RULING
OF THE PLENARY SESSION
OF THE SUPREME COURT
OF THE RUSSIAN FEDERATION

No. 10

Moscow 23 April 2019

On Application of Part IV of the Civil Code of the Russian Federation

[Abstract]

In order to ensure the correct and uniform resolution of disputes regarding the protection of intellectual property rights by the courts, the Plenary Session of the Supreme Court of the Russian Federation, guided by Article 126 of the Constitution of the Russian Federation, Articles 2 and 5 of Federal Constitutional Law No. 3 of 5 February 2014 "On the Supreme Court of the Russian Federation", hereby rules to provide the following clarifications:

…

General issues of IP protection

52. In accordance with Article 1248 of the Civil Code of the Russian Federation [hereinafter – the CC RF], disputes pertaining to the protection of violated or disputed intellectual rights are, by general rule, considered and resolved by the court.

Item 2 of Article 1248 of the CC RF provides a list of situations, in which intellectual rights are to be protected in the administrative (extrajudicial) manner. If a person applies to court with a claim that is subject to consideration in the administrative (extrajudicial) manner, the court refuses to accept the corresponding statement of claim (Item 1 of Part 1 of Article 134 of the Civil Procedure Code of

the Russian Federation [hereinafter – the CPC RF], Item 1 of Part 1 of Article 127.1 of the Commercial Procedure Code of the Russian Federation [hereinafter – the ComPC RF].

When courts consider cases on violation of IP rights, the objections of the parties, pertaining to a dispute subject to consideration in administrative (extrajudicial) manner, are not to be taken into account and cannot serve as basis of the court decision.

53. If administrative or criminal liability measures are used against a person that violated the intellectual rights to the results of intellectual activity or means of individualization, this does not exclude the possibility that civil law measures of intellectual rights protection will be used against that person.

Herewith it should be noted that the refusal to hold a person administratively or criminally liable does not by itself mean that it is impossible to use civil law protection measures.

54. If an exclusive right is violated by an employee of a legal person or of a citizen in the course of labour (service, employment) duties, the proper defendant in regard of a claim for application of liability measures is the aforementioned legal person or citizen, whose employee committed the violation (Item 1 of Article 1068 of the CC RF).

55. In consideration of cases regarding the protection of violated intellectual rights, the courts should take into account that the law does not provide an exhaustive list of admissible pieces of evidence that may help establish the fact of a violation (Article 55 of the CPC RF, Article 64 of the ComPC RF). This is why, when resolving whether such a fact indeed took place, the court may, by virtue of Articles 55 and 60 of the CPC RF, Articles 64 and 68 of the ComPC RF, accept any piece of evidence indicated in the procedural legislation, including those acquired with the use of information and telecommunication networks, including the Internet.

In particular, admissible evidence includes printouts of materials published in an information and telecommunication network (“screenshots”), made and certified by the persons participating in the case, indicating the address of the printed webpage, as well as the exact time of the printout. Such printouts are subject to evaluation by the court in consideration of the case, along with the rest of the evidence (Article 67 of the CPC RF, Article 71 of the ComPC RF).

The fact of unlawful distribution of counterfeit tangible media within the framework of a retail purchase and sale contract may be established not only by provision of a cashier's check, sales receipt or of another document confirming payment for the goods, as well as by hearing the testimony (Article 493 of the CC RF), but also based on other evidence, e.g. audio or video recording.

The consent of the person recorded by audio or video means is not necessary for an audio or video recording to be admitted as evidence.

Information that a person distributes counterfeit products is not information about the private life of such a person; in particular, such information is not protected by the right to respect for private and family life.

Evidence necessary for a case may be secured by a notary, if there are reasons to believe that in the future it will become impossible or problematic to provide evidence (Articles 102, 103 of the Fundamentals of Legislation of the Russian Federation on the Activities of Notaries, Law No. 4462-1 of 11 February 1993). In particular, a notary may certify the contents of a website as of a particular moment in time.

In urgent situations, when the case is being prepared for trial, as well as during the trial, the court may, in accordance with and in the manner stipulated in Item 10 of Part 1 of Article 150 and Article 184 of the CC RF, Article 78 and Item 3 of Part 1 of Article 135 of the ComPC RF, examine and inspect the evidence at its location (in particular, the court may inspect the information posted on a certain information and telecommunication network resource in real time).

