

FICPI 16TH OPEN FORUM

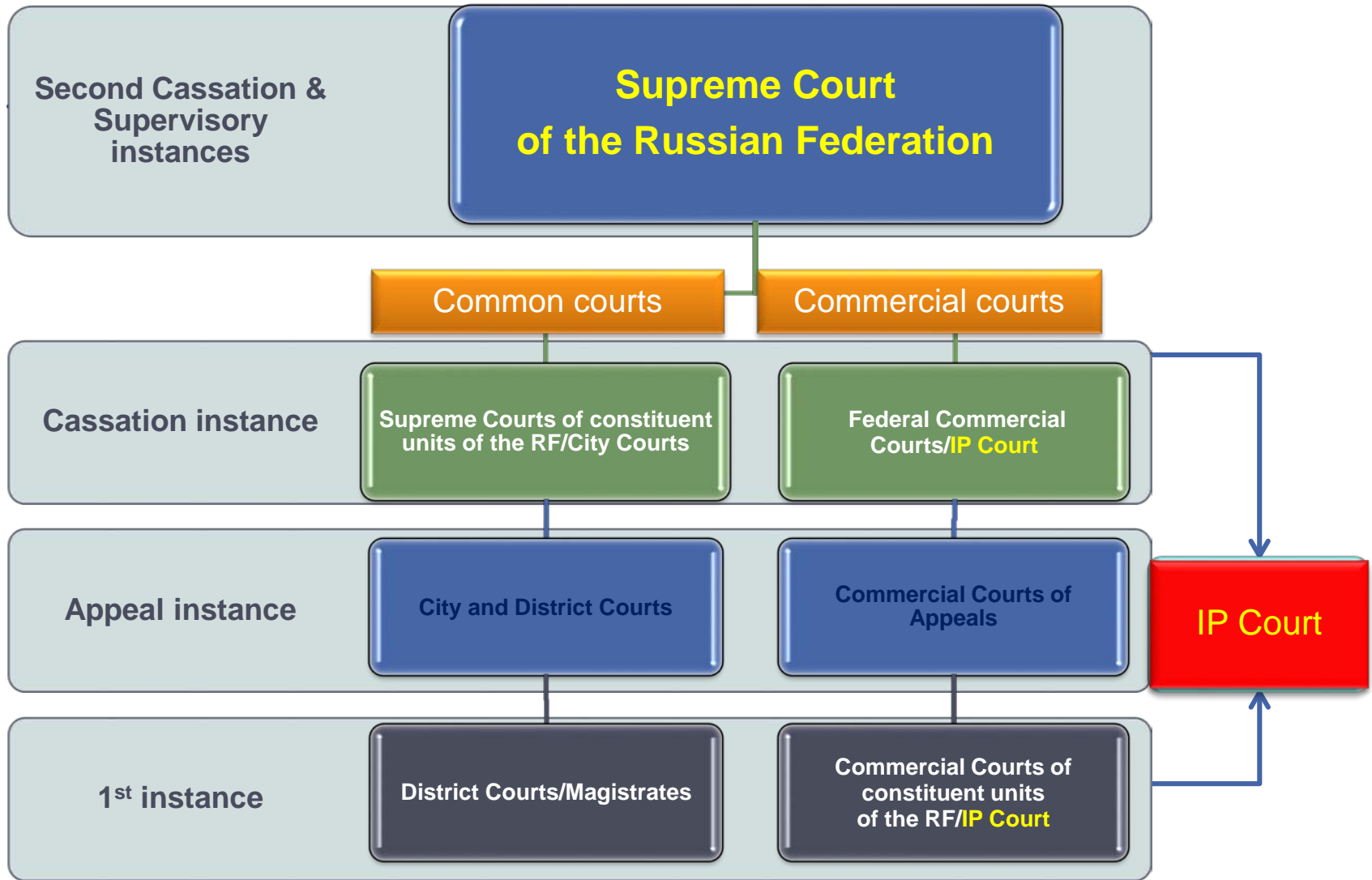
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