

**ORDER OF THE RUSSIAN PATENT AND TRADEMARK AGENCY NO. 56 OF APRIL 22, 2003 ON THE RULES OF FILING OBJECTIONS AND APPLICATIONS AND THE CONSIDERATION THEREOF BY THE PATENT DISPUTES CHAMBER (with the Amendments and Additions of December 11, 2003)**

For the purpose of bringing the contents of regulatory legal acts of the Russian Patent and Trademark Agency into line with Federal Law No. 166-FZ of December 11, 2002 on Amending Law of the Russian Federation No. 3520-1 of September 23, 1992 on Trademarks, Service Marks and the Names of Places of Origin of Goods, Federal Law No. 22-FZ of February 7, 2003 on Amending the Patent Law of the Russian Federation No. 3517-1 of September 23, 1992, I hereby order:

1. The endorsement of the Rules of Filing Objections and Applications and the Consideration Thereof by the Patent Disputes Chamber attached hereto.

2. The invalidity of the following:

- the Rules of Filing Objections and the Consideration Thereof by the Chamber of Appeals of the Russian Patent and Trademark Agency, endorsed by the Russian Patent and Trademark Agency on April 19, 1995 registered by the Ministry of Justice of the Russian Federation No. 844 of April 27, 1995.

- the Rules of Filing Complaints, Applications and Petitions and the Consideration Thereof by the Supreme Patent Chamber of the Russian Patent and Trademark Agency endorsed by Order of the Russian Patent and Trademark Agency No. 107 of May 21, 1998 registered by the Ministry of Justice of the Russian Federation No. 1568 of July 23, 1998 as amended by Order of the Russian Patent and Trademark Agency No. 232 of December 4, 1998 registered by the Ministry of Justice of the Russian Federation No. 1696 of February 3, 1999.

Director General  
of the Russian Patent  
and Trademark Agency

A.D. Korchagin

Registered by the Ministry of Justice of the Russian Federation May 8, 2003-05-28  
Registration No. 4520

**Annex  
to Order  
of the Russian Patent and Trademark Agency  
No. 56 of April 22, 2003**

**Rules of Filing Objections and Applications and the Consideration Thereof by the Patent Disputes Chamber (with the Amendments and Additions of December 11, 2003)**

The present Rules of Filing Objections and Applications and the Consideration Thereof by the Patent Disputes Chamber (hereinafter referred to as "the Rules") have been issued in accordance with Article 2 of the Patent Law of the Russian Federation No. 3517-1 of September 23, 1992 (Vedomosti S'ezda Narodnykh Deputatov Rossiyskoy Federatsii i Verkhovnogo Soveta Rossiyskoy Federatsii, item 2319, No. 42, 1992) as amended by Federal Law No. 22-FZ of February 7, 2003 on Amending the Patent Law of the Russian Federation (Sobranie Zakonodatelstva Rossiyskoy Federatsii, item 505, No. 6 of February 10, 2003) and Article 43 of the Law of the Russian Federation No. 3520-1 of September 23, 1992 on Trademarks, Service Marks and the Names of Places of Origin of Goods (Vedomosti S'ezda Narodnykh Deputatov Rossiyskoy Federatsii i Verkhovnogo Soveta Rossiyskoy Federatsii, item 2322, No. 42, 1992) as amended by Federal Law No. 166-FZ of December 11, 2002 on Amending the Law of the Russian Federation on Trademarks, Service Marks and the Names of Places of Origin of Goods (Sobranie Zakonodatelstva Rossiyskoy Federatsii, item 4927, No. 50 of December 16, 2002). The present Rules deal with the filing of objections to applications and patents for secret inventions, the consideration and the issue of which was effected by the federal executive body concerned with intellectual property.

**I. The Objections and Applications Filed with the Patent Disputes Chamber**

In compliance with the Patent Law of the Russian Federation, the Law of the Russian Federation on Trademarks, Service Marks and the Names of Places of Origin of Goods and the international treaties of the Russian Federation the following objections and applications may be filed with the Patent Disputes Chamber.

1.1. The objection to a decision to refuse the awarding of a patent or to issue a patent for an invention, useful model, industrial design.

1.2. The objection to a decision to deem the application for an invention, useful model and industrial design revoked.

1.3. The objection to the awarding of a patent for an invention, useful model and industrial design.

1.4. The objection to the effect in the territory of the Russian Federation of an authorship certificate or a patent of the USSR issued earlier for an invention, a certificate or a patent of the USSR for an industrial design, an Eurasian patent for an invention issued in compliance with the Eurasian Patent Convention of September 9, 1994.