56. By general rule, the use of results of intellectual activity or of means of individualization in several ways is regarded as the corresponding number of violations of the exclusive right.

Herewith, if a result of intellectual activity or a mean of individualization is used by one person in various ways aimed at one economic goal, this forms only one violation of the exclusive right. For example, the storage or transfer of counterfeit goods (where finalized by the same person actually introducing such goods into the civil turnover) are an element of introduction of the goods into the civil turnover and do not form separate violations; sale of goods with consequent delivery to the buyer is regarded as a single violation of the exclusive right.

57. Where the right holder’s exclusive right is violated, it may protect its violated right by any of the means listed in Article 12 and Item 1 of Article 1252 of the CC RF, in particular by filing a claim for suppression of activities violating the

exclusive right (e.g. requesting the court to prohibit a certain performer from performing certain works).

By virtue of sub-item 2 of Item 1 of Article 1252 of the CC RF, a claim for suppression of activities violating a right or creating the danger of such violation may be filed not only against the person performing or preparing for such activities, but also against other persons, who can suppress such activities.

Such a claim may only be satisfied, if the unlawful activities of a certain person have not yet been finalized, or if there is a threat of violation of right. For example, if the plaintiff requests that the defendant be prohibited from offering counterfeit goods for sale of from selling them, such a claim is not subject to satisfaction, where the goods owned by the defendant have already been sold. Claims for general injunctions, prohibiting a certain person from using the results of intellectual activity or means of individualization in the future (e.g. from publishing information in information and telecommunication networks, including the Internet) are also not subject to satisfaction. Such actions are directly prohibited by the law (third paragraph of Item 1 of Article 1229 of the CC RF).

58. If the plaintiff requests to publish the court decision regarding the violation that will name the actual right holder (sub-item 5 of Item 1 of Article 1252 of the CC RF), it must indicate, where such a publication should be made and provide reasons for its choice. The defendant may present its objections regarding the source of publication. Evaluating the plaintiff's arguments and the defendant's objections, the court may determine the source, in which the court decision is to be published, acting on the premise that such a choice must be directed at remedying the violated right (e.g. should be published in the same printed publication that published false information about the right holder; in the official bulletin of the federal executive body in the sphere of IP; in a source that is distributed depending on the location of production and distribution of counterfeit goods or the location and nature of the plaintiff's activities).

59. By virtue of Item 3 of Article 1252 of the CC RF, where the right holder's exclusive right is violated, it may choose the type of remedy (where so stipulated in the Civil Code of the Russian Federation): instead of restitution it may claim that the perpetrator pays compensation for violating the aforementioned right. It is not allowed to recover both the damages and the compensation.

Compensation is subject to recovery, if the fact of the violation has been proven; herewith, the right holder is neither obliged to prove that it incurred damages nor to prove their amount.

When compensation claims are filed, the right holder may select one of the manners of calculating the compensation sum, as indicated in sub-items 1, 2 and 3 of Article 1301, sub-items 1, 2 and 3 of Article 1311, sub-items 1 and 2 of Article 1406.1, sub-items 1 and 2 of Item 4 of Article 1515, sub-items 1 and 2 of Item 2 of Article 1537 of the CC RF. The plaintiff may also change the selected manner of calculation prior to the adoption of the court decision, since the subject matter and the grounds of the stated claims are not altered by such a change.

The court may not change the manner of calculation of the compensation sum upon its own initiative.

The author of results of intellectual activity, who was not the holder of the exclusive right at the moment of its violation, may not claim compensation for violation of the exclusive right.

60. The compensation claim is of pecuniary nature.

Independent of the manner in which the compensation sum is calculated, the statement of claim must indicate the amount of claim as a fixed sum (Item 6 of Part 2 of Article 131 of the CPC RF, Item 6 of Part 2 of Article 125 of the ComPC RF). The payable state fee is determined based on the volume of the stated claim.

The violation of rights to every result of intellectual activities or every mean of individualization creates separate grounds for applying the measures of IP protection (Articles 1225, 1227, 1252 of the CC RF).

