

Industrial designs and utility models in Russia given longer term of protection

Part IV of the Russian Civil Code¹, which came into force on 1 January 2008, replaced all Russian laws covering IP², including the Patent Law³. The most substantial development in patent protection introduced by Part IV is a longer term of protection for utility models and industrial designs: a maximum of 13 years (instead of 8 years) for utility models and 25 years (instead of 15 years) for industrial designs. How this change applies to existing rights has recently been clarified.

Under Part IV the validity term of a patent is 10 years for a utility model and 15 years for an industrial design. This can be extended upon application by the right holder by 3 years for a utility model and 10 years for an industrial design. Previously, the Patent Law provided for a 5 year validity term for a utility model with a possible 3 year extension, and a 10 year validity term for an industrial design with a possible 5 year extension.

One of the issues remaining was: which utility models and industrial designs (apart from those applied for after 1 January 2008) can enjoy such a long term of protection? The wording of the Enactment Law of Part IV⁴ contains only a general rule according to which "rights to any results of intellectual activity which enjoy protection as of the date of the enactment of Part IV of the Code continue being protected in accordance with the rules of Part IV of the Code". Rospatent (the Russian Patent and Trade Mark Office) answered the question in an Information letter given on 26 May 2008.

According to the Information letter, all utility models and industrial designs which were, or might have been, in force on 1 January 2008, enjoy the new validity and extension terms. The new regulation applies to utility models and industrial designs which, at 1 January 2008, were:

- in the original validity term;
- in the extension to the validity term; or
- terminated early and after 1 January 2005 because of the right holder's failure to pay renewal fees when due.

The new regulation does not apply to utility models and industrial designs where the term expired before 1 January 2008.

Although the application of the new regulation is now defined, there are still some practical aspects to be clarified by Rospatent. For example:

- As the state fees due to Rospatent for renewals have not yet been updated, it is not yet certain what fees are due and when. Given this uncertainty, it is advisable for right holders, in order to strengthen their position, to at least inform Rospatent of their intention to seek an extension under the new regulation.
- The Rospatent public database is being updated slowly and currently refers to numerous utility model and industrial design patents as expired, without taking the new regulation into account. This raises two issues. Firstly, one cannot rely on the register to show whether it is now safe to carry out a patented activity. Secondly, the fact that the register indicates that rights have expired may well encourage infringing activity

and rights holders should exercise extra vigilance.

It is fair to say that the new regulation has the potential to make utility model and industrial design patent applications more attractive to domestic and international businesses. Certainly, popularity would be an additional factor to encourage Rospatent to deal in the most efficient manner with outstanding administrative issues.



Natalia Gulyaeva
Moscow

natalia.gulyaeva@lovells.com



Tatania Mrdulyash
Moscow

tatania.mrdulyash@lovells.com

¹ Civil Code of the Russian Federation (Part IV) of 18 December 2006 No 230-FL.

² We reported on trade marks in our January 2008 IP Newsletter, and on copyright in our April 2008 IP Newsletter and in this Newsletter (page 16).

³ Patent Law of the Russian Federation of 23 September 1992 No 3517-1.

⁴ Enactment Law of Part IV of the Civil Code of the Russian Federation of 18 December 2006 No 231-FL.