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The Eurasian Umbrella or Russia

Denis Ashikhin, Gorodissky & Partners, compares the national and regional patent protection policies and tools in Russia and the Eurasian Economic Union respectively.

The recently established Eurasian Economic Union directly touching among other IP areas is only one of the bright examples the integration. Accordingly, it might be instrumental to comprehend the most effective way to protect IP in this territory may be by basing it on already available patent protection tools.

Evaluating proper patent strategy in the region, you will definitely take into account at least several CIS countries. Each of them of course has its own national patent legislation. However you should not forget that there is a Eurasian Patent Convention which encompasses Armenia, Azerbaijan, Byelorussia, Kyrghyzstan, Kazakhstan, Russia, Turkmenistan and Tajikistan. Five of those countries (Russia, Armenia, Byelorussia, Kyrghyzstan, Kazakhstan) are already members of the Eurasian Economic Union which bears some semblance to the European Union.

There are no customs borders between those five countries, but a national regime of patent protection exists in each. Hence, the patent strategy should be underpinned by careful consideration of where patents should be obtained.

Statistics shows that still patentees are interested mostly in Russia, recent tendencies are adding Kazakhstan and Byelorussia to Russia. So it is worth considering and comparing the national (taking Russia as the example) and regional – Eurasian - ways of getting patent protection.

Patenting processes in Russia can be initiated by filing a conventional/non-conventional Russian patent/utility model application or entering the Russian national phase with a PCT application (which might also be for an invention patent or utility model). Similarly, an application for invention can be filed with the Eurasian Patent Office or the Eurasian regional phase can be entered with a PCT application. The deadlines are 12 months for filing a convention application and 31 months for entering the national/regional phase with the PCT applications.

Article 1350 of the RF Civil Code (hereinafter referred to as the Code) sets forth: "*A technical solution relating to a product … or a process, including use of a product or a method for a particular purpose in any field of technology … is protected as an invention*". This definition of the invention is harmonized with that stipulated by Article 27 of TRIPS which reads as "*…patents shall be available for any inventions, whether products or processes, in all fields of technology…*". The following subject matters are excluded from protection: discoveries, scientific theories and mathematical methods, aesthetic creations relating to external appearance of articles, rules and methods of games, intellectual or business activities, computer programs, presentation of information, animal breeds and plant varieties, integrated circuits layouts.

Russia has very applicant-oriented filing requirements where an application can be filed in any language with further submission of its Russian-language translation. The only document that should mandatorily be filed in Russian is a petition for granting a patent. Such flexible language of filing requirement surely gives the applicant a chance to take a last-moment-decision on possibility to file and successfully arrange filing.

Invention applications

There is a two-stage examination procedure for invention applications, which includes formal examination and substantive examination.

During formal examination the application documents are checked for completeness and for compliance with the formal requirements. For triggering examination on merits, the applicant should file an examination request. Such a request should be filed within three years from

Résumé

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Denis holds an engineer diploma from the National University of Science and Technology (MISIS) and a diploma in law from the Russian State Academy of Intellectual Property. Got training at the Intellectual Property Office in Newport, law firms Boehmert & Boehmert, Vossius & Partners and Hoffmann Eitle in Germany. Started his carrier with the Federal Institute of Industrial Property (Russian PTO). Joined Gorodissky and Partners in 2007 and at present works in the Mechanics Department of the firm. He focuses his work on counseling clients on creating patent protection strategy in the field of machinery and equipment for metallurgy, mining, motor vehicles, trucks, passenger cars, ships, helicopters and other flying machines, aircraft, spacecraft and other transport vessels, agriculture and forestry etc. as well as generation, transmission and distribution of electricity, natural gas, steam and hot water, production of hydroelectricity. Has a great experience of oppositions and appeals before the Russian and Eurasian Patent Offices.

the filing date – or international filing date in case of a PCT application. This three-year term may be extended for two months provided that the extension fee is timely paid. If the substantive examination is not requested within said term the application is deemed to be withdrawn, but may be reinstated within 12 months from the term expiration date if the official fee for reinstatement is paid and the examination request is made.