If the plaintiff establishes the overall claimed amount of compensation without indicating a separate sum for every individual violation, the court acts on the premise that the stated compensation sum is calculated based on equal shares claimed for every violation.

If the plaintiff does not indicate the amount of claim (the amount of compensation claimed), the court issues a ruling to leave the corresponding statement of claim without action (Article 136 of the CPC RF, Article 128 of the ComPC RF).

61. When stating a claim for recovery of compensation within the amount from 10 000 to 5 000 000 rubles, determined at the court’s discretion, the plaintiff must substantiate the amount of the recoverable sum (Item 6 of Part 2 of Article 131, eighth paragraph of Article 132 of the CPC RF, Item 7 of Part 2 of Article 125 of the ComPC RF), thus, in its own opinion, proving the proportionality of the claimed compensation sum to the violation. This rule does not apply when the minimal compensation is claimed.

When claiming a compensation in the double amount of the value of the right to use the result of intellectual activity or a mean of individualisation or the double amount of the value of counterfeit copies (goods), the plaintiff must present the calculation and the substantiation of the recoverable sum (Item 6 of Part 2 of Article 131, eighth paragraph of Article 132 of the CPC RF, Item 7 of Part 2 of Article 125 ComPC RF), as well as documents confirming the value of that use or the number of copies (goods) and their price. If it is not possible to present the evidence, the plaintiff may motion for the court to request such evidence from the defendant or third persons.

Where the above requirements are not met, the court may issue a ruling to leave the corresponding statement of claim without action (Article 136 of the CPC RF, Article 128 of the ComPC RF).

In order to substantiate the calculation and value of the violated right, it is allowed to present data on the value of the exclusive right, in particular those from foreign sources. Rights management organizations may, as evidence, refer to fees and tariffs stipulated by them in substantiation of calculation of the claimed compensation. Said evidence is evaluated by the court following the rules on evaluation of evidence and has no priority over other pieces of evidence.

If the right holder claims compensation in the amount of a double value of the right to use a work, an object of neighboring rights, invention, useful model, industrial sample or trademark, the compensation amount is determined based on the price that, in comparable circumstances, is usually charged for their lawful use in the way in which the perpetrator used them.

If the right holder claims compensation in the amount of the double value of the counterfeit copies (goods), then in order to determine the compensation amount the court should take into account the value of those copies (goods), at which they are actually sold or offered for sale to third persons. Thus, if counterfeit copies (goods) were sold or are offered for sale by the perpetrator within the framework of wholesale purchase and sale contracts, it is the wholesale price of copies (goods) that should be taken into account.

62. By general rule, when considering compensation cases, the court determines the compensation amount within the limits stipulated in the Civil Code of the Russian Federation (second paragraph of Item 3 of Article 1252).

When compensation is claimed within the limits from 10 000 to 5 000 000 rubles, the court determines the compensation amount based on the evidence presented by the parties, without exceeding the claims stated by the plaintiff.

The court determines the amount of recoverable compensation and adopts a decision (Article 196 of the CPC RF, Article 168 of the ComPC RF), taking into account that the plaintiff presents the evidence substantiating the amount of compensation (fifth paragraph of Article 132, Item 1 of Part 1 of Article 149 of the CPC RF, Item 3 of Part 1 of Article 126 of the ComPC RF), and that the defendant may dispute both the fact of violation and the amount of compensation claimed by the plaintiff (Items 2 and 3 of Part 2 of Article 149 of the CPC RF, Item 3 of Part 5 of Article 131 of the ComPC RF).

The court must substantiate the amount of the recoverable compensation. When determining the compensation amount, the court, in particular, takes into account the circumstances pertaining to the object of violated rights (for example, how well-known it is to the public); the nature of the infringement (in particular, whether a trademark was placed on the goods by the right holder itself or by third persons without the right holder's consent, whether a copy was reproduced by the right holder itself or by third persons, etc.); the duration of unlawful use of a result of intellectual activity or a mean of individualisation; the nature and degree of the perpetrator's fault (in particular, whether the infringement is a severe one and whether it took place repeatedly); potential pecuniary losses of the right holder; whether the use of results of intellectual activity or means of individualisation is a significant element of the perpetrator's commercial activities and adopts a decision based on the principles of reasonableness and fairness, as well as proportionality of compensation to the consequences of the infringement.

