

Russia: new rules for IP agreements

Following the introduction in January 2008 of the new IP laws in Part IV of the Russian Civil Code,¹ Rospatent (the Russian Patent and Trade Mark Office) and other government authorities have been drafting regulations² to clarify some provisions. One of these relates to IP agreements, and applies to agreements entered into on or after 1 January 2009. We look at some key points.

REGISTRATION OF IP AGREEMENTS

In accordance with Part IV, the IP right holder must register certain types of IP agreements with Rospatent, and also register their termination and any change to an essential condition. This applies to:

- assignments of exclusive rights to utility models, inventions and designs, trade marks, registered topography of integral circuits, registered software, and databases;
- licences of exclusive rights to utility models, inventions and designs, trade marks, and registered topography of integral circuits; and
- pledges of exclusive rights to utility models, inventions and designs, and topography of integral circuits.

In the case of an assignment or pledge, the right holder must either enter into a formal assignment or pledge agreement or simply complete a standard form (expected to be published soon).

PATENT LICENCES

The new regulations expressly state that, in order to be registrable, a patent licence must contain the following:

- details of the parties (that is, their full names and addresses);
- details of the patent;
- an indication of the type of licence (exclusive or non-exclusive) and its scope;

- the territory of the licence – if this is not specified then the Russian Federation will be presumed;
- the term of the licence – if this is not specified then five years will be presumed; and
- details of the fee and/or royalties (for example, the amount of a fixed fee or the method of payment/royalty determination).

Termination of a patent licence *ex parte* (that is, without the agreement of both parties) is now only possible if that option is expressly set out in the agreement. This, combined with the provision in Part IV that the invalidity of the patent does not terminate the licensee's obligation to pay royalties for the period when the patent was valid, clearly gives the licensor better protection.

COMMENT

There has been a swift reaction to this clarification of certain issues relating to IP agreements, and since the beginning of this year, IP right holders have been showing a greater interest in licensing their rights.

It is thought likely that further new regulations relating to Part IV of the Russian Civil Code will also strengthen the interests of IP right holders. ■



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¹ Civil Code of the Russian Federation (Part IV) of 18 December 2006 No 230-FL. We covered some of the changes relating to trade marks, copyright, and designs/utility models in our IP Newsletters of January, March and July 2008 respectively.

² Regulations on state registration of assignment agreements on invention, industrial design, registered topography of integral circuits, software, database and of non-agreement based assignments of exclusive rights to invention, industrial design, trade mark, service mark, appellation of origin, registered topography of integral circuits, software, database. 24 December 2008 No 1020.