

**IP/Digital**

BRYAN  
CAVE  
LEIGHTON  
PAISNER **BLP**

formerly Goltsblat BLP  
in Russia

## IP/Digital

Our international team of IP/Digital practice has extensive experience of assisting clients on a broad range of IP issues including the protection, enforcement and ownership of all types of IP rights, avoidance of infringement of third party IP, advising on IP ownership and licensing strategies, drafting and negotiating IP licences and assignments.

We handle all forms of IP litigation and have a particularly strong reputation in copyright, design right and trade mark disputes. We resolve most of our cases through negotiation and other alternative dispute resolution processes, but have considerable experience in handling proceedings in the Russian and UK Courts as well as taking cases to the European Court of Justice. We also deal with privacy and defamation cases.

We provide advice on IP rights that businesses have and can undertake comprehensive audits of IP portfolios. Our trade mark and design registration team offers a one-stop shop for national and international brand management and protection. This allows us to take the time to understand our clients' business and brands and to give them on-going strategic advice. We have the capability and industry knowledge to ensure that our clients' valuable portfolio is managed to its full potential.

Our international team of IP/Digital practice consists globally of more than 30 lawyers based in Moscow, London as well as in 32 office all over the world.

We provide one of the strongest IP practices in Russia. Our multifunctional Moscow IP team includes IP attorneys, IP litigators, trade mark and patent attorneys. The ratings of independent agencies state that our attorneys are among the most efficient in resolving disputes in state arbitration courts, courts of general jurisdiction, antimonopoly bodies, the Chamber of Patent Disputes of Rospatent and prosecutor's offices.

## Our Services

# #1

**TOP Ranked (1st tier) IP/Digital Practice**  
according to the **Legal 500 2018**

The IP/Digital practice for several years has been top-ranked / highly recommended by major international legal directories, such as **Chambers & Partners, Best Lawyers,** and others.

### IP/IT Dispute Resolution

- IP/IT dispute resolution, including proceedings at all Russian national courts
- IP litigation in the UK courts, at the UK and the European trade marks offices, and the major domain name dispute resolution panels
- Arbitration, mediation and other forms of alternative dispute resolution
- Trade mark, service mark and patent-related disputes at the Chamber of Patent Disputes of the Russian Patent Office (Rospatent)
- Domain name disputes
- Negotiations and settlements involving IP rights
- Copyright and internet-related litigation, arbitration and mediation
- IP licensing and franchising disputes
- Disputes regarding confidential information and trade secrets
- Disputes relating to advertising law violations
- Anti-Piracy Initiatives

### IP/IT Consulting

- Advising on and implementing intra-group IP structuring to safeguard IP ownership and maximise revenues, for tax purposes or in preparation for disposal
- Looking at IP protection from the point of view of investors, and from that of companies looking to attract investment
- Due diligence of IP assets
- IP-related tax issues
- Transfers within M&A
- Advising on IT regulatory issues
- Franchising
- Drafting and negotiating IP licences and assignment (including corporate support)
- Import, export and distribution of goods
- Services/agency agreements, including for IT-related rights use
- Advising software distributors, resellers and software developers on IP and commercial law, protection of copyright and know-how
- Drafting software development agreements and software license agreements
- Legal support for Internet business and advice on Russian Internet law
- Advising foreign IT companies on compliance with the Russian legislation including personal data protection
- Assisting our clients on implementation of internal IT policies and intra-group IT charges
- Advertising (including in the Internet) and labeling
- Other IP/IT issue outsourcing

### IP/IT Registration

- Registering, prosecuting and maintaining trade marks, patents and registered design and managing international portfolios of these rights
- Applying for registration, modification and termination of franchising agreements, licensing and assignment agreements
- Conducting preliminary and comprehensive trademark and patent searches
- Registering trademarks with the customs authorities exercising control over imports
- Preparing and filing documents for software and domain name registrations

Chambers Europe 2018  
about IP Practices:

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*Best known for its strong standing in IP litigation. Also acts on non-contentious matters, including transactional IP, due diligence and advertising issues. Traditionally instructed by global FMCG, media and entertainment clients. The IT sector has been an active area of late, including software rights and domain name litigation.*

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## Below, we list selected recent projects handled by associates of IP/Digital practice

### IP Dispute Resolution and anti-piracy initiatives

#### A LEADING LARGE FOREIGN COSMETICS PRODUCTION

In a lawsuit contesting a resolution passed by the Chamber for Patent Disputes on Rospatent regarding early termination of legal protection for a trademark, our lawyers successfully defended the interests of a leading large foreign cosmetics production company in the RF Supreme Arbitration Court.