63. If several interrelated results of intellectual activity or means of individualization belong to the same person (a work and a trademark in which that work is used, a trademark and the appellation of origin, a trademark and an industrial design), the compensation for infringement of rights to each of the objects is determined separately.

64. Provisions of the third paragraph of Item 3 of Article 1252 of the CC RF regarding the decrease of the amount of compensation are subject to application when one action violates the rights to several results of intellectual activity or means of individualization (hereinafter – in case of multiplicity of offences), in particular when one action infringes the rights to:

– several interrelated results of intellectual activities or means of individualization: a musical work and its phonogram; a work and a trademark in which that work is used; a trademark and the appellation of origin; a trademark and an industrial design;

- several results of intellectual activities or means of individualization, which are not interrelated (in particular, if a person sells an item of goods carrying different trademarks, put on it illegally, or distributes a tangible medium carrying several different copies of works).

The cited provision of the Civil Code of the Russian Federation regarding the decrease of the compensation amount may also be applied when several offences, comprising a single process of an object's use, are perpetrated by one person in regard of one result of intellectual activities or mean of individualization (e.g. reproduction of a work and its further distribution).

The provisions of the third paragraph of Item 3 of Article 1252 of the CC RF are applied only in the case of multiplicity of offences, and only if the plaintiff claims that the corresponding manner of decrease of compensation should be applied.

65. Compensation is a liability measure for a fact of infringement within the scope of a single intent of the perpetrator. If the plaintiff right holder applied to court claiming a fixed-sum compensation by virtue of Item 1 of Article 1301, Item 1 of Article 1311, Item 1 of Article 1406.1, sub-item 1 of Item 4 of Article 1515, sub-item 1 of Item 2 of Article 1537 of the CC RF due to creation of several counterfeit copies (goods) by the defendant, new compensation claims against the same person regarding the goods from the same production lot (edition, production run, etc.) are not subject to consideration.

When considering the first case on recovery of a fixed-sum compensation, the court determines the compensation amount proportionate to the infringement as a whole. In this regard, if the plaintiff repeatedly applies to court for recovery of another compensation for the same violation, such an action is aimed at review of the court's conclusions (reached by the court in the earlier considered case based on the evidence presented in that case), where the court has already determined the amount of compensation proportionate to the infringement as a whole. Therefore, in such a situation the court refuses to accept the statement of claim or terminates the proceedings, if the statement of claim has been accepted (Item 2 of Part 1 of Article 134 of the CPC RF, Item 2 of Part 1 of Article 127.1 of the ComPC RF; third paragraph of Article 220 of the CPC RF, Item 2 of Part 1 of Article 150 of the ComPC RF).

The distribution of several tangible media during unlawful use of a result of intellectual activity or mean of individualisation comprises a single infringement, if such a violation is within the scope of a single intent of the perpetrator (e.g. a single intent of the perpetrator to distribute a production lot of counterfeit copies of

one work or of counterfeit goods). Herewith, each transaction of purchase and sale (exchange, donation) of tangible media (both identical and non-identical) is qualified as a separate infringement of the exclusive right, unless the single intent of the perpetrator in performance of several transactions is proven.

Where the single intent of the perpetrator is proven, the number of counterfeit copies, goods (the volume of a production lot, edition, production run, etc.) may characterize the nature of the infringement as a whole and must be taken into account by the court in determining the exact amount of compensation.

If a person is held liable for an offence and thereafter continues to engage in unlawful acts of the same nature, it may be repeatedly held liable for the acts that it committed after being held liable.

66. If a compensation claim in the amount of double the value of counterfeit copies (goods), calculated based on the discovered number of distributed counterfeit copies (goods) is satisfied, this does not preclude recovery of compensation calculated on the same basis, if new counterfeit copies (goods) are discovered.

67. Pecuniary claims aimed at protection of copyright and (or) neighbouring rights (except for the rights to photographic works and works produced by a process analogous to photography) in information and telecommunication networks, including the Internet, may be satisfied by the court even if during the consideration of the case it is established that the infringement was remedied by the defendant after preliminary measures were taken in accordance with Article 144.1 of the CPC RF or after the claim was filed to court.

