

General Concerns of Importing Goods into Russia

October 25, 2019

Principle of Territoriality

Protection of registerable IP is not worldwide.

The protection of most of the registerable IP objects doesn't exceed beyond the territory of a country of their registration.

Russia

Trademarks

- *National registration*
- *International registration designating Russia (according to the Madrid Agreement and the Madrid Protocol)*

Inventions, Utility Models, Industrial Designs

- *National patent*
- *Eurasian patent (according to Eurasian Patent Convention which covers eight countries: Armenia, Azerbaijan, Belarus, Russia, Kazakhstan, Kyrgyzstan, Tajikistan, Turkmenistan)*

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Exhaustion of IP Rights (First-Sale Doctrine)

Exhaustion of intellectual property rights means that rightholder loses the right to control the resale of the protected goods. And depending on the type of exhaustion in a particular country or region of importation such control can be saved by the rightholder.

Three types of exhaustion of IP rights:

- *international*
- *regional*
- *national*

Russia applies the **national** exhaustion principle.

Goods may only be imported into Russia by the IP rightholder, licensee or third party having rightholder's consent.

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Detection of IP infringements

Ways of Detecting and Suppressing IP Rights Infringements

- **Search for illegally imported goods within the territory of the country:**
 - *detection of points-of-sale, including on the Internet,*
 - *search for channels through which the goods are being imported,*
 - *estimation of the volume of illegally imported goods,*
 - *collection of evidence,*
 - *initiation of legal procedures connected with IP rights infringement.*

- **Control over the import of goods (Customs IP Register):**
 - *Registration of IP rights in the Customs Register (obtaining detailed information of the goods, their quantity and foreign supplier, taking the entire consignment of the goods under arrest at the Customs prior to the court decision at the stage of the declaration of the goods).*

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The Eurasian Economic Union includes five countries:

- **The Russian Federation** (since 2010)
- **The Republic of Belarus** (since 2010)
- **The Republic of Kazakhstan** (since 2010)
- **The Republic of Armenia** (since 2015)
- **The Kyrgyz Republic** (since 2015)

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The Eurasian Economic Union

- The Eurasian Economic Union imposes no restrictions on the movement of goods within the territory of the Union.

If goods are imported to one of the Members of the Union, the Customs will not control the movement of the goods within the Union.

- The United Customs IP Register was announced by the Members of the Union but there are still no defined requirements for applying thereof.

If a rightholder wants to protect the market of the Union from the import of counterfeit products or parallel (grey) import the rightholder has to register the trademark(s) with each national Customs Register of the Member.

- Taking into account the territorial principle of protection for trademarks, the rightholder needs to have a registered trademark in each Member where the rightholder wants to file an application with the Customs Register.

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Russian Customs IP Register (IP Objects)

IP Objects

- Trademarks
- Copyrights and neighbouring rights

Term of Registration

- The maximum term is **three** years but it shall not exceed any of the following terms:
 - term of validity of IP right
 - term of an insurance
 - Power of Attorney's term

The term of registration can be extended unlimited number of times.

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Applicants

- **Rightholder** (or its representative)

- **Exclusive Licensee** (or its representative)

A License Agreement must be registered with the Russian PTO.

Such an Agreement must authorize the Licensee to initiate legal proceedings to protect its IP rights.

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Russian Customs IP Register (Licensing)

Main rule for agreements of IP rights in Russia:

If an IP object is registered,
all agreements in respect of such IP object
should be registered as well!

Registerable IP objects

- Trademarks
- Inventions
- Utility models
- Designs
- Software (optional)

Type of agreements which should be registered:

- Assignments
- License / sublicense and franchise / subfranchise agreements
- Pledge agreements
- Amendments to the abovementioned agreements

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Non-Typical Situations (Exceptions)

International registration of trademarks with Russia as a designated country:

- license / sublicense, franchise / subfranchise agreements or pledge agreements are to be registered with Russian PTO

Eurasian patents:

- assignments are to be registered with Eurasian Patent Office (*a partial assignment is not allowed by the Eurasian Patent Convention, so the assignment should cover all the countries where the Eurasian patent is in force*)
- license / sublicense, franchise / subfranchise agreements or pledge agreements are to be registered in each country where the patent is in force

Registered **software** in Russia:

- assignments or pledge agreements are to be registered with Russian PTO
- license agreements are excluded from this rule and need not be registered in any way

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Russian Customs IP Register (Required Documents)

The application filed to the Russian Customs IP Register without evidence of infringement regarding each type of goods will be rejected.

Main documents and information required:

- Regarding Rightholder: an extract from the trade, commercial or tax register issued within 1 year (*information about rightholder's name and address, number and date of registration and persons who have the right to sign documents on behalf of the rightholder*)
- Regarding Trademark: an extract from the WIPO / Russian PTO (valid within 1 month)
- Insurance agreement in amount of approx. 7,000 EURO (7,700 USD) effective in the territory of the Russian Federation (*liability insurance, which should cover the importer's damages regarding expenses related to injunctive relief (arrest goods) at Customs if the rightholder doesn't prove infringement of its rights*)
- Description of original and counterfeit goods
- **Evidence of infringement regarding each type of goods mentioned in an application**, e. g. notification from Customs about previous cases of unauthorized import, mystery shopping, information about legal proceedings against unauthorized importers (*information about the previous import of branded goods or information about selling such goods in the territory of Russia*)
- A list of authorized importers and licensees
- A Power of Attorney from the Rightholder, etc.

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- Thank you for your attention!



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