

## **Protection of Intellectual Property Rights in the Sphere of Fashion in Russia**

In the process of creation of new designs for clothing, footwear and fashion accessories such as bags, hats, and belts, a need arises for protection against imitation by unfair competitors.

In Russia as in most other countries there exist different forms of legal protection of new works including those in the sphere of fashion. Russian law, similar to law of other countries, does not contain special provisions for fashion designs, and the objects of fashion, though possessing some specificity, are subject to common rules of the law.

### **The Legislative Framework**

The Russian legislation protecting intellectual property objects is contained in Part IV of the Civil Code of the Russian Federation (of December 18, 2006 with amendments of November 8, 2008).

The Russian Federation is member of the World Intellectual Property Organization (WIPO) as well as it is a party to a number of WIPO international conventions and treaties, the main of which are as follows:

- Paris Convention for the Protection of Industrial Property (Russia is a contracting party since July 1, 1965);
- Madrid Agreement Concerning the International Registration of Marks (Russia is a contracting party since July 1, 1976);
- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Russia is a contracting party since June 10, 1997);
- Patent Cooperation Treaty (PCT) (Russia is a contracting party since March 29, 1978);
- Nairobi Treaty on the Protection of the Olympic Symbol (Russia is a contracting party since April 17, 1986);
- Trademark Law Treaty (TLT) (Russia is a contracting party since May 11, 1998);
- Berne Convention for the Protection of Literary and Artistic Works (Russia is a contracting party since March 13, 1995);
- Singapore Treaty on the Law of Trademarks (Russia signed the treaty on March 26, 2007).

Russia, as a party to the above-listed conventions and treaties together with local Russian laws enable foreign and local companies to have effective protection of their works against infringement and unauthorized use. The whole range of intellectual property objects can be used for this purpose.

Such objects of industrial property as trade names, commercial designations, trademarks, service marks and industrial designs are successfully used to protect one's rights on fashion innovations. Copyright protection is also popular. Domain names should be also mentioned since they are used to identify the producers of goods and services in the market, though they are not objects of law in Russia.

### **Trade Names**

Trade names and commercial designations are the principal means used to identify businesses. Trade names are protected in all member countries of the Paris Convention for the Protection of

Industrial Property<sup>1</sup>. Moreover, according to the same provision of the Convention, a trade name shall be protected without the obligation of filing or registration, whether or not it forms part of a trademark. However, if there exists a possibility that the use of a new trade name in Russia will conflict with other trade names or trademarks already in use in this country, the owner of the new trade name should conduct a novelty and similarity search of their name in Russia in order to avoid violating the rights of existing trade name and trademark owners.

Unfortunately the Integrated State Register of Legal Entities which is maintained by the Russian Federal Tax Service is not available for making a similarity search of a trade name. It is recommendable to at least make a search through the database of trademarks registered in Russia. Consequently, no one can be completely sure that the name searched through the trademark database will not infringe the rights of other businesses since the search will not be complete as not all trade names contain registered trademarks or form a part of such a trademark. The opportunity to make such a search should not be neglected, however, since a registered trademark similar to a new trade name may significantly complicate one's business.

Fuller and almost total security against such problems can be provided by the registration of the meaningful part of the trade name of a legal entity as a trademark. During the examination conducted by the Russian Federal Service for Intellectual Property, Patents and Trademarks (Rospatent), namely its department Federal Institute for Industrial Property (FIPS), the designation filed for registration as a trademark is subject to a meticulous similarity search among both registered trademarks and pending applications with prior filing dates. Registration is possible if the trade name or the part filed for registration meet the requirements of the Russian law to trademarks<sup>2</sup>.

As to the format of a trade name, Russian requirements are similar to those found in other countries. Trade names being registered in Russia should contain an indication to the company's legal form (i.e. limited liability company, open joint stock company, etc.), should mention its type (i.e. state, municipal, private), and the profile of its activities (i.e. industrial, scientific, commercial, etc.). Moreover, besides the type and legal form, trade names registered in Russia should contain the proper name of the legal entity<sup>3</sup>. Below are examples of a few trade names of Russian fashion houses, namely *SlavaZaitsev's Model Agency LLC*, *Fashion House ValentinYudashkin LLC*, *ABS MODUS Model Agency LLC*, etc.

The owner of a trade name has the right to use it in any way not contrary to the law. This is actually what is implied by an "exclusive right" to a trade name. This right is not limited by any term. An exclusive right to a trade name is valid from the date of the legal entity's registration in the Integrated State Register of Legal Entities until the moment of exclusion of the trade name from the Register or in connection with the cancellation of the company or change of its trade name.

