

Amendments to the pre-trial procedure for IP disputes

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On June 1, 2016, the mandatory pre-trial procedure came into force. On May 26, 2017 the State Duma approved in the second reading amendments to the current pre-trial procedure.

Under the amendments, the pre-trial procedure extends only to the monetary disputes. The amendments (art. 1252 of the Russian Civil Code) also directly prescribe that the pre-trial procedure doesn't apply to nonpecuniary claims for infringement of IP rights (for example, suppression of acts that infringe or endanger the IP rights; seizure and destruction of counterfeit goods; official publication of the court decision rendered against an infringer).

The general term of pre-trial procedure is 30 days, unless other term and (or) procedure is stipulated by law or agreement.

The amendments provide a special pre-trial procedure for disputes on early termination of a trademark. The interested party (claimant) has to send to the right holder a proposal to annul the trademark or to conclude a trademark assignment or license agreement with respect to all goods or part of the goods.

The proposed bill provides a two-month period for consideration of the proposal. The claimant is entitled to file a lawsuit for the early termination of a trademark within 30 days from the expiry of the two-month period for consideration of the proposal.

Moreover, the three-year period of non-use is calculated not from the date of filing the application to a court, but from the date of mailing a proposal to a right holder.

The amendments introduce a special pre-trial procedure for filing an application for preliminary injunction, if the pre-trial procedure for the dispute is mandatory. The court, which grants the preliminary injunction, sets in a time limit for filing the pre-trial claim, not exceeding 15 days. Currently, this deadline is prescribed for filing a lawsuit, and therefore the claimant could not apply the preliminary injunction and comply with the pre-trial procedure simultaneously. Under the new provisions, the lawsuit must be filed within 5 days from the expiry of the pre-trial procedure.

Thus, if the bill is adopted and enters into force in the version, outlined above, the pre-trial procedure will not apply for nonpecuniary claims, with the exception of the disputes on the early termination of a trademark, and the legislation will take into account the influence of pre-trial procedure on the application of preliminary injunction.

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