

## Reviews

*Review*

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# Key Issues in the Intellectual Property Court's Presidium Rulings



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## Abstract

The comment reviews key positions in the rulings of the Presidium of the Russian Intellectual Property Court (IPC) issued in the period from November, 2024 to June, 2025. 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 regular review covers predominantly 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 questions related to trademark law, patent law and various procedural matters.



## Keywords

trademarks; cancellation for lack of use; unfair competition; patent; grace period; pharmaceuticals; industrial application; inventive step.

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## I. Trademarks and Other Distinctive Signs

### A. Validity

#### 1. Sculptures in the Trademark

##### *IPC Presidium Resolution of 28 March 2025 in Case No. SIP-217/2024*

The heiress of the sculptor of 'Worker Man and Kolkhoz Woman' filed an objection with Rospatent under Subpara 1, Para 9, Article 1483 of the Russian Federation Civil Code (hereinafter — the Civil Code) opposing the granting of protection to trademarks that feature an image of the sculpture.

While Rospatent has recognized the applicant as an interested party, since she had inherited all the exclusive rights of the author V.I. Mukhina-Zamkova, it has rejected her objection, establishing the city of Moscow owns the sculpture: in 1950, the author created a plaster sculpture commissioned by the Mosfilm studio for use as its logo. This image is identical to the original sculpture, so it is unclear which sculpture is used in the trademarks.

Accordingly, in Rospatent's opinion, no consent from the sculptor's heiress was required for the registration of the disputed trademarks.

Rospatent has concluded also there was no risk of confusion between the trademarks and the image of the sculpture, because, among other things, the sculpture image is not perceived as a distinctive element of the disputed trademarks.

The Intellectual Rights Court has overturned Rospatent's decision and referred the objection for reconsideration on the following grounds.

In 1950, the law permitted the transfer of only certain rights rather than the entire copyright. The sculptor transferred to Mosfilm the right to use the sculpture as the Mosfilm logo, but retained the right to use the work in other ways.

The IPC has noted a contradiction in the position of Rospatent, which has recognized the applicant as having an interest in filing an

objection, since she had inherited the copyright, but at the same time concluded there was no need to obtain her consent for trademark registration.

Under Subpara 1, Para 9 of Art. 1483 of the Civil Code, only the copyright holders and their heirs have the right to file an objection.

Rospatent's assertions that image of the sculpture is not perceived as a distinctive element are inconsistent with the presumption arising from the very fact of registration of the disputed trademarks without disclaiming this image. In a situation like this, it is assumed all protected elements of the trademark perform an identifying function.

The IPC recalled that, when in the presence of an earlier protected work, the following circumstances have to be assessed in order to conclude that a trademark does not comply with Subpara 1, Para 9, Article 1483:

- the work must simply be protected by copyright: in this respect, the provision is aimed at protecting the copyright in the 'earlier' work;

- the trademark must be identical to the work or there must be a likelihood of confusion with that work;

- there must be no consent from the rightholder of the opposing work to register the trademark.

## 2. Pennames in the Trademark

*IPC Presidium Resolution of 24 March 2025 in Case No. SIP-726/2024*

**Consent to use a pseudonym in the name of a non-profit organization does not imply consent to register a trade mark that includes such a pseudonym.**

Rospatent has dismissed the objection filed by the heir (spouse) of Elizaveta Petrovna Glinka under Subpara 2, Para 9, Art. 1483 of the Civil Code against the registration of the pseudonym "Doctor Lisa" as a service mark for a broad list of services in the name of a public organization.

Stating the spouse had previously approved the use of the pseudonym in the name of the public organization and that the objection was not intended to protect the reputation of E.P. Glinka, Rospatent did not recognize her spouse as a person interested in filing an objection.

The IPC has overturned Rospatent's decision and invalidated the legal protection granted to the disputed service mark.

The court disagreed with Rospatent's conclusion that the heir had no interest in filing an objection.

The IPC noted that the objector's interest in this case was based solely on the fact that he was the heir of a well-known person who had used this pseudonym, and that the request for consent to register the service mark was aimed at protecting his property interest (ruling of the RF Constitutional Court of 28 January, 2016 No. 123-O).

The IPC acknowledged question of whether consent was or was not given is one that is decided not at the stage of assessing the person's interest, but at the stage of considering the objection on its merits. Thus the arguments in Rospatent's cassation appeal were based on a misunderstanding of the circumstances relevant to filing an objection and of those necessary for allowing one based on the results of its consideration on the merits.

Regarding the merits of the dispute, both Rospatent and the right-holder acknowledged that the service mark reproduced E.P. Glinka's pseudonym and that no specific consent had been obtained for its registration; however, they considered that such consent was implied by the consent to use the pseudonym in the name of a public organisation.

At the same time, a public organization's name and a disputed service mark are different objects; the conditions for granting them legal protection differ; they have different legal status and scope of legal protection; and they are governed by different rules of civil law. The name of a public organization is not a distinctive sign protected under the rules of Part Four of the Civil Code.

The heir's consent to register a pseudonym as a service mark is a transaction that intermediates the granting of the right to register a sign in respect of a specific list of goods and services.

In the absence of the heir's direct expression of wish to register the disputed service mark, Rospatent did not confirm that the heir's will included consent for the public organization to use the disputed sign as a service mark in relation to a wide range of services, some of which are not directly related to the organization's charitable activities (e.g., 'targeted marketing; organization of exhibitions for commercial or advertising purposes,' etc.).

The public organization retained the right to use the pseudonym 'Doctor Lisa' in its name and to conduct activities under this name.

This decision provides, to a certain extent, a balance between this organisation's rights and the heir's right to use the pseudonym.

The fact that a public organization carries out its statutory activities, which were previously carried out under the leadership of Elizaveta Glinka, and that Elizaveta Glinka became famous in connection with the activities of this organization, does not grant this organization any authority in relation to the pseudonym of its former leader.

### 3. Intended Use of Goods and Services

*IPC Presidium Resolution of 18 June 2025 in Case No. СИП-434/2024*

**The assessment of whether a sign indicates a purpose of use must be made in relation to each goods and services item claimed. Rospatent cannot limit itself to an abstract statement that the sign indicates the intended purpose of the goods; it must specify the intended purpose in the decision.**

**The sole fact that a sign is descriptive for some goods does not mean that it is false or misleading for all others.**

Rospatent has rejected the registration of the designation 'Spetskabel' as a trademark on the basis of Para 1 and 3 of Art. 1483 of the Civil Code, since in relation to some of the goods and services filed, it indicates the intended purpose, and for the rest, it may mislead consumers as to the properties and intended purpose of the goods and services. Following the applicant's objection, Rospatent has decided to partially register the disputed sign for certain services but refused to register the trademark for the remaining goods and services.

The first instance court has invalidated the decision regarding the rejection and ordered Rospatent to re-examine the objection. The IPC Presidium upheld the first instance court's conclusions.

The first instance court agreed with the semantic meaning of the sign ("special-purpose cable") identified by Rospatent but concluded that it had assessed the disputed sign for its compliance with Subpara 3, Para 1, Art. 1483 of the Civil Code without taking into account the perception of this sign by the target group of consumers of the goods and services specified in the application.

