International Comparative Legal Guides

Patents 2021

A practical cross-border insight into patent law

11th Edition

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1 Patent Enforcement

1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

Patent infringement disputes are tried before commercial courts and courts of general jurisdiction. The choice of court does not depend on the claimant, but on the infringer's status. Claims against legal entities, individual entrepreneurs or natural persons pursuing economic activity are tried by commercial courts; claims against natural persons are heard before courts of general jurisdiction.

Claims could also be brought before the Federal Antimonopoly Service if a competitor infringes a patent.

1.2 Can the parties be required to undertake mediation before commencing court proceedings? Is mediation or arbitration a commonly used alternative to court proceedings?

The parties cannot be required to undertake mediation, unless they have voluntarily agreed to do so. If the parties have a valid mediation agreement, the court might request for its conditions to be met before the parties initiate court proceedings. Mediation or arbitration are used as alternatives to litigation, but they are not very common in practice.

1.3 Who is permitted to represent parties to a patent dispute in court?

In commercial courts, natural persons can be represented by attorneys-at-law, patent attorneys and other persons holding a law degree. Interests of legal entities can also be represented by their authorised bodies.

In courts of general jurisdiction, requirements depend on the court level, i.e. there is no educational or bar membership requirement for representatives before the justice of the peace or district courts. However, only attorneys at law, patent attorneys and other persons holding a law degree can represent a natural person in regional courts and the Supreme Court. Legal entities can be represented by their authorised bodies in courts of general jurisdiction.

1.4 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

In order to initiate court proceedings, the claimant must file a claim together with supporting evidence and the required documents. In commercial court proceedings, the claimant must also prove that they notified all relevant parties to the proceedings about the filed claim by sending them a copy.

The court fees depend on the type of action being taken and claimant's status (natural person or legal entity). The fees for monetary claims depend on the claimed amount, whereas the fees for non-monetary claims are fixed.

The length of time between filing the claim and the first hearing depends on the court and the region, but generally it takes about two months, if preliminary hearings are not delayed.

1.5 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

Disclosure orders are not possible at the pre-trial stage. However, once proceedings have been initiated, a party can request the court to make an order for the disclosure of evidence from an opposing party.

1.6 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

A party must prepare documents to meet the formal filing requirements and gather the necessary evidence. If the parties in commercial court proceedings are legal entities or individual entrepreneurs and the claimant is seeking monetary compensation, the claimant has to send a cease-and-desist letter to the infringer before filing the claim. The court will accept the claim if the infringer does not comply with the requests outlined in the cease-and-desist letter, or if the claimant does not receive a response within 30 days of sending the letter.

1.7 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

After the court initiates the proceedings, the defendant is required to submit written arguments regarding the claim. Further arguments can be presented by the parties as written statements or announced verbally during the hearings.

Each party has to provide evidence for their arguments. Evidence can be written, material or verbal and it can include expert or specialist opinions, witness testimonies and audio- and video-recordings, etc.

Each party can change either the claims or the grounds for the claims (but not both) at any stage of the proceedings, but before the first instance court issues the final judgment.

1.8 How long does the trial generally last and how long is it before a judgment is made available?

Generally, after commencing the proceedings, it can take three to six months to issue the final judgment, if all necessary evidence has been gathered before the trial on the merits of the case. However, a trial can often last longer.

The operative part of the judgment is announced at the end of the trial on the merits and is published in the database within a few days after the announcement. The full judgment should be produced within 15 days after the announcement of the operative part, but in practice it may take longer, especially if the case was tried by the court of general jurisdiction.

1.9 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

No specific alternative procedure is available, but the parties can use the generally accepted alternative dispute resolution procedures (ADR), e.g. mediation and arbitration, providing that both parties agree to it. The advantage of ADR over litigation is that the parties can appoint mediators and arbitrators that are experienced in the area of the dispute, thus making proceedings more expedient. Moreover, by using the ADR mechanisms, the parties can keep the details of the dispute confidential.

1.10 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?

Judgments are published in the online court database, where the third parties are able to familiarise themselves with the relevant decisions.

1.11 Are courts obliged to follow precedents from previous similar cases as a matter of binding or persuasive authority? Are decisions of any other jurisdictions of persuasive authority?

The courts are not obliged to follow precedents from previous similar cases, but they tend to do so, especially if the rulings were issued by the Supreme Court, the specialised IP Court or higher-instance courts. Moreover, if the judgment violates the uniform application and interpretation of the law, it could be overturned during the supervisory review process. The Supervisory review process is an appeal stage for court decisions that have already entered into legal force that intends to rectify major violations omitted by previous courts, e.g. violation of human rights or public interests.

