



The Eurasian Economic Union and new IP protection tools in the CIS region

📅 18/03/2021

📖 INTELLECTUAL PROPERTY, RUSSIA

Roberto A. Jacchia
Alisa Pestryakova

The protection of intellectual property in the CIS region has registered fast developments according to a unique model comprised of two parallel systems: that of the **Eurasian Patent Convention** (an international agreement providing for a partly unified mechanism of patent protection) and that of the **Eurasian Economic Union** (an international organization for regional economic integration, including intellectual property matters). The outcome is quite unique and a rare example of effective regional cooperation offering concrete opportunities and potential for added value to economic players.

Patent protection at the regional level of the CIS countries has been available since 1996 based on the Eurasian Patent Convention (EAPC), which was signed on 09 September 1994. The Eurasian patent offers protection in all EAPC

member States (Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Russia, Tajikistan, Turkmenistan) by the filing a single application. The EAPC is administered by the Eurasian Patent Organization (EAPO) with headquarters in Moscow, Russia. The applicant may claim protection for the invention in all countries by a single application (which can be made based on the PCT application system). Protection is granted to the invention as a result of the examination carried out by the national offices of the relevant countries. The patentability criteria of the EAPC are the same as those of the Patent Cooperation Treaty (PCT) and the European Patent Convention (EPC).

In 2019 a Protocol to the EAPC was signed extending the scope of the convention to industrial designs, besides patents. The Protocol shall enter into force on 17 March 2021, but the option of



filing applications and obtaining a “single stop” **regional protection for industrial designs** in all member States will become operative with the adoption of a number of implementing regulations and procedures, which is unlikely to happen during 2021. Until the details of the Eurasian industrial design registration and protection process are in place, the existing mechanisms of the EAPO will be utilized.

The most recent initiative of the EAPO is the creation of a **regional Register of Pharmaceutical Products**. Starting from 01 March 2021 any owner of a Eurasian patent for a pharmaceutical substance can file a request for including its patent into the Register. The Register of the EAPO will contain information about the Eurasian patents related to pharmaceutical substances with international nonproprietary names, as well as details of countries where protection is in place, terms of protection, existing licenses and pharmaceutical products marketing authorizations for the pharmaceutical products issued based on the patents concerned.

The **Eurasian Economic Union (EAEU)** was founded in 2014 by the Treaty on the Eurasian Economic Union (EAEU Treaty), which was based on the Declaration on Eurasian Economic Integration of November 18, 2011. Current members of the EAEU are Armenia, Belarus, Kazakhstan, Kyrgyzstan and Russia. The EAEU Treaty includes Section XXIII on Intellectual Property, where harmonization of national legislations in the IP area and the protection of the interests of rightholders in the EAEU Member States are declared to be among the aims of the Union. The Treaty sets the **national treatment principle** in all Member States and is comprised of Attachment no. 26 containing the Protocol on the protection of intellectual property rights. The Protocol enumerates the IP rights and lays down a number of general principles relative to their protection. Significantly, it provides for the **principle of regional exhaustion** of the trademark right, and creates the single **EAEU trademark** and the single **EAEU appellation of origin**. However,

until presently, neither the EAEU trademark, nor the EAEU appellation of origin right were implemented.

It took 5 years to reach consensus and sign the EAEU Agreement governing the registration of the EAEU trademark and the EAEU appellation of origin, which is a separate instrument developed downstream of the Protocol and its founding principles. The Agreement was signed between the governments of the Member States on 03 February 2020 and concretely introduced the EAEU trademark, the EAEU appellation of origin, their registration procedures and the implementation and maintenance of the official register.

The Protocol provided that only graphical marks could be registered as EAEU trademarks. This excluded the registration of unconventional marks, e.g. sound, colour or smell marks. Russian law allows instead the registration of word marks, figurative marks, 3D marks and other types of marks. The Agreement defines the “Union trademark” as a mark used for the individualization of goods and services that is protected in all EAEU Member States. Other provisions say that the Agreement is not applicable to the signs of certification or guarantee and to marks that cannot be presented in a graphical form.

The Agreement requires the Cyrillic transliteration of the mark applied for and the translation of the mark into all national languages of the Member States. The Russian language is set as the main language of the EAEU trademark and the EAEU appellation of origin, so applications should be either filled in in Russian, or be accompanied by a Russian translation.

The Agreement sets a deadline for the **filing of objections** to the registration of an EAEU trademark of 3 months from the application publication date. This is different to Russian law, which allows the filing of observations against the application during the whole period of its examination. Besides, the Agreement also lays down a fixed timeframe for examination by the national IP offices.



The national office shall issue its examination report within 6 months and cannot raise grounds for rejection after expiry of that term.