When considering cases that challenge Rospatent decisions made on the basis of Para. 1 of Art. 1483, the court takes into account any existing or potential associative links that consumers may have regarding the disputed sign, based on the evidence available in the case materials.

Para 2.5 of Guidelines No. 12<sup>1</sup> states 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. Signs consisting solely of elements characterizing the goods, are not granted legal protection, and manufacturers are not granted the exclusive right to use them because any person may need to use signs that characterize the goods in civil transactions.

Para 2.5.5 of Guideline No. 12 states: “The term ‘intended use of goods’ refers to the area of application of goods, their functions, consumer group, etc. The following elements may indicate the intended use of goods: ‘for children and expectant mothers’, ‘for women’, ‘for boys’, etc.”

The IPC proceeded from the assumption that the association characterizing goods and services should be direct and require no interpretation. In this case, it is only reasonable to assume this particular sign may be used by different persons in relation to specific goods or services and, consequently, it must be free from the rights of specific persons.

At the same time, Rospatent’s decision fails to provide a specific analysis of how the target consumer group perceives the claimed sign in relation to the disputed goods and services. Rospatent limited itself to an abstract statement that the sign would be perceived as indicating the intended purpose of the goods and services.

Unlike the examples given in Guideline No. 12, where, regardless of the type of goods or services, the sign always indicates a clear purpose that does not require additional justification (“for boys”), in the case at hand, the court was unable to determine what specific purpose Rospatent had in mind for the disputed goods and services.

Only by knowing the associative link suggested by Rospatent in relation to the claimed sign, one can verify whether it is reasonable to assume its existence among consumers of the disputed goods and services, and whether it is direct or requires interpretation.

Para 4.1.2 of Guideline No. 12 states: the same sign may be considered descriptive in relation to some goods, false in relation to others, and

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<sup>1</sup> The Guidelines for the implementation of administrative procedures and actions within the framework of the provision of public services for the state registration of trademarks, service marks, collective marks, and the issuance of certificates for trademarks, service marks, collective marks, and their duplicates, approved by order No. 12 of the Federal State Budgetary Institution “Institute for Industrial Property”. 20 January 2020.

fanciful in relation to still others: a presumed false association of a sign with specific goods and services that lacks credibility in itself gives the sign a fanciful character. Such signs may be registered.

With regard to the provisions of Subpara 1, Para 3 of Art. 1483, Rospatent's decision also contained abstract wording. In drawing conclusions about whether the disputed sign could mislead consumers regarding some of the claimed goods and services (and whether it was false regarding others), Rospatent did not specify what would mislead consumers about the type or purpose of each of the listed goods and services, nor why consumers would perceive the suggested associations as plausible.

Rospatent's conclusions cannot be verified in the absence of such an indication.

The first instance court has found that, with regard to some of the goods and services, Rospatent had identified grounds for refusing registration that differed from the grounds on which the refusal to register had been based during the examination of the designated sign (applying Para 1, Art. 1483 instead of Para 3) and had not brought these grounds to the applicant's attention. In its cassation appeal, Rospatent has referred to the fact that, both at the examination stage and at the stage of consideration of the objection, it had applied the provisions of Sub 3, Para 1 and Subpara 1, Para 3, Art. 1483, and therefore no new grounds had been identified.

The Presidium has rejected this argument on the grounds that the provisions of Subpara 3, Para 1 and Subpara 1, Para 3, Art. 1483 do not establish a single, collectively applicable basis for refusing to register a trademark. Just because a sign is descriptive for some goods does not mean that it is false or misleading for all others; for certain goods, it may be fanciful and not covered by any of the above provisions. In fact, Rospatent determines separately for each product and service item whether or not legal protection can be granted to a trademark.

## **B. Cancellation for Lack of Use**

### **4. Use under Control of the Rightholder**

*IPC Presidium Resolution of 26 December 2024 in Case No. SIP-64/2024*

**Even if a contract for the supply of goods bearing a trademark is concluded abroad, if it indicates the buyer's intention to use the trademark in**

**Russia, it may prove the use of the trademark in Russia under the right-holder's control.**

**The usual condition of trade in certain goods, which does not constitute a temporary obstacle, cannot be recognised as a valid reason for a trademark not being used.**

A company has filed a claim with the IPC for cancelling the legal protection of a trademark in relation to goods in ICGS Class 34 (snus; cigarettes; mouthpiece cigarettes; tobacco; tobacco products) due to its lack of use.

The first instance court upheld the claim in full. The IPC Presidium has overturned the decision regarding the early termination of protection for goods classified as 'Tobacco; tobacco products' and remanded the case, noting the following.

1. With regard to tobacco and tobacco products, the rightholder submitted a supply agreement between themselves and a Russian organisation, as well as universal transfer documents confirming the sale of these goods in Russia. These documents indicate this Russian entity as the seller.

The first instance court has concluded the documents did not confirm the fact that the trademark was used under the control of the right-holder.

The Presidium of the Court has noted that the rightholder's control may differ in cases where the trademark is used by another person for the production of goods (e.g. control of product quality, production and sales volumes) and in cases where the original goods are imported and subsequently sold. In the latter case, there is no need for additional quality control and monitoring of production volumes. At the same time, the intention of the rightholder must be to use the trademark within the Russian Federation.

Although the supply contract provides for the supply of goods to a Russian entity abroad, it contains conditions on the need for the quality of goods supplied under it to comply with the standards and other regulatory documentation of the Russian Federation, on the mandatory marking with tax stamps, the requirements for which are established in accordance with the domestic legislation, and on the presentation of information for consumers in Russian.

Thus, according to the IPC Presidium, the court of first instance's conclusion that the use of the disputed trademark by a Russian entity



under the rightholder's control was unproven was premature, as it was made without a full assessment of the available evidence in light of the aforementioned legal position.

2. The rightholder pointed out that the reason for not using the trademark in relation to the product 'snus' was the seizure of this product supplied to the Russian Federation.

The IPC Presidium has agreed with the first instance court that the existence of a valid reason for non-use had not been proven.

In accordance with Subpara 2, Para 3, Article 1486 of the Civil Code, evidence submitted by the rightholder demonstrating that the trademark was not used due to circumstances beyond their control may be taken into account when deciding on the cancellation of legal protection of the trademark due to lack of use.

The IPC Presidium has noted that temporary circumstances preventing the rightholder from carrying out normal activities, in a situation where there are reasonable grounds to believe that these activities will resume, are a valid reason for non-use of a trademark. On the one hand, such a situation protects the interests of the rightholder, for whom the three-year period provided for by law and international treaties is objectively insufficient to ensure normal use of the trademark. On the other hand, it protects the interests of society as a whole in cases where legal protection is provided only for trademarks that will objectively be able to fulfil the function of indicating the origin of specific goods once the temporary obstacles have been removed.

At the same time, the seizure of the goods 'snus' in this case is not a temporary reason preventing the use of the disputed trademark in this part. According to Para 8, Art. 19 of Federal Law No. 15-FZ of 23 February 2013 'On the Protection of Citizens' Health from the Effects of Environmental Tobacco Smoke, the Consequences of Tobacco Consumption or the Consumption of Nicotine-Containing Products,' the wholesale and retail trade in naswar, chewing tobacco (snus), edible nicotine-containing products, and nicotine-containing products intended for chewing, sucking, and sniffing.