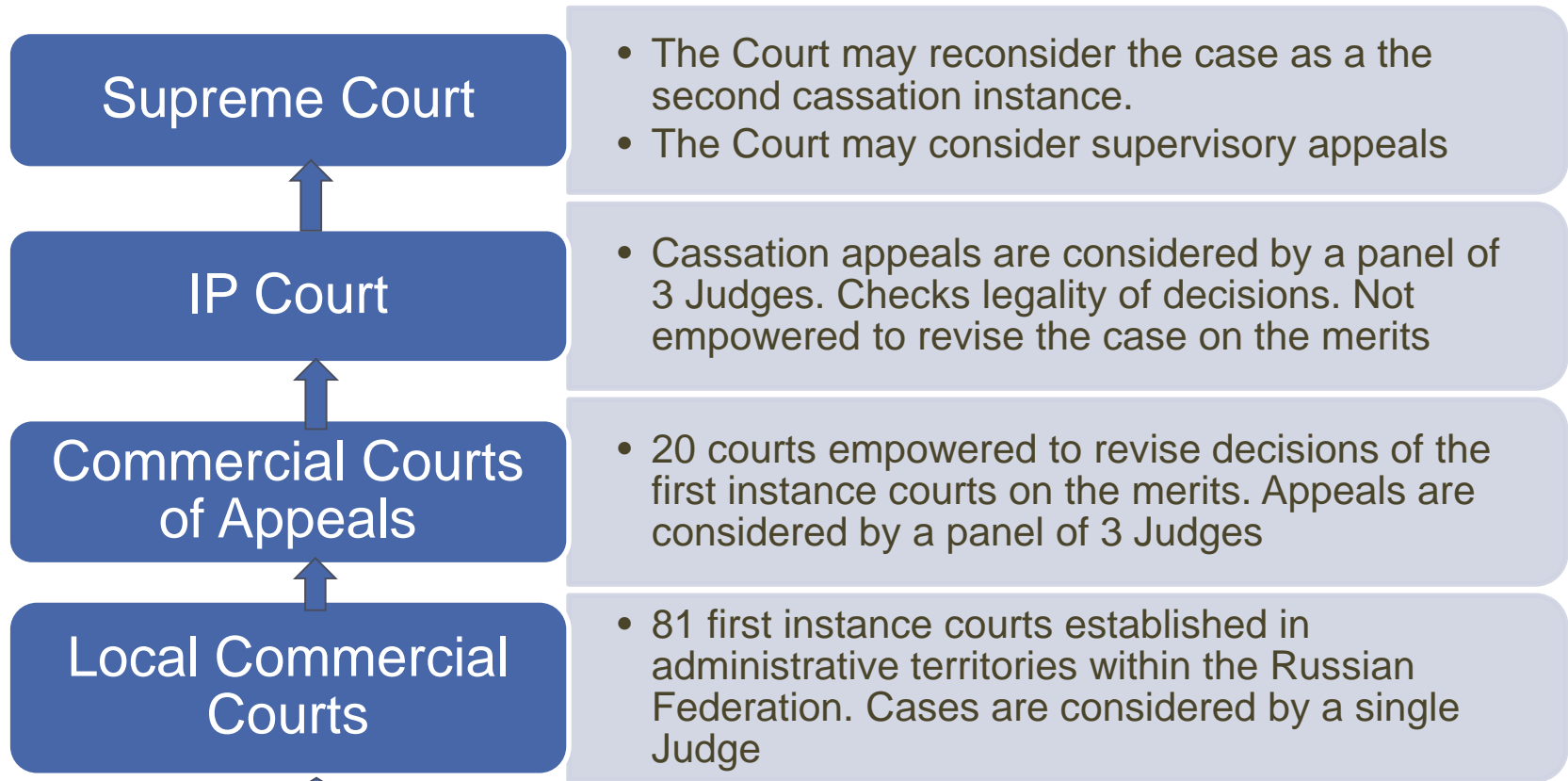
ENFORCEMENT: WHEN AND WHERE TO ACT?