1.5. The objection to the decision adopted according to the results of the formal expert examination of an application for registration of a trademark and a service mark (hereinafter referred to as "trademark"), the registration and granting of the right to use the name of place of origin of goods or the provision of the right to use the name of place of origin of goods that have been already registered, whereby its acceptance for consideration is refused.

1.6. The objection to the decision of the expert examination of a declared designation on an application for the registration of a trademark, the registration and granting of the right to use the name of place of origin of goods or the granting of the right to use the name of place of origin of goods that has been already registered, and also the decision to grant or refuse granting the protection exercised under the Madrid Agreement on the International Registration of Marks of April 14, 1891 as revised in Brussels on December 14, 1900, Washington on June 2, 1911, the Hague on November 6, 1925, London on June 2, 1934, Nice on July 15, 1957 and Stockholm on July 14, 1967 and amended on September 28, 1979 or the Protocol to the Madrid Agreement on the International Registration of Marks adopted in Madrid on June 27, 1989.

1.7. The objection to the decision to deem a revoked application for the registration of a trademark, the registration and granting of the right to use the name of place of origin of goods or the granting of the right to use the name of place of origin of goods that has been already registered.

1.8. The objection to the provision of legal protection to a trademark, the name of place of origin of goods, the issuance of a certificate for the right to use the name of place of origin of a good, to the effect in the territory of the Russian Federation of the registration effected in the USSR of a trademark, service mark, and also to the granting of protection to the international registration of a mark on the territory of the Russian Federation.

1.9. The objection to the granting of legal protection to a trademark in the name of an agent or representative of the person who is the holder of the exclusive right to this trademark in one of the member states of the Paris Convention on the Protection of Industrial Property of March 20, 1883.

1.10. The application for declaring a trademark as generally known in the Russian Federation.

1.11. The application for termination before due date of the legal protection of a trademark in the event of transformation of a registered trademark into a designation that has become generally used as a designation of a specific kind of goods.

1.12. The application for termination before due time of the legal protection of a trademark, and also for termination before due time of the legal protection of international registration of a trademark on the territory of the Russian Federation in connection with the trademark's non-use continuously during any three-year term after the registration thereof or the provision of legal protection for the international registration of a trademark in the territory of the Russian Federation.

1.13. The application for termination of the legal protection of the name of place of origin of a good and of the effect of the certificate for the right to use the name of place of origin of a good or the termination of the effect of the certificate for the right to use the name of place of origin of the goods.

1.14. The objection to the granting of legal protection for a trademark which is generally known in the Russian Federation.

## **II. The Terms for Filing Objections and Applications and the Standards Governing Them**

2.1. The objection envisaged by Items 1.1 - 1.2, 1.5 - 1.7 of the present Rules shall be filed by the person that has filed the application for the awarding of a patent for an invention, useful model, industrial design, the registration and granting of the right to use the name of place of origin of goods or the granting of the right to use the name of place of origin of goods that have been already registered (hereinafter referred to as "the registration and/or the granting of the right to use the name of place of origin of a good").

The objection envisaged by Items 1.3, 1.4 and 1.8 of the present Rules shall be filed by any person.

The objection envisaged by Item 1.9 of the present Rules shall be filed by the interested holder of the exclusive right to a trademark in one of the member states of the Paris Convention for the Protection of Industrial Property.

The application envisaged by Item 1.10 of the present Rules shall be filed by a person that considers his trademark a generally known one.

The application envisaged by Items 1.11 - 1.13 of the present Rules, and also the objection envisaged by Item 1.14 of the present Rules shall be filed by any person.

The said persons, except for those permanently residing outside the Russian Federation and foreign legal entities, may commit actions relating to the filing of the objections envisaged in Items 1.1 - 1.4 of the present Rules either in person or through representatives they authorise, in particular, patent attorneys registered with the federal executive governmental body in charge of intellectual property (hereinafter referred to as "patent attorneys").

The actions relating to the filing of the objections and applications envisaged by Items 1.5 - 1.14 of the present Rules may be committed by the said persons, with the exception of the natural persons permanently residing outside the Russian Federation and foreign legal entities, either in person or through patent attorneys they authorise.

The natural persons permanently residing outside the Russian Federation and foreign legal entities shall commit the actions relating to the filing of objections and applications, will among other things take part in the meetings of the Patent Disputes Chamber's college through patent attorneys.