Thus, snus is harmful to human health and is expressly prohibited from sale under current legislation. Such an obstacle to the use of the disputed trademark for the individualisation of snus is permanent rather than temporary. There are no grounds for believing that this ban will be lifted.

Moreover, the legislator only broadens the scope of the ban. Article 19 of Federal Law No. 456-FZ of 30 December 2015 ‘On the Protection of Citizens’ Health from the Effects of Environmental Tobacco Smoke, the Consequences of Tobacco Consumption or the Consumption of Nicotine-Containing Products,’ was supplemented by Part 8; it stipulates the wholesale and retail trade in naswar and chewing tobacco (snus) is prohibited. On 1 March 2025, Para 4.1, Part 1, Art. 6 of Federal Law No. 203-FZ of 13 June 2023 ‘On State Regulation of the Production of and Trade in Tobacco Products, Tobacco Goods, Nicotine-Containing Products and Raw Materials for Their Production’ have come into force. This clause prohibits the production of naswar and chewing tobacco (snus) in the Russian Federation. Accordingly, it is not reasonable to consider restrictions on marketing goods such as ‘snus’ to be temporary.

In other words, the ban on selling the aforementioned goods in the Russia is a normal practice for the circulation of tobacco products, but not a temporary obstacle that could be considered grounds for not using the trademark.

## 5. Valid Reasons for not Using a Trademark, and Export Restrictions

*IPC Presidium Resolution of 01 November 2024 in Case No. SIP-1161/2023*

**The validity of reasons for not using the trademark, particularly due to export restrictions, is assessed separately for each disputed product. If a goods item is broad in its scope, consideration is given to which goods covered by this item have been supplied to the Russian Federation, and whether restrictions have been imposed on any of them.**

The Company filed a lawsuit seeking revocation for lack of use of the legal protection of a trademark that was registered, among other things, for meat.

The first instance court has satisfied the claim, and the IPC Presidium upheld the court’s ruling. The court has noted, in particular:

1. The plaintiff’s interest in cancelling a trademark’s protection for lack of use shall be considered on the date of submission. At the same time, evidence that appears later can be taken into consideration — if it confirms the interest on the date stated.

2. The rightholder must prove that the trademark was used in relation to the goods in question, which the court has determined to be of

interest to the plaintiff. According to the general rule, similar goods are not taken into consideration, except in the case of widely known trademarks (Para 166 of Supreme Court Resolution No. 10<sup>2</sup>). If the rightholder presents evidence the trademark is not used in relation to all of the disputed goods, and if proof is presented that the trademark is widely known in relation to the goods that the court has determined to be of interest to the plaintiff, the court must assess whether any of the disputed goods are similar to those in relation to which the court has determined that the trademark is widely known.

3. When assessing the validity of reasons for lack of use, it should be borne in mind that if the government of the relevant country has imposed a ban on the export of a certain sub-type of goods, this does not justify such non-use for other sub-types of this type of goods that the rightholder supplied before the restrictions were introduced and, hence, for which it could use the trademark. If a trademark is registered for a broad category (in this case, ‘meat’), this does not mean the rightholder is obliged to use the trademark for all types of goods in that category (beef, pork, etc.). If the rightholder exclusively produces and sells beef under its trademark, it cannot be forced to produce and sell other types of meat during the period of product restrictions, as this would violate the expectations of consumers who associate a specific product with a specific sign. The rightholder gets to decide which products to market under its trademark, making sure the quality of goods meets consumers’ expectations. Consequently, if trade restrictions are imposed on the very goods that the rightholder has introduced, this constitutes a valid reason for not using the disputed trademark in relation to those product categories under which the relevant goods are classified.

4. Submitting a document to the court that has been drafted in a 0.5 mm font (equivalent to 1.4 typographic points), when it could have been drafted and printed in any font, is considered an abuse of procedural law.

## **6. Use of Independent Products rather than Components**

### *IPC Presidium Resolution of 12 February 2025 in Case No. SIP-334/2024*

The company has filed a claim with the IPC against a Swedish company (hereinafter — the rightholder) for early termination of legal pro-

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<sup>2</sup> Ruling of the RF Supreme Court’s Plenum of 23 April 2019 No. 10 “On the Application of Part Four of the RF Civil Code.”

tection of its trademarks containing the word “Ericsson” on the grounds that the company did not use these designations for “heating, cooling and ventilation devices” in ICGS Class 11.

The IPC has satisfied the claim; the IPC Presidium upheld the decision of the court of first instance.

The rightholder had to present to the court evidence, that it used the disputed trademarks or allowed the use by other persons under its control in the period from 18 January 2021 to 17 January 2024 specifically in relation to the product category of ICGS Class 11, ‘heating, cooling and ventilation devices.’

The first instance court has classified the goods for which the company presented evidence as goods not belonging to ICGS Class 11.

The court also has noted that the company had not confirmed that the goods listed in the documents it had submitted were independent products, rather than merely components of telecommunications equipment divided into several parts for subsequent assembly and use on the market. In other words, the rightholder failed to prove that the parts of base stations and digital modules containing, e.g., fans/ventilation elements could be used independently as products designed to cool a room or circulate air in it.

Moreover, the court has noted that the company did not refer to, neither proved that its goods were products for multiple purposes. In such cases, it is permissible to classify a single product under two separate product categories that are not related as ‘general vs specific’ or are not different forms of the same product.

In rejecting the cassation appeal, the IPC Presidium has emphasised: the disputed trademarks were registered not only for ICGS Class 11, but also for a large number of goods in ICGS Class 9, which were not the subject of the dispute and in that regard trademark protection was not cancelled.

As for the existence or absence of valid reasons for not using the trademark in relation to the disputed goods, which would allow the period of evidence to be ‘shifted’, in the present case, there was no need to assess them, since the company had not proved that it had used the disputed trademarks to distinguish the goods in ICGS Class 11 between 18 January 2021 and 25 February 2022, or in general during the three-year period preceding the restrictions to which it referred. Therefore the IPC Presidium did not assess whether any valid reasons for not using the disputed trademark existed or not.

The IPC Presidium also has rejected the argument in the cassation appeal that there were grounds for applying the provisions of Articles 54 and 55 of the Convention on Legal Assistance and Legal Relations in Civil, Family and Criminal Matters, concluded in Chisinau on 7 October 2002 ('the Chisinau Convention'). In the Company's view, the first instance court failed to consider that a judicial authority in Kazakhstan had established the use of relevant goods bearing the disputed signs within Kazakhstan borders, and this fact was relevant to the case in view of the regional principle of exhaustion of rights in the Eurasian economic union (EAEU).

The IPC Presidium has noted that, in fact, the company insisted on the prejudicial nature of the conclusions and circumstances set out in the decisions of the foreign court. The Court has explained that the aforementioned provisions of the Chisinau Convention either do not apply to this case, or they establish a procedure for recognising and enforcing certain decisions in accordance with the requested party's legislation.

At the same time, it does not follow from the provisions of Article 69 of the Russian Federation Commercial Procedural Code that the circumstances established in judicial acts of foreign courts do not need to be proven, i.e. there were no grounds for changing the burden of proof.

