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OFFICE FOR HARMONIZATION  
IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

# Modernization of the IPR System in the Russian Federation (P4M-IP)

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## Organisational structure, independence, technical issues

	Similarities	Differences
1.1	Both BoA and CoPD are special departments within the organizational structure of the OHIM and FIPS respectively.	CoPD does not have a Presidium and there are no special provisions in Ru legislation concerning the Grand Board.

## Organisational structure, independence, technical issues

	<b>Commentaries and proposals</b>
1.1	<p>Enhance independence and autonomy by establishing a body entrusted with organisation matters. Suggestion: Establish a Presidium-like body.</p> <p>Enhance predictability by excluding incoherence resulting from contradictory decisions. Suggestion: Establishing an Enlarged or Grand Board.</p>
1.2.	<p>Consider creating Registry for the CoPD for the purpose of dealing with all administrative matters in the appeal proceedings.</p> <p>Streamline processes and increase procedural transparency and predictability by the creation of process cards and internal working instructions.</p>



## Organisational structure, independence, technical issues

	Similarities	Differences
1.3	The Head of CoPD as well as the President of BoA has managerial and organizational powers to organise the work of the CoPD Divisions, allocate cases, implement Office administrative acts.	The composition and the organizational structure of CoPD is regulated by internal acts of FIPS (not by CoPD itself)

## Organisational structure, independence, technical issues

	<b>Commentaries and proposals</b>
1.3.	Regarding the composition and organizational structure it may be considered that the basic rules are adopted by external regulations of legislative nature.
	It should be noted that in relation to this Rospatent and CoPD FIPS are limited by the current Russian legislation governing the range of issues that must be resolved by regulations. However at this stage it is possible to discuss the advantages and disadvantages of regulation of such issues by external normative documents.

## Organisational structure, independence, technical issues

	Similarities	Differences
1.4.		A decision of CoPD should be approved by the Director of Rospatent and comes into force from the date of its approval. If a decision of CoPD is not approved, the Director of Rospatent should send an opposition or application for re-examination of the case by another college/panel of CoPD

## Organisational structure, independence, technical issues

	<b>Commentaries and proposals</b>
1.4.	<p>This is an interesting concept which, unlike the position under current OHIM Boards of Appeal legislation, would give, practically speaking, an appeal right the Russian Office.</p> <p>Regarding the fact that it appears that the director has the right to refuse to sign the decision, which delays proceedings, it may be envisaged in order to avoid or limit the this possibility, that, like OHIM`s Boards of Appeal, CoPD has the right to invite the Director to submit observations on specific cases and issues. This would, at least, limit the remittal to another chamber in cases where the director would disapprove the decision.</p>

## Organisational structure, independence, technical issues

	Similarities	Differences
1.5.		Division of legal representation of FIPS is a part of CoPD and some staff members from other departments (including those from Legal representation) can be called upon to take part in deciding on a case whereas the Litigation Service is a part of another department of OHIM and its staff members don't take part in the proceedings before the BoA.

## Organisational structure, independence, technical issues

	Similarities	Differences
1.6.	<p>There is specialization of panels in terms of the types of industrial properties: 3<sup>rd</sup> Board of Appeal deals with design cases and all others with TMs, in CoPD there are Divisions of the means of individualization (staff members of which compose panels dealing with TM disputes) and Division of the patent law objects (experts consider cases on designs, among others).</p> <p>Decisions of CoPD and BoA must be drafted by the staff members of CoPD and BoA respectively</p> <p>For some reasons (e.g. relations with parties to a case, conflict of interests, etc.) members of a panel can be replaced by some other member of boards.</p>	<p>There are no fixed panels in CoPD and chairpersons. For each case to be considered by the CoPD a new panel should be formed (it must consist of not less than 3 persons and composed of CoPD staff members, in addition some other staff members from different Rospatent/FIPS departments from the list of experts approved by Rospatent Order No 32 of 22 February 2008 can be called upon to take part in the proceedings and they can also be chairpersons, or a members of a panel or just perform certain task in the course of the proceedings) and approved by the Head of CoPD.</p>

## Organisational structure, independence, technical issues

	<b>Commentaries and proposals</b>
1.6.	<p>Consider Single-Member Decisions for straight forward cases that effectively endorse the decision of the first instance.</p> <p>And probably consider the rules for formation of “Grand Board” by defining the minimum quorum and maximum number of its members.</p>

## Organisational structure, independence, technical issues

	Similarities	Differences
1.7.	The decisions of BoA and CoPD are not final and can be challenged before the court (full review of the merits)	The time limits for appealing BoA and CoPD decisions are different as well as special procedural rules and depend on the judicial system in RF and EU.