Decisions from other jurisdictions of persuasive authority are usually not taken into account.

1.12 Are there specialist judges or hearing officers, and if so, do they have a technical background?

The first instance court judges usually do not have a technical background and there are no specialist judges. However, judges in the IP Court (a court that reviews commercial court decisions as a court of third instance (cassation procedure)) are experienced in patent infringement cases and typically do have a relevant technical background.

1.13 What interest must a party have to bring (i) infringement, (ii) revocation, and (iii) declaratory proceedings?

(i) A patent owner and an exclusive licensee whose interests are affected by the infringement have a standing to sue for patent infringement.
(ii) Any party that became aware of the infringement can file a revocation action with the Chamber for Patent Disputes (CPD) of the Russian IPO.
(iii) Any party whose interests are affected by a fact of legal significance, if the party can prove that these facts cannot be established otherwise.

1.14 If declarations are available, can they (i) address non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?

In principle, declaratory proceedings in Russia are available for establishing the facts of legal significance. However, they can neither address non-infringement nor claim coverage over a technical standard or hypothetical activity.

1.15 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of, but not all of, the infringing product or process?

The law does not stipulate a strict division between primary and secondary liability for patent infringement, thus each party can be held responsible separately for each infringing act: manufacturing; importing; storing; selling; or distributing. The court evaluates the scale of infringement and the role of each party and imposes liability accordingly. A party may be liable for infringement by supplying part of the infringing product, if this part is protected by an independent patent claim.

1.16 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

Yes, a party will be liable for infringing a patent by importing a product into the Russian Federation.

1.17 Does the scope of protection of a patent claim extend to non-literal equivalents (a) in the context of challenges to validity, and (b) in relation to infringement?

Equivalents can be used both in the context of challenges to validity and in relation to infringement, but only for patents for inventions and not for utility models.

1.18 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition? Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

A defence of patent invalidity can be raised during the infringement proceedings, but it will be bifurcated. Invalidity proceedings can be raised separately before the Chamber for Patent Disputes. There are no restrictions on a defence of invalidity.

1.19 Is it a defence to infringement by equivalence that the equivalent would have lacked novelty or inventive step over the prior art at the priority date of the patent (the "*Formstein* defence")?

The "*Formstein* defence" is not available in Russia.

1.20 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

In addition to lack of novelty and inventive step, a patent can be invalidated if:

(1) a patent was granted for a non-patentable subject matter;
(2) an invention or utility model lacks industrial applicability;
(3) a patent specification lacks sufficiency of disclosure of the claimed invention;
(4) the granted claims comprise features that were not disclosed in the application at the filing date;
(5) double patenting has been discovered; and
(6) patent documents contain a mistake regarding the inventor or holder, e.g. it does not indicate the correct inventor or holder.

1.21 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

The court can stay proceedings pending resolution of validity in the Chamber for Patent Disputes.

1.22 What other grounds of defence can be raised in addition to non-infringement or invalidity?

In addition to the commonly raised non-infringement or invalidity, there are other grounds that could be used as defence, e.g. prior use in good faith, non-commercial use for private or scientific purposes, exhaustion of rights, existence of a valid licence, etc.

1.23 (a) Are preliminary injunctions available on (i) an *ex parte* basis, or (ii) an *inter partes* basis? In each case, what is the basis on which they are granted and is there a requirement for a bond? Is it possible to file protective letters with the court to protect against *ex parte* injunctions? (b) Are final injunctions available? (c) Is a public interest defence available to prevent the grant of injunctions where the infringed patent is for a life-saving drug or medical device?

(a) Preliminary injunctions are available on an *ex parte* basis. The injunction can be granted if the applicant proves that urgent temporary measures are necessary to secure the applicant's interests, which cannot be guaranteed in the absence of preliminary measures. The courts may ask for a security bond, at the court's discretion or at the defendant's request. Filing a protective letter does not prevent the court from issuing an *ex parte* injunction. However, preliminary injunctions are not easily granted by the Russian courts and it usually takes a significant level of proof in order to convince the court. Preliminary injunctions in patent litigation cases are generally not common.
(b) Yes, when necessary the court can grant a final injunction without requesting a bond from the claimant.
(c) In principle, a party can raise a public interest defence; however, considering that injunctions are generally granted in exceptional cases, a public interest defence will not be the strongest argument against the injunction. Compulsory licensing is available under Russian law; however, in practice it is rare.