Regarding the application of the principle of exhaustion, the IPC Presidium has noted its legal significance in determining whether or not the use of a trademark requires the consent of the rightholder, typically when considering a dispute over alleged infringement of an exclusive trademark right. However, the use of a particular trademark in cancellation proceedings must be established in a different way — without applying the principle of exhaustion. As the IPC Presidium emphasised, Russian lawmakers clearly proceed from the assumption that in order to maintain legal protection of a trademark in the Russian Federation, the trademark must be used exclusively within its borders.

## **C. Unfair Competition**

### **7. Good Cat, Bad Cat...**

*IPC Presidium Resolution of 21 April 2025 in Case No. ЧИП-532/2023*

**Information from the trademark register is not the only factor that matters when considering cases of unfair competition. The actual use of the distinctive sign by the defendant (including in a different form and in**

**relation to related goods and services) also plays a role, as it reveals the true purpose of registering the trademark.**

The Belyi Kot (White Cat) company filed a lawsuit against the Druzhnyi Belyi Kot (Friendly White Cat) company, seeking a declaration that the acquisition and use of three trademarks were an abuse of rights and an act of unfair competition.

Initially, the claim was dismissed, but as a result of the partial reversal of the first instance court's decision, the Belyi Kot's claims were partially upheld upon reconsideration. The defendant's actions in acquiring and using two trademarks in relation to some of the goods were declared as acts of unfair competition that were contrary to the provisions of Article 14.4 of the Law on Protection of Competition, Article 10.bis of the Paris Convention and Article 10 of the RF Civil Code.

Once again disagreeing with the decision, the plaintiff appealed to the IPC Presidium, which partially overturned the decision.

Regarding the part of the decision in which the court refused to declare the defendant's actions as unfair competition, the IPC Presidium has noted that the court had incorrectly applied the methodology for determining the boundaries of an antitrust violation. As a result, all the disputed services in ICGS Class 35 and some of the disputed goods fell outside the product boundaries of the market.

In conducting its business of manufacturing cleaning and house-keeping products, the plaintiff had long used its own trademark incorporating the word element 'White Cat', as well as a trade name with the distinctive part 'White Cat'.

The defendant is the plaintiff's former distributor, who became its competitor in the market for cleaning and housekeeping products. Taking the established circumstances into account, the first instance court has ruled out the possibility of the defendant's choice of signs subsequently registered as trademarks being an accidental coincidence. The court also noted that after registering the signs, the defendant continued to operate in the market for cleaning and housekeeping goods and services and has begun to position itself as the official and sole owner of the brand.

The court of cassation drew attention to the fact that it is incorrect to compare the items of goods in the list of the plaintiff's trademark registration (the company 'White Cat') with the goods and services items specified for the defendant's trademarks (the company 'Friendly White

Cat’); the activities carried out by the plaintiff under the name ‘White Cat’ should be compared with the goods and services for which the defendant’s disputed trademarks are registered, including taking into account the activities for which these are used.

Unlike disputes considered by Rospatent, where only the specific disputed sign in the application or trademark and the list of goods and services as stated in the application or trademark are relevant, cases of unfair competition also consider the defendant’s actual use of the distinctive signs (including in a different form and in relation to related goods and services), because this reveals the true purpose of acquiring exclusive rights to the trademark.

In other words, one must consider the purposes for which the defendant chose to register its sign for a specific goods or services category. The purpose may be apparent from the actual use of the sign.

Overall, the IPC Presidium has stated that the scope of an infringement grounded in the Law on Protection of Competition should be determined with by taking into account the extent (including in terms of goods) to which the alleged infringer can gain an advantage over the aggrieved party in the course of its business activities, and the extent (including in terms of goods) to which the alleged infringer’s actions may result in losses for the aggrieved party or damage its business reputation.

## **II. Patents**

### **A. Validity**

#### **8. Crystalline Lattices**

*IPC Presidium Resolution of 17 December 2024 in Case No. SIP-1013/2023*

**When examining the inventive step of a new crystalline form, Rospatent must assess whether, in a specific case, such a form exhibits useful properties that are unexpected for an expert, that it demonstrates an effect (technical result) that is unexpected for the said expert, whether its discovery was a routine operation or whether it was aimed at solving a specific technical problem.**

Two patent applications for groups of inventions described in the claims as crystalline polymorphs of compounds have been filed with Rospatent.



Rospatent has established that the compounds described in the formula were known from the prior art. The proposed compound differs from that known from the opposing source in that it is presented in crystalline form with specific parameters of its crystal lattice. For an expert in this field of technology it is obvious stability of the crystalline form indicated as a technical result refers to properties that cannot be considered unexpected, since it is known from the prior art that the forms of compounds — crystals, hydrates and solvates — are obtained precisely to improve or modify properties such as stability, purity, solubility, etc. Thus, information about the stability achieved by the proposed crystalline polymorph of the compound clearly follows from the prior art.

Following an assessment of both applications, Rospatent has decided not to grant patents for the groups of inventions due to their failure to meet the patentability requirement of an inventive step.

Furthermore, Rospatent has dismissed the company's objection to these decisions to refuse to grant patents.

The first instance court has invalidated Rospatent's decisions and ordered Rospatent to reconsider the company's objections. The court took into account the expert's explanation that there is no established method for obtaining specific polymorphs that are useful in practical terms, and therefore the task in question may not be obvious to an expert. The court considered Rospatent's conclusions regarding the obviousness of identifying new crystalline forms of polymorphs by changing the parameters of their production, as well as the obviousness of these forms having improved stability properties, to be unfounded, since, from an expert's point of view, the production of specific polymorphs, and the fact that these polymorphs will necessarily have improved stability, is not obvious.

Supporting the conclusions of the first instance court, the IPC Presidium has stated that, compared to the substance disclosed in the prior art, the distinctive feature of the inventions according to the independent claim in the applications is the specific crystalline form of this substance.

The IPC Presidium pointed out that the Civil Code does not establish a specific, solely possible methodology for verifying an invention's compliance with the inventive step requirement. However, a possible option for the methodology for verifying the inventive step of an invention, provided for in Para 76 of Rules No. 316, involves a specific algorithm of actions:



to identify the closest prior art to the invention (step 1);

to identify the features that distinguish the claimed invention, as characterised in the independent claim, from the closest prior art (distinguishing features) (step 2);

to identify solutions from the prior art that have features coinciding with the distinctive features of the claimed invention (step 3);

to analyse the prior art to confirm the known influence of features coinciding with the distinctive features of the claimed invention on the technical result specified by the applicant (step 4).

This methodology is not the only one possible.

Given the specific nature of substance polymorphism precluding use of standard methodology for assessing the inventive step of new crystalline forms of a known substance, applying this methodology when considering a patent application for a crystalline form of a substance will always mean that the latter meets the inventive step condition for patentability, since if the claimed crystalline form is new, it is impossible to find a crystal in the prior art that has the same peak arrangement on the powder X-ray diffractogram. Therefore, the verification will be completed in step 3.

At the same time, this approach does not correspond to the essence of patent law. The reason is that different polymorphic modifications of the same pharmaceutical substance do not necessarily demonstrate different pharmacological activity. Therefore, searching for a specific crystalline form is not necessarily related to solving a specific technical problem. It may, for example, be motivated solely by the desire to obtain a patent dependent on the patent for the substance itself.