## Organisational structure, independence, technical issues

	Similarities	Differences
1.8.	<p>The decisions of BoA and CoPD have constitutive effect and affect the TM and Design Registers.</p> <p>They are binding for the first instance at the office.</p> <p>Both BoA and CopD do not deal with infringement matters (this should be settled by the courts)</p>	<p>CoPD can only affirm, change or annul decisions of Rospatent departments and doesn't deal with any matter related to compensations and costs. These cases should be brought to the court, so CoPD decisions are not enforceable directly, they can serve as a basis for the actions before the court.</p>



## Organisational structure, independence, technical issues

	<b>Commentaries and proposals</b>
1.8.	For <i>inter partes</i> cases it may be considered that the decisions refusing the granting of legal protection of a trade mark or a design, have enhanced authority in the sense that once they have become definitive the same party may not file later on the same application.

## Use of IT, ways of correspondence and availability of information to the public

	Similarities	Differences
2.1.	<p>In both offices the level of use of electronic means for communication in the proceedings before the appeal instances is low.</p> <p>In both offices there is a tendency to develop and promote the use of electronic means of communication in appeal procedures (e.g. this is expressed clearly in <a href="#">The Order of the Federal service for intellectual property N 92 of 29 June 2015 "About Integrated strategy of Informatization of the Federal service for intellectual property for 2015-2020" (in Russian)</a>), as well as the intention to make as much relevant information on applications and registered IP rights as possible to the public, develop the databases and electronic tools (for example for checking the similarity of goods and services), etc.)</p>	<p>In case of BoA the most frequent means of communication is fax communication and currently it is possible to file electronically only the notice of appeal, while in CoPD it is postal communication and upon the applicant's request in <i>ex parte</i> procedures (objections to decisions of Rospatent departments), it is possible to communicate electronically via the applicant's 'My Account'.</p>



## Use of IT, ways of correspondence and availability of information to the public

	<b>Commentaries and proposals</b>
2.1.	Introduce IT Solutions to enable users to electronically communicate more swiftly and efficiently with the CoPD.

## Use of IT, ways of correspondence and availability of information to the public

	Similarities	Differences
2.2.	Both CoPD and BoA decision can be found on the webpages of the Offices in special case law databases.	In eSearch Case Law database (OHIM) all decisions of all instances (examination, opposition, cancellation, decisions of BoA, national courts and GC/CJEU), while there is no database where the decisions of FIPS/Rospatent examination instances can be found. Only CoPD decisions are available to the public. The decisions of Arbitration courts (commercial disputes courts) including decisions of the Court for Intellectual Rights, can be found here <a href="http://kad.arbitr.ru/">http://kad.arbitr.ru/</a> (database of Arbitration courts)



## Use of IT, ways of correspondence and availability of information to the public

	<b>Commentaries and proposals</b>
2.2.	Extend database to first instance decisions and make it publicly accessible.

## Appeal procedure

	Similarities	Differences
3.1.		<p>As in Russia the procedure of TM and design examination is different from that in the EU (e.g. for TMs there is no opposition proceedings, designs are under patent law) in Ru legislation it is not expressed clearly what proceedings (and appeals) are <i>ex parte</i> or <i>inter partes</i>.</p> <p>But in fact each of the objections listed in the Civil Code and the Rules of CoPD (see Question 1.7 of the Questionnaire) can be subsumed under one of these categories of the proceedings. As it is explained in Question 2.3. of the Questionnaire, objections against Rospatent examination department can be <i>ex parte</i> or <i>inter partes</i> (depending on involvement of third parties, e.g. objections against decisions of formal examination, or decisions of substantive examination based only on absolute grounds are <i>ex parte</i> proceedings; decisions of examination when relative grounds have been raised are <i>inter partes</i> proceedings).</p> <p>But for both types of proceedings a uniform procedure for the consideration of objections and applications/appeals filed with CoPD has been established and provided for by CoPD Rules.</p>



## Appeal procedure

	Similarities	Differences
3.2.		The rules related to the persons entitled to appeal are more detailed in CoPD

## Appeal procedure

	Similarities	Differences
3.3.	<p>In general the parties to the proceedings can act personally or through their authorised representatives (including their employees, patent attorneys).</p> <p>In both offices there are special rules concerning representation of those persons whose domicile or place of business is located outside the EU or Russia respectively: in this case these persons must be presented by patent attorneys (some exceptions may be provided by legislation)</p>	<p>There is no such provision in Ru legislation as “An employee of a legal person to which this paragraph applies may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons have neither their domicile nor their principal place of business nor a real and effective industrial or commercial establishment within the Community” (see Question 2.6 of the Questionnaire)</p>

## Appeal procedure

	Similarities	Differences
3.4.		There is no notice of appeal and statement of grounds in Russia, an appellant should file an appeal with additional documents within the prescribed time.



