, in particular, a mouse).

(On re-examination, the intellectual property court dismissed the claims in its judgement of 18 October 2022).

II. Patents

8. Extension of Patent Term for a Divisional Application

IPC Presidium Resolution of 29 August 2022 in Case No. SIP-1141/2021

In case a patent granted on the basis of a divisional application is extended, the filing date of the divisional application should be considered to be the initial application filing date.

Rospatent issued supplementary patent at the request of the right holder on the basis of Para 2, Art. 1363 of the Civil Code.

The company believed that Rospatent extended the term of the disputed patent validity in violation of Para 2, Art. 1363 of the Civil Code and filed a petition to the IPC to recognise the actions of Rospatent as unlawful. The Company pointed out that the statutory requirement of at least five years between the filing date of the claim for an invention and the date of the first

authorisation for the use of its protected product had not been met in the case at hand.

The authorisation to use the medicinal product related to the disputed patent was received in 2014, while the divisional application that served as the basis to grant the disputed patent was not filed until 2020.

The IPC disagreed with this argument of the company, noting the following.

Taking into account Paras 1 and 2, Art. 1363 of the Civil Code, two legal events are relevant for establishing if the validity term of a patent for an invention relating to a medicinal product based may be extended:

1) date of patent application filing from which the term of validity of the patent shall be calculated;

2) date of the first authorisation to use the medicinal product (registration certificate). A patent for an invention relating to a medicinal product shall be renewed if more than five years have elapsed between dates (1) and (2).

For the purposes of Para 2, Art. 1363 of the Civil Code, the application filing date shall be determined by the date from which the patent term is calculated. Since the beginning dates of the calculation of patent validity term for a patent granted on the basis of a divisional application and for a patent granted on the basis of an initial application coincide and are determined by the initial application's filing date, the filing date of the divisional application (for the purposes of this norm) should be considered to be the filing date of the initial application.

9. Invention Novelty and Science Fiction

IPC Presidium Resolution of 29 July 2022 in Case No. SIP-649/2021

Mere suggestions about possible future technical solutions do not vitiate the novelty of the invention. Otherwise, when analysing novelty, the prior art should have included science fiction literature, among other things.

Rospatent received an objection and, upon considering it, invalidated the patent for the invention 'S1P Receptor Modulators for the Treatment of Multiple Sclerosis' on the grounds of the lack of novelty. The patent holder appealed to the IPC, which granted its application and recognised the decision invalid due to its failure to comply with the requirements of Paras 1 and 2, Art. 1350 of the Civil Code, ordering Rospatent to reconsider the ob-

jection to the granting of the patent. The IP Presidium upheld the decision of the first instance court, dismissing the cassation appeals of Rospatent and the invalidity applicant.

In granting the claim for invalidation of Rospatent's decision, the IPC examined not only the information sources presented in the case materials, but also took into account the answers of scholars and research institutions to the court enquiries made by the court pursuant to the procedure provided for by Part 1.1, Art. 16 of the Commercial Procedural Code, as well as the answers by expert R. Y. Yakovlev to the questions asked by the court and representatives of the parties.

The first instance court concluded that the technical solution was not presented in the prior art because the opposing source only made a theoretical assumption, and a survey was planned to verify this assumption.

The IPC Presidium upheld the decision, noting the validity of the approach that merely announcing a trial of a drug in the required dose does not provide a basis for recognising the known use of the drug in that dose.

10. Assessing Originality of an Industrial Design

IPC Presidium Resolution of 28 July 2022 in Case No. SIP-1251/2021

When an industrial design is assessed for its compliance with the condition of patentability 'originality', the disputed object must be evaluated and its essential, dominant features have to be singled out in the first place. Such features are determined irrespective of the analogue design chosen: they are inherent in the industrial design and characterise it as such.

Rospatent granted a patent for the industrial design 'Furniture module-transformer with storage system, sofa and folding bed' and rejected an invalidity application against it.

The first instance court decision, upheld by the ruling of the IPC Presidium, invalidated Rospatent's decision due to non-compliance with the requirements of Para 3, Art. 1352 of the Civil Code (assessment of originality).

In rejecting the cassation appeal, the IPC Presidium reminded that when checking the originality of an industrial design, first of all, its appearance is examined and its essential, dominant features are identified. The Presidium recalled the definitions of such features and their differences from mere nuancing features.

In the next step, the appearance of the product is compared with the appearance features of an opposing product selected from the range of analogues. This comparison makes it possible to determine whether the set of distinctive essential features of the disputed industrial design creates a different visual impression from the item in question.

When comparing the visual impressions of two items, information about known solutions that determine the appearance of products of this purpose and similar purposes (about the range of analogues) is taken into account, and the limitations of designers' abilities to develop a solution for the appearance of the product of the given purpose, associated, in particular, with the functional features of the product are considered (consideration of the designer's degree of freedom).

In the present case, however, as the first instance court found, instead of determining the essential features inherent in the disputed industrial design, then examining the closest analogue to determine whether these essential features are inherent in it, and identifying the essential features of the disputed industrial design which are distinctive from the closest analogue, thus determining the materiality of the contribution of such distinctive features to the appearance of the disputed industrial design, Rospatent began by comparing the disputed and opposed appearances of the products, and selected only the most material distinctive features of the disputed industrial design.

The IPC Presidium CIP emphasised that the essential, dominant features of the disputed appearance of a product are determined irrespective of the analogue chosen: they are inherent in the industrial design and characterise it as such.

Information about the authors:

M.A.Kolzdorf —LLM, Senior Lecturer.

N.I. Kapyrina — Candidate of Sciences (Law), Assistant Professor.

Contribution of the authors:

M.A. Kolzdorf — para 1, 6, 8.

N.I. Kapyrina — para 2, 3, 4, 5, 7, 9, 10.

The article was submitted to the editorial office 11.06.2023; approved after reviewing 23.06.2023; accepted for publication 23.06.2023.