GORODISSKY

GENERAL OVERVIEW OF COURT SYSTEM IN RUSSIA



IP INFRINGEMENT CASES



IP infringement suit to be filed with the court at the defendant's location

ACTIONS OF PATENTEE

INFRINGEMENT ACTIONS

(ARTICLE 1358 OF THE CIVIL CODE)

- ✓ Import into Russia, manufacturing, use, offer to sell, sale, other introduction into civil commerce or storage for these purposes of a product in which the invention is used.
- ✓ The actions as above in respect of a product obtained directly by the patented method. If the product obtained by the patented method is new, an identical product shall be considered obtained by the patented method unless proven otherwise.
- ✓ Handling of a device during the functioning (use) of which in accordance with its purpose the patented method is automatically used,
- ✓ Dealing with a product intended for its use in accordance with the new patented purpose,
- ✓ The realization of a method in which the invention is used, in particular by the application of that method.

ENFORCEMENT OPTIONS

- CIVIL ACTION
- ADMINISTRATIVE ACTION
- CRIMINAL ACTION
- UNFAIR COMPETITION ACTION

CIVIL REMEDIES

CLAIMS:

- Recognition of right
- Cessation of activities infringing the right or creating a threat of its infringement
- Damages/Compensation
- Seizure/destruction of infringing products and/or equipment
- Publication of court decision
- Liquidation of legal entity

CEASE AND DESIST LETTER

- Case under jurisdiction of the common courts –
No C&D letter can be sent
- Case under jurisdiction of the commercial courts –
C&D letter must be sent

A lawsuit can be filed in 30 days from the date of sending

PRELIMINARY*/INTERIM** INJUNCTION

- Seizure of property or monetary funds
- Ban on performing certain actions
- Ordering to perform certain actions
- Transfer of disputed property to the plaintiff
- Other

INJUNCTIONS SHOULD BE ADEQUATE TO THE CLAIMS

* Before filing the lawsuit (up to 15 days for filing)

** After filing the lawsuit or along with the lawsuit

COLLECTING AND SECURING EVIDENCE

- Evidence should be collected by the plaintiff:
 - Proof of infringement;
 - Duration of infringement;
 - Amount of damages.

Exception for the use of the new product produced by the patented method – *reversing a burden of proof on the defendant*

COLLECTING AND SECURING EVIDENCE

- Without assistance
- Detective
- Notary Public
- Court Order
- Within the frame of administrative or criminal case

No discovery proceedings are provided by the law

COLLECTING AND SECURING EVIDENCE

WITHOUT ASSISTANCE

- Purchase (if possible)
- Advertising materials
- Technical information
- Certificates of Conformity
- etc.



EAC



COLLECTING AND SECURING EVIDENCE



DETECTIVE

- Report of a detective may be used as evidence
- Respective documents confirming facts stated in the Report (receipt, invoice, contract, etc.) should be attached
- Detective may be invited to the hearings as a witness

COLLECTING AND SECURING EVIDENCE

NOTARY PUBLIC:

The Notary Public can secure evidence in case there is a risk that it would be difficult or impossible to obtain evidence in future.

- Printouts from the web-site
- Test purchase
- Demonstration of a product and/or distribution of materials at an exhibition
- Ordering for an expertise (!)