Upon expiration of 18 months from the filing date, an application is published by the Patent Office. Publication of the application is associated with an obligation of the Russian PTO to publish search report – a new legislative provision that never existed before. In turn, the search publication is associated with another new feature of the patent procedure – a possibility for a third party to submit own observations regarding the claimed inventions after the application has been published. The observations – prior art references as well as arguments – are obligatory for considering by the Examiner. The observations practice clearly is intended to become an invitation to any interested party to intervene in examination proceedings at an early stage for preventing improper issuance of a patent instead of merely waiting for issuance thereof to invalidate. The observation process in its current state is, however, involving the third parties only at submitting stage, yet the law requires neither obligation from the Russian PTO to publish information on submitted observation nor to lay out or forward to the submitted party a report on results of observation consideration.

There is another important step associated with the search report. Peculiarity of the Russian prosecution is that the applicant has the only chance to voluntarily amend application materials. This chance is given after the issuance of the Search Report. The law yet does not define a deadline that closes the window for voluntary amendments leaving this definition to yet pending new regulations. However, practice shows that the search report is usually issued and sent simultaneously with the first Official Action. Accordingly, in the absence of any regulatory definition it is reasonable to assume that deadline for filing voluntary amendments is the term for responding to that first Official Action.

The international law and agreements, as well as practical considerations, give three other possibilities to file voluntary amendments with the Patent Office:

1) within a month after entering national phase in Russia pursuant to Rule 78 of the Regulations under the Patent Cooperation Treaty;
2) with the Russian translation of the application for convention applications; and
3) with the PPH examination request – here it should be mentioned that the Russian PTO participates in all PPH projects, including the Global PPH.

In line with law and regulations of almost all other countries the Russian patent law does not allow amendments (voluntary or made at the examiner's request) that introduce a "new matter" as well as another invention violating unity requirement.

But what should be kept in mind, and what is not always correctly comprehended by foreign applicants, is that a new technical result which is not disclosed in the original application cannot be entered. On the other hand, it should be understood that the new technical result (new task or aim of invention) may result in other set of essential features which will require from an examiner new search, new consideration etc. In other words, being good or bad "new technical result" now is a kind of "new matter" in Russia.

A patentable invention must be industrially applicable, sufficiently disclosed, new and must involve inventive step. The invention is industrially applicable if the purpose of the invention is achieved and means for carrying out the invention are disclosed in the description or publically available from the prior art before the priority date of the invention.

To fulfil the sufficiency of disclosure requirement the description shall disclose the essence of the invention in all necessary detail for its carrying out by a person skilled in the art. The description of the invention should contain each and every feature of the claims and preferably as many embodiments and examples as possible.

Previously, this requirement was covered by the industrial applicability criterion. But nowadays it is considered to be independent and is thought to be of great importance. The message from the PTO is that examiners will pay careful attention thereto. In any case please note that non-compliance with the sufficiency of disclosure requirement is (along with the other three criteria) both a reason for rejection as well as for invalidation of a patent.

The invention is new if it is not anticipated by a single prior art reference. The characteristic of the purpose of the invention should obligatory be considered as a feature of the invention.

The invention involves inventive step if it is not obvious for a person skilled in the art.

The prior art comprises any information publicly available in the world including any printed publication as well as information about open use of the invention anywhere ("absolute world novelty"). For the purpose of novelty consideration the prior art includes published earlier priority applications for inventions, utility models and industrial designs filed in Russia, and Russian and Eurasian patented inventions with earlier priorities.

Applicable is a 6-month grace period which is calculated back from the filing date of the application. The grace period includes a disclosure of information concerning the subject matter of the invention made by the inventor, applicant or third party who has directly or indirectly obtained information therefrom.