#### VIMPELCOM

Bryan Cave Leighton Paisner (Russia) LLP lawyers acted for VimpelCom - one of the leading Russian companies in the mobile services market in a court action concerning infringement of copyright and related rights as a result of use of a famous Russian song in a TV commercial.

#### WILLIAM GRANT & SONS LIMITED

We are representing William Grant & Sons Limited - a major importer of alcoholic beverages into Russia in a series of actions against importation and distribution of counterfeit products in Russia.

#### ST BARTHOLOMEW'S AND THE ROYAL LONDON CHARITABLE FOUNDATION

We advised St Bartholomew's and The Royal London Charitable Foundation on its strategy for ensuring it obtains value from future commercialisation of the medical research that it funds. We are specifically acting on the negotiation of a revenue-sharing arrangement regarding exploitation of patents for a promising new anti-cancer treatment funded by the Foundation.

#### WILDWOOD TRADING COMPANY

In the UK we are acting for retailer Wildwood Trading Company in a successful High Court trial against two companies and an individual who were importing and selling copies of Wildwood's original sleigh bed design. The judgment included an indemnity costs order against two of the Defendants.

#### A SOFTWARE HOUSE IN THE UK AND RUSSIA

Advising a software house in the UK and Russia on misuse of confidential information and copyright infringement issues as a result of a large team of ex-employees setting up a competing business and collaborating with our client's largest customer.

#### POLISH MANUFACTURER OF MILK AND YOGURT PRODUCTS

In Russia our advocates successfully solved the Court dispute initiated by one of the competitors against our client - the Polish manufacturer of milk and yogurt products - on the trade mark and patent rights infringement by using the same design of packaging for cheese exported into Russia by the client.

#### PHILIPS

Our lawyers successfully interceded and acted on behalf of Philips, in a case initiated by the Russian Federal Antimonopoly Service regarding the circulation of improper advertisements.

#### WELL-KNOWN GERMAN COMPANIES (AUTOMOTIVE INDUSTRY)

We successfully represented a number of well-known German companies (automotive industry) in series of litigations against patent-holder in disputes over patent invalidity.

**A MAJOR GERMAN PHARMACEUTICAL COMPANY**

Our lawyers represented the interests of a major German pharmaceutical company in a series of patent disputes relating to the client's inventions initiated under statements of claim filed by companies producing generic medications.

**FRITOLAY**

In Russia we have presented FritoLay in a dispute involving patent infringement that might have resulted in a criminal case being initiated against our client. Our lawyers successfully defended the interests of our client during the pre-trial investigation and prevented the client from being criminally prosecuted.

**GENERAL PARTNERSHIP SMARTMONEY**

Our attorneys have successfully protected the rights of General Partnership SmartMoney in court disputes over unlawful use of the clients' trademarks in domain names by Russian cyber-squatters.

**SEVERAL LEADING INTERNATIONAL COMPANIES IN THE FASHION AND COSMETICS BUSINESS**

In Russia we have successfully protected the rights of several leading international companies in the fashion and cosmetics business, as well as one of the leading international companies in the motor industry in court disputes over unlawful use of the clients' trademarks in domain names by Russian cyber-squatters.

**SICK AG IN RUSSIA**

Acting on behalf of Sick AG in Russia we have successfully resolved several potential disputes over unlawful use of the client's trademarks in domain name by third parties on the prejudicial stage.

**SEVERAL CONSUMER GOODS COMPANIES**

We have significantly reduced the number of counterfeit products distributed in Russia in violation of the IP rights of several consumer goods companies.

**ONE OF THE LARGEST HEALTHCARE COMPANIES**

Bryan Cave Leighton Paisner (Russia) LLP lawyers recently represented one of the largest healthcare companies and successfully settled out of court dispute in respect of copyright violation in a TV commercial.