EXPERTISE

- Experts:
 - May be entrusted to a State expert organization
 - Individual expert
 - Group of experts
- Rights of the parties:
 - propose experts
 - propose questions
 - challenge the experts
 - requesting new or repeated expertise
- Payment:
 - burden lies on a party filed the motion (Plaintiff, Defendant or both)

DAMAGES

- Lost profit
- Expenses related to restoration of the infringed rights

DAMAGES

SUPPORTING ARGUMENTS:

- There is a granted license with respect to the same subject-matter – license fees
- Standard license fees
- Valuator's report
- Court expertise
- Marketing research

DAMAGES OR COMPENSATION

In case of infringement the right holder can claim, instead of payment of damages, a statutory compensation:

- 10 000 rubles – 5 000 000 rubles to be determined by the court, or
- double price of a license in comparable circumstances

GENERAL ASPECTS

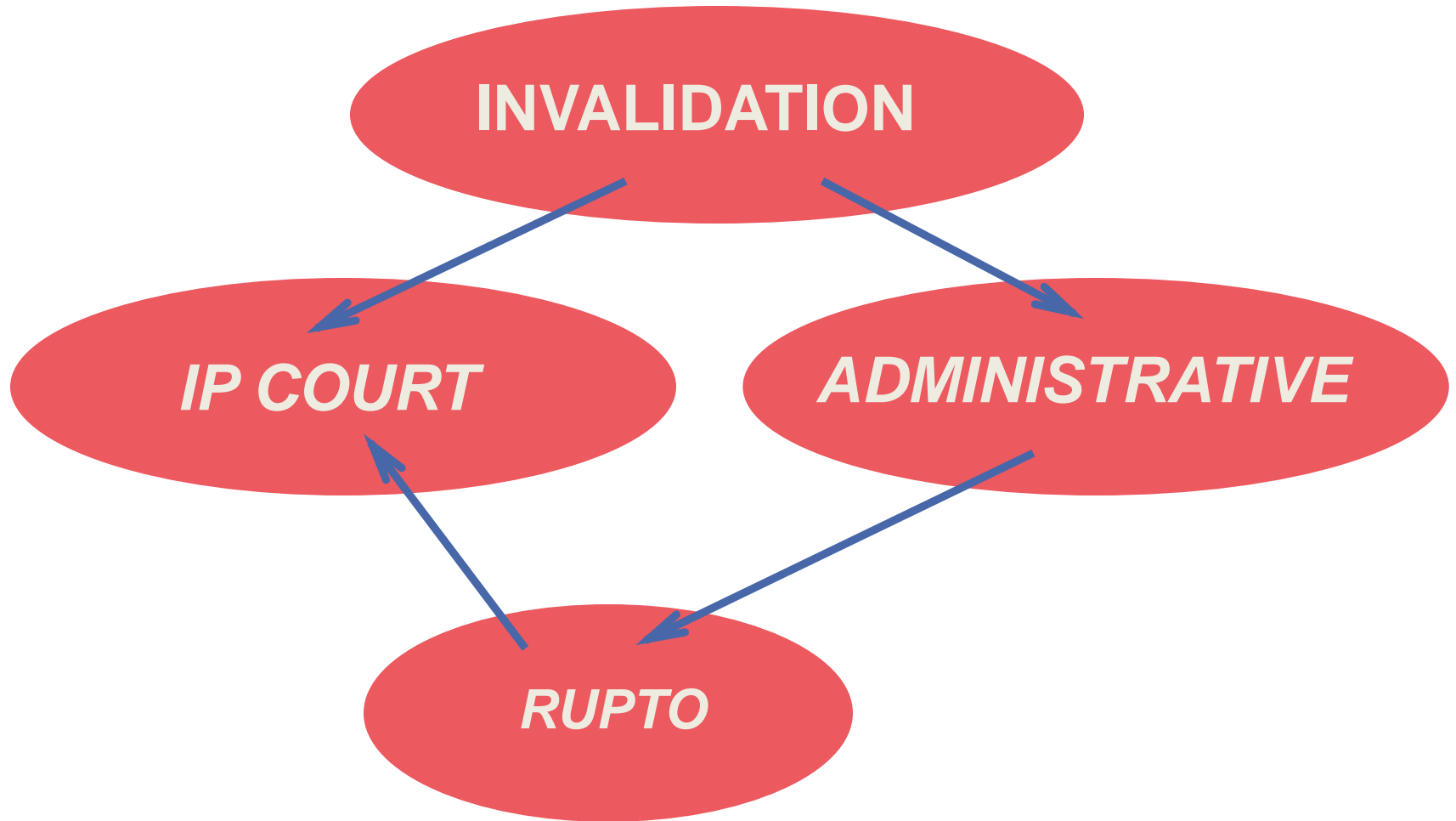
- Duration:
 - 6-8 months (1st instance)
 - 2-3 months (appeal instance)
 - 2-3 months (first cassation instance)
 - 2-4 months (second cassation instance)
 - 2-4 months (supervisory instance)
- New evidence: limited possibility at the appeal instance
- Legal costs can be reimbursed in the reasonable amount to be determined by the court
- Invalidity defense: patent infringement action in the commercial courts is not suspended in case of invalidation action launched in the administrative order