As mentioned above the Federal Tax Service responsible for the Integrated State Register of Legal Entities does not monitor the registration of similar trade names, but it is nonetheless very important to the companies, including fashion houses which invest considerable amounts into advertising campaigns for their goods and services, to prevent the appearance of similar designations in the market. Consequently, it is advisable to use the services of patent and trademark attorneys who deal with monitoring of trademarks registered in Russia so that the

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<sup>1</sup>Paris Convention for the Protection of Industrial Property. Article 8: *Trade Names*.

<sup>2</sup>Civil Code of the Russian Federation. Part IV. Article 1483: *Grounds for Rejection of State Registration of a Trademark*. Points 1-5.

<sup>3</sup>Civil Code of the Russian Federation. Part IV. Article 1473: *Trade name*. Point 2.

owners of trade names can be timely informed at least of the registration of similar or identical trademarks by FIPS.

Protection of one's rights to a trade name can be exercised in court as well as through administrative procedures. Conflicts connected with the infringement of one's rights to a trade name are under the competence of commercial courts known in Russia as Arbitrazh Courts; however, upon mutual agreement the parties can have their case heard in courts of general jurisdiction.

If unfair competition has taken place in light of Article 10*bis* of the Paris Convention<sup>4</sup> the aggrieved party can apply to the Federal Antimonopoly Service of Russia (FAS). In light of the Federal Law *On Protection of Competition*<sup>5</sup> the FAS considers the aggrieved party's applications, examines the materials and documents presented by the parties and issues its decision at a hearing in the presence of both parties or their representatives. A decision in favor of the plaintiff can have a fundamental role for success at further court hearings.

If the FAS considers actions connected with the registration of a trademark which are aimed against the owner of the trade name to be unfair competition and issues a corresponding decision, the owner of this trade name can apply to the Chamber for Patent Disputes of Rospatent which can determine the registration of this trademark during the whole term of its validity to be totally or partially invalid in accordance with Russian Civil Code provisions<sup>6</sup>.

### **Commercial Designations**

A commercial designation, like a trade name, is used to identify businesses and is a rather new object of industrial property in Russia.

The right to use commercial designation as one of the means of individualization of industrial, trade and other enterprises is provided by Articles 1538-1541 of the Russian Civil Code, Part IV (of December 18, 2006 with amendments of November 8, 2008). Earlier the notion 'commercial designation' was mentioned in Article 1039, Chapter 54 of the previous revision of the Civil Code which was valid from March 1, 1996 till January 1, 2008. At the international level 'commercial designation' as a means of individualization was mentioned for the first time in the Convention on Establishment of the World Intellectual Property Organization (WIPO) in 1967.

The Civil Code does not contain the definition of a commercial designation but mentions certain features and conditions which serve to identify it. Thus the Code states that commercial designations can be used by legal entities doing business (including non-profit organizations which have a legal right to do business in accordance with their constituent documents) as well as by individual businessmen in order to identify trade, industrial or other enterprises owned by them. Commercial designations are different from trade names and are not subject to obligatory inclusion in constituent documents and registration in the Integrated State Register of Legal Entities<sup>7</sup>. The enterprises mentioned above include model agencies, fashion houses and other similar businesses which for many years have used designations that became very popular among consumers as a result of intensive advertising on signboards, goods and packaging. Since the Civil Code does not specify the means of registration of commercial designations, most

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<sup>4</sup>Paris Convention for the Protection of Industrial Property. Article 10*bis*: *Unfair Competition*.

<sup>5</sup>Federal Law of the Russian Federation No.135-FZ of July 26, 2006 *On Protection of Competition*. Chapter 1. Article 14.

<sup>6</sup>Civil Code of the Russian Federation. Part IV. Article 1512: *Grounds for Challenging and Invalidation of Granting Registration to a Trademark*. Point 2.6.

<sup>7</sup>Civil Code of the Russian Federation. Part IV. Article 1538: *Commercial Designation*. Point 1.

analysts<sup>8</sup> conclude that commercial designations are to be protected without registration in view of their notoriety on the basis of Article *6bis* of the Paris Convention<sup>9</sup>. Current Russian legislation does not provide any other options for the protection of this object of industrial property.

The owner of a commercial designation enjoys the exclusive right to its designation on the whole territory of Russia. This implies that the right holder possesses an exclusive right to use its commercial designation as a means of individualization of his company in any way not contrary to the law. It is clear that this designation should possess sufficient distinctive features and should have definite associations with a certain company. Under 'the sufficiency of distinctive features' the law makers obviously implied the ability of a commercial designation to identify a company. This evidently means that one's commercial designation should not be similar to the extent of confusion with other commercial designations whose owners have prior rights to them as well as it should be dissimilar to trademarks, service marks and trade names of the third parties registered earlier. Moreover, a commercial designation should be well-known within a definite territory.

