



Upcoming in 2022 amendments to Russian legislation governing patent attorneys' activities

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The Russian Parliament adopted and the Russian President signed in December 2021 a piece of legislation amending the Federal Law “On patent attorneys” issued in 2008 (Patent attorney law).

By way of general introduction, it can be noted that, similarly to other jurisdictions, that of patent attorney is a regulated profession, which is accessible as a result of a special examination held by the Russian Patent Office (Rospatent) that confirms the necessary qualification and skills of the professional in the fields of registration, prosecution, protection and management of IP right. The status of patent attorney is granted in relation to specific IP objects, namely, inventions and utility models, trademarks, industrial designs, computer programs and databases, appellations of origin. The Rospatent administers all procedures,

and maintains the patent attorneys register.

In accordance with the provision of article 1247 of the Russian Civil Code, persons domiciled abroad, and foreign entities may interact with the Rospatent only through a Russian registered patent attorney, unless otherwise provided in international arrangements (e.g. such agreements are in force with Armenia, Azerbaizhan, Kazakhstan, Tajikistan, Ukraine and certain other neighboring countries, substantially by a procedure of mutual recognition of the domestic status). According to official information of Rospatent source, the special rule on mutual grant of permission to represent national rightholders/applicants in the patent office of another country concerned is provided either by bilateral agreements governing IP matters, or by exchange of diplomatic notes (memorandums) between Russia and such other countries. Patent attorneys



registered in other countries are obliged to comply with all applicable legal requirements in force in the country concerned.

The Patent attorney law deals with the patent attorney status and attestation, registration procedures, grounds and procedure for suspension of registration or exclusion from the register. The changes in the law introduced in December 2021, are broader than the previous ones, of 2011, 2012, 2013 and 2020 respectively.

Most of the latest amendments will come into force with a year delay on 22 December 2022, but for adding geographical indications to the specialized practice area of appellations of origin, which is effective starting from 21 April 2022. From that day, examination issues and tasks for that area will cover not only appellations of origin, but also geographical indications as a new intellectual property right existing in Russia since 2020.

The Patent attorney law amendment contains clarifications and detailed provisions in connection with the status of patent attorney, his or her activity and its performance, the requirements and experience of candidates, the rights and obligations of a patent attorney, provisions in case of conflict of interests, patent attorney–client privilege and some other. Certain of these provisions became the object of legislation for the first time.

The current law provides that patent attorneys interact with the Rospatent on behalf of applicants, rightholders and other interested parties. However, scope of patent attorneys activities is much wider than just interaction with the Rospatent, and the amendment specifies that the activity of a patent attorney is aimed at the protection of the rights of the client, who is a person or legal entity having entered into a patent attorney service agreement, and includes interaction with the Rospatent, its offices, other state authorities, persons and legal entities, and furthermore that the patent attorney will also act as the client's

representative of record in court cases on IP issues.

Patent attorneys must be Russian citizens having acquired patent attorney status as a result of qualification and experience in the specific area of specialization. There is no change to the prevailing options as to the legal form of the activity, which includes private practice as well as employment.

The new provisions that are worth special attention are briefly described below.

Conflict of interests

The true novelty of the amendment to the law is the governance of conflicts of interests now contained in article 4 “Rights and obligations of a patent attorney”.

Part 10 of the article provide that neither a patent attorney, nor his/her employer can accept instructions from a client in the following cases:

- the patent attorney was involved in a dispute/review of case or the taking of decision on the same IP object or subject of instructions as an employee of the Rospatent, its offices and institutions;
- the patent attorney or its employer handled the matter on behalf of another party in the same dispute or with respect to the same IP object/matter and the interests of the former principal are/were adverse to the interests of the new client.

The new text of the Patent attorney law also deals with conflicts upon an IP object between clients of the same patent attorney: he/she cannot accept instructions from both sides but may assist in the settlement of the dispute.

Article 3 of the new version of the law provides an extensive description of patent attorneys' activities and can be looked at in order to understand the scope of permissible and impermissible activities in conflict of interests contexts.

Besides, the new legislation considers as falling within a conflict of interests

situations, with respect to cases which are under review by the Rospatent involving the patent attorney's relatives or person under their direct supervision.

Responsible representative

The new notion of responsible representative of the rightholder appears in the amended text of the law for the first time. This is a patent attorney, who is recorded in the official register of the Rospatent as a responsible representative at the request of the rightholder. Notices given to the responsible representative will be deemed notices duly given to the rightholder in connection with the specified IP object made by the Rospatent or other Russian state authorities. Consequently, the responsible representative is obliged to duly inform the rightholder of any notice received, even after the expiry or termination of legal representation or the patent attorney's instructions. The procedure of registration of a responsible representative of a rightholder will be specified by subsequent operative regulations.

Patent attorney–client privilege

The Patent attorney law was moreover supplemented by new article 4.1. entitled "Protection of patent attorney secrecy" that qualifies all information on the activities of the client and the relevant IP rights received from the client as privileged and confidential. Such information cannot be appropriated or disclosed to third parties by the patent attorney or his/her employer, except upon request of state authorities in cases provided for by Russian law. The patent attorney and his or her employer are

obliged to maintain the privilege and are civilly liable for non-compliance for that obligation.

Authority to request information from state authorities

A new legal power is granted to patent attorneys by the amendment to the law once it has come into force. Namely, the patent attorney will be entitled to request from state authorities the information that are necessary for performing the client's lawful instructions. The state authority shall provide the requested information, which falls within its competence within one month, except for information that is the object of special restrictions under personal data legislation, or that qualifies as a state secret or classified information. Again, implementing regulations governing the form and procedure for filing requests by patent attorneys will be introduced.

The law furthermore specifies an exhaustive list of cases, when a request may be rejected, namely

- absence of the requested information;
- non-compliance with form and procedural requirement;
- situations where the area of specialization of the patent attorney does not match with the object of the request;
- restriction to access to the information provided by Russian laws and regulations.

The date of coming into force of the amendments to the law is eagerly awaited, and is expected to considerably affect the organization and structure of the patent attorney profession in Russia.



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