**XX CENTURY FOX**

Advised XX Century Fox on customs clearance and determination of the customs value of goods, including intellectual property, and representing the Company's interests in court cases appealing against customs authority actions.

**ONE OF THE LEADING INTERNATIONAL FOOD PRODUCERS**

With a CIS network of trademark attorneys to rely on, our company is fighting counterfeiting and sale of counterfeits of products manufactured by one of the leading international food producers holding the rights to more than 500 trademarks.

## IP Consulting

### METRO AG

In Russia Bryan Cave Leighton Paisner (Russia) LLP lawyers advised Metro AG on its model of trademark licensing and franchising in Russia, assisted with drafting and registration of all trademark license and franchise agreements with the Russian Intellectual Property Office.

### ROYAL CANIN

We assisted Royal Canin with franchising and trademark licensing and implementation of global franchising arrangement in Russia.

### WHERE INTERNATIONAL

We advised Where International on licensing structure for the proper use of Where trademarks in printing and publishing Where Magazines in Moscow and St. Petersburg; drafted the licensing agreements and arranged for their registrations with Rospatent.

### A LARGE INTERNATIONAL MEDIA COMPANY

Bryan Cave Leighton Paisner (Russia) LLP lawyers conducted IP due diligence of Russian subsidiaries of a large international media company that holds exclusive rights in many famous Russian TV series and films.

### KIMBERLY CLARK

Bryan Cave Leighton Paisner (Russia) LLP assisted Kimberly Clark with trademark licensing and registration of trademark license agreement with the Russian Intellectual Property Office.

### LUMINAR

In the UK we acted for Luminar on its re-organisation. We dealt with Luminar's extensive IP holdings and IP assets and their owners had to be identified, moved between group companies and licensed, both internally and with a view to possible future sales. The transaction involved taking account of past partial re-structuring and the particular legal difficulties of transfers of unregistered trade mark rights/goodwill.

### A MULTINATIONAL MEDIA HOLDING COMPANY

Acting for a multinational media holding company interested in merging with a Russian media group, we conducted a due diligence review of Russia's biggest mass media companies. Our research included the key aspects of the history of these companies. This enabled our client to determine the viability of the proposed transaction and its terms.

### YUM!, SAMSONITE, METRO AND OTHER FMCG COMPANIES

We prepared know-how license and franchise agreements for Yum!, Samsonite, Metro and other FMCG companies involving transfer of know-how as well documents necessary for protection of know-how, including company guidelines and policies, lists of information protected as know-how, confidentiality and non-disclosure clauses and statements, etc.

### THE ROYAL BANK OF SCOTLAND

Advising The Royal Bank of Scotland on IP aspects of the acquisition, leasing and ultimate sale of a major UK hotels portfolio, including issues relating to interior design rights, branding and licensing.

### ASCENT FLIGHT TRAINING

We continue to act for Ascent Flight Training (a consortium of Lockheed Martin and VT Group) on its £6 billion contract to provide the Ministry of Defence with military flight training for the armed forces for the next 25 years. We are advising on ownership and licensing structures and negotiating key licensing provisions for IP in software and data.

### LINPAC

Advised the international packaging and logistics company Linpac on a case involving patent rights and design rights in a device created for the rapid movement of goods within factory and distribution premises.

### PRIMARY CAPITAL AND NAPIER TURBOCHARGERS

Acting for Primary Capital and Napier Turbochargers on Napier's acquisition of a part of Siemens' turbocharger business, including a significant patent portfolio.

### TESCO

Advising Tesco on an extensive range of IP issues including 'patent pool' licence terms relating to MP3 player standards technology and a variety of licensing, infringement and protection issues relating to designs, brands and copyright.

### PLAYTECH

Advising global gaming giant Playtech on its joint venture with William Hill. Playtech will provide online gaming services for all of William Hill's online gaming brands worldwide, and also contributed further existing brands to William Hill's offering.

### HORNBY

Acting for Hornby (makers of Hornby model trains and Scalextric slot racing cars) on a major transaction, the acquisition of the Corgi model car business, including the ongoing recording of the ownership change in the worldwide trade mark portfolio in over thirty countries. The world-famous Corgi brands were of central importance to the deal.