68. The expression of several different results of intellectual activity or means of individualization in one tangible medium (in particular, copying of several works, placement of several different trademarks on one tangible medium) is a violation of the exclusive right to every result of intellectual activity or mean of individualization (third paragraph of Item 3 of Article 1252 of the CC RF).

Herewith, with regard to trademarks the courts should note that if the protected rights to trademarks actually establish protection of different variants of one and the same designation, have graphic differences that do not alter the nature of the trademark and are recognized by the consumers as one and the same designation preserving its recognisability independent of the graphical representation, then the simultaneous infringement of rights to several such trademarks comprises a single infringement, if it is within the single scope of the perpetrator’s intent.

69. If the exclusive right to the result of intellectual activity, owned by several persons (e.g. co-authors (Article 1258 of the CC RF) or a collective of performers (Article 1314 of the CC RF), is infringed by a single action, then, if all the co-authors (co-performers) apply for the protection of the infringed right, the court determines the overall amount of compensation for the infringement and distributes the recovered compensation among the co-plaintiffs in accordance with the third paragraph of Item 3 of Article 1229 of the CC RF – in equal shares among all the right holders, unless an agreement concluded among them stipulates otherwise.

If there is joint coauthorship, and one of the co-authors (co-performers) applies to court without a corresponding power of attorney from the other co-authors, the court, taking into account the fourth paragraph of Item 3 of Article 1229, Item 4 of Article 1258, Item 3 of Article 1314 of the CC RF, determines the overall amount of compensation for the infringement and also determines, which share of the compensation is due to the plaintiff in accordance with the third paragraph of Item 3 of Article 1229. Herewith, the court draws other co-authors to participation in the case in the capacity of third persons, preserving their right to file separate claims. Co-authors may also enter the case in the capacity of co-plaintiffs.

70. Even after the legal protection of the corresponding result of intellectual activity or mean of individualization is terminated, a claim for damage restitution or a compensation claim may be filed by a person that was the right holder at the moment of the infringement.

When the right to use a result of intellectual activity or a mean of individualization is provided to a third person under a license contract, or when the exclusive right is transferred to a third person under an alienation contract, the right to claim damages caused by an infringement perpetrated before said contract was concluded is not transferred to the new right holder. The corresponding claim may be filed by the person that was the right holder at the moment of the infringement.

Herewith, the right to claim damages or compensation may be transferred under an assignment of claim agreement that is subject to registration in the corresponding manner (Item 2 of Article 389 of the CC RF).

71. A claim to apply liability measures for infringement of the exclusive right is filed against the person, whose unlawful actions resulted in the infringement of the exclusive right. If several consecutive infringements of the exclusive right were perpetrated by different persons, each of these persons is individually responsible for the infringements.

In accordance with Item 6.1 of Article 1252 of the CC RF, if a single infringement of the exclusive right to the result of intellectual activity or a mean of individualization is perpetrated jointly by a number of persons, such persons are jointly and severally liable to the right holder.

The provision on joint and several liability is applied, when the infringement results from the joint actions of several persons aimed at a single result. By virtue of Item 1 of Article 323 of the CC RF, the right holder may demand payment of compensation from all the perpetrators jointly, as well as from each of them separately, both in full or in part.

As regards recourse liability, liability for the infringement is distributed among the persons that jointly infringed the exclusive right in accordance with Item 2 of Article 1081 of the CC RF, i.e. in the amount corresponding to the degree of fault of each of the wrongdoers.

Herewith, it is not obligatory for all the persons that consecutively perpetrated different infringements of the exclusive right to the result of intellectual activity or a mean of individualization (e.g. production, wholesale, retail sale of counterfeit tangible media) to participate in the case as co-defendants; nor it is for all the perpetrators in case of joint infringement.

72. If damages or compensation were recovered from a person (and, equally, if a tangible medium was taken from such a person) in the absence of fault, this person may file recourse claims against the person guilty of the former person's infringement, claiming damages incurred, including the sums paid to third persons (Item 4 of Article 1250 of the CC RF). Provisions of Article 1081 of the CC RF are not subject to application in this situation.