What is the difference between a commercial designation and a trade name? A commercial designation can be both verbal and graphic. It can also contain color elements and sounds. A trade name can consist of word elements only. As distinguished from a trade name, a commercial designation can be used to identify several companies.

The exclusive right to a commercial designation which contains the right holder's trade name or its parts is enjoyed by him independently of the right to his trade name.

A commercial designation as well as a trade name can be used in a trademark owned by the right holder. At the same time the commercial designation itself, being a part of a trademark, enjoys separate protection independently from the trademark registration.

Commercial designations are frequently used as names of restaurants, cafes, shops and other similar businesses, for instance, *GAZPROM*, *McDonald's*, and *Microsoft*. Commercial designations can be successfully used by fashion houses as well.

## **Trademarks and Service Marks**

The most popular forms of protection of IP rights of industrial companies, trade organizations and service enterprises are trademarks and service marks. This means of protection is encouraged first of all by well-developed legislation, which enables the owners of marks to easily protect their rights. There is also an automated database, which reduces the time to make the novelty search, and a special research and examination state authority, the Federal Institute for Industrial Property (FIPS) which is a part of Rospatent. Finally there is a well-developed system of international treaties, agreements and other contracts, which enable the owners of marks to obtain their protection simultaneously in a number of countries at lower costs.

A great advantage of trademarks (from here and further the term 'trademark' will be used both for trademarks and services marks since the law is practically the same for these two IP objects) is the possibility for their owners to assign rights to a trademark through a license agreement or an assignment of rights agreement. These advantages are not available for trade names or commercial designations. Thus a trademark is an object of purchase and trade which makes it,

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<sup>8</sup>*Commentary to Part II of the Civil Code of the Russian Federation for Businessmen*. Edited by M. I. Braginsky, Moscow, 1996.

<sup>9</sup>Paris Convention for the Protection of Industrial Property. Article *6bis*: *Well-Known Marks*.

considering the enormous value of well-known trademarks, not only an effective means against infringement and a safe advertising product but a profitable item of commerce as well.

The legislation covering trademarks is contained in the Civil Code of the Russian Federation, Part IV, Chapter 76, Articles 1477-1515.

This law defines a trademark as a sign capable of individualizing goods produced by legal entities and independent businessmen. The ownership of a trademark grants its right holder the exclusive right to a trademark which is attested by a certificate.

The state registration of a trademark is conducted by FIPS in the State Register of Trademarks and Service Marks of the Russian Federation.

Various signs may be registered as trademarks in Russia among them word, figurative, three dimensional and other signs or their combinations. The most popular are 'word plus design' marks. A trademark may be registered in any color or combination of colors.

The law does not mention sound, luminous, olfactory and tactile trademarks. However, since 1997 FIPS accepts applications for sound and luminous trademarks. The number of such trademarks is minor in comparison with ordinary word marks, design and 'word plus design' marks but with the development of sound and luminous advertising their number will obviously increase every year. Fashion houses in particular may be interested in registration of sound and luminous trademarks which are successfully used as advertising sound-bites and luminous effects during fashion shows. One should not forget about olfactory trademarks which can be used, for instance, with respect to fashionable clothing. In this connection an experiment of an Indian firm comes to mind. The firm was a producer of men's neckties made of fibers soaked with a nice fragrance which lasted over the whole life time of the tie. Various features of such olfactory trademarks reflected in a definite item of goods will, of course, attract customers.

Three dimensional trademarks may present a special interest to fashion designers. Though it may be rather difficult to reflect all the peculiarities of designs of clothing, footwear or headgear in a three dimensional trademark apart from an industrial design (which will be discussed below) through which it is possible to specify all the minor details. The main advantage of trademarks in contrast to industrial designs is the possibility to renew a trademark registration for 10 years innumerable scores of times. It also involves a simpler procedure for preparing the filing materials, as well as lower costs of registration and less rigid originality requirements. One of the main requirements for a three dimensional trademark to obtain protection is that the configuration of goods reflected in the exterior form of the trademark is not determined exclusively or mainly by the property or function of the goods.