The powers of a representative and in appropriate cases of a patent attorney shall be acknowledged by a power of attorney that comprises an indication of the scope of such powers. Any action of a representative, in particular, a patent attorney within the scope of the powers conferred thereon or any action of the Patent Disputes Chamber in respect of a representative, in particular, a patent attorney shall have the same consequences as the actions of the principal or the actions in respect of the principal.

**2.2.** Objections and applications shall be drawn up in an arbitrary form by means of typing.

Objections and applications as well as the materials attached thereto shall be presented in Russian or another language.

If an objection, application and the materials attached thereto are presented in another language, they shall be accompanied by a translation thereof into Russian as signed by the person who filed the objection or application or by his patent attorney.

An objection or application presented in another language shall be deemed filed as of the date of its receipt by the Patent Disputes Chamber if its translation is received within two months of the date when a notice stating the need for complying with this requirement was forwarded by the Patent Disputes Chamber to the person who filed the objection or application.

The objection or application shall be signed by the person(s) who filed it or by the person's representative. On behalf of a legal entities the objection shall be signed by the head of the organisation or another person authorised to do so in the established manner as including an indication of his/her position, the signature being sealed by the seal of the legal entities.

The signature shall be available together with the name and initials of the person who made the signature.

The objection shall comprise an indication of the number of application for the awarding of a patent for an invention, useful model, industrial design, an application for registration of a trademark or an application for registration and/or granting of the right to use the name of place of origin of the goods, and/or the number of the patent, certificate or international mark registration concerned.

The application envisaged by Item 1.10 of the present Rules shall comprise the number of the trademark certificate or the registration of the application for registration thereof. If the application is relating to a designation without legal protection in the Russian Federation it shall come together with a specimen of the designation made in compliance with the Rules for Drawing Up, Filing and Considering an Application for the Registration of a Trademark and Service Mark endorsed by Order of the Russian Patent and Trademark Agency No. 32 of March 5, 2003 registered by the Ministry of Justice of the Russian Federation, registration No. 4322 of March 25, 2003.

The application envisaged by Items 1.11 - 1.13 of the present Rules shall comprise an indication of the number of the relevant trademark certificate or the number of mark international registration, the number of registration and certificate of the right to use the name of place of origin of the goods.

The following shall also be indicated in the objection or application:

the family name, forename, patronymic (if any) of the natural person who filed the objection or application;

the residential address of the natural person or the location of the legal entities, including the official name of the country and also phone, telex, and fax numbers (if any);

the address for correspondence purposes, the full name of the addressee in compliance with the ordinary fast postal delivery requirements, phone, telex, fax numbers (if any). The following may be indicated as the address for correspondence purposes:

- the residential address or the location address in the Russian Federation;

- the address of the person who filed the objection or application and who permanently resides in the Russian Federation;

- the residential address or the location address of a representative, in particular, a patent attorney registered with the federal executive governmental body in charge of intellectual property or another address on the territory of the Russian Federation.

The objection against a secret invention shall indicate the address for secret correspondence in addition to the address for open correspondence.

**2.3.** The objection envisaged by Items 1.1 - 1.8 of the present Rules shall be filed with the Patent Disputes Chamber within the term set by the Patent Law of the Russian Federation and the Law of the Russian Federation on Trademarks, Service Marks and the Names of Places of Origin of Goods.

If the objection is not filed within the term envisaged by Items 1.1 - 1.2, the term may be restored on the petition of the person who filed the objection.

The petition for restoration of a missed term for filing the objections envisaged by Items 1.1 - 1.2 of the present Rules may be filed within 12 months after the expiry of the term missed.

The petition for restoration of a missed term for the filing of the objections envisaged by Items 1.5 - 1.8 of the present Rules may be filed within two months after the expiry of the missed term.

Such petitions shall be filed simultaneously with the objection.

The petition shall contain confirmation of the excuse for missing the term for filing the objection.

**2.4.** A document acknowledging that duty was paid at the set rate shall be attached to the objection, application or petition for restoration of the missed term for filing the objection.

If the duty was paid at a rate lower than the established one and/or if a document confirming the payment thereof is not filed or is drawn up in breach of the established standards, the objection, application or petition for restoration of the missed term for the filing of the objection shall not be accepted for consideration.

By request of the person who filed the objection, application or petition for restoration of the missed term for the filing of the objection the amounts of duty paid in excess or the amounts of duty paid for the filing of an objection or application not accepted for consideration shall be refunded or accepted to offset in the established manner other duties.

**2.5.** The objection shall contain reasons explaining the unlawfulness of the decision objected against, the refusal to review a decision made, the declaration of an application revoked, the unlawfulness of the awarding of a patent, certificate or the provision of legal protection.