While searching through various polymorphic crystalline forms of a substance may be a routine task for a specialist in pharmaceuticals, if the search for a specific polymorphic crystalline form is aimed at solving a specific technical problem, then its decisive new form should be recognised as possessing an inventive step, if it is not obvious to an expert from the prior art.

The Presidium has noted that, although all crystalline forms of a single substance may have different properties, it is impossible to predict which as-yet-unknown crystalline form will have relevant parameters. It can only be asserted that, if a new form is found, its properties will differ from those of the known form in some way. Individual differences (or their combination) may be unexpected.

The IPC Presidium has noted verification of the new crystalline form for compliance with the condition of inventive step includes analysing, among other things:

whether the polymorphism of a specific substance (rather than polymorphism in general as a phenomenon) is known (or obvious to an expert);

whether the methods, including standard methods, for obtaining a specific crystalline form of a specific substance are known (or obvious to an expert);

whether a specific change is unexpected (an unexpected effect / technical result) for an expert in physical and chemical properties compared to known forms of a specific substance.

Thus, the mere obtaining of a new crystalline form of a known polymorphic substance by standard methods, or the study of its properties and demonstration of differences in its properties from other known crystalline forms or from the amorphous form, does not constitute an invention that meets the 'inventive step' condition for patentability, if the properties described in the corresponding application do not disclose an effect (technical result) that is unexpected for an expert and allows the new crystalline form to be used in a way that the known crystalline forms of the same substance could not.

In such a situation, when examining the inventive step of a new crystalline form, Rospatent must assess whether, in a specific case, such a form demonstrates useful properties that are unexpected for an expert, whether it demonstrates an unexpected effect (technical result), whether its discovery was a routine operation or whether it was aimed at solving a specific technical problem.

## **9. Industrial Application of a Pharmaceutical Composition under a Eurasian Patent**

*IPC Presidium Resolution of 09 December 2024 in Case No. SIP-863/2023*

**For demonstrating industrial applicability of a pharmaceutical composition under a Eurasian patent, its therapeutic efficacy must be confirmed. While activity on cells in vitro can confirm the biological activity of a substance, it cannot demonstrate the therapeutic efficacy of a pharmaceutical composition.**

**Rospatent cannot go beyond the objection filed in relation to certain independent points of the formula and invalidate the patent in its entirety**

**without an objection filed in relation to all points of the formula and in the absence of the patent holder's intention to amend the formula.**

An objection has been filed with Rospatent against the validity of a Eurasian patent within Russia for a group of inventions, specifically against two independent claims, the protection for that had been extended. The applicant raised, among other grounds, these claims do not meet the patentability requirement of industrial applicability.

Rospatent upheld the objection on this ground, therefore, other conditions were not assessed. The Eurasian patent was declared invalid in its entirety.

The first instance court patent holder's claim, refusing to invalidate the decision of Rospatent. The IPC Presidium upheld the court's ruling.

The first instance court has ruled that the application materials and the description of the group of inventions covered by the disputed patent did not contain information allowing the conclusion that the compositions in question could be used in healthcare, i.e. there was no information objectively confirming that the invention could be used for its intended purpose; there is no test data and no examples of treatment or prevention of disease; they contain only declarative information; the description shows only methods of preparation for studies that are carried out in vitro. At the same time, the results of other studies were not provided.

Agreeing with the conclusion of the first instance judgement, the IPC Presidium has noted the following:

1. According to Subpara 4, Para 1.4.6.3 of the Rules for the Preparation, Filing and Examination of Eurasian Applications at the Eurasian Patent Office, approved by Order of the Eurasian Patent Office No. 22 of 18 May 1998 (hereinafter referred to as Rules No. 22), for an invention relating to a means for the treatment, diagnosis or prevention of a disease in humans or animals, reliable information confirming its suitability for the treatment, diagnosis or prevention of the specified disease should be provided. With regard to compositions, section 1.4.6.3 of Rules No. 22 stipulates that examples must be provided that indicate the ingredients included in the composition and their characteristics and quantitative ratios. The method of obtaining the composition must also be described (Subpara 8, Para 1.4.6.3 of Rules No. 22).

The criterion of industrial applicability implies the invention is fundamentally suitable for use in any branch of industry. Inventions that

can only be implemented once in specific, unique conditions may meet the requirement of industrial applicability.

It is the patent holder who must prove that the invention can be implemented in principle to achieve the stated purpose, so that the expert (i.e. an expert in the relevant field of technology) has no doubts.

The IPC Presidium was agreed with conclusion of the first instance court, stating the patent holder's position was that, in the case under consideration, the pharmaceutical composition was based on a new compound not known from the prior art.

For this reason, the applicant believed that the provisions of Subparas 4 and 8, Para 1.4.6.3 of Rules No. 22 did not apply to the group of disputed inventions, but rather the provisions of Subpara 2 of the same Para.

Subpara 2, Para 1.4.6.3 stipulates: for an invention relating to a new chemical compound with an established structure, the structural formula and physicochemical constants must be provided. For an invention relating to a chemical compound with unidentified structure, a set of characteristics is provided that allow it to be identified. Furthermore, a description is provided of the method by which these compounds are obtained; where necessary, the possibility of using the compound for a specific purpose is confirmed; for biologically active substances, quantitative characteristics of activity (and toxicity, where necessary) are provided, as well as selectivity of action and other relevant information.

At the IPC Presidium hearing, the representative of the Eurasian Patent Organisation also considered it possible to apply the latter provision on unknown compounds to pharmaceutical compositions if a single application seeks legal protection for a group of inventions that includes both the new compound itself — not known from the prior art — and compositions containing such a compound.

Given that the group of disputed inventions is covered by a patent obtained from a divisional application for a new compound not known in the prior art, the representative of the Eurasian Patent Organisation has pointed out this approach was applicable to the case at hand.

However, the court has observed that the Eurasian Patent Organisation has not provided any data suggesting that the countries participating in the Eurasian Patent Convention interpret the provisions of international agreements in this area in this way.

Meanwhile, the need to apply such an approach in the present case does not follow from the literal content of Para 1.4.6.3 — according to it relevant requirements must cover inventions relating to means for the treatment, diagnosis or prevention of diseases in humans or animals, and compositions. The disputed independent patent claims to the group of inventions relate only to pharmaceutical compositions.

Therefore, the IPC Presidium has acknowledged it is necessary to confirm the therapeutic efficacy of a pharmaceutical composition.

Both Rospatent and the first instance court reasonably assumed that while activity on cells *in vitro* can confirm the biological activity of a substance, it cannot demonstrate the therapeutic efficacy of a pharmaceutical composition because when the composition is applied to a living organism, many accompanying factors arise that can affect therapeutic efficacy, despite biological activity. Therapeutic efficacy example depends on parameters such as, e.g., absorption, distribution, metabolism and excretion, which cannot be tested on cells *in vitro*.

2. The IPC Presidium has acknowledged as worthy of consideration the arguments of the appellants that there are no grounds for declaring the disputed patent completely invalid.

The procedure for considering objections is based on the provisions of Article 45 of the Russian Federation Constitution and Article 11 of the Civil Code and provides for the protection of the rights of the person filing the objection through administrative proceedings.

An objection cannot be upheld arbitrarily. For approval, the administrative body must agree with both the claim and its grounds.