COUNTER ACTIONS OF DEFENDANT

DEFENDANT'S STRATEGY

- Attempt to prove absence of the infringement
- Invalidation of the patent
- Patent term extension nullity action
- Use of file wrapper estoppel doctrine
- Use prior-right doctrine
- Use of subsequent-right doctrine

INVALIDATION OF PATENT



INVALIDATION OF PATENT

- **Granted patent validity can be opposed and the patent can be invalidated in case of:**
 - Non-correspondence of the claimed subject-matter(s) to criteria of patentability
 - Revealed introduced new subject-matter
 - Revealed double patenting
 - Improper inventorship or assigning
- **Granted patent can be considered invalid:**
 - Totally
 - Partially – new patent with the amended claims shall be issued

BAYER VS GEDEON RICHTER (A40-90149/2011)

- Bayer filed a lawsuit against GR and local pharmacy for infringement of a patent.
- GR challenged the validity in the Chamber of Patent Disputes
- The 1st instance court dismissed the lawsuit since the patent was invalidated partially and a new patent with the amended claims was not issued on the date of the hearing on the merits. The court decided that invalidation of the patent leads to termination of the exclusive rights.
- The Court of Appeals supported such position although at this stage the new patent with the amended claims was issued. The 1st independent claims remained unchanged.
- The Court of Cassation upheld the above decisions.

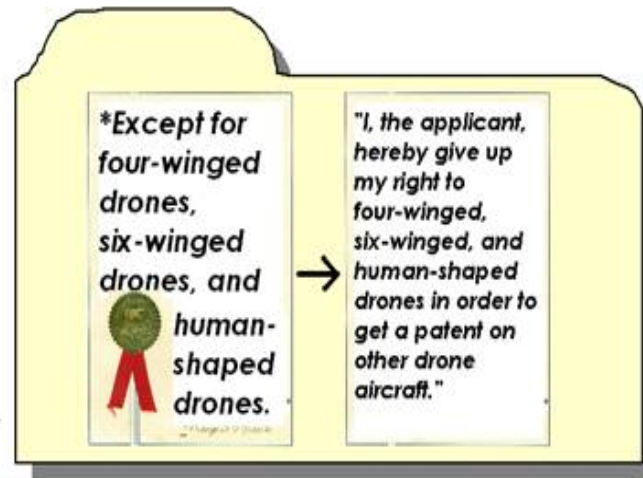
BAYER VS GEDEON RICHTER (A40-90149/2011)

- The Presidium of the Supreme Commercial Court reversed the above decisions and returned the case back for new consideration.
- Position:
 - in case a new patent is issued the exclusive right shall remain in force as from the first filing date
 - the courts should check whether new patent is infringed