Among grounds for rejection of registration of a trademark the most frequent is the lack of a distinguishing capacity. Signs lacking such capacity are: (a) those consisting only of elements that are commonplace to designate certain kinds of goods, (b) generally adopted symbols and terms, (c) those pointing to the kind, quality, quantity, properties, application, value of goods and the place and time of their manufacture or sale, and (d) those that represent the configuration of goods which is determined exclusively or mainly by the property or function of the goods. Such elements may be incorporated as non-protected parts in a trademark, provided they do not prevail. However, the above provisions will not be applied to signs that have acquired a distinctive character as a result of their intensive use and, if proved by the applicant, such signs can be granted full protection. Moreover, while evaluating the distinguishing capacity of signs consisting of non-protectable elements such as numbers or letters (or their combinations) not having a word character, the PTO examiners may determine that the insufficiency of distinctive

features of the sign is compensated by the specific design of the letters or numbers. As a result such a sign actually becomes a design mark.

Combinations of letters can be considered protectable if the position of vowels and consonants in such combinations makes them readable in accordance with the rules of the Russian language. The abbreviations of popular local companies are examples of such combinations. The abbreviations for Kamsky Automobile Plant – *KAMAZ*, for Volzhky Automobile Plant – *VAZ*, for Leningradsky Optomechanical Association – *LOMO* are registered as trademarks in Russia since they may be referred to fancy words. If the letters are in the Latin alphabet the same requirements are applied to them.

The signs consisting of consonants only, for instance, *RMZ*, *SMZ*, etc. are considered non-protectable according to Russian law. However, some of them have become well-known among consumers as a result of their long and intensive use, for instance, such signs as *BMW* (for cars), *SKF* (for bearings) and *TDK* (for cassettes and disks) have acquired distinctive features and were registered as trademarks. Most of such signs can be referred to well-known trademarks which have a special status in accordance with Article *6bis* of the Paris Convention<sup>10</sup>.

The signs consisting only of numbers or their combinations can be granted protection on the same grounds, i.e. when they acquire sufficient distinctive features. Usually numbers or their combinations are made in a special script and depicted together with design elements, and this helps to improve their distinctive features. In case numbers as part of a sign do not possess enough distinctive characteristics and do not prevail among other elements of the sign, they may be disclaimed, i.e. considered non-protected elements of the sign, while the sign as a whole will be granted protection.

Signs claimed for registration as a trademark in Russia are subject to novelty examination. Signs will not be registered as trademarks if they are identical or confusingly similar to

- trademarks of other persons with an earlier priority applied for registration in respect of homogeneous goods;
- trademarks of other persons protected in the Russian Federation as well as by virtue of international treaties to which the Russian Federation is a party, in respect of similar goods with an earlier priority;
- trademarks of other persons, recognized in accordance with the law as well-known in the Russian Federation in respect of homogeneous goods.

It should be noted that similar trademarks as specified above can be registered in Russia in case a letter of consent from the owner of the prior trademark is presented<sup>11</sup>.

Signs, identical or confusingly similar to appellations of origin of goods, protected under the Civil Code of the Russian Federation, will not be registered as trademarks in respect of any goods<sup>12</sup>.

It should be also mentioned that signs will not be registered as trademarks if they are identical or similar to:

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<sup>10</sup>Paris Convention for the Protection of Industrial Property. Article *6bis*: *Well-Known Marks*.

<sup>11</sup>Civil Code of the Russian Federation. Part IV. Article 1483: *Grounds for Refusal of State Registration of a Trademark*. Point 6.

<sup>12</sup>Civil Code of the Russian Federation. Part IV. Article 1483: *Grounds for Refusal of State Registration of a Trademark*. Point 7.

- trade names or commercial designations protected in the Russian Federation the rights to which arose prior to the priority date of the trademark under registration<sup>13</sup>;
- titles of works of science, literature and art, characters or quotations from them, works of art or their fragments known in the Russian Federation by the filing date of the application, without consent of a copyright owner, provided the rights to these works arose prior to the priority date of the trademark under registration.

The same is true in respect of last names, first names, pseudonyms and their derivatives, portraits and facsimiles of famous persons known at the filing date of application, without the consent of that person or his successor as well as in respect of industrial designs, compliance marks and domain names the rights to which belonged to other persons in the Russian Federation, prior to the priority date of the trademark under registration<sup>14</sup>.

It should be noted that a novelty search for a sign proposed for filing is not conducted among trade names, commercial designations, industrial designs, compliance marks and domain names by the FIPS examiners. In case it happens so that the trademark identical or similar to the above-mentioned objects has been, nevertheless, registered by FIPS, conflicts between the owners may be solved by applying to the Chamber of Patent Disputes of Rospatent. The Chamber's decisions may be appealed in court.