If additional materials are filed together with the objection envisaged by Items 1.3, 1.4, 1.5, 1.8, 1.9 and 1.14 of the present Rules, a verification shall be performed to see if they change the reasons provided to support the availability of grounds for declaring a patent, certificate and/or the provision of legal protection fully or partially invalid.

Additional materials shall be deemed to have changed the said reasons if they contain an indication of a breach of the conditions of legal protection of an invention, useful model, industrial design, trademark, the name of place of origin of a good different from those specified in the objection, or an indication of the sources of information not mentioned in the objection, except for public dictionaries and reference books.

Such materials may be compiled in the form of an independent objection filed in compliance with the terms for filing the objections set out in the present Rules.

The application envisaged by Item 1.10 of the present Rules and/or the materials attached thereto shall contain the actual data confirming the trademark's being generally known by the public.

The application envisaged by Item 1.11 of the present Rules and/or the materials attached thereto shall contain the actual data on the fact that the registered trademark has become a generic term in the public's mind.

The application envisaged by Item 1.12 of the present Rules may be substantiated only by the applicant's statement on the non-use of the trademark continuously during any three-year term after its registration and the granting of legal protection for the international registration of the mark on the territory of the Russian Federation and the non-use thereof before the filing of such an application.

The application envisaged by Item 1.13 of the present Rules and/or the materials attached thereto shall contain actual data on:

the disappearance of conditions characteristic for a geographic object and/or on the impossibility of manufacturing of goods possessing the special properties specified in the State Register of the Names of Places of Origin of Goods in the Russian Federation;

the loss by foreign legal entities or natural persons of a right to a given name of place of origin of a good in the country of origin of this goods;

the loss by the goods of the special properties specified in the State Register of the Names of Places of Origin of Goods in the Russian Federation in respect of a given name of the place of origin of the goods.

It is prohibited to provide additional materials to the applications specified in Items 1.10, 1.11 and 1.13 of the present Rules if they contain actual data different from that available in the applications. Such materials may be drawn up as an independent application filed in compliance with the terms for the filing of applications set out in the present Rules.

**2.6.** The objection or application shall be related to one patent application or one application for the registration of a trademark, the registration and/or the granting of the right to use the name of place of origin of goods or to one protected object, i.e. invention, useful model, industrial design, trademark, the name of place of origin of the goods. The materials of an objection or application shall be filed in duplicate apart from the application envisaged by Item 1.10 of the present Rules that is filed as single copy.

**2.7.** In place of the filing of an objection or application repeating the content of an objection or application of the same person filed earlier and not accepted for consideration a petition may be filed for the consideration as such an objection or application of the materials of the objection or application filed earlier. In this case the payment of duty or the offset of a duty paid earlier shall be effected in the established procedure.

**2.8.** No acceptance for consideration shall be effected of an objection or application relating to a revoked patent application, a revoked trademark registration application or a revoked application for the registration and/or granting of the right to use the name of place of origin of the goods or those relating to the awarding of a patent for an invention, useful model, industrial design, the granting of legal protection to a trademark, the name of place of origin of a good of which the effect has been terminated, except for the objections specified in Items 1.2 and 1.7 of the present Rules.

**2.9.** The objection, which is provided for by Items 1.1-1.3 of the present Rules and which concerns a secret invention, shall be filed in accordance with the legislation on state secrets and with the present Rules, subject to the special features of the legal protection and the use of secret inventions, established in Section VI.1 of the Patent Law of the Russian Federation.

The objection and the appended documents, if they contain information comprising a state secret shall be filed with the Chamber for Patent Disputes with the use of special communication and with the observance of the legislation requirements for a state secret.

In case of necessity the federal executive body dealing with intellectual property may request from the person whose address is indicated for keeping secret correspondence a copy of the license for the performance of works with information comprising a state secret.

### **III. The Registration and Acceptance of an Objection or Application**

**3.1.** An objection or application received shall be registered and an incoming reference number shall be assigned thereto.

If an objection or application received by the Patent Disputes Chamber complies with the conditions for the filing hereof set out in Section II of the present Rules, a notice of the acceptance of the objection or application for consideration shall be forwarded to the person that has filed the objection or application within one month after the date of receipt thereof by the Patent Disputes Chamber, the notice indicating the date of the meeting of the Patent Disputes Chamber's college dedicated to the consideration of the objection or application.

