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# Electronic filing: A real need for the applicants and attorneys

Yury Kuznetsov, Alexander Mits, and Ekaterina Shushunina from Gorodissky & Partners here describe the requirement in Russia for electronic filing from applicants and attorneys and discuss the pros and cons of the new system in place.

**F**or many years, all Russian applicants were using exclusively a paper-based procedure for obtaining patent rights before the Russian Patent Office (RUPTO). This procedure being uneasy, as such, was additionally complicated by the requirements of the RUPTO to present filed applications and submit responses to the office actions in a number of copies multiplying amounts of paper pages in procedural turnover.

The developing strategy of the Russian Government to provide their own citizens with easy and regular access to state services available at any Internet access point resulted in moving much of the traditional paper consuming services into so-called Public Services e-Portals where anyone properly registered could get electronic services from various administrative entities. Through such Public Services, it is possible to request passport issuance, renew driver's licenses, sign up for doctor's visits, pay and check taxes, etc. Naturally, the RUPTO was required to create a similar electronic system allowing citizens willing to get patents to electronically file applications and communicate with the Office during examination proceedings.

RUPTO announced readiness of electronic tools for patent filings and prosecution in 2014, offering two services for potential patent applicants:

- Electronic service for filing inventions/utility models applications;
- Personal accounts for continuing prosecution electronically or traditionally filed applications.

By offering the electronic turnover as two services, the RUPTO apparently wished to smoothen the process of transition to e-prosecution by offering a starting point from the most convenient stage – filing or prosecution, with a possibility to return to traditional paper form if dissatisfied. Such behavior of RUPTO appears quite reasonable due to the absence of unanimous appreciation of e-prosecution even among the patent professionals society. Despite all benefits of e-systems, clearly explained by RUPTO, many patent professionals required lots of guarantees as a pre-condition of their entering into e-prosecution turnover. Some of the requirements were indeed reasonable – the system was new, had never been tested outside RUPTO and expectedly – made in the way PUPTO felt convenient mostly for own needs while requiring observing a number of specific formats and conditions.

Professional cautiousness overweighed clear benefits of e-system: its 24-hour availability, no paper and postage expenses, the absence of OCR for electronically filed documents, and faster turnover inside Patent Office. When a drop of interest to newly offered e-tools became

## Résumés

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Yury has an engineer diploma (the Moscow State Technical University) and a diploma in law (the Moscow State Legal Academy). He worked as an examiner in the Russian PTO. Yury represents multinational and Russian clients, his primary focus is prosecution and enforcement of patent rights in the fields of electronics, communications, computer systems, audio and video engineering. He has great experience of oppositions and appeals before the Russian and Eurasian Patent Offices and representing clients in a number of litigation cases. Yury is a member of AIPPI, FICPI, LESI, Russian Chamber of Patent Attorneys and Council of the Eurasian Patent Attorneys.

### Alexander Mits, Partner, Russian and Eurasian Patent Attorney

Alexander heads the Filing Department and is in charge of filing patent applications with the Russian PTO, EAPO and PTOs of other countries, including former USSR countries. He counsels foreign and Russian clients on legal requirements and peculiarities of procedures for filing invention and utility model patent applications, especially in electronic filing with the Russian PTO. He also gives presentations and writes on the issues.

### Ekaterina Shushunina, Russian Patent Attorney

Ekaterina joined Gorodissky & Partners in 2002 and has been working in the Filing Department since that time. Her educational background includes Moscow State Linguistic University and Russian Academy of Justice, majoring in linguistics and law. She specializes in preparing and filing applications with the Russian and Eurasian Patent Offices, as well as Patent Offices of other countries. Ekaterina's experience also includes consulting foreign and Russian clients on patent and utility model legislation and requirements for filing invention and utility model patent applications.



noticeable, RUPTO made an extraordinary decision to push introducing the system by offering it for serious global testing to a trustworthy entity, which had to satisfy the following requirements:

- Being for many years one of the largest filing agents with RUPTO;
- Having a developed internal computer prosecution system, preferably – proprietary;
- Having own computer department capable of generating technically grounded testing reports on hardware-software issues and to address interoperability issues in on-fly mode with RUPTO;
- Capability of its computer system to be interoperable with most or all known e-services in the world;
- Having the largest filing department capable of massive testing, by filing hundreds of documents through it per each testing day.

The selection process ended in December 2014 by nominating Gorodissky & Partners Law Firm as the testing partner (testing platform) with almost an immediate start of the testing project afterward.

Massive testing started and within just a few days brought the first

results; not very positive for RUPTO and completely disappointing for the testing partner. Filing of each application was designed as a repetitive process of filling in application petition by very time-consuming manual input supplemented by similarly manual collection and attaching of application documents. As a result, electronic filing through e-filing system appeared 3-4 times longer than the same procedure in paper format. Testing results showed that e-filing system was designed for filing just few patent applications daily – in no way for massive filing.