## Appeal procedure

	<b>Commentaries and proposals</b>
3.4.	We consider the way of filing an appeal before CoPD more time effective, taken into account that you don't distinguish between Notice of Appeal and Statement of Grounds of Appeal.

## Appeal procedure

	Similarities	Differences
3.5.	The documents (appeal/notice of appeal, etc.) should be submitted in written form.	Objections can be filed directly with Rospatent or sent by post. Filing of objections electronically or by fax is not available.

## Appeal procedure

	Similarities	Differences
3.6.		<p>There are different rules for time limits for filing an appeal with BoA and CoPD.</p> <p>In Russia there is no single time limit:</p> <ol style="list-style-type: none"><li>1. for TMs (and appellations of origin) it's four months from the date of sending the decision;</li><li>2. for designs it's seven months from the date of sending the decision</li></ol> <p>These time limits can be extended (restored upon the appellant's request) – see in details in Question 2.9 of the Questionnaire</p>



## Appeal procedure

	<b>Commentaries and proposals</b>
3.6.	Consider shorten and make uniform appeal time limit with the aim of having only one appeal time limit (2 or 4 months) and by do so, speeding up proceedings and at the same guarantee greater legal security.

## Appeal procedure

	Similarities	Differences
3.7.	Payment of an appeal fee is one of the requirements for admission of the appeal for consideration	The fees for different types of objections filing with CoPD are different, there is no single appeal fee



## Appeal procedure

	<b>Commentaries and proposals</b>
3.7.	Consider creating current accounts for key users which are held by CoPD and which allows the CoPD to immediately debit the amount of the appeal fee from that account.

## Appeal procedure

	Similarities	Differences
3.8.	The applicant should provide the copies of the documents and their translation to the language of correspondence and proceedings	The rules for the language of correspondence and proceedings in BoA and CoPD are different due to objective reasons (BoA works in 23 official languages and CoPD works in the only official language of RF – Russian)

## Appeal procedure

	Similarities	Differences
3.9.	<p>In both offices submission of additional documents upon the expiry of the prescribed time limits is possible, there is no strict prohibition.</p> <p>In general both BoA and CoPD in appeal proceedings are limited by the case files (facts, evidence and arguments provided by the parties).</p> <p>Additional materials changing the grounds for the objection are not allowed and can be submitted as a separate objection</p>	

# Appeal procedure

	Similarities	Differences
3.10.		<p>Paragraph 4.4 of CoPD Rules provides that CoPD, having found that there are several objections involving the same parties, or multiple objections of the same entity or different entities that belong to the same protected object - industrial design, trademark, under consideration before CoPD, has the right to schedule the consideration of these objections or applications for the same oral hearing with the consent of all parties. In this case the decision is made for each case separately.</p> <p>Unlike the possibility to schedule the consideration of these objections or applications for the same oral hearing as provided for by CoPD Rules, in BoA OHIM the implementation of the joint procedures for the appeal proceedings (joinder of appeals) is allowed, namely in those cases where the parties to the dispute are the same, and the subjects of the dispute are closely related; these separate appeals may all be consolidated into one and one joint decision should be made.</p>

## Appeal procedure

	<b>Commentaries and proposals</b>
3.10.	Consider to take a joint decision after a joint hearing. Consider the possibility of ancillary appeal. In <i>inter partes</i> proceedings, the defendant may in his response, seek a decision annulling or altering the contested decision on a point not raised in the appeal. Such submissions shall cease to have effect should the appellant discontinue the appeal proceeding.