A copy of the objection envisaged by Items 1.3, 1.4, 1.8 and 1.14 or a copy of the application envisaged by Items 1.11 and 1.13 of the present Rules together with the notice of its having been accepted for consideration shall be forwarded to the owner of the exclusive right to the invention, useful model, industrial design, trademark or to the holder of the certificate for the right to use the name of place of origin of the goods (hereinafter referred to as "the right-possessor") with the proposal to file a response statement with the Patent Disputes Chamber and the person who filed the objection or application before the date of the meeting of the Patent Disputes Chamber's college. The copy of the objection provided for by Item 1.3 of the present Rules and dealing with a secret invention, and also containing information constituting a state secret shall be sent with the use of special communication.

Where necessary, the Patent Disputes Chamber shall be entitled to invite the person who made the decision on the results of the expert examination.

**3.2.** If an objection or application received by the Patent Disputes Chamber does not comply with the terms for the filing thereof set out in Section II of the present Rules a notice of refusal to accept the objection or application for consideration shall be forwarded to the person that has filed the objection or application within one month of the date of receipt thereof by the Patent Disputes Chamber.

Where necessary, the Patent Disputes Chamber may forward an enquiry within one month after the receipt of an objection or application to the person that has filed it asking this person to provide the information required for consideration of the objection or application within three months after the receipt of the notice.

In the event of timely provision of the information so requested the objection or application shall be deemed received on the date of actual receipt, and in this case a notice of acceptance or refusal to accept the objection or application for consideration shall be forwarded to the person that has filed the objection or application within one month of the date of receipt of the said information by the Patent Disputes Chamber.

If within the said three-month term the information so requested fails to be provided, the objection or application shall not be considered, and the Patent Disputes Chamber shall notify accordingly the person that has filed it, upon the expiry of five months after the date when the enquiry was forwarded.

Notifications and inquiries provided for by this Item and dealing with secret inventions and containing information constituting a state secret shall be sent with the use of special communication.

**3.3.** On the request of the person(s) that has (have) filed an objection or application, the amount of duty paid may be refunded to the account specified in the refund petition before the date of forwarding of the notice of acceptance of the objection or application for consideration.

**3.4.** The person(s) that has (have) filed an objection or application is entitled to withdraw the objection or application so filed at any stage of its consideration on the merits of the case at a meeting of the Patent Disputes Chamber's college. In this case the proceedings on the objection or application shall be terminated.

**3.5.** When the Patent Disputes Chamber considers the objection envisaged by Items 1.5 and 1.6 of the present Rules, the applicant may file a separation application asking for separation in compliance with Item 6 of Article 10 of the Law of the Russian Federation on Trademarks, Service Marks and the Names of Places of Origin of Goods and Item 14.3 of the Rules for Drawing Up, Filing and Considering an Application for the Registration of a Trademark and a Service Mark endorsed by Order of the Russian Patent and Trademark Agency No. 32 of March 5, 2003 registered by the Ministry of Justice of the Russian Federation, registration No. 4322 of March 25, 2003.

The separation application may be filed before the time when the Patent Disputes Chamber adopts its decision on the original application.

**3.6.** When the Patent Disputes Chamber considers the objection envisaged by Item 1.8 of the present Rules the right-possessor may file an application for separation of specific registration of the trademark for certain goods or for part of goods in compliance with Paragraph 2 of Item 1 of Article 17 of the Law of the Russian Federation on Trademarks, Service Marks and the Names of Places of Origin of Goods and Chapter III of the Rules of Extending the Effective Term of Registration of a Trademark and a Service Mark and of Amending It endorsed by Order of the Russian Patent and Trademark Agency No. 32 of March 5, 2003 registered by the Ministry of Justice of the Russian Federation, registration No. 4301 of March 21, 2003.

**3.7.** The further consideration of the objection shall be pursued separately with account taken of the results of consideration of the petition and the application specified in Items 3.5 - 3.6 of the present Rules under the separated and the original application and/or registration.

If necessary, the Patent Disputes Chamber's college may postpone its meeting.

#### **IV. The Consideration of an Objection or Application by the Meeting of the Patent Disputes Chamber's College**

**4.1.** Cases concerning objections or applications shall be examined on a collective basis at a meeting of the Patent Disputes Chamber by at least three members thereof, in particular, including the chairperson and the person responsible for consideration of the case approved by the chairman of the Patent Disputes Chamber (hereinafter referred to as "the Patent Disputes Chamber's college").

The chairman of the Patent Disputes Chamber may serve on the college of the Patent Disputes Chamber and be the chairperson thereof.

The consideration of an objection or application shall be performed with the composition of the Patent Disputes Chamber's college unchanged. If one of the members of the college is replaced during the hearing, the consideration of the case shall be started again.