FILE WRAPPER ESTOPPEL

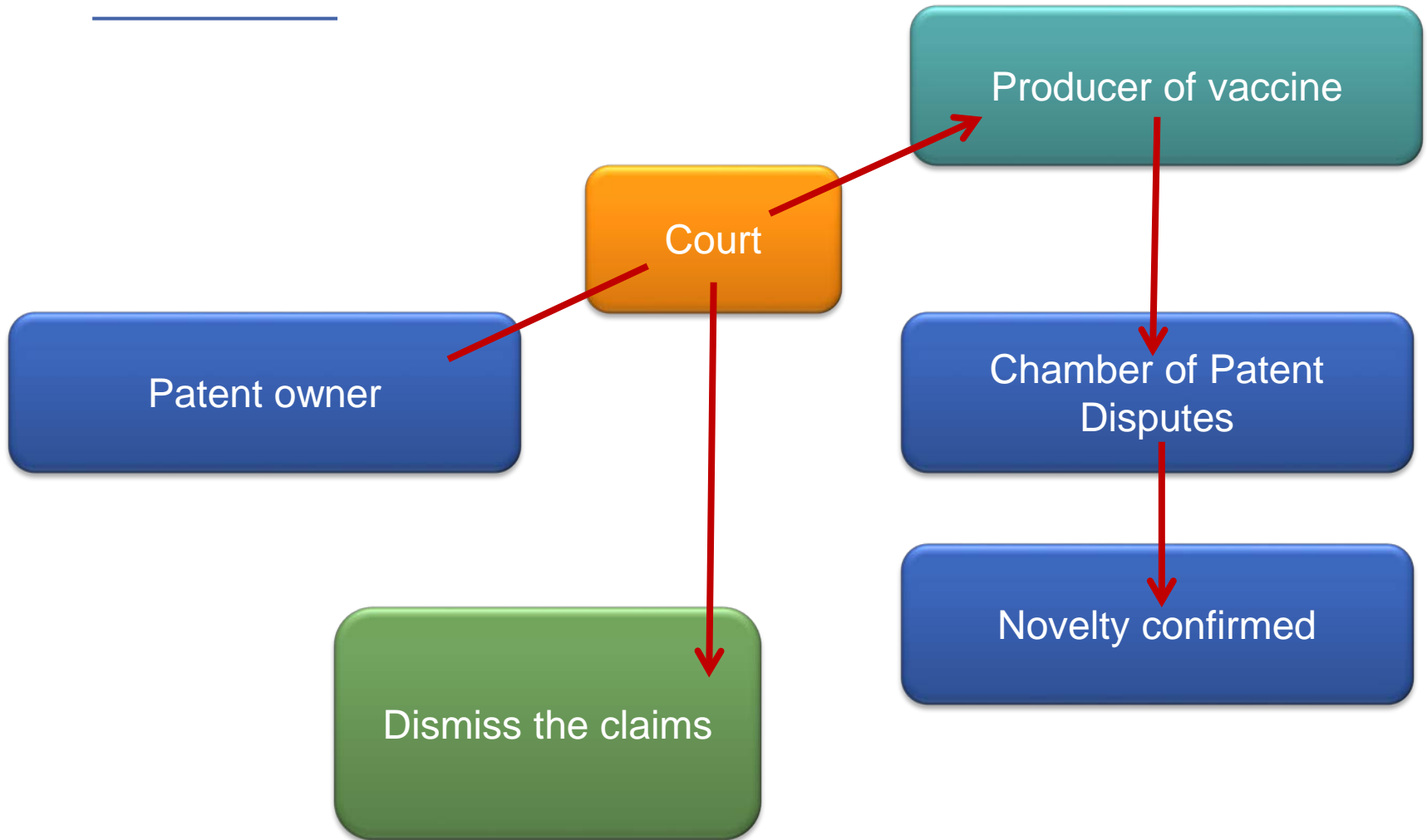


-Patent-



-Patent File History-

FILE WRAPPER ESTOPPEL



RESTRAINT ON ABUSE OF PATENT RIGHTS

- Doctrine of equivalents:
 - An **equivalent feature** should be **known** in the art as such equivalent **before the filing (priority) date of the inventions** the allegedly infringing actions
- Prior-User-Rights Defense
 - “Prior user” right shall be **available**
 - **in respect of** identical technical solution
 - as well as **equivalent technical solution**

THANK YOU FOR YOUR ATTENTION!

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