1.24 Are damages or an account of profits assessed with the issues of infringement/validity or separately? On what basis are damages or an account of profits assessed? Are punitive damages available?

The damages award is assessed together with the infringement case. Damages can cover real losses and lost profits, but the threshold for proving both is high. Therefore, in many cases claimants seek compensation instead of damages.

The biggest advantage of compensation over damages is that the claimant does not need to prove the amount. The court can award 10,000 to 5,000,000 RUB compensation, depending on the severity of infringement and circumstances of the case, or the double value of royalty paid under licences granted in similar circumstances.

Punitive damages are not available.

1.25 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?

Court orders are enforced either voluntarily by parties to whom they are addressed or through the state bailiff service after the claimant applies for compulsory enforcement.

1.26 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?

In addition to monetary, the claimant can also seek non-monetary relief, namely recognition of its rights, discontinuation of infringing activity, seizure of infringing materials, and publication of the court decision. The courts do not grant cross-border relief.

1.27 How common is settlement of infringement proceedings prior to trial?

At least a half of all patent infringement disputes are settled during the pre-trial stage.

1.28 After what period is a claim for patent infringement time-barred?

The limitation period for patent infringement disputes is three years from the day when the claimant found out or could have found out about the infringement.

1.29 Is there a right of appeal from a first instance judgment, and if so, is it a right to contest all aspects of the judgment?

Yes, a first instance judgment can be appealed. A party can contest all aspects of the judgment.

1.30 What are the typical costs of proceedings to a first instance judgment on (i) infringement, and (ii) validity? How much of such costs are recoverable from the losing party?

(i) The official and attorneys' fees as well as other related costs (such as translations and expert fees) largely depend on the complexity of each case and the size of monetary claims. At the pre-trial stage, the costs depend on the evidence that a party wishes to gather and the willingness to negotiate an out-of-court settlement. At the pre-trial and first instance trial stages, legal fees start approximately from 15,000 EUR. A lot will depend on the time spent on case analysis – this usually is the most time-consuming part and usually falls under the pre-trial phase. Generally, the costs are recoverable from the losing party, but the courts will only compensate what they find to be reasonable, especially when it comes to the compensation of attorney fees. If the claim is awarded partially, the costs could be divided between the parties proportionally.

(ii) The costs for invalidation proceedings also include the official and attorneys' fees and other related costs such as translations and expert fees. The costs are not recoverable. The costs would depend on the complexity of each case and on the documents filed by the party challenging the validity.

1.31 For jurisdictions within the European Union: What steps are being taken in your jurisdiction towards ratifying the Agreement on a Unified Patent Court, implementing the Unitary Patent Regulation (EU Regulation No. 1257/2012) and preparing for the unitary patent package? Will your country host a local division of the UPC, or participate in a regional division? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?

This is not applicable in Russia.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant, and if so, how?

It can be modified by correcting technical and apparent errors in the claims, specification or drawings. In order to amend a patent, a patent holder should submit a request with the Russian IPO and pay the appropriate official fees.

2.2 Can a patent be amended in *inter partes* revocation/invalidity proceedings?

During invalidation proceedings before the Chamber for Patent Disputes (CPD) within the Russian IPO, the board of the CPD can propose amendments to the claims that eliminate the grounds for patent invalidity.

2.3 Are there any constraints upon the amendments that may be made?

The CPD's suggestions are limited to adding features into independent claims, provided that such amendments do not add a new matter and do not expand the claim scope. The law allows adding any feature(s) from the patent specification, but in practice, the CPD suggests adding the features from dependent into independent claims rather than the features from the specification. Thus, the patent holder should rely on dependent claims only in case of an invalidity action against his patent.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

The parties are free to include any terms provided they do not contradict the requirements of Russian law. Such limitations can include restrictions regarding royalties paid between commercial organisations and the term of the licence agreement.

As gratuitous contracts between commercial legal entities are forbidden, granting an exclusive, worldwide, free licence for the duration of the patent between commercial legal entities is prohibited.

Term of the licence cannot exceed the term of patent validity. If the term of the licence is not specified in the agreement, the licence is deemed to be concluded for a five-year term.

3.2 Can a patent be the subject of a compulsory licence, and if so, how are the terms settled and how common is this type of licence?

