

Intellectual Property

BRYAN
CAVE
LEIGHTON
PAISNER **BLP**



Intellectual Property

Our international team of IP 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 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 Practice
according to the **Legal 500 2017**

The Intellectual Property 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 Global 2017
about IP Practices:

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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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Below, we list selected recent projects handled by associates of IP 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.

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In the past year the attorneys have been engaged in a number of high-profile, precedent-setting cases, attracting significant public attention

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World Trademark Review 2016

Intellectual Property Contacts

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*The team is noted for its litigation capabilities,
particularly within the internet and social network spaces.*

Chambers Europe 2016

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*Highly regarded for its strong
performance in IP disputes.*

Chambers Europe 2015

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*Department head Elena Trusova is well known
for trade mark protection and litigation work and has practical
experience of handling high-profile cases.*

Chambers Global 2017

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- Bryan Cave Leighton Paisner is purposely structured in a way few other law firms are – as a fully integrated international team that provides clients with clear, connected legal advice, wherever and whenever they need it
- One global integrated team of 1600 lawyers in 32 offices globally, including in Russia, the UK, USA, Europe, Asia and the Middle East
- Expertise across 147 different specialisms
- Some of the world's most active M&A, real estate, financial services, litigation and corporate risk practices
- The practice expertise and deep knowledge across a range of client industries/sectors
- Proven and widely recognised ability to develop innovative client services
- Cutting edge new systems and technologies
- The combined revenues of the new firm Bryan Cave Leighton Paisner will be over USD 900 m

Expertise

CORPORATE

- Corporate Finance and Transactions
- Employee Benefits
- International Trade
- Investment Management
- Private Client
- Public Policy and Government Affairs
- Securities
- Tax Advice and Controversy
- Technology, Entrepreneurial and Commercial

LITIGATION AND CORPORATE RISK

- Antitrust and Competition
- Class Actions
- Commercial Disputes
- Intellectual Property
- International Arbitration and Construction Disputes
- Investigations, Financial Regulation and White Collar
- Labour and Employment
- Product Liability
- Real Estate Disputes

FINANCE

- Asset Finance
- Banking
- Energy, Environmental and Infrastructure
- Energy Finance
- Structured Debt
- Real Estate Finance
- Restructuring and Insolvency

REAL ESTATE

- Commercial Construction
- Commercial Real Estate
- Planning and Zoning

People

- BLP and Bryan Cave (BCLP) lawyers are ranked 268 times in Chambers Global, Europe and UK
- 39 Tier 1 ranked lawyers in Chambers Global and UK
- 10 senior statesmen/eminent practitioners in Chambers Global and UK

Clients

- 40% (or 191 companies) of the Fortune 500 rely on Bryan Cave Leighton Paisner for supporting their business goals and protecting their interests
- 30 of the world's top 50 banks
- 12 of the world's biggest sovereign wealth funds

Awards and rankings

- 8 times winner of a Law Firm of the Year award on different markets since 2004
- Twice named the 'World's Most Innovative Law Firm' (International Legal Technology Association)
- Ranked Number 1 most innovative law firm by Legal Business (2017)

Offices

- **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; Paris
- **CEE** – Moscow
- **Middle East** – Abu Dhabi; Dubai; Tel Aviv
- **Asia** – Beijing; Hong Kong; Shanghai; Singapore

BRYAN CAVE LEIGHTON PAISNER IN RUSSIA

- The Russian practice of Bryan Cave Leighton Paisner (before the merger – GBLP) was established in 2009 as a result of a merger between one of the biggest teams of Russian lawyers and the major UK law firm Berwin Leighton Paisner (BLP)
- The highly respected Moscow team of over 100 lawyers, qualified under Russian and English law, has over 20 years of experience in providing legal support for major Russian businesses, as well as multinationals implementing large-scale investment projects in Russia
- Clients include over 1700 companies, among them major multinational investors operating in Russia (including 130 Forbes Global clients), Russian and international banks and financial institutions and Russian industry-leading companies
- 5 times winner of Law Firm of the Year in Russia since 2009, including Chambers Europe Awards 2010, 2014 and 2015; The Legal Business Awards (Legal 500) 2010; The Lawyer European Awards 2014
- #2 by revenue in the top-50 law firm ranking by revenue in Russia (according to the leading national ranking Pravo.Ru 2017)
- Top-ranked by The Legal500 and Chambers & Partners in core practice areas: corporate/M&A, real estate & construction, dispute resolution, competition/antitrust, tax/customs, IP

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