

Geographical Indication- New IP Object in Russia

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- A new intellectual property object – a **geographical indication** has been introduced in the Russian Federation (Federal Law No. 230-FZ of July 26, 2019).
- The said Federal Law has complemented the provisions of the Civil Code of the Russian Federation.
- A **geographical indication** is a sign used to identify goods as originating in a certain geographical area, the quality, reputation or other characteristics of which are essentially linked to their geographical **origin** (Paragraph 1 of Article 1516 of the Civil Code of the Russian Federation).
- The aforementioned provisions of the law are to enter into force as of **July 27, 2020**.

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According to their main characteristics, Russian Geographical Indications (Gis) are equal to Protected Geographical Indications (PGIs), which are defined under the EU legislation.

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Russian GI a name used to identify goods as:	European PGI is a name that identifies a product:
The same	originating in a specific place, region or country;
The same	whose given quality, reputation or other characteristic is essentially attributable to its geographical origin;
The same	of which at least one of the production steps takes place in the defined geographical area.

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Up to present, the Russian legislation has provided protection only to **Appellations of Origin of goods (AO)**.

An **AO** to which legal protection is granted is a sign that represents or contains a contemporary or historical, official or unofficial, full or abbreviated name of a country, city or rural settlement, locality, or other geographical object and also a derivative of such appellation which became known as a result of its use to designate the special properties of goods which are defined exclusively **or mainly** by the natural conditions and/or human factors specific for the geographical object concerned (Article 1516 of the Civil Code of the Russian Federation).

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- **In the EU**, there are more than **3, 000** registered AOs and GIs, while **in Russia** there are **219** registered AOs, of which:
- **188** - protected in the name of Russian rights holders;
- **31** - protected in the name of foreign rights holders.

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Russian AOs:

- Vologda lace



- Russian vodka



- Astrakhan black caviar



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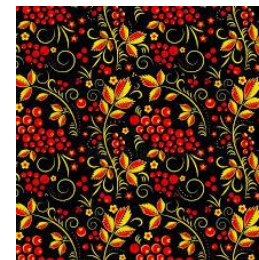
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Russian AOs:

- **Khokhloma painting**



- **Kamchatka red salmon**



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Foreign AOs protected in Russia:

- **MURFATLAR** (for wines)
- **Prosecco** (for wines)
- **ASTI** (for wines)
- **DURO** (for wines)
- **KARLOVARSKA HORKA** (for spirits)
- **TEQUILA**



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Foreign AOs protected in Russia:

- **Gorgonzola** (for cheese)
- **Prosciutto di Parma** (for dry-cured ham, ham)
- **Grana Padano** (for cheese)
- **Parmigiano Reggiano** (for cheese)

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Strict requirements are the main reason why so few applications for AOs are being filed in Russia.

One of the requirements is that an application shall be accompanied by **the opinion of a competent governmental body** confirming that the applicant, within the borders of the geographical object concerned, produces goods, the specific properties of which are exclusively or mainly determined by natural and/or human factors specific for the geographical object concerned.

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Governmental authorities empowered to issue opinions

The Ministry of Agriculture	The Ministry of Healthcare	The Ministry of Industry and Trade	Federal Service for Alcohol Regulation
<ul style="list-style-type: none"> • agricultural products; • foodstuffs; • non-alcoholic products; • beekeeping products; • goods made of fish and seafood 	<ul style="list-style-type: none"> • mineral drinking medical water; • mineral natural water; • table water 	<ul style="list-style-type: none"> • folk products • artistic craft 	<ul style="list-style-type: none"> • alcohol • alcohol-containing food products

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To date, no state bodies have been established for preparing opinions with regard to:

- **precious stones;**
- **minerals;**
- **therapeutic muds.**

At the same time, a considerable number of designations indicating a geographical origin, including foreign ones, are required protection in Russia.

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- The introduction of GIs into the Russian legislation will result in:



A more simplified procedure for obtaining legal protection to signs indicating a geographical origin;

- Obviously, the registration procedure will become more attractive for foreign applicants.

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In Russia, GIs will not be limited to agricultural products.