The Russian law provides two grounds when a compulsory licence may be issued:

(i) If the invention is not used or is not sufficiently used by the patent holder for a period of four years from the date the patent was issued, if such non-use causes an insufficiency of goods in the market.

(ii) If the patent holder is unable to use the patented invention (second patent) because it infringes on another's patent (first patent), and the holder of the first patent refuses to grant a licence to the patentee of the second patent, the holder of the second patent can file a court claim to obtain a compulsory licence.

However, compulsory licences are infrequent in Russian practice.

4 Patent Term Extension

4.1 Can the term of a patent be extended, and if so, (i) on what grounds, and (ii) for how long?

It is possible to extend the 20-year term of a patent for inventions related to medicines, pesticides or agricultural chemicals that require a marketing authorisation. The overall term, with granted extensions, is up to 25 years. In response to the patent holder's request, an additional patent with new claims restricted to the authorised product can be issued. The term of the additional patent is equal to the term that passed between the filing date and the date on which the marketing authorisation was obtained, minus five years. However, the term cannot exceed five years.

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable, and if not, what types are excluded?

The following cannot be patented under Russian law:

- Human cloning methods and human clones.
- Methods that modify the genetic integrity of human embryo cells.
- Use of human embryos for industrial and commercial purposes.
- Other inventions contrary to public interest and humanity and moral principles.

The following are not deemed to be inventions *per se*:

- discoveries;
- scientific theories and mathematical methods;
- claims concerning solely the outward appearance of products and intended to satisfy aesthetic requirements only;
- rules and methods of games and for intellectual or business activity;
- computer programs; and
- claims relating to the presentation of information, without a technical character or effect.

Patent protection also cannot be granted for:

- plants and animal varieties, as well as biological methods for producing them, with the exception of microbiological methods and products made by using such methods; and
- topographies of integrated circuits.

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

Applicants (or other individuals) do not have a duty to disclose to the Russian IPO any prejudicial prior art documents or other information.

5.3 May the grant of a patent by the Patent Office be opposed by a third party, and if so, when can this be done?

A granted patent may be opposed by any party at any time during its period of validity by filing an action before the Chamber for Patent Disputes of the Russian IPO.

5.4 Is there a right of appeal from a decision of the Patent Office, and if so, to whom?

Russian IPO decisions, such as grant decisions, or decisions to reject or withdraw an application, can be appealed before the Chamber for Patent Disputes within seven months after the decision was sent to the applicant. The applicant can also request copies of the documents cited in the decision within three months after the decision was sent, and in that case, the seven-month period for appeal will be counted from the date when those documents were sent to the applicant. The decisions of the Chamber for Patent Disputes, including decisions in invalidation actions initiated by third parties, may be appealed before the IP Court.

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

If there are identical inventions with the same priority date filed by different applicants, the applicants have to decide who will become the patent holder and then notify the patent office about their decision within one year. Otherwise, both applications will be considered withdrawn. When granting a patent for one of the applications, authors of both applications will be indicated as co-authors of the subject invention.

Ownership disputes are resolved through a court order. If a person other than the applicant is recognised as the one entitled to file a Russian patent application in accordance with a court decision, that decision can represent a ground for patent revocation.

5.6 Is there a "grace period" in your jurisdiction, and if so, how long is it?

The Russian law provides for a six-month grace period. Namely, any public disclosure of information related to the subject matter of the invention by the inventor, applicant, or other person that received this information directly or indirectly from them, should not be taken into account when determining patentability, if it occurred within six months before the filing or priority date.

5.7 What is the term of a patent?

The term of validity of the Russian patent for an invention is 20 years from the application filing date if properly maintained. This 20-year term can be extended for up to five years for inventions relating to medicines, pesticides or agricultural chemicals, as explained in question 4.1. Russian law also allows obtaining utility model protection for technical solutions relating to devices. A utility model has a shortened patent term of 10 years with no renewal options.

5.8 Is double patenting allowed?

Under Russian law, double patenting can happen if:

(1) independent claims in both applications are (100%) identical; or

(2) an independent claim in one application cites one or more alternative inventions, and at least one of these alternative inventions matches with the invention in the independent claim of the other application.

Double patenting is otherwise not allowed in Russia and represents grounds for patent revocation. However, there is an exception with regard to Eurasian patents. Eurasian and Russian patents granted for the applications with the same priority date related to identical inventions could be in force simultaneously in the Russian territory. It concerns applications filed by the same applicant, as well as different applicants.