## Appeal procedure

	Similarities	Differences
3.11.		Submission and consideration of objections before CoPD do not have suspensive effect
3.12.		<p>Unlike the procedure of revision of decisions by OHIM departments in Rospatent it's not possible to return contested decisions to the relevant departments/experts (who took these decisions) for review. The expert can only participate at the oral hearing and express his or her opinion (not obligatory).</p> <p>But of course in case of cancellation of a decision on recognition of an application as withdrawn the application materials are forwarded to the appropriate department/expert for examination</p>
3.13.	In both offices it is not prohibited to change the list of goods and services (but it's allowed to limit it, not to extend) in the course of appeal proceedings	The rules concerning the possibility to amend a sign (or design) applied for registration seem to be a bit stricter in BoA. As in the course of examination of an application in Rospatent it is allowed to make some amendments to the signs applied for registration (provided that such amendments do not change substantially the trade mark, for instance upon applicant's request and with special fee the colour of some elements of the sign can be changed (e.g. the colour of red cross can be changed for a black or some other, some non-dominant not distinctive elements can be removed – but in each case it is on examiners' discretion

## Appeal procedure

	Similarities	Differences
3.14.	In both BoA and CoPD their members are authorised to change the grounds for refusal set out by an expert in a challenged decision	
3.15.	Both CoPD and BoA are not authorised to check the authenticity or falsification of evidence and documents submitted by the parties. Where falsification is alleged upon the request of an interested person some special procedures for checking authenticity of the documents can be launched by competent national authorities. No “punishment” for the parties.	
3.16.	In general in both BoA and CoPD consideration of appeals should be oral proceedings.  The hearings take place at headquarters of the offices (in Moscow and Alicante respectively).  No time limits for the hearings provided by any legal act.  Recording of an oral hearing is on discretion of BoA/CoPD	In practice in CoPD all the appeal cases are examined at oral hearings (it depends on the parties if they participate at the hearing or not, in some cases they don’t appear at the hearing for some reasons or can request for rescheduling the date of the hearing). See the question 2.18 of the Questionnaire  The decision of CoPD panel must be drafted and sent to the parties to the case within two months from the date of announcement of the operative part of the decision of the CoPD panel

# Alternative dispute resolution

	Similarities	Differences
4.1.	<p>In RF ADR can be used for dispute resolution alongside with jurisdictional ways of settling disputes (judicial and administrative).</p> <p>In RF there are special Federal laws creating legal framework for applying different types of ADR: <a href="#">Federal law №193-FZ of 27 July 2010 on the Alternative Dispute Resolution with the Participation of an Intermediary (Mediation Procedure) (in English)</a>; the Federal Law No 102-FZ dated 24 July 2002 “On arbitral tribunals in the Russian Federation” (exists only in Russian) which regulates domestic arbitration, i.e. internal commercial disputes without any foreign elements (includes Article 6.1. Application of mediation procedure to a dispute, that is under consideration before an arbitral tribunal); <a href="#">Law of the Russian Federation N 5338-1 of 7 July 1993 on International Commercial Arbitration (in English)</a> which regulates international commercial arbitration, i.e. disputes with a foreign element such as when parties are located in different countries or when foreign substantive law is to be applied</p>	<p>There is neither Mediation service in FIPS/Rospatent nor special regulations on Mediation procedure in CoPD and it is beyond the competence and functions of Rospatent and FIPS to carry out alternative dispute resolution procedures, including mediation, and also to assist the parties in undertaking procedures of this kind.</p>



## Alternative dispute resolution

	<b>Commentaries and proposals</b>
4.1.	<p>Consider offering Effective Dispute Resolution (EDR) by means of alternative resolution methods, conciliation and mediation through active case management.</p> <p>If CoPD is legally unable to offer mediation, it may be considered to envisage the establishment, at the appeal level, of a short cooling off period, in order to give parties the opportunity of amicable settlement through ADR or direct negotiations.</p>

## Alternative dispute resolution

	Similarities	Differences
4.2.	<p>In the course of the appeal procedure (<i>inter partes</i>) prior to the announcement of the board's decision it is possible for the parties to settle their dispute amicably</p>	<p>No request for mediation (or other ADR) can be filed by the parties with CoPD (as well as no proposal for ADR can be made to the parties by a member of CoPD). If the parties wish to change appeal procedure for mediation (or other ADR) an appellant has only the right to withdraw his or her appeal at any stage of its consideration of the merits during the CoPD panel session prior to the announcement of the operative part of the decision of the CoPD panel. In this case, the appeal proceedings should be terminated (but in case of appeals against Rospatent decisions the appeal can be withdrawn and filed again more than once within the period for appeal).</p>



## Alternative dispute resolution

	<b>Commentaries and proposals</b>
4.2.	Consider offering suspension of appeal proceedings when ADR is requested because parties are negotiating externally with or without the assistance of a mediator.

# Thank You



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