**4.2.** Persons being relatives or spouses, relatives or spouses of the participants in the case hearing, and also the persons who took the decision being disputed shall be prohibited to serve on the college of the Patent Disputes Chamber.

**4.3.** The following persons may take part in the consideration of a case at a meeting of the Patent Disputes Chamber's college: the person that has filed an objection or application, and/or a representative thereof, the holder of an authorship certificate and a certificate of the USSR, the holder of a patent, the owner of the exclusive right to a trademark, the holder of a certificate for the right to use the name of place of origin of a good and/or a representative thereof, and where necessary, the person that has taken the decision on the results of an expert examination.

Persons attending the board's sitting that examines the objections relating to a secret invention shall possess and present for review to the chairman their identity cards and documents confirming the prescription for the fulfilment of assignments of standard form and access to information containing a state secret.

The absence of any of the persons entitled to take part in the consideration of a case, provided he/she has been notified of the date and place of the college' meeting shall not prevent consideration of the case.

Having recognised that the case cannot be considered at a given meeting due to the absence of any of the persons entitled to take part in the consideration of the case, the college shall be entitled to postpone the meeting of the college to another date.

The date of a meeting of the college may be postponed on the initiative of the Patent Disputes Chamber or on a written request of the person notified of the acceptance of an objection or application for consideration under Item 3.1 of the present Rules in connection with the need for ensuring conditions conducive to a full and objective hearing of the case.

The persons specified in Paragraph 1 of the present item may demur in a substantiated way any member of the college or the whole college. The demurrer shall be declared prior to the commencement of consideration of the case on the merit thereof.

The demurrer shall be considered by the members of the college and if it is satisfied the objection or application shall be heard by the college of a different composition. The persons taking part in consideration of the objection or application shall be notified of the new date and time of the college's meeting in the manner established by Item 3.1 of the present Rules.

**4.4.** The Patent Disputes Chamber, having established that it has several objections or applications to consider and the same parties take part in these cases, or it has several objections or applications of one person or different persons relating to one protected object, i.e. invention, useful model, industrial design, trademark, the name of place of origin of a good, it shall be entitled to consolidate the consideration of these objections or application in one meeting if all the parties consent thereto. The decision of the Patent Disputes Chamber shall be taken for each case separately.

**4.5.** The meetings of the Patent Disputes Chamber's college shall be held in a meeting room.

The chairperson shall open the meeting of the college and present the members of the college and the person taking part in the consideration of the objection or application.

The meeting of the Patent Disputes Chamber's college shall be chaired by a chairperson.

**4.6.** The consideration of an objection or application on the merits thereof shall be commenced by a report of the chairperson or a member of the Patent Disputes Chamber's college.

Normally, further consideration shall follow the below sequence:

- a speech by the person that has filed the objection or application and/or a representative thereof, in particular, a patent attorney;
- a speech by the right-possessor and/or a representative thereof, in particular, a patent attorney;
- a speech by the person who took the decision on the results of an expert examination;
- replies by the persons taking part in the hearing to the questions of members of the Patent Disputes Chamber's college;
- addenda to earlier speeches by the persons taking part in the hearing.

The consideration of the applications envisaged by Items 1.10 and 1.11 may be started by a speech of the right-possessor.

**4.7.** One of the members of the Patent Disputes Chamber's college shall keep minutes of the meeting. The minutes shall comprise the following:

- the application number for a patent for an invention, useful model, industrial design, application for the registration of a trademark or application for the registration and/or granting of the right to use the name of place of origin of goods in relation to the objection or application being considered and/or the number of relevant patent, certificate or international mark registration (if the application envisaged by Item 1.10 of the present Rules is being considered, a description of the designation or the number of trademark registration application or the number of trademark certificate shall be provided);
- the date of the meeting;
- the composition of the college for patent disputes;
- a list of the persons taking part in the consideration of the objection or application;
- the main reasons provided by the persons taking part in the consideration of the objection or application that are not available in the original materials of the objection or application filed;
- the resolution part of the decision.

The minutes shall be signed by all members of the Patent Disputes Chamber's college.

On the request of a person taking part in consideration of the objection or application, he/she shall be provided with a copy of the minutes within three working days of the date of the request.

The persons taking part in consideration of the objection or application and the members of the Patent Disputes Chamber's college shall be entitled to file their concurrent opinion in writing at the meeting of the college or within three working days after the date of the meeting of the Patent Disputes Chamber's college.

Recording equipment may be used at the meeting of the Patent Disputes Chamber's college on the consent of members of the college and all the persons taking part in the consideration of the objection or application. When the objection relating to a secret invention is examined, it shall be prohibited to use the recording equipment.