The Rules do not provide for the possibility of granting an objection to a greater extent than requested by the person raising the objection.

Any other approach contradicts to the provisions of Article 45 of the Constitution and Article 11 of the Civil Code regarding the administrative procedure for considering a specific dispute, which can be used exclusively at the discretion of the specific person initiating this procedure in cases provided for by law.

Rospatent could not go beyond the objection and invalidate the disputed patent in its entirety without an objection filed in relation to the remaining patent claims and in the absence of the patent holder's intention to amend the claims of the group of inventions under the disputed patent.

The decision to invalidate a Eurasian patent in Russia on the grounds that it does not meet the conditions for patentability has the same legal significance as invalidating a Russian patent on the basis of Para 1, Article 1398 of the Civil Code. In accordance with Para 139 of Resolution No. 10, Rospatent's decision to invalidate a patent results in the patent being cancelled and the corresponding exclusive right being terminated from the date on which the patent application was filed with Rospatent; this also involves the relevant entry being cancelled in the State Register.

Thus, the decision to invalidate the Eurasian patent in the Russian Federation has retroactive effect.

## **10. How Long Can the Grace Period for the Author Last?**

*IPC Presidium Resolution of 29 November 2024 in Case No. СИП-551/2024*

**The period specified in Subpara 2, Para 4, Article 1352 of the Civil Code is retrospective in nature and cannot be restored, even if there are valid reasons for doing so.**

Rospatent has refused to grant the applicant a patent for the industrial design of a "Tool Bag" due to lack of originality.

In her objection, the applicant argued that she had been directly involved in selling a product whose appearance was recognised as the closest prior art to her design, but she had missed the twelve-month deadline for filing an application, as set out in Para 4, Art. 1352 of the Civil Code, due to compelling reasons: namely, pregnancy and maternity leave.

In rejecting the objection, Rospatent has noted that the law does not provide grounds for restoring the period specified in Para 4, Art. 1352 of the Civil Code for a valid reason, and the administrative body does not have the relevant powers.

The applicant has appealed to the IPC, requesting, among other things, that the legal position reflected in the ruling of the RF Supreme Court No. 78-KG18-74 of 29 January 2019 be taken into account by analogy. According to the RF Supreme Court's explanations, when resolving the issue of restoring the missed deadline for applying to the court, it is necessary to take into account the provisions of the Constitution, which guarantee women who combine work under an employment contract with the fulfilment of family obligations the same opportunity

as other citizens to exercise their rights and freedoms in the field of labour.

In rejecting the application to invalidate Rospatent's decision, the IPC concluded that the time limit set forth in Subpara 2, Para 4, Art. 1352 of the Civil Code is a substantive, not a procedural one. Substantive time limits are not restored unless otherwise expressly provided by law; the restoration of such time limits is not covered by analogy of law. Meanwhile, the law does not provide for the possibility of calculating the period established in Article 1352 of the Civil Code in any other way, or from any other date.

The IPC Presidium upheld the first instant court's ruling and dismissed Rospatent's cassation appeal, noting the following:

Recognising the constitutional importance of supporting mother and child, the IPC Presidium has stated that the provision in Subpara 2, Para 4, Art. 1352 of the Civil Code is universal in nature and is not intended to infringe in any way on the rights of mothers and children.

The IPC Presidium also has noted that neither the provision in question nor any other provisions of the Code establish a deadline for filing a patent application. On the contrary, the applicant chooses the moment of submitting the application. At the same time, the Civil Code establishes certain consequences of the result of such a choice.

In the provision under consideration, the date on which the industrial design application was filed is taken into account when determining the scope of information that became publicly available worldwide prior to the industrial design's priority date, but which is nevertheless not considered when establishing its novelty and originality.

This rule is not prospective (it does not give the right to take any action following a specific date), but retrospective: it allows information disclosed in the past — within twelve months prior to the date of filing the application for an industrial design — to be disregarded.

Retroactive deadlines cannot be restored.

The court has noted that, in effect, by requesting the reinstatement of the 'deadline for filing a patent application', the applicant was asking for this deadline to be extended retrospectively and for information disclosed twenty-five months prior to the filing date of the application for the disputed industrial design to be excluded from the public domain. However, the Civil Code does not allow for this possibility.



Furthermore, the IPC Presidium has emphasised that Subpara 2, Para 4, Article 1352 of the Civil Code establishes an exception to the general rule set out in Paras 2 and 3 of the same Article, according to which novelty and originality are assessed on the priority date of the industrial design.

The Presidium of the Court recalled that exceptions cannot be interpreted by analogy; they do not permit a gap in legal regulation, meaning that anything not covered by the exception is subject to the general rule, and the introduction of exceptions to the general rule is at the legislator's discretion.

## 11. Hindsight Bias Revisited

*IPC Presidium Resolution of 22 April 2025 in Case No. SIP-730/2022*

**The inventive step is assessed based on the knowledge of an expert at the time of the priority date of the disputed invention, rather than at the time of the subsequent examination (e.g. when an objection or court case is considered). Attention should be paid to the risk of subsequent analysis.**

Following consideration of an objection, Rospatent has recognised a group of inventions protected by a Eurasian patent did not meet the conditions of 'novelty' and 'inventive step'. The rightholder exercised their right to submit an amended set of claims, but Rospatent has refused to maintain legal protection in part. Having decided that the group of inventions in the refined formula did not possess an 'inventive step', the administrative body upheld the applicant's objection in its entirety.

The patent holder appealed to the court, and, at the first hearing, their claims were rejected. However, the court of cassation overturned this decision, remanding the case for a retrial.

Upon reconsidering the case, the court upheld the claims and recognised Rospatent's decision invalid. After considering the appeals filed by Rospatent and the objector, the IPC Presidium agreed with the first instance court's decision on the merits, but having identified remediable errors, has adopted a new judicial act.

Regarding the compliance of the amended set of claims with the 'inventive step' criterion for the group of inventions, the IPC Presidium has noted that Rospatent had made an error when identifying the closest prior art, i.e. when carrying out the initial check for compliance with this criterion.



In the decision contested, the first instance court found the technical result of the group of inventions disclosed in the amended set of claims was the production of a new chemical compound (tofacitinib), which is capable of inhibiting Janus kinase 3 and is suitable for treating a number of diseases.

Having examined the amended set of claims for the group of inventions covered by the disputed patent, Rospatent has declared this technical solution as lacking inventive step as compared to prior art in information source 2.

The first instance court has refuted Rospatent's conclusion: the compound described in this source is a product with a different purpose, as it inhibits a different protein kinase (tyrosine kinase instead of Janus kinase 3).

Moreover, as the IPC Presidium noted, source 2 was published in 1997, i.e. at a time when the structure and activity of Janus kinase 3 had not yet been discovered or confirmed, and its effectiveness in treating disorders characterised by Janus kinase 3 involvement had not yet been demonstrated.

Consequently, the technical solution known from information source 2 does not and could not have been intended to inhibit Janus kinase 3.

As in the first review of this case, the IPC Presidium has recalled that the inventive step is assessed based on the knowledge of an expert at the time of the priority date of the disputed invention, rather than at the time of the subsequent examination (e.g. when an objection or court case is considered); it also drew attention to the risk of subsequent analysis if this requirement is not met.