The owners of trademarks which are being used in Russia should note that in order to inform everybody of their exclusive right to the trademarks they are authorized to use 'protective marking' which should be depicted near the trademark and may consist of a letter 'R' or a circled letter 'R' (®) or words 'trademark' or 'registered trademark'. These symbols point out that the sign being used is a protected trademark. The illegal use of protective symbols or 'special marking' as it is referred to in the Criminal Code of the Russian Federation can entail penal sanction. Article 180 of the mentioned Code reads:

“Illegal use of special marking in respect to a trademark which is not registered in the Russian Federation, or the name of the place of origin of goods, if this deed has been committed repeatedly or has inflicted sizable damage, shall be punishable with a fine in an amount of up to 120 thousand roubles, or in the amount of the wage or salary, or any other income of the convicted person for a period of up to one year, or by compulsory works for a term of 120 to 180 hours, or by corrective labour for a term of up to one year.”<sup>15</sup>

The same actions “committed by a group of persons by previous concert or by an organised group, shall be punishable with deprivation of freedom for a period of up to six years with a fine in an amount of up to 500 thousand roubles or at the rate of the salary or wages or another income of the convicted person for a period of up to three years or without such.”<sup>16</sup>

As can be noted from the above cited provision of the Criminal Code, the illegal use of trademarks is being given serious attention in Russia. However, legal scholars note that this article is applied rather seldom since such infringements are usually caused by the mere ignorance of the law and simple verbal notice is usually quite sufficient in such cases.

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<sup>13</sup>Civil Code of the Russian Federation. Part IV. Article 1483: *Grounds for Refusal of State Registration of a Trademark*. Point 8.

<sup>14</sup>Civil Code of the Russian Federation. Part IV. Article 1483: *Grounds for Refusal of State Registration of a Trademark*. Point 9.

<sup>15</sup>Criminal Code of the Russian Federation. Article 180: *Illegal Use of a Trademark*. Point 2.

<sup>16</sup>Criminal Code of the Russian Federation. Article 180: *Illegal Use of a Trademark*. Point 3.

It should be mentioned that this provision does not refer to goods produced and marked with trademarks and protective symbols abroad and later imported to Russia. So foreign couturiers and designers making a fashion show in Russia or taking part in a fashion exhibition should not worry about the trademarks with protective symbols which appear on their works. It is clear that trademarks used by exhibitors will not infringe the rights of other trademark owners in Russia.

However, if the designers are going to open a workshop for the production of clothing and other fashion goods in Russia, they should take timely measures to register their trademarks with FIPS.

Participants in exhibitions or shows may enjoy the right to exhibition priority in accordance with Article 11 of the Paris Convention and Article 1495, point 2 of the Russian Civil Code. In accordance with Article 11 “the countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them”<sup>17</sup>. Russian law provides that “priority of a trademark affixed to exhibits of official or officially recognized international exhibitions organized in the territory of a member country of the Paris Convention for the Protection of Industrial Property may be fixed as of the date at which the display of the exhibit began at the exhibition (exhibition priority), provided the trademark application is filed with the Federal Executive Authority on Intellectual Property within six months from the above-mentioned date.”<sup>18</sup>

Foreign applicants from member countries of the Paris Convention also enjoy the right to convention priority in accordance with Article 4 of the Convention<sup>19</sup>. The Russian legislation in this respect reads that “priority of a trademark may be fixed as of the date of filing of the first application in a member country of the Paris Convention for the Protection of Industrial Property (convention priority), provided the application is filed with the Federal Executive Authority on Intellectual Property within six months from the above-mentioned date”<sup>20</sup>.

Please see below a picture of the trademark owned by a famous Russian fashion house (Rightholder: *ValentinYudashkin Group International Ltd.* (CY); TM Registration No.304982):



The below trademark is owned by *Wolverine World Wide, Inc.* (US) corporation, the well-known producer of clothing and footwear (IR No. 916710):

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<sup>17</sup>Paris Convention for the Protection of Industrial Property, Article 11:*Inventions, Utility Models, Industrial Designs, Marks: Temporary Protection at Certain International Exhibitions.* Point 1.

<sup>18</sup>Civil Code of the Russian Federation, Part IV, Article 1495: *Conventional and Exhibition Priority of a Trademark.* Point 2.

<sup>19</sup>Paris Convention for the Protection of Industrial Property. Article 4:*Patents, Utility Models, Industrial Designs, Marks, Inventors' Certificates: Right of Priority.* Points A-I.

<sup>20</sup>Civil Code of the Russian Federation. Part IV. Article 1495: *Conventional and Exhibition Priority of a Trademark.* Point 1.