Concurrently with filing capabilities, interoperability of the RUPTO's e-filing system with Gorodissky & Partners internal docketing system was checked. The aim of that side of testing was studying possibilities of providing streamlined interaction of these two electronic systems. The study of Gorodissky & Partners internal system interoperability was expected to be rather easy since during years of accommodating various requirements of our clients to electronic documents turnover computer engineers of Gorodissky & Partners managed to make the docketing system as flexible as possible for almost immediate adjusting it to any conditions.

Another challenge was revealed here – RUPTO e-filing system had been tough designed! Careful study of its functionality resulted in the conclusion that it was not possible to provide complete interoperability with Patent Office e-filing system. The detailed report in respect of its technical capabilities was quite brief as to the conclusions made by computer engineers:

- System was targeted to hardware and software capabilities usual for individual applicants, not to specialized systems technically designed for operating with small volumes of applications;
- System was inherently designed for adding most information and documents manually, not by pre-assembled packages;
- Adding of electronic signature is difficult;

**“Today, when the process of electronic filing operates smoothly, we can say that all the efforts and time we spent were not in vain.”**



- Platform software was not designed to become interoperable with in-house e-document systems;
- System was designed with very rigid requirements to document structures;
- Documents, drawings, and sequences had to be submitted in special formats;
- System did not provide any tools allowing to check uploaded documents before their submission.

Those crucial deficiencies made implementation of e-filing system in the incumbent state unreasonable and even harmful. The imperfections of the system in general and, primarily, the amount of time required for handling each application made it virtually impossible to cope with the usual large number of filing orders and – in the long run – could jeopardize interests of applicants. However, the concept of electronic filing itself and prospects it could discover was definitely worth all efforts required to make the system more convenient and user-oriented for patent law firm use. With this aim, it was decided to divide all above-mentioned flaws into two groups and to deal with them depending on their nature.

The first group of flaws (corrigible flaws) were those potentially completely or substantially removable by an interaction between software engineers of Gorodissky & Partners and RUPTO.

The second group included flaws which correction required substantial modifications of technical essence of the RUPTO e-filing platform. Since creation, development, and implementation of the platform was supported and financed by the Russian Government, such major changes required the approval of responsible authorities, and thus – hardly possible. Having considered all pros and cons, it was decided that Gorodissky & Partners internal docketing system and internal technology of work at the filing stage had to go through a number of changes and additions to be adapted to this group of flaws.

Long and hard joint work started and, after eleven months of close cooperation and constant mutual consultations, it successfully resulted in elaborating a convenient model of interaction between RUPTO and Gorodissky & Partners. This model was implemented in a new, enhanced e-filing system completed and introduced at the end of 2015 and since that time being actively used. Today, when the process of electronic filing operates smoothly and accurately it would be fair to say that all efforts and time spent were not in vain. The statistics gathered by the RUPTO shows steady growth of the amount of applications filed electronically.

The total number of new patent applications filed by Gorodissky & Partners with the RUPTO within 2016 amounts to 6,937 – 6,893 of them were filed electronically, thus making the share of electronically filed applications more than 99%. According to a survey prepared by Gorodissky & Partners, the percent of electronic exchange continues to increase: within the half-year of 2017 the firm filed 3,188 applications, only eight of them were submitted to RUPTO on paper. The total number of applications filed with RUPTO through e-filing system in 2016 was 10,362 – 6,893 of them were filed by Gorodissky & Partners, which makes the share of the company in electronic filing in Russia quite substantial (more than 66%, two-thirds of the total amount).

We are glad that our efforts opened the door for all Russian law firms to increase use of e-filing systems – according to 2017 filing statistics there are many new participants in the process of e-filing with RUPTO. Raise of e-filing also confirms that improvements suggested, tested, and implemented with the direct involvement of Gorodissky & Partners team made e-filing system of RUPTO convenient, effective, and attractive for all professional representatives, who use the system more and more actively.

So, what can a patent attorney get as benefits from filing applications electronically versus traditional paper filing? Basing on our experience

obtained during the intensive testing and use of e-filing system, several basic advantages can be named:

- in case of filing on paper, it takes 1-2 weeks in average to receive confirmation of filing and application number from RUPTO, whereas electronic filing allows obtaining official filing receipt within a few minutes after filing
- RUPTO accepts applications in paper format within a relatively limited time frame, till 17:45, even though the official closing time of RUPTO is 18:00. E-filing systems, in contrast, gives opportunity to file applications up to the end of day, even after the official closure of Patent Office, which can be crucial in situations when urgent filing on the last possible day is required;
- Personal account of e-filing system allows access to application materials at any time;
- Official notifications are delivered immediately after issuance, while in paper form they may reach applicant or attorney hardly earlier than same 1-2 weeks;
- The electronic system of RUPTO is substantially more interoperability with a particular in-house docketing system than originally;
- Minimizing possibility of correspondence loss or misdelivery;
- Sufficient security in transactions obtained by encryption of correspondence by digital signature allowing to maintain a high level of confidentiality;
- Amount of official filing fee is reduced by 15%;
- Electronic interaction with RUPTO has provided an opportunity to stop using paper almost completely and move to an ecologically-friendly paperless procedure.