### MARS, MOTOROLA AND PTC SOFTWARE

Bryan Cave Leighton Paisner (Russia) LLP lawyers drafted a large number of copyright license and assignment agreements including agreements for Mars, Motorola and PTC Software.

### NORWEGIAN HI-TECH COMPANY

We advised a Norwegian hi-tech company on inventions created by employees and compliance with Russian law.

### A CONTRACT RESEARCH ORGANISATION

Drafted a supplementary agreement to an agreement on clinical testing for a contract research organisation in the field of the pharmaceutical and biotech industries.

## Information Technologies

### ACCENTURE

Assisted Accenture on a number of major technology outsourcing transactions.

### SAP

Advised SAP on software development and IPR in Russia.

### BLACKBAY

Advised Blackbay on delivery of mobility software solutions to the Royal Mail.

### MOTOROLA

Prepared a set of technology development agreements for Motorola and advised Motorola on technology development and IP in Russia.

### FINANCIAL TIMES

Advised Financial Times over an eight-year period in relation to technology contracts, intellectual property and regulatory issues for the newspaper and FT online information businesses.

### ORANGE

Assisted Orange on the implementation of its cutting edge IPTV service including user relationships, content and infrastructure.

### SMARTLINE INC.

Advised SmartLine Inc, developer and distributor of security software on software licensing, prepared a set of software license and sublicense agreements.

### TELEATLAS BV

Advised TeleAtlas BV and its Russian subsidiary on technology licensing in Russia and compliance with Russian regulatory requirements.

### TESCO DIGITAL

Assisted Tesco Digital on all technology and content aspects of its Tesco Digital service, which it has launched as a rival to iTunes.

### **TOMTOM**

Advised TomTom - Dutch producer of navigation equipment on compliance with Russian IP and personal data laws.

### **VT COMMUNICATIONS**

Advised VT Communications (the company formed from the privatisation of the BBC World Service transmitter sites) on its arrangement with Radio Netherlands Worldwide for the purchase of broadcast transmission equipment and provision of playout services from Madagascar's primary radio broadcast site.

### **A LARGE INTERNATIONAL IT COMPANY**

Advised a large international IT company on compliance with Russian regulatory requirements prior to launch of new products and services for the Russian market, intellectual property and disclosure of information.

### **HIGHWAYS AGENCY**

Advised Highways Agency on the outsourcing of its IT infrastructure and network functions to Atos Origin (a deal which won the "Computing Award for Excellence 2008 for Outsource Project of the Year").

### **PTC**

Assisted PTC (Parametric Technology) on software licensing, tax and commercial law issues, prepared agreements with its Russian software resellers.

### **MCPS/PRS**

Advised MCPS/PRS, the UK's major music royalty collecting society, on various technology and licensing projects.

### **MARS**

Assisted Mars on software licensing, provision of technical services and intra-group IT charges, drafted services and software license agreements.

### **FANSHAKE.COM**

Advised Fanshake.com (a music social networking site founded by an ex-Yahoo! executive) on its technology infrastructure, content licensing deals and customer terms.

### **SHAZAM ENTERTAINMENT**

Advised Shazam entertainment on copyright in Russia.

**MARS**

Advised Mars on its advertising contracts and relations with content providers.

**A LEADING UK BANK**

Advised a leading UK bank on CRM deployment and compliance with Russian personal data regulations.

**ORANGE**

Advised on the development, bundling and cross-licensing of software applications on Orange branded phones (including on arrangements for collaboration between Nokia and France Telecom and device manufacturers).

**LONELY PLANET**

Acted for international publisher, Lonely Planet in relation to European distribution and licensing arrangements for mobile content and associated global privacy issues.



**IP Registration**

**FINANCIAL TIMES**

We manage the Financial Times' entire global trade mark portfolio and have recently advised on its new marketing campaign "We Live in Financial Times" including international trade mark filings to protect the Financial Times' rights. The work that we carried out for the Financial Times supports one of the UK's leading brands which has a strong worldwide footprint.

**JP MORGAN, TGI FRIDAY'S, TIE RACK, FINANCIAL TIMES, FTSE, BAFTA, OCADO, ACE LIMITED, ETC.**

We manage trade mark portfolios for a large number of prominent companies, including: JP Morgan, TGI Friday's, Tie Rack, Financial Times, FTSE, BAFTA, Ocado, ACE Limited (the world's largest insurance company), Pirelli, Dentsply International (the world's largest manufacturer of professional dental health products), Campbell Gray Hotels, Searcy, MWB Malmaison (owner of Hotel Du Vin and Malmaison hotel chains) and City Inn.