# WOLVERINE

BOOTS + SHOES + APPAREL + GEAR

Below is trademark registration No. 364325 owned by a chain of retail sale shops in Russia trading in clothing and related goods among other things (Right holder: *Trade House KholdingTsentr Ltd.* (RU)). This is an example of a trademark consisting of two consonants which acquired distinctive features due to their original graphics and thus were granted protection in Russia.



## Industrial Designs

Industrial design protection for items of clothing, footwear, headgear, cloth patterns, and similar articles may be of special interest to designers and couturiers of such goods. According to Russian legislation “an artistic-design presentation of an article, manufactured industrially or by artisans, that defines its outward appearance, shall be protected as an industrial design”<sup>21</sup>. The so called ‘patent scheme’ of protection for industrial designs is valid in Russia. A patented industrial design as an artistic-design presentation is protected from being used by third parties irrespective of the fact whether they have created it independently or copied it. This scheme of protection meets the provisions of Articles 25 and 26 of the TRIPS Agreement<sup>22</sup>.

In Russia, as in many other countries, original presentations of articles defining their outward appearance have several methods of protection, namely as copyright objects, as trademarks (mostly as three dimensional trademarks) and finally as industrial designs. Trademark use and the peculiarities of Russian trademark legislation were discussed above. The use of industrial designs for the protection of original patterns of clothing, footwear and headgear from copying is considered quite effective, although the period of validity of a patent for an industrial design lasts for 10 years only and the procedure to obtain and maintain a patent is rather expensive.

An industrial design shall be granted protection if it is new and original. Essential features of an industrial design include features that determine the aesthetic and/or ergonomic characteristics of

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<sup>21</sup>Civil Code of the Russian Federation. Part IV. Article 1352: *The Conditions of Patentability of an Industrial Design*. Point 1.

<sup>22</sup>TRIPS Agreement (Agreement on Trade-Related Aspects of Intellectual Property Rights) of April 15, 1994.

the article's outward appearance, in particular, the shape, configuration, form, ornament and combination of colors.

The examiners define an industrial design as new if the sum of its essential features, manifested in the representations of the article and listed in the list of the essential features of the industrial design, was not known from information generally available in the world before the priority date of the design. Naturally the examiners consider all prior applications of the third parties filed in Russia as well as Russian patents and copyright certificates for similar or identical industrial designs<sup>23</sup>.

In order to secure designation of an industrial design as original, the applicant will have to prove that its essential features are determined by the creative nature of the article's special aspects<sup>24</sup>.

According to Russian law industrial designs are considered non-patentable if they are solutions determined exclusively by the technical function of an article, if they relate to architectural works (with the exception of minor architectural forms) and industrial, hydrotechnical and other stationary structures, and if they represent objects of unstable shape such as liquids, gaseous and dry substances and the like<sup>25</sup>.

An article may be protected as an industrial design both as a whole and in part. It is important that all parts of the article are clearly visible from its representation enclosed to the application materials. As an industrial design there may be patented a set of clothing combined by a unique creative concept, for instance, a suit consisting of a jacket, a vest, trousers and the like. The article can be depicted in either a three dimensional or two dimensional format or both.

A part of an article can be claimed as an industrial design if it can be used together with other articles and possesses independent functions. For instance, a door handle, a fastener or a clasp for clothing or footwear, a car headlight, etc.

One application for an industrial design may contain different variants of the design. It is important that these variants, different in their essential features, were combined by the same aesthetic and/or ergonomic characteristics.

Many articles such as items of clothing, footwear or headgear may be protected both as an industrial design and as a three dimensional trademark. Naturally the form of protection is to be decided upon by the applicant. However, if both methods of protection are used for the same article, both applications must be filed in the name of the same applicant.

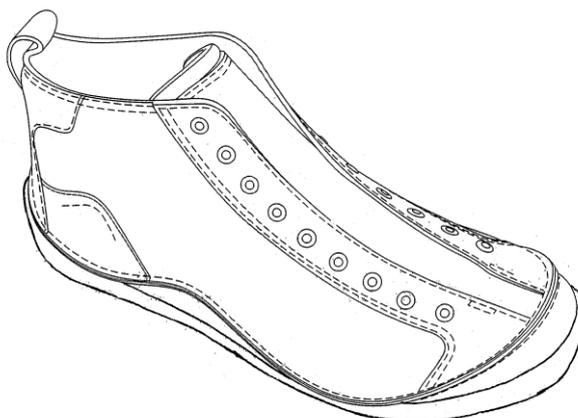
See below the pictures of industrial designs for shoes patented in Russia (Rightholder: *Wolverine World Wide, Inc.* (US), Authors – Julie Saint Louis (CA), MainonBellie (CA), Christian Ardissono (IT); Patents No. 68229, 68231):

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<sup>23</sup>Civil Code of the Russian Federation. Part IV. Article 1352: *The Conditions of Patentability of an Industrial Design*. Point 2.