The scientists who responded to the request based on Part 1.1 of Article 16 of the Commercial Procedural Code also pointed to the difficulty of drawing conclusions about the inhibitory activity of the disputed compound against Janus kinase 3 based on the information in source 2.

The IPC Presidium, nevertheless, found some remediable errors in the court ruling.

Indeed, the court has imposed on Rospatent the obligation to reinstate the disputed Eurasian patent in the Russian Federation as a remedial measure.

However, Rospatent does not have the authority to enforce decisions concerning the termination or restoration of the validity of a Eurasian patent in the Russian Federation.

The IPC Presidium amended the concluding part of the judicial act accordingly, specifying the amended claims for the group of inventions covered by the disputed patent. This will ensure that the court ruling adopted in this case can be interpreted unambiguously, and that the relevant entries can be made in public registers.

## 12. Simplicity Can be Deceptive

*IPC Presidium Resolution of 23 December 2024 in Case No. СИП-236/2024*

**It is not permitted to engage an expert to supplement the applicant's obligation to provide evidence.**

**When assessing the inventive step, the general knowledge of an expert should be taken into consideration. However, the level of this knowledge should be assessed based on the priority date of the disputed invention and not on any other date, such as the date on which an objection is filed or the date on which the case is considered in court.**

**If the protectability of the disputed composition is confirmed, then the method of obtaining such a composition cannot be recognised as known from the prior art and general knowledge of a specialist on a legally significant date.**

Rospatent has rejected the company's objection to the granting of a patent for a group of inventions titled 'Medicinal composition with protective action and method for its preparation.'

The first instance court's decision, affirmed by the IPC Presidium, recognised Rospatent's decision as lawful and upheld it.

As the IPC Presidium dismissed the cassation appeal, it stated the following:

1. The company's argument that the court's refusal to grant the motion to involve an expert in the case is unlawful is not based on the provisions of the Commercial Procedural Code and the explanations given in Para 40 of Resolution No. 46 of the Plenum of the Supreme Court of 23 December 2021 'On the application of the Commercial Procedural Code of the Russian Federation when considering cases in the court of first instance.'

Indeed, the court has no duty to involve an expert in the case. The court decides whether they need to be involved in each case, based on

the facts and evidence presented. If the court concludes that the case can be heard without the involvement of someone with specialist technical knowledge, no expert shall be involved.

The IPC Presidium has noted that the first instance court's refusal was not only duly justified, but also reasonable insofar as the specialised court has the necessary competence to independently resolve technical issues in the case under consideration (Ruling of the RF Supreme Court No. 300-ES16-19920 of 9 February 2017; IPC Presidium ruling of 29 February 2024 in case No. SIP-868/2022).

Moreover, the Presidium has noted that it is not permitted to engage an expert to supplement the applicant's obligation to provide evidence. In this case, when justifying the grounds for the objection, the objector did not confirm that this was known to a person skilled in the art on the priority date of the disputed patent for the distinctive feature of the group of inventions.

2. The arguments in the cassation appeal centred on the fact that two substances known from the prior art are the starting components for obtaining a new chemical compound by simple mixing.

However, the fact the components required to obtain a new chemical compound are known from prior art, does not mean that the compound itself is known.

When analysing an inventive step, the general knowledge of a specialised expert should be taken into consideration. However, as the IPC Presidium has repeatedly pointed out, the level of this knowledge should be assessed based on the priority date of the disputed invention and not on any other date, such as the date on which an objection is filed or the date on which the case is considered in court.

The company had to confirm that the expert was aware of certain circumstances relating to this group of inventions on the priority date, and not after this date, especially if the expert's opinions were based on information from the description of this group of inventions.

In view of this circumstance, these opinions were not taken into account by either Rospatent or the first instance court.

The opinion on the need to take into account the risk of subsequent analysis (retrospective or hindsight bias) is given, e.g., in the IPC Presidium's decisions dated 18 December 2023 in case No. SIP-730/2022 and dated 16 October 2024 in case No. SIP-190/2023.

At the same time, as expressly stated in Para 79 of Rule 316<sup>3</sup>, an invention shall not be considered as failing to meet the requirement for an inventive step due to its apparent simplicity and due to the fact that the mechanism for achieving the technical result is disclosed in the application materials, if such disclosure did not come from the prior art, but only from the application materials.

In these circumstances, the IPC Presidium was agreed with the conclusions of Rospatent and the first instance court regarding the unknown nature of the disputed feature from the opposing sources and the general knowledge of an expert on the priority date of the disputed group of inventions.

3. On the question whether claim 2 of the disputed invention met the inventive step requirement, the IPC Presidium has noted that while the disputed medicinal composition is confirmed as patentable, the method of obtaining such a composition cannot be considered as known from the prior art and general knowledge of an expert on the relevant date.

## **B. Entitlement and ownership**

### **13. Disagreements when Submitting an Application**

*IPC Presidium Resolution of 24 June 2025 in Case No. SIP-830/2024*

**When several persons co-own the right to obtain a patent, it shall be exercised jointly. Any dispute between the co-owners on this matter shall be settled in court.**

An individual filed a lawsuit against the company seeking to invalidate patents due to the incorrect indication of the company as the sole patent holder. The first instance court has denied the claims, finding that both the individual and the company were entitled to the disputed patents. The court has concluded that the individual had chosen an inappropriate route to protect their right, since the company was lawfully listed as the patent holder, hence invalidating the patents would result in the unlawful deprivation of the moral and patent rights of the company and other authors.

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<sup>3</sup> Rules for Drafting, Filing, and Examining Documents that are Grounds for Taking Legally Significant Actions for State Registration of Inventions and Forms Thereof, approved by Order No. 316 of the Ministry of Economic Development of the Russian Federation. 25 May 2016.

The IPC Presidium has overturned the court ruling and referred the case for retrial, noting the following.

Since filing a patent application is essentially a way of determining the future fate of intellectual property and exclusive rights to it, it is covered by the provisions of Para 3, Art. 1229 and Para 3, Art. 1348 of the Civil Code. The application to transactions aimed at determining the fate of intellectual property of the rules on joint action by co-owners of rights also follows from Subpara 9, Para 35 of Resolution No. 10.

Consequently, the right to obtain a patent (the right to file an application) had to be exercised jointly by the co-authors, i.e. with the consent of all co-authors.

A person's intention to exercise their right to obtain a patent and designate a specific person as the patent holder does not have to be expressed in an agreement between the co-owners of the right to obtain the patent; it can be established based on various forms of evidence.

At the same time, the IPC Presidium has recalled that if a unilateral transaction is concluded when its conclusion is not provided for by law, by other legal acts or by agreements between the parties, or the requirements for its conclusion are not met, then, as a general rule, such a transaction does not entail the legal consequences for which it was intended (Para 51 of Resolution No. 25 of 23 June 2015).

Therefore, the lack of consent from one of the co-authors regarding the disposal of the right to obtain a patent should not result in legal consequences for such actions.

However, declaring a patent invalid in its entirety, rather than in part, is an extreme measure in such a case.

If it is established that one of the co-owners of the right to obtain a patent does not wish to do so, while the other co-owners of that right do wish to do so, this does not mean that the patent must in any case be declared invalid in its entirety.