When considering a case on infringement of the exclusive right, the court, upon the motion of the defendant, draws persons to participation in the case (in the capacity of third persons), against whom, in the defendant's opinion, recourse claims may later be filed. Herewith, failure to draw such persons to participation in the case regarding the infringement of the exclusive right does not preclude the later filing of a claim against them by way of recourse.

73. The use of results of intellectual activity and means of individualization at the instructions or following the task of the right holder (e.g. production of copies of works by a printing office following the task of the publishing house, production of goods with placement of the trademark under a contract concluded with the right holder) falls within the scope of the right holder's exclusive right and does not require for a license contract to be concluded.

The use of results of intellectual activity or means of individualization at the instructions or following the task of a person infringing the exclusive right of the right holder does, in its turn, also form an infringement of the exclusive right.

Measures of protection of exclusive rights stipulated in Article 1252 of the CC RF may be applied against the person that unlawfully used the result of intellectual activity or a mean of individualization. Herewith, taking into account the provisions of Item 6.1 of Article 1252 of the CC RF, a person that instructed or tasked someone to illegally use the result of intellectual activity or a mean of individualization and the person that performed such an instruction or task are jointly and severally liable to the right holder, except when the person that acted following such instructions or task neither knew nor ought to have known about the infringement of the right holder's exclusive right. Claims stated against such a person are not subject to satisfaction. This does not preclude the use of other measures of protection of the exclusive right listed in Item 5 of Article 1250 of the CC RF against this person.

74. If a copyright object is registered as an industrial design with the right holder's consent, the way of protection of the exclusive right from infringements is determined by the nature of the infringements. If the perpetrator uses the industrial design (Article 1358 of the CC RF), the patent holder may protect its rights in any way stipulated for protection of patent rights (Paragraph 8 of Chapter 72, Article 1252 of the CC RF). If the exclusive right to the use of a work (Article 1270 of the CC RF) is infringed simultaneously with the exclusive right to the use of an industrial design, both the copyright holder and the patent holder may engage in protection in any of the ways stipulated for the protection of the corresponding rights (Articles 1252, 1301, Paragraph 8 of Chapter 72 of the CC RF).

If registration and the following use of a work as an industrial design were performed without the consent of the author of the work, the author may defend its copyright independent whether a claim to annul the patent has been stated. Herewith, the satisfaction of the corresponding claims of the author does not by itself result in annulment of the patent.

A court decision in a copyright infringement case cannot obstruct the conclusion of a license contract between the patent holder and the author of the work.

Clarifications given within this item also apply if the copyright object is registered as a trademark.

75. In accordance with Item 4 of Article 1252 of the CC RF, where the production, distribution or other use, as well as import, transportation or storage of tangible media containing the result of intellectual activity or a mean of individualization leads to infringement of the exclusive right to such a result or mean, such media are regarded as counterfeit and are subject to removal from circulation and destruction without any compensation, unless the Civil Code of the Russian Federation stipulates other consequences.

If it is established that the defendant has counterfeit tangible media, the court adopts a decision on removal from circulation and destruction. If the holder of the exclusive right does not make the corresponding statement, the court must submit this issue for discussion of the parties.

Other consequences are stipulated in Item 2 of Article 1515, Item 1 of Article 1537 of the CC RF for situations, when goods, labels, package are discovered, on which a trademark, appellation of origin or a confusingly similar designation is placed illegally, but public interests require that such goods enter into circulation.

Herewith it should be noted that if a trademark is placed on goods by the right holder or with the right holder's consent, and such goods are then transferred to the territory of the Russian Federation without the right holder's consent, such goods may be removed from circulation and destroyed during enforcement of trademark infringement consequences only if their quality is improper and (or) for the purpose of protecting public health and safety, the environment and cultural values.

This does not preclude the use of other measures aimed at preventing the circulation of the corresponding goods.

A tangible medium may be recognized as counterfeit only by the court. Where necessary, the court may appoint an expert examination in order to clarify issues that require special knowledge. For example, the fact that a tangible medium containing unlawfully processed software is counterfeit may be established with due regard to the conclusions of an expert, who discovers the evidence of such processing.

Herewith, an expert may not be asked to establish whether a designation expressed in a tangible medium is confusingly similar to a trademark, the exclusive right to which belongs to the right holder; such an evaluation is made by the court from the viewpoint of an ordinary consumer of the corresponding goods, who does not have the special knowledge of a recipient of goods, for the individualization of which the trademark was registered (hereinafter – ordinary consumer), with due regard to Item 162 of this Ruling.