*“Sources appreciate the all-encompassing support.” They do everything they can, they look at everything from every angle. They don't just say what you can and can't do, they show you everything you could do to win a case,” a client says.*



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## IP/Digital Contacts

### Moscow



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*The team benefits from the unique combination of its famous Russian brand and the reputation of an international law firm. Advises global FMCG, media, IT and entertainment companies on a wide array of IP-related litigious issues, including copyrights and trade marks.*

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**Chambers Global 2017**

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*Clients recommend the Intellectual Property team for its efficiency and high level of service.*

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**Chambers Europe 2017**

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*Elena Trusova is particularly well versed in IP disputes. She represents clients in litigation involving copyright and trade marks, unfair competition and internet-related matters. Clients appreciate her thorough approach: “She goes through every detail very closely, she’s very involved,” a client says, adding: “She can explain everything succinctly.”*

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**Chambers Europe 2018**

# FACTS & FIGURES ABOUT BRYAN CAVE LEIGHTON PAISNER (FORMERLY GOLTSBLAT BLP IN RUSSIA)

- Bryan Cave Leighton Paisner (Russia) LLP (until 2018 in Russia – Goltsblat BLP) is a new milestone in developing the firm. Now, as part of a global law firm, one of the biggest in the world, Bryan Cave Leighton Paisner (Russia) LLP provides comprehensive legal support for any large-scale deals, project and disputes in any jurisdiction, whenever and wherever clients may need it
- A well-established, stable team, one of the biggest on the Russian market, built up over more than 20 years and recognised as a leader in Russia
- 100+ Russian and English law-qualified lawyers in the Moscow office
- Resources and expertise to provide full-service legal support for all business matters, transactional work, projects and litigations in Russia and internationally
- Leading positions and profound Russian law expertise with the absolute majority of the practices in Russia recognised as market leaders / top-ranked by leading national and international rankings (The Legal 500, Chambers&Partners, Best Lawyers, Mergermarket, Pravo.ru-300, etc.)
- New products and services, including expertise relating to the US legislation, sanctions related advice, cyber and data security, private wealth, technology, etc.
- Strong global practices, integrated international teams in the M&A, real estate, international financial services, litigation and corporate risk practices, all boasting a wealth of hands-on experience of international projects, diverse industry expertise and in-depth knowledge of local specifics in various jurisdictions



*Well-recognised team that benefits from its very strong local brand as well as the international capacity.*

Chambers Global 2018



## • EXPERTISE:

- Corporate / M&A
- Dispute Resolution
- Real Estate & Construction
- Antitrust & Competition
- Banking & Finance
- Tax
- Customs & International Trade
- Employment, Pensions & Benefits
- IP / IT
- Commercial
- Compliance
- White Collar Crime Defence
- PPP / Infrastructure
- Insolvency & Bankruptcy
- Sanction-related Advice

# 1400

lawyers globally

# 32

offices in 11 countries

**US** – Atlanta, Boulder, Charlotte, Chicago, Colorado Springs, Dallas, Denver, Irvine, Jefferson City, Kansas City, Los Angeles, Miami, New York, Phoenix, San Francisco, St Louis, Washington D.C.

**Europe** – Berlin, Brussels, Frankfurt, Hamburg, London, Manchester, Moscow, Paris

**Middle East** – Abu Dhabi, Dubai, Tel Aviv

**Asia** – Beijing, Hong Kong, Shanghai, Singapore

# USD 1 bn

combined revenues of the firm is approximately USD 1 bn

# 40%

of the Fortune 500 rely on Bryan Cave Leighton Paisner to support their business goals and protect their interests



Bryan Cave Leighton Paisner (Russia) LLP is a many times winner of Law Firm of the Year, continuously recognised by Chambers Europe Awards, The Legal Business Awards (The Legal 500), The Lawyer European Awards, etc.

# x2

Twice named the 'World's Most Innovative Law Firm' (International Legal Technology Association) and ranked Number 1 most innovative law firm by Legal Business (2017)

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