Inventive step criterion

Getting back to the inventive step criterion, we would like to draw the reader's attention to some specific Russian approach in determining thereof. The examination for inventive step is conducted in accordance with the following procedure: an examiner determines the closest prior art, identifies the features distinguishing the invention from the closest prior art, and identifies the prior art references having the features coinciding with the distinguishing features of the invention. However, the examiner cannot reject an invention as lacking inventive step merely basing such rejection on actual existence of prior art references, together disclosing the entire combination of features that defines the claimed invention. Any proper rejection should prove that the identified references teach same influence of the distinguishing features disclosed therein on the technical result of the invention. According to the Russian PTO regulations under technical result is understood as a characteristic of a technical effect, phenomenon, property etc. objectively exhibited when a method is executed or a product is made or used. The Russian PTO regulations require that all technical results that a claimed invention is capable to demonstrate are mentioned in the description. The applicant's failure to mention a technical result or mentioning an irrelevant one allows the Examiner to conduct an inventiveness examination without establishing influence of the distinguishing features on the technical result, otherwise necessary.

If the invention meets all the patentability requirements the Examiner will issue a Decision of Grant. After issuing the Decision of Grant any amendments to the claims and description except for corrections of obvious and technical errors become impossible.

In case of non-compliance of the invention with at least one patentability requirement the Examiner issues a Decision of Rejection. An appeal on the Decision of Rejection may be filed with the Patent Office. The board of Examiners considers the appeal and confirms or reverses the Decision of Rejection. The Decision of the board of Examiners may be further appealed in the IP Court.

The main specifics of the appeal is that it cannot comprise any amendments to the rejected claims. Therefore, going into the appealing procedure, the applicant can only bring reasons why the rejected set of claims should be granted, but cannot suggest, for example, an amended set of claims in case the Board rejects the reasons brought in the appeal. Therefore, as an option to an appeal, or together with an appeal, a divisional application may be used. Although being a separate application a divisional allows continuing prosecution after issuing a Decision of Grant/Rejection for its parent application. Such divisional application, or even a number of them, will provide a possibility of introducing same or amended sets of claims as those in the rejected parent application. Divisional applications should be filed before registration of a patent in the State Patent Register (in case of allowance) and before filing appeal against Decision of Rejection with the PTO.

A new and very useful option available during invalidation proceedings is transformation of the invention patent into a utility model patent. The difference in the patentability criteria may allow retaining protection of the invalidated invention as the utility model. However, such a transformation should be made within the validity period of the utility model patent which is 10 years.

In comparison to that, the validity term of an invention patent is 20 years from the filing date of the application. The term of an invention patent relating to a medicine, pesticide or agrochemical substance can be extended for up to five years in case of obtaining a marketing approval but only in respect of the product for which the approval was obtained.

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Utility models

Utility models as a form of protection differ from inventions, not only by a substantially narrowed validity term, but by generally overall restricted protectability. Another restriction is in that according to Article 1351 of the Code "*A technical solution relating to an apparatus is protected as a utility model*". No other types of subject-matters but apparatuses are admissible. The most recently enacted amendments to the Code significantly reduced the scope of obtainable utility model rights. After those amendments, a utility model application may contain only one independent claim. No alternative features can be recited in the claims and no doctrine of equivalents is applicable to the utility models while establishing the infringement. Further, all utility model applications become subject to the substantive examination – before they were granted in a registration mode, upon formal examination completing.

A patentable utility model must be industrially applicable, sufficiently disclosed, and new. Although no "inventive step" patentability requirement is applicable for utility models, successfully passing examination of its novelty is not an easy task. Examination of novelty of utility models is conducted only with regard to their essential features – the only features that contribute to the utility model technical result. Needless to state that such examination approach highly increases importance of choosing and disclosing in the application materials the proper technical result (only one technical result may be mentioned). If a utility model meets all the patentability requirements the Examiner issues a Decision of Grant. The validity term of a utility model patent cannot be extended over 10 years.