All reports on and **objections** to an EAEU trademark application are forwarded to the filing national office, which notifies the applicant of grounds for rejection. Upon expiry of the 3 months term allowed for answering objections, the national offices make their final decision on the application after due assessment of the applicant's answer, if any. In contrast, Russian law provides for a 6 months term for answering objections by the Russian Patent Office (Rospatent) on Russian national applications.

The Agreement provides that detailed rules and procedures for EAEU trademark registration shall be issued by means of special regulations. The registration of the EAEU trademark will for practical purposes be feasible after implementation of all necessary procedural regulations at the EAEU and national levels.

The Agreement provides that the enforcement of trademark rights remains within the scope of the national legal systems and falls under the jurisdiction of the national courts. Special IP Courts are not envisaged at the EAEU regional level to deal with disputes on EAEU trademarks and EAEU appellations of origin.

Conversely, the Court of the EAEU was established in 2014, but its competence was limited to control the uniform application of the EAEU Treaty as well as other EAEU agreements and acts. Potentially, the EAEU Court might be seized of disputes on the enforcement of the Agreement on EAEU trademarks and EAEU appellations of origin by the Member States, but litigation between private parties on EAEU trademarks and EAEU appellations of origin, their registration and protection remain outside its competence. In real life, the EAEU Commission does not yet allow the filing of applications, as the dedicated IT system of electronic communication between the Commission and all national

Customs authorities is not fully installed and not ready to operate.

The **Customs Code of the EAEU** (which came into effect in 2018) provides another tool for the protection of IP rights – the **United Customs Register** of intellectual property objects (Register). The Customs authorities of all EAEU Member States shall be required to take action with respect to IP objects listed in the Register.

In accordance with the United Customs Code, the Register may include copyright and related rights items, trademarks and appellations of origin that are protected in all EAEU members. The Register shall be kept by the Eurasian Economic Commission, which already issued General Rules of procedure (Rules) and the Procedural Regulation (Regulation).

In accordance with the Rules and the Regulation, the Commission administers and facilitates the applications review process. Applications shall be filed with the Eurasian Economic Commission, which shall forward them to the national customs authorities for review and later notify the applicant of their decision. The Commission shall also furnish Customs authorities and other interested parties with information contained in the Register. The Regulation provides detailed procedures, relevant forms of applications and documents and requirements to fill them in it. Appellations of origin are not listed in the Regulation as an IP right registerable in the United Customs Register.

To sum up, the foundation of the Eurasian Economic Union was a brave attempt of regional cooperation in the CIS area. Although the officially announced aim of the Union was economic integration, the EAEU Member States had, and probably still have, different political positions on the level of delegation of their economic powers to the level of regional regulation. Some members, for example, have an interest in free flows of labor, others in a common market for goods and services. It is clear that the regional integration not only brings benefits, but also limits the countries' sovereignty in the areas of



joint policy and delegated powers, and this is the likely reason for a so far moderate (if not “adagio”) tempo of the process at the EAEU level.

Since the Union’s foundation in 2014, the Members States agreed to merge their customs territories and adopted accordingly the single Customs Code of the EAEU in 2018. The governance of intellectual property was another field of common interest of all Member States, which was the subject of detailed and active discussion. Moreover, the legal treatment of intellectual property has long been based on the same international

conventions and is already harmonized to a remarkable extent. The Eurasian Patent System is a reality and constitutes proof that regional IP rights are effective tool and can be successfully operated. The introduction of the regional trademark and appellation of origin is a logical step forward towards greater simplification, enhanced protection of IP rights and increased effectiveness of enforcement against counterfeits in the common customs territory of the EAEU. The EAEU history is still in its infancy, but it shows a very promising future at the horizon.



Roberto A. Jacchia

PARTNER



r.jacchia@dejalex.com



+39 02 72554.1



Via San Paolo 7
20121 - Milano



Alisa Pestryakova

ASSOCIATE



a.pestryakova@dejalex.com



+7 495 792 54 92



Ulitsa Bolshaya Ordynka 37/4
119017 - Moscow

MILANO

Via San Paolo, 7 · 20121 Milano, Italia
T. +39 02 72554.1 · F. +39 02 72554.400
milan@dejalex.com

ROMA

Via Vincenzo Bellini, 24 · 00198 Roma, Italia
T. +39 06 809154.1 · F. +39 06 809154.44
rome@dejalex.com

BRUXELLES

Chaussée de La Hulpe 187 · 1170 Bruxelles, Belgique
T. +32 (0)26455670 · F. +32 (0)27420138
brussels@dejalex.com

MOSCOW

Ulitsa Bolshaya Ordynka 37/4 · 119017, Moscow, Russia
T. +7 495 792 54 92 · F. +7 495 792 54 93
moscow@dejalex.com

