

# Newsletter

## *On important provisions of the Resolution of the Plenum of the Supreme Court of the Russian Federation dated April 23, 2019 No. 10*

September 3, 2019

### Dear Ladies and Gentlemen!

On April 23, 2019 the Plenum of the Supreme Court of the Russian Federation adopted the Resolution No. 10 "On Application of the Fourth Part of the Civil Code of the Russian Federation" that summarizes the judicial practice in the area of intellectual property of the recent years.

You may find below our brief comments with respect to the most important provisions of the Resolution.

Jurisdiction of domain disputes	Disputes on the means of individualization, such as trade/service marks, etc. (except for appellations of origin of goods), and, respectively, domain disputes are subject to jurisdiction of <b>arbitrazh (commercial) courts</b> regardless of the parties in a case.	cl. 4
Regime of a joint exclusive right	The joint exclusive right belonging to several persons <b>cannot be divided into shares</b> . The relationship of such persons shall be determined by an agreement between them, and if an agreement is not reached – by the court.	cl. 35
Requalification of an assignment agreement into a license agreement	If an agreement on alienation of exclusive right contains certain restrictions (e.g., on terms, territory, methods of use of an intellectual property ("IP")) or establishes the validity period of an agreement, it may be qualified by the court as a license agreement, or if that is not possible – such an agreement will be hold invalid fully or in a relevant part.	cl. 37
Presumption of non-gratuitous nature	If it is not explicitly stated in a license agreement that it is gratuitous, it is considered as non-gratuitous.	cl. 40
Disposal of the IP that will be created in the future	It is confirmed the possibility of conclusion of an agreement on alienation of exclusive right and a license agreement with respect to the IP that will be created (arise) in the future.  The respective right will be transferred (granted) at the time specified in the agreement, but not earlier than the date of origin of such right provided that the IP and the transfer	cl. 47

	(granting) of the respective right are not subject to state registration. In the latter case, the right is deemed transferred (granted) at the time of such state registration	
Evidence in disputes on breach of the exclusive rights	The parties involved in a case can independently verify <b>screenshots</b> from the websites by indicating the website page address and the exact time of receipt of such screenshots.	cl. 55
	<b>Audio or video recording</b> confirming distribution of counterfeit products is admissible evidence even without permission for such recording from a person distributing such counterfeit products.	cl. 55
One goal – one violation	As a rule, the use of IP in several ways represents the corresponding number of violations. However, if such use is aimed at achieving <b>one economic goal</b> , it should be considered as <b>one violation</b> .	cl. 56
Release from liability	<p>A person can be released from liability for the violation of IP rights if he/she:</p> <ul style="list-style-type: none"> <li>○ acted under <b>instructions of a third party</b> and</li> <li>○ <b>did not know and should not have known</b> about the violation of the IP rights of a right holder.</li> </ul> <p>In other cases, such person shall be <b>jointly liable</b> with a person who has given him/her such instructions.</p>	cl. 73
Bringing to liability of a website owner	<p>A website owner can be recognized as a person who directly uses the IP which was posted on such a website by third parties in cases if he/she:</p> <ul style="list-style-type: none"> <li>○ <b>substantially reworks</b> the third-party IP, and (or)</li> <li>○ <b>receives income</b> from the posted IP.</li> </ul> <p>In such cases, a domain owner is considered as a person that directly uses the IP.</p> <p>At that, unless proven otherwise, it is assumed that an administrator of a domain name directing to a website is an owner of such website.</p>	cl. 78
Citation of photographs	It is allowed to cite any work, including photos, if such a work <b>has been legally published and</b> the citation is implemented <b>for the purposes and to the extent provided by law</b> .	cl. 98
Use of a patent without consent of a patent holder	The use of <b>only particular features</b> of an invention/utility model or <b>not all the essential features</b> of an industrial design without	cl. 123

	the consent of a patent holder does not violate the patent holder's exclusive right.	
"Dual patenting"	If there are two patents with different priority dates issued for identical inventions, utility models and industrial samples, until a patent with a later priority date is declared invalid, the actions of a holder of such a patent <b>cannot be treated as an infringement</b> of a patent with an earlier priority date.	cl. 125
Trade secret and know how	It is <b>not mandatory</b> to introduce a trade secret regime to preserve confidentiality of the information constituting know how. The confidentiality can be observed by other reasonable measures.	cl. 144
Name of a non-profit organization	Although a non-profit organization is not entitled to have a firm name, the unauthorized use of its name can be recognized as <b>an act of unfair competition</b> .  A non-profit organization's name can be also protected as a commercial designation.	cl. 147
Actions not constituting a trademark infringement	<ul style="list-style-type: none"> <li>○ Use of a trademark during the period <b>between the date of a trademark application filing and the date of a trademark registration</b>;</li> </ul>	cl. 155
	<ul style="list-style-type: none"> <li>○ Storage and transportation of trademarked goods <b>without the goal to sell them</b>;</li> </ul>	cl. 156
	<ul style="list-style-type: none"> <li>○ Manufacture, storage and transportation of goods by a third party <b>under an agreement with a trademark holder</b>;</li> </ul>	cl. 156
	<ul style="list-style-type: none"> <li>○ Use of a word trademark in <b>plain meaning</b> of the word in written publications or oral speech <b>without the goal to identify the goods</b>.</li> </ul>	cl. 157
Protection of well-known trademark in a domain dispute	If a well-known trademark is used in a domain name, then as a trademark infringement can be recognized not only the actual use of a trademark in respect of similar goods (as in case of a common trademark), but also <b>the registration of a domain name</b> .	cl. 158
Use of means of individualization in keywords in context advertising	Use of keywords similar to any means of individualization of another holder can be recognized as <b>an act of unfair competition</b> under article 14.6 of the Federal Law "On Protection of Competition".	cl. 172

We hope that the information provided herein will be useful for you. If any of your colleagues would also like to receive our newsletters, please let us know by sending us his/her email address in response to this message. If you would like to learn more about our **Intellectual Property Practice**, please let us know in reply to this email. We will be glad to provide you with our materials.

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Sincerely,  
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