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products, and if so, how quickly are such measures resolved?

Unlike trademarks and copyright, patents for inventions or utility models cannot be recorded in the Customs IP Register, which makes border control measures unavailable.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

In principle, antitrust law can be deployed to prevent relief for patent infringement, but this rarely happens in practice.

7.2 What limitations are put on patent licensing due to antitrust law?

Antitrust law does not impose specific limitations on patent licensing.

7.3 In cases involving standard essential patents, are technical trials on patent validity and infringement heard separately from proceedings relating to the assessment of fair reasonable and non-discriminatory (FRAND) licences? Do courts grant FRAND injunctions, i.e. final injunctions against patent infringement unless and until defendants enter into a FRAND licence?

FRAND licensing is not available in Russia.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

Most significant amendments to patent legislation took place a few years after the reform of the Russian Civil Code in 2014. There were no changes of similar significance in 2019.

8.2 Are there any significant developments expected in the next year?

Current developments and legislative initiatives focus on creating a "green corridor" for patent applications related to: the prevention and treatment of COVID-19; new regulations on the distribution of intellectual property rights between the state, executors, and third parties; and patenting in the state defence and security area.

8.3 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

In 2019, the Russian Supreme Court published an overview of the court practice related to the implementation of Part IV of the Russian Civil Code, summarising various practice on patent enforcement.

Although not a trend, an interesting development to follow is related pharmaceutical patent enforcement. In 2019, the Supreme Court, for the first time, confirmed a ruling that ordered a generic drug producer to withdraw an application for "registration of the maximum price" with the Ministry of Health, explaining that such registration creates a threat of patent infringement. However, according to the previously established practice, such registrations were considered to be of a preparatory character and, thus, not infringing patent rights.

Natalia Osipenko's practice focuses on patent prosecution and litigation before the Russian and Eurasian Patent Offices, as well as other competent bodies, such as the Chamber for Patent Disputes, particularly within the fields of chemical technology, engineering and life sciences. She has significant experience drafting applications in the areas of materials science and construction materials and equipment. Natalia's responsibilities also include preparing patentability, patent validity, freedom to operate and infringement opinions.
Prior to joining PETOŠEVIĆ in 2019, Natalia worked at another international law firm, where she took Russian, Eurasian and PCT applications for major multinational companies through the full prosecution cycle, from drafting and filing, preparing infringement and validity opinions to oppositions and appeals. Natalia also worked as an intellectual property specialist for a Russian manufacturer of navigation instruments for military and commercial aircraft, and as a patent engineer and research scientist for the Belgorod State Technological University, where she was involved in scientific research and IP protection of the university's research and development activities.

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Mayya Pak mainly handles trademark enforcement and contentious matters. She coordinates investigations, advises clients on trademark protection and enforcement strategies and represents them before the courts and police and customs authorities. Mayya also handles domain name disputes and copyright matters. She has represented clients from a variety of industries, including food and beverage, fashion, technology and entertainment.
Mayya is an active member of many well-known intellectual property organisations, such as the International Trademark Association (INTA), the American Intellectual Property Law Association (AIPLA), the International Association for the Protection of Intellectual Property (AIPPI) and the Licensing Executives Society International (LES), and has represented PETOŠEVIĆ at numerous events and conferences.
Prior to joining PETOŠEVIĆ in 2017, Mayya worked for four years as legal counsel in the litigation and dispute resolution department of a finance and real estate company in Moscow. She was also head of the legal department in a Moscow IT company for two years, and interned at the International Bar Association's Legal Policy & Research Unit.

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PETOŠEVIĆ Russia joined PETOŠEVIĆ GROUP in 2013. The Moscow office has been growing over the last several years and currently consists of 10 specialised lawyers and paralegals providing full range of intellectual property and related services, including the enforcement of IP rights and prosecution before the Russian IPO.
PETOŠEVIĆ GROUP, including the Russia office, serves a diverse mix of clients, from individuals to the world's leading corporations. PETOŠEVIĆ Russia clients include a well-known energy drink producer, one of the largest global manufacturers of confectionary, pet food and other food products, a multinational technology company, and a global hotel giant.
The Moscow team comprises an attorney at law, trademark and design attorney, two trademark attorneys, three patent attorneys, including two Eurasian Patent Attorneys authorised to represent clients before the Eurasian Patent Office, a junior associate, two trademark and patent paralegals and an administrative assistant. The team has 100 years of IP-focused practice combined.

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