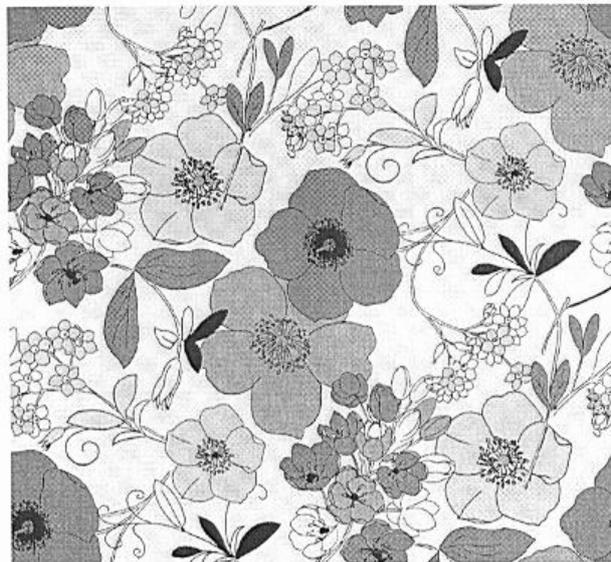
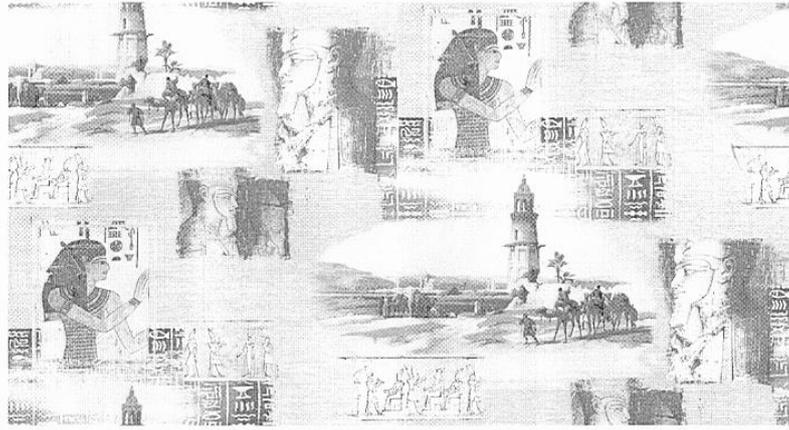
<sup>24</sup>Civil Code of the Russian Federation. Part IV. Article 1352: *The Conditions of Patentability of an Industrial Design*. Point 3.

<sup>25</sup>Civil Code of the Russian Federation. Part IV. Article 1352: *The Conditions of Patentability of an Industrial Design*. Point 5.

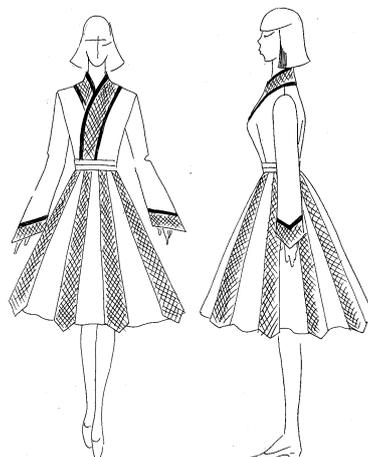


Below are pictures of industrial designs of cloths patented in Russia (Rightholder: *Bonlife Ltd.* (RU); Author – Galina V. Meshkova (RU); Patents No. 68236, 68238, 68239):





See below pictures of industrial design “women’s dress for dancing” patented in Russia (Rightholder: *East Siberian State Technologic University* (RU); Authors: - V.G. Inkizhina, S.V. Pavlova, N.L. Fedorova (RU); Patent No. 67015):



## Copyright

Quite often the articles protected as industrial designs, especially arts and crafts works, may also enjoy protection of the copyright law.

At present the Russian Federation is a party to the main international conventions on copyright protection as well as to a few important regional copyright treaties. Thus within the framework of the Commonwealth of Independent States (the CIS) Russia is a party to the regional agreement of the CIS countries on cooperation in the sphere of copyright and related rights protection dated September 24, 1993. 13 CIS member states have adopted this agreement. The parties have agreed to apply among each other the provisions of the International Copyright Convention in the revision of the year 1952, considering that they have been bound by the clauses of this Convention since May 27, 1973, the date of its accession by the USSR. This implies that all parties have agreed to apply the national regime to the works of the authors from other member states. Moreover, the parties have announced their intention to take the necessary steps to develop and adopt legislative proposals on protection of copyright and related rights in accordance with the requirements of the Berne Convention for the Protection of Literary and Artistic Works (of September 9, 1886, with amendments of September 28, 1979), Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms (of October 29, 1971) and International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (of October 26, 1961).