Eurasian Patent Convention

The previous part of this article was an introduction of the most frequently used national system in the Eurasian Economic Union region and described only those features of the system where comparison with the alternative way – using the Eurasian Patent Office instead – is the most illustrative. Then Eurasian way is the proper way for you in case you are not ready to go ahead with a number of national applications in different national languages, attend different patent procedures and communicate with different national patent attorneys, sometimes in completely unknown environment. All these and other potential problems may be removed just by filing a single Eurasian application.

As mentioned above, a Eurasian Patent Convention covers eight member states that agreed to ensure same protection for the rights conferred by Eurasian patents as to those by their own national ones.

The Eurasian Patent Office is located in Moscow and operates on the basis of the Eurasian Patent Convention. The Eurasian Patent Office grants a single unitary patent without any necessity of further validation thereof in each country. The patent is granted in the Russian language and no translation in other languages is necessary unless an infringement procedure is initiated.

In accordance with paragraph 1.1 of Eurasian Rules for compiling and filing patent applications: "*the subject-matters of inventions may be, created or transformed by humans material objects or processes, in particular apparatus, method, substance, biotechnological product as well as their use*". Being a bit different from the definition of invention given in the Russian legislation the wording of the invention definition according to the Eurasian law in principle covers the same subject-matters.

Methods are understood as processes of implementing actions resulting in creation of new or changing of known material objects or in their exploitation. In contrast to Russia where the invention can be used for any purpose, use in Eurasia is understood as being implemented for unknown purpose only. To be patentable, an invention must be industrially applicable, new, and involve inventive step. In Eurasia the sufficient disclosure requirement is considered

to be a separate patentability requirement but is rather a part of the industrial applicability requirement. The exceptions from patentability and the availability of patent protection for methods of medical treatment are the same as mentioned above with regard to the Russian national patent legislation.

Like the Russian PTO the EAPO uses a deferred examination. A request for examination shall be filed within six months from the date of publishing a Search Report. The search report is published together with the application and this usually takes place after expiration of 18 months from the filing date. The International publication and International Search Report substitute those of the EAPO. If no request for examination is filed, the application is deemed to be withdrawn. Like in Russia the application may be reinstated within 12 months from the missed term provided that the Official fee is paid and excusable reason for missing the set term is provided.

In contrast to Russia a six-month grace period in Eurasia is calculated back from the Eurasian filing date or from the priority date, if any. Thus, if an invention was disclosed before e.g. PCT filing date and there is a priority application on which conventional priority is claimed for this PCT case filing the Eurasian application may be the only way out to protect the invention in the region.

The substantive examination system in Eurasia is quite similar to the Russian one. However, a substantial advantage of prosecution in Eurasia is that amendments can be voluntarily made at any prosecution stage before issuing the final Decision – on patent grant or rejection.

The accelerated examination is available and includes the PPH program with the JPO and the EA-PCT program covering the EPO, JPO, USPTO, KIPO and RUPTO and working similarly to PPH.

The rejected Eurasian patent applications can be transformed into Russian patent applications within six months after the applicant received Decision on Refusal of Patent Grant or within six months from the date on which the applicant received a notification on dismissing the Appeal against refusal of patent grant. The Russian application in which the Eurasian application is transformed, receives the same filing and priority dates of the Eurasian application.

It is important to know that, in accordance with Article 1397 of the Code the Eurasian patent and Russian patent, for identical invention (identical invention and utility model) with the same priorities may validly co-exist. However, if the assignees are different such inventions shall be used with due account for the rights of each, and if the assignee is the same, such assignee may grant a license only for all such inventions.

Conclusions

Comparing the prosecution time and cost, the following should be taken into account:

Time required for obtaining a patent in Russia and Eurasia is quite comparable.

Cost for obtaining the patent in Eurasia is, of course, significantly higher than that in Russia but may be comparable with two-three corresponding national applications in the member countries.

Summarizing the above, the reader will appreciate that both the Russian and Eurasian systems are not much different from the world leading patent systems.

The Eurasian market being created to comprehensively upgrade, raise the competitiveness of, and cooperation between the national economies has enormous innovative potential and meaning of adequate IP protection therein will surely be increasing day by day.