The decision of the Patent Disputes Chamber's college shall be adopted according to the results of a closed meeting of members of the Patent Disputes Chamber's college after the completion of

consideration of the objection or application on the merits thereof. The decision shall be taken by a simple majority of votes of the members of the Patent Disputes Chamber's college. If the votes split the vote of the chairperson who chairs the meeting of the Patent Disputes Chamber's college shall be decisive.

The resolution part of the decision of the Patent Disputes Chamber's college shall be announced by the chairperson.

**4.8.** When considering the objections envisaged by Items 1.1, 1.3, 1.6 - 1.8 of the present Rules, the Patent Disputes Chamber's college shall limit itself by the information search materials indicated in the expert examination statement.

If any person taking part in the consideration of such an objection or a member of the Patent Disputes Chamber's college present information out of dictionaries/reference books and/or a reference to additional circumstances that have not been taken into account in the expert examination decision, such information and additional circumstances may be taken into consideration when the decision is adopted. In this case the person that has filed the application for a patent for an invention, useful model, industrial design, an application for the registration of a trademark or an application for the registration and/or granting of the right to use the name of place of origin of goods, the holder of the patent, the holder of the exclusive right to the trademark, the holder of the certificate for the right to use the name of place of origin of the goods or a representative thereof shall be familiarised with the information and/or circumstances and they shall be provided with an opportunity for presenting their opinions.

If a more thorough investigation is needed for the newly presented sources of information or additional circumstances the meeting of the Patent Disputes Chamber's college may be postponed.

**4.9.** While considering the objections envisaged by Item 1.1 of the present Rules, the Patent Disputes Chamber's college shall be entitled to suggest that the person that has filed an application for the awarding of a patent for an invention, useful model or industrial design amend the formula of the invention, useful model, the list of significant features of the industrial design if such amendments eliminate the reasons that have served as sole ground for drawing the conclusion that the object under consideration fails to comply with the patentability terms and also a ground for drawing the conclusion that the declared object be classified as part of the list of the decisions (objects) not deemed patentable inventions, useful models, industrial designs.

When considering the objections envisaged by Items 1.3 and 1.4 of the present Rules, the Patent Disputes Chamber's college shall be entitled to suggest that the holder of a patent, the holder of an authorship certificate and a certificate of the USSR amend the formula of the invention, useful model, the list of significant features of the industrial design if without the making of the amendments the disputed patent, authorship certificate and certificate of the USSR must be deemed fully invalid, and with the making of the amendments they may be deemed partially invalid.

The said amendments must comply with the changes made in the formula of the invention, useful model, the list of significant features of the industrial design envisaged by the rules of drawing up, filing and considering an application for the awarding of a patent for an invention, the rules of drawing up, filing and considering an application for the awarding of a patent for a useful model and the rules of drawing up, filing and considering an application for the awarding a patent for an industrial design effective as of the date of filing of the application.

**4.10.** While considering the objections envisaged by Items 1.6 and 1.8 of the present Rules the Patent Disputes Chamber's college shall be entitled to suggest that the person that has filed an application for the registration of a trademark, the registration of the name of place of origin of goods and/or the right to use the name of place of origin of goods that have been already registered update the materials of the application if the update eliminate the reasons that served as a sole ground for the decision to refuse registering a trademark and if the update makes it possible to register the trademark, or if without the update the granting of legal protection to the trademark must be deemed fully invalid, and with the update it may be deemed partially invalid.

The said update shall comply with the changes admissible during the consideration of an application for the registration of a trademark, service mark, the name of place of origin of goods and the provision of the right to use the name of place of origin of a good and also an application for the granting of the right to use the name of place of origin of goods that have been already registered and are envisaged by the rules of drawing up, filing and considering an application for the registration of a trademark and a service mark and the rules of drawing up, filing and considering an application for the registration and granting of the right to use the name of place of origin of a good and an application for the granting of the right to use the name of place of origin of a good that has been already registered, effective as of the date of filing of the application.

## **V. The Decisions Adopted by the Patent Disputes Chamber**

**5.1.** According to the results of consideration of an objection the Patent Disputes Chamber may adopt the decision to satisfy it, to refuse satisfying it, to terminate proceedings.



In such a case the decision of the Patent Disputes Chamber may envisage the revocation, amendment or upholding of the decision being disputed.

The decision to amend the decision being disputed shall be taken by the Patent Disputes Chamber in case when the reasons for the decision are deemed erroneous and other grounds are established which prevent the satisfaction of the objection in full.