Disagreement with the application submitted may indicate the existence of a dispute between the co-owners of the right to obtain a patent.

Consequently, if the co-authors do not agree on how to dispose of the right to obtain a patent, how to file a patent application, or the conditions for obtaining a patent — e.g., by designating one person as the patent holder — and if the co-authors have a dispute, it shall be resolved in court.

Such a dispute may be considered taking into account the circumstances of the relationship between the co-owners of the right to obtain a patent, including taking into account their good faith towards each other.

#### **14. Dependent Invention and Co-Authorship**

*IPC Presidium Resolution of 28 May 2025 in Case No. IPC-83/2024*

**Co-authorship is impossible without some form of coordination between co-authors.**

**For an invention to be recognised as dependent, it is not necessary to use all the features of the ‘parent’ invention. An invention covered by a ‘junior’ patent may be declared dependent on an invention covered by a ‘senior’ patent in the overlapping part (when a specific implementation of the invention covered by the ‘junior’ patent simultaneously involves the implementation of the invention covered by the ‘senior’ patent).**

**To satisfy a claim for dependency in situations of partial overlap between ‘senior’ and ‘junior’ patents, it must be proven that the rights of the holder of the ‘senior’ patent have been infringed or are under a real threat of such infringement.**

**The IPC does not have the authority to declare on its own an invention as dependent, so the courts consider an independent claim for this purpose in accordance with the general rules of jurisdiction.**

A group of individuals submitted two claims to the IPC against the patent holder:

- to declare the patent invalid insofar as it fails to name the plaintiffs among the inventors,

- to declare the defendant’s invention as dependent on the plaintiffs’ invention.

The claims were grounded on the facts: the plaintiffs had previously disclosed some of the features of the disputed patent to the authors, and therefore were co-authors of the invention; the plaintiffs hold a patent for another invention, some of whose features overlap with those of the invention covered by the contested patent, and therefore the plaintiff’s invention is dependent on the defendants’ invention.

The first instance court has denied the claims because the information provided by the plaintiffs to the defendant was not new, was known

from the prior art, and the plaintiffs did not prove that they had worked together on this invention.

The court also has found no grounds for declaring patent dependency, given that Article 1358.1 of the Civil Code applies only when implementing a dependent invention leads to the use of the basic invention. This was not the case here, as only a range within the basic invention coincided with the second invention.

The IPC Presidium, on the basis of Part 1.1 of Article 16 of the Commercial Procedural Code, has issued a request to scientists and, based on the opinions presented, came to the following conclusions.

The IPC Presidium has rejected the argument that co-authorship should be recognised because, in the plaintiffs' opinion, certain features of the invention in the disputed patent overlap with features of the invention.

Co-authorship is impossible without some form of coordination between co-authors. In this case, the approach set out in Para 83 of Resolution No. 10 may be applied to similar situations involving the joint creation of works: coordination is required, and 'co-authorship of a work arises when each co-author, by mutual agreement, including verbal agreement, has made a creative contribution to the work. An agreement on co-authorship may be reached at any stage of the creation of the work or after its completion. The condition for creating a work in co-authorship may be contained in an agreement concluded by each of the co-authors separately with a third party.'

The very basis of patent law is that information about patented technical solutions is open, which allows for more technical creativity. The authors of technical solutions, based on prior art, should not list all the authors of the prior art solutions used as their co-authors. Patents for such solutions can be obtained independently. However, the use of patented technical solutions alongside other inventions, utility models, or industrial designs, is permitted with the consent of the latter's right-holders in accordance with the rules on dependent inventions, utility models, and industrial designs (Article 1358.1 of the Civil Code).

The IPC Presidium has disagreed with the first instance court's conclusion that it was impossible to recognise the invention as dependent when the invention in question could be implemented in such a way that it did not affect the invention under the plaintiffs' patent.

This understanding of the institution of dependent inventions, utility models, and industrial designs does not comply with Article 1358.1 as interpreted in Subpara 2, Para 125 of Resolution No. 10.

Indeed, there may be cases where the 'junior' invention, regardless of its implementation, necessarily involves the use of the 'senior' invention. Such cases are described, for example, in Subpara 2 and 3, Para 1, Art. 1358.1.

At the same time, the provisions of Subpara 1 of the same provision of the Civil Code are broader. Thus, Subpara 2, Para 125 of Resolution No. 10 describes a situation where the specific implementation of an invention under a 'junior' patent simultaneously means the implementation of an invention under a 'senior' patent.

In such a case, the invention under the 'junior' patent is dependent on the invention under the 'senior' patent in the overlapping part (when a specific implementation of the invention under the 'junior' patent simultaneously involves the implementation of the invention under the 'senior' patent), and the court's decision to recognise the invention under the 'junior' patent as dependent must indicate this overlapping part.

In view of this, the first instance court's decision is based on the incorrect application of Para 1, Art. 1358.1. However, in this case, this did not lead to the adoption of a fundamentally incorrect decision.

According to Para 2, Art. 12 of the Civil Code, recognition of a right is an acceptable means of protecting civil rights.

As a general rule, the concept of dependent inventions, utility models, and industrial designs is used to assess the legality of specific actions already taken (in a case initiated by the patent holder of the invention under the 'senior' patent to protect the infringed right to the invention under the 'senior' patent) or the specific intended use of the invention under the 'junior' patent, which objectively requires the issuance of a compulsory licence at the request of the holder of the 'junior' patent. In such circumstances, there is a person who denies or otherwise does not recognise the right.

The plaintiffs filed a lawsuit seeking declaration of the invention under the disputed patent as dependent on the very existence of such an invention, rather than for the purpose of preventing any existing use.

At the same time, the mere existence of a 'junior' patent may indicate the existence of a right subject to protection only if any use of the invention under the 'junior' patent simultaneously and necessarily implies the use of the invention under the 'senior' patent.

In a situation where only certain implementations of the invention under the 'junior' patent require the consent of the patent holder of the



‘senior’ patent, the mere existence of the ‘junior’ patent does not infringe the rights of the holder of the ‘senior’ patent: the actual actions of the holder of the ‘junior’ patent may never infringe upon the legal protection afforded to the ‘senior’ patent.

Regarding a similar situation, Para 57 of Resolution No. 10 states that requests for a general prohibition on a specific person from using the results of intellectual activity or means of individualisation in future will not be granted. This prohibition is established directly by law (Subpara 3, Para 1, Art. 1229 of the Civil Code).

Thus, in a situation where the inventions covered by the ‘senior’ and ‘junior’ patents partially overlap, to satisfy a claim for recognition of an invention as dependent, it must be proven that the rights of the holder of the ‘senior’ patent have actually been infringed or that there is a real threat of such infringement.

The facts established by the first instance court suggesting that the holder of the ‘junior’ patent is actually able to implement their invention without infringing on the legal protection of the invention under the ‘senior’ patent, do not mean that the ‘junior’ patent is unconditionally independent, but rather the failure of the holder of the ‘senior’ patent to prove their right to sue.

In turn, the absence of the right to sue also entails a refusal to honour the stated claims.

The request to recognise the patent as dependent does not fall within the competence of the IPC at first instance. The courts must consider an independent claim for declaring a patent as dependent in accordance with the general rules of jurisdiction.

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