As of this writing most member states of the CIS regional agreement have amended their local legislation in accordance with these obligations.

The Russian Federation has signed a Partnership and Cooperation Agreement with the European Community and its Members on June 24, 1994 which came into effect on December 1, 1997 and contains an obligation of the Russian Federation to continue further development of mechanisms for the protection of intellectual property rights in order that by the fifth year of the Agreement being in force, the level of IP rights protection in Russia is the same as that in the European Community including the effective measures for the observance of IP rights. Moreover, since the date this Agreement came into effect, Russia is to provide to the legal entities and physical persons of the European Community the regime of recognition and protection of their rights for IP objects no less favorable that offered to any other third country on the basis of bilateral agreements. Russia has met its obligations with respect to the above Agreement.

The authors of applied art works which inter alia include clothing, footwear and headgear designs enjoy the following rights in relation to their works:

- the exclusive right to the work;
- the right of authorship;
- the right to be named;
- the right to inviolability of the work;
- the right of disclosure.

Moreover, in accordance with the Russian Civil Code the author has a right to remuneration for the use of service-related work as well as the right to the revocation of his work, the right to resale royalty and the right of access to fine arts work.<sup>26</sup>

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<sup>26</sup>Civil Code of the Russian Federation. Part IV. Article 1255: *Authors' rights*. Points 2 & 3.

Exclusive authors' right to his work extends to works, either disclosed on the territory of the Russian Federation or undisclosed but existing in any objective form on the territory of the Russian Federation and recognized as belonging to the authors, regardless of their nationality. Copyright extends to works, either disclosed beyond the borders of the Russian Federation or undisclosed but existing in any objective form beyond the borders of the Russian Federation and recognized as belonging to the authors who are citizens of other states or do not have any citizenship in compliance with international treaties to which the Russian Federation is a party<sup>27</sup>.

In order to have his rights recognized, the owner may use a copyright notice which should be placed on every copy of the work and should consist of the following three elements:

- a circled Latin letter C: ©;
- the name (the title) of the owner of the exclusive copyright;
- the year of first appearance of the work.<sup>28</sup>

Foreign legal entities and physical persons as well as Russian citizens permanently residing outside Russia who are interested in protection of their rights on IP objects in this country should note that correspondence with Rospatent is restricted to duly registered Russian patent and trademark attorneys if an international treaty of the Russian Federation does not provide otherwise.

## Literature

1. Civil Code of the Russian Federation. Moscow, 2008.
2. Paris Convention for the Protection of Industrial Property of March 20, 1883.
3. Madrid Agreement Concerning the International Registration of Marks of April 14, 1891.
4. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks of June 27, 1989.
5. *Trademarks in the Russian Federation*. Mescheryakov V.A., Kalinovsky V.E. and others. Moscow, *Arbat-Inform*, 2004.
6. TRIPS Agreement (Agreement on Trade-Related Aspects of Intellectual Property Rights) of April 15, 1994.
7. Criminal Code of the Russian Federation of June 13, 1996 (with revisions and addenda of February 13, 2009).
8. Federal Law of the Russian Federation *On Protection of Competition* of July 26, 2006 (with revisions and addenda of November 8, 2008).
9. Federal Law of the Russian Federation *On State Registration of Legal Entities and Individual Businessmen* of August 8, 2001 (with revisions and addenda of December 30, 2008).
10. *The Intellectual Property Right in the Russian Federation*. Sergeev A.P. 2<sup>nd</sup> Edition, Moscow, 2004.
11. *Paris Convention for the Protection of Industrial Property. Commentary*. G. Bodenkhauzen. *Progress*, Moscow, 1977.
12. *Intellectual Property*. Meggs P.B., Sergeev A.P. *Yurist*, Moscow, 2000.
13. *Commentary to Part II of the Civil Code of the Russian Federation for Businessmen*. Edited by M. I. Braginsky. Moscow, 1996.

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<sup>27</sup>Civil Code of the Russian Federation. Part IV. Article 1256: *Exclusive Right to a Work of Science, Literature and Art on the Territory of Russia*. Point 1.

<sup>28</sup>Civil Code of the Russian Federation. Part IV. Article 1271: *Copyright Notice*.