- They can also be used on natural products such as:

honey



crabs



foodstuffs



handicraft



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Geographical Indication – New IP Object in Russia Comparison between AO and GI

AO	GI
word designations representing a name of a geographical object	any sign which identifies goods as originating in a certain geographical area
special properties of goods in respect of which an AO can be registered are defined exclusively by natural and/or human factors specific for the geographical object	certain quality, reputation or other characteristics of goods in respect of which a GI can be registered are essentially linked to their geographical origin
a designation which became known as a result of its use with regard to certain goods	a designation which identifies goods as originating in a certain geographical area

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AO	GI
all the stages of goods manufacture, essentially affecting the goods characteristics, must be completed on a certain geographical area	at least one of the stages of goods manufacture, essentially affecting the goods characteristics, must be completed on a certain geographical area
for the registration purpose it is required to submit the opinion of a competent governmental body (federal or regional) confirming that the applicant, within the borders of a geographical object concerned, produces goods which meet the requirements established by the Civil Code	an applicant by itself collects and submits to the Russian PTO documentation confirming that the applicant produces goods having the certain quality, reputation or other characteristics of which are essentially linked to their geographical origin

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Case Analysis (EMILIA, Case No SIP-185/2018)

- **On June 30, 2014**, an application for an AO for the designation “**EMILIA**” was filed in respect of **wine** in the name of 25 Italian companies.
- At the examination stage, the Certificate of Protection of Protected Geographical Indication (PGI) issued by the Ministry of Agricultural, Food and Forestry Policies of Italy was submitted.
- **On August 4, 2016**, the Russian PTO **refused** its registration due to the unconformity of the latter to the requirements for an AO. The reason was that the designation “EMILIA” had not been protected as an AO in Italy.

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Case Analysis (EMILIA, Case No SIP-185/2018)

- **On November 3, 2016**, an opposition against the decision of refusal was filed with the Chamber for Patent Disputes.
- The opposition was dismissed.
- **On March 30, 2018**, the applicants filed a statement of claims against the decision of the Russian PTO with the Intellectual Property Rights Court (hereafter – the Court).
- The Court ruled that the opposition must be re-considered by the Chamber for Patent Disputes. The Court stated that the Chamber for Patent Disputes must establish which category of GIs the designation “EMILIA” fell into.

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Case Analysis (EMILIA, Case No SIP-185/2018)

- The Supreme Court upheld the decision of the Intellectual Property Rights Court.
- When re-considering the case the Chamber for Patent Disputes pointed out that Russian AOs were equal to European PDOs (Protected Designations of Origin).
- Considering that, in accordance with all the provided documentary evidence, the applied designation “EMILIA” has fallen into a category of PGIs, it cannot be protected as an AO in Russia.

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Case Analysis (“NAPA VALLEY”, Case No. SIP-237/2017)

- The Chamber for Patent Disputes decided on the above case that the essence of the object protected by virtue of American **certification mark** No. 4853438 “**NAPA VALLEY**” for wines did not coincide with the essence of an AO protected under the Russian law.
- *Starting from July 27, 2020, it will be possible to reapply for both designations “EMILIA” and “NAPA VALLEY” to protect them as GIs in Russia.*

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GIs can be registered in the name of:

- Individuals;
- Legal entities;
- Association of goods producers, raw materials producers, packers, distributors and others;
- Registration of a designation as a GI identifying the goods as originating from a foreign territory is possible provided that the said designation is protected as a GI in its country of origin.

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- A registered GI **is protected for 10 years** from the date of filing and is renewable for every 10 years as long as it is still possible to produce the goods which meet the requirements for GIs established by the Civil Code;
- A renewal request must be accompanied by documents confirming that an applicant manufactures goods having certain characteristics appearing on the State Register of GIs;
- With regard to a GI identifying goods as originating from a territory located out of Russia, a rights holder must submit a document confirming its right to the respective designation in the country of origin at the date of filing a renewal request.

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The following actions constitute an illegal use of a GI:

- The use of a registered GI by persons **having no right** to use it even if they indicate the actual place of origin of goods or the use of a GI in a translated form or together with such expressions as “kind”, “type” or “imitation”;
- The use of a registered GI by persons **having the right** to use it in respect of those goods being deficient in the characteristics recorded in the State Register or with regard to those **goods manufactured out of the geographical region** recorded in the State Register;
- The use of a designation being **similar** to a registered GI in respect of any goods and being **capable of misleading** consumers as to the place of origin and properties of goods or the quality, reputation or other characteristics of goods.

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The following actions **do not** constitute an illegal use of a GI:

- The use of a registered GI by third parties in respect of goods entered into the channels of commerce directly by the rights holder or with its consent.



Such an international principle of the exhaustion of the right will allow producers having no right to use a GI to place it on goods in case such goods are manufactured from the raw materials obtained from the rights holder or with its consent.

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The legal protection of a GI shall be terminated if:

- the rights holder has lost the right to produce goods having certain characteristics recorded in the State Register;
- the rights holder systematically fails to follow the method of production, storage conditions and transportation of goods appearing in the State Register.

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Objectives:

- *to struggle against the rights holder's abuse of its right to a GI;*
- *to prevent consumer fraud.*

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The introduction of a GI into the legal system of the Russian Federation would bring obvious advantages to both Russian and foreign applicants.

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- Thank you for your attention!
- Any questions?



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