When the objection envisaged by Items 1.1, 1.5 - 1.6 of the present Rules are considered in the event of revocation of the decision being disputed the decision of the Patent Disputes Chamber must contain grounds for the revocation of the decision being disputed and a conclusion on the awarding or refusal to award a patent for an invention, useful model, industrial design or a conclusion on the acceptance for consideration of an application for the registration of a trademark, the registration and granting of the right to use the name of place of origin of goods or the granting of the right to use the name of place of origin of goods that have been already registered or the refusal to accept it for consideration or a conclusion on the registration or refusal to register a trademark, the registration and granting of the right to use the name of place of origin of goods or the granting of the right to use the name of place of origin of goods that have been already registered or a conclusion on the granting or refusal to grant protection effected in compliance with the Madrid Agreement on the International Registration of Marks or the Protocol to the Madrid Agreement on the International Registration of Marks.

In the event of revocation of the decision being disputed when the subject matter of consideration is the objection envisaged by Item 1.1 of the present Rules that has been accepted without an information search or according to the results of an incomplete search and also in cases when the patent holder amended on the suggestion of the Patent Disputes Chamber the formula of an invention, useful model, the list of significant features of the industrial design the decision of the Patent Disputes Chamber shall be taken with due regard to the results of an additional information search completed in full.

In the event of revocation of the decision whereby an application was declared withdrawn by a decision of the Patent Disputes Chamber the materials of the application shall be forwarded for expert examination.

According to the results of consideration of the objection envisaged by Items 1.3 and 1.4 of the present Rules, in cases when the patent holder, the holder of an authorship certificate or certificate of the USSR has amended on the suggestion of the Patent Disputes Chamber the formula of an invention, useful model, the list of significant features of the industrial design the decision of the Patent Disputes Chamber shall be taken with due regard to the results of an additional information search completed in full.

When the objections envisaged by Items 1.3, 1.4 and 1.7 of the present Rules are considered, the decision of the Patent Disputes Chamber shall contain grounds for revocation of the decision.

The decision to terminate proceedings on an objection shall be adopted by the Patent Disputes Chamber if during the preparation for consideration of the objection or during the consideration thereof no circumstances have been discovered that fail to comply with the terms and requirements established by Section II of the present Rule and that preclude the possibility of accepting the objection for consideration and the making of a decision on the objection.

**5.2.** According to the results of consideration of applications, the Patent Disputes Chamber may adopt the decision to satisfy the application, to refuse satisfying the application, to terminate proceedings.

In the event of non-filing by the holder of the exclusive right to a trademark of a reply to the application specified in Item 1.12 of the present Rules the Patent Disputes Chamber shall be entitled to take the decision to terminate before due time the legal protection of the trademark or to terminate before due time the legal protection of the international registration of the mark in the territory of the Russian Federation.

The decision to terminate proceedings on an application shall be taken by the Patent Disputes Chamber if circumstances precluding the possibility of accepting the application for consideration are discovered during the preparation for considering the application or during the consideration of the application.

## **VI. The Entry into Force of a Decision of the Patent Disputes Chamber**

**6.1.** The decision of the Patent Disputes Chamber shall be drawn up and designed by all members of the college of the Patent Disputes Chamber and one copy thereof shall be deposited in the application case. The decision of the Patent Disputes Chamber shall be forwarded to the person that has filed an objection or application, and if the objection or application relates to the granting of legal protection it shall also be forwarded to the patent holder, the holder of the authorship certificate and certificate of the USSR, the holder of the exclusive right to a trademark, the holder of a certificate for the right to use the name of place of origin of goods, within two months after the date of the meeting of the Patent Disputes Chamber's college which adopted it. The decision of the Chamber for Patent Disputes dealing with secret inventions and containing information constituting a state secret shall be forwarded with the use of special communication.

In the event of the partial invalidation of a patent for a secret invention a new patent shall be issued for a secret invention with the formula cited in the respective decision of the Chamber for patent disputes.

**6.2.** If a member of the Patent Disputes Chamber has a concurrent opinion it shall be recorded in the copy of the decision deposited in the materials of the objection or application after the signatures of the members of the Patent Disputes Chamber's college or as an annex to the decision.

**6.3.** The decision of the Patent Disputes Chamber shall be approved by the head of the federal executive governmental body in charge of intellectual property and it shall enter into force as of the date of the approval.

If a decision of the Patent Disputes Chamber is not approved the head of the federal executive governmental body in charge of intellectual property shall forward an objection or application for consideration by the Patent Disputes Chamber's college in a different composition.