These are main and important advantages to persuade applicants or professional representatives to choose between electronic and paper filing in favor of the former.

At this point, it is worth returning to an important issue that did not find its implementation in the enhanced system, but required software and organizational solutions on the user's side.

That issue is the flaws which correction or modifications were recognized as non-achievable at the stage of studying RUPTO e-filing system. Those flaws were not software defects of RUPTO e-platform, more likely its specifics, the way some elements were designed to function, nevertheless they could result in defects of electronically



submitted documents and cause problems for users if not timely detected.

Such flaws were primarily the consequences of rigid requirements to format of documents submitted, in particular, type font to be used, space between the lines, formatting to be used to mark paragraphs, definitions of files with claims, peculiarities of submitting drawings, division of application parts into files, etc. Again, this is not something that may be named as malfunctioning of the system, but rather non-flexible requirements and absence in e-filing system of tools to re-check the prepared documents for conformity to those requirements, which can lead to situations when elements of documents not meeting them may be incorrectly recognized or even lost.

When our software engineers started studying the second group of flaws they almost immediately named them as “incorrigibles” and the only remedy they could suggest was “adjusting technology at our side to minimize any further risks and keep detecting new incorrigibles”. That was indeed the only correct recipe because of the existence of most incorrigibles, as such, became a real surprise to RUPTO itself.

Massive filing of applications electronically highlighted the majority of “incorrigibles”, e.g. loss of separate terms, paragraphs, inscriptions on drawings, substitution of certain symbols and Cyrillic letters by different elements. While operating RUPTO e-system it became obvious that non-conformity of application documents to formal and technical requirements of the system could become a serious obstacle for correct filing.

Facing unwillingness of the RUPTO either to modify the implemented e-system in this part or to ease restrictions, the only way to secure safe filing and prosecution was adjusting the in-house system to make it capable of detecting possible drawbacks of documents before submitting them to Patent Office.

With that in mind, software engineers of Gorodissky & Partners analyzed and took into consideration all aspects and details that became known, and organized a very accurate process of preparing and completing documents required for filing. The internal docketing system was modified and furnished with a number of tools that would allow to automatically check the correctness of documents and their conformity to requirements of RUPTO e-system at each preparation stage. To illustrate the way system works, we suggest studying the process of preparation of Russian translation. Before final completion, the translation passes several levels of verification first as a draft, then as the text thoroughly revised by a patent attorney. Afterwards, the application is handed over to graphics group responsible for preparation of drawings of proper quality and format, fully complying with technical and formal regulations for e-filing. The significance of correct drawings should not be underestimated since drawings are the part of application required for establishing filing date and loss of certain elements of drawings during the transition to RUPTO e-system can entail a change of filing date. After above stages are completed, Gorodissky & Partners docketing system performs a final check of all documents for correctness, detects and eliminates

remaining defects if any, thus securing that application can be safely filed electronically.

Almost two years of interaction with RUPTO e-filing system have proven that organizing preparation of applications for filing in such a way guarantees both high quality of documents and their full compliance with requirements of e-filing.

Another issue worth mentioning is filing translations prepared by a third party – translation services – at rather moderate prices. It appears reasonable to warn applicants against certain traps they can fall into in their urge to minimize costs.

If the translation received from a third party is filed electronically without prior revision or modification, the risk of facing “incorrigibles” increases since there is no guarantee that the text meets requirements of RUPTO. If, for example, translation includes tables, fonts or characters non-recognizable by e-filing system certain parts of the text can be lost or presented with other characters or unusual code tables.

In conclusion, we would like to state that creation of e-filing system and its successful implementation has definitely become a breaking point that marks the beginning of a new stage in the development of both the RUPTO and the whole Russian patent practice. A convenient process utilizing contemporary technologies corresponds entirely to the spirit of the age and increases convenience and accessibility of obtaining patent protection in Russia. Perfection does not have limits and system development that started two years ago is still underway. Every application filed by us electronically is a new test allowing to check the correctness of everything already done and to suggest new improvements. We do our best to further develop filing services for all applicants and to make interaction with Patent Office as close to ideal as possible.

“The concept of electronic filing itself and prospects it could discover was definitely worth all efforts required.”

# Gorodissky & Partners Russia

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