76. By virtue of Item 5 of Article 1252 of the CC RF, if it is established by the court that the tools, equipment or other means are primarily used or intended for the infringement of exclusive rights to results of intellectual activity and means of individualization, such equipment, other devices and materials are subject to removal from circulation and to destruction at the expense of the perpetrator, by virtue of a court decision, unless the law stipulates that they are to be forfeited to the state budget. This rule also applies if the holder of the exclusive right fails to make the corresponding statement.

Where the holder of the exclusive right fails to make a statement in regard of removal from circulation and destruction of the aforementioned tools, equipment or other means, the court submits this issue for discussion of the parties in order to clarify, under what circumstances said means were used.

77. The features of liability of an information intermediary, stipulated in Article 1253.1 of the CC RF, are an exception to the rules stipulated in Item 3 of Article 1250 of the CC RF regarding the use of liability measures (in the form of restitution of damages and payment of compensation) for IP infringements committed in entrepreneurial activities of the perpetrator, independent of its fault.

The court establishes whether a certain person is an information intermediary by taking into account the nature of that person’s activities. If a person engages in activities stipulated in Article 1253.1 of the CC RF, such a person is regarded as an information intermediary in the part pertaining to these activities. If a person simultaneously engages in different types of activities, the court should separately resolve whether this person can be regarded as an intermediary in regard of every type of such activities.

Liability of information intermediaries, in particular for infringements in entrepreneurial activities, is entailed in case of fault.

Other provisions of Article 1250 of the CC RF (in particular those stipulating that protection measures are used in case of infringement with regard to the nature of the infringed right and of consequences of the infringement; regarding the persons, at whose request such measures may be used) apply to information intermediaries on a general basis.

Claims for suppression of infringements may also be stated against an information intermediary (Item 4 of Article 1253.1 of the CC RF).

78. A website owner determines the manner of use of the website on its own (Item 17 of Article 2 of Federal Law No. 149 of 27 July 2006 “On Information, Information Technologies and Information Protection” (hereinafter – Federal Law “On Information, Information Technologies and Information Protection”). Therefore the burden to prove that the content featuring the results of intellectual activity or means of individualisation was placed on the website by third persons and not by the website owner (and that the website owner is thus an information intermediary) lies on the website owner. In the absence of such evidence it is presumed that the website owner is the person directly using the corresponding results of intellectual activity or means of individualisation.

If the website owner modifies the content featuring the results of intellectual activity or means of individualisation, posted on the website by third persons, the issue of whether this owner is an information intermediary depends on how active a role that owner played in the formation of such content and (or) whether it received income directly from the unlawful placement of the content. Significant remaking of the content and (or) receipt of said income by the website owner may indicate that it is not an information intermediary, but a person directly using the corresponding results of intellectual activity or means of individualization.

Unless otherwise follows from the facts of the case and the presented evidence, in particular from the information placed on the website (Part 2 of Article 10 of Federal Law “On Information, Information Technologies and Information Protection”), it is presumed that the administrator of the domain name, addressing to the corresponding website, is the website owner.

79. When applying Article 1254 of the CC RF, the courts should take into account that it does not entitle a holder of a simple (non-exclusive) license to protect its rights by means stipulated in Articles 1250 and 1252 of the CC RF. Only a holder of an exclusive license has that right by virtue of said article of the Civil Code of the Russian Federation.

The license holder may state compensation claims for the infringement of exclusive rights, if its own rights, received by virtue of a license contract (and not those of the right holder), are infringed.

Taking this into account, a holder of an exclusive license may protect its rights by means stipulated in Articles 1250 and 1252 only in case of infringement of the authority to use the results of intellectual activity or means of individualization provided to it.

If a holder of an exclusive license on its own challenges the provision of legal protection to other results of intellectual activity and means of individualization in violation of said right, the right holder is drawn to participation in the case.

…

Chief Justice of the Supreme Court of
the Russian Federation V.M. Lebedev

Secretary of the Plenary Session, Judge of
the Supreme Court of the Russian Federation V.V. Momotov