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Eurasian Patent Office: The New Convenience

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Some 25 years ago, nine former Soviet republics – Azerbaijan, Armenia, Belarus, Georgia, Kazakhstan, Kyrgyzstan, Moldova, Russia and Tajikistan decided to unite their efforts in intellectual property. They set up the Eurasian Patent Office (EAPO). That office was designed primarily to provide a convenient opportunity for patenting inventions. By that time, the European Patent Office had been operating for many years and proved its efficiency. The Eurasian Patent Organisation relied on the experience of EPO and imbibed many features of the European Patent Convention. It was also evident that aside from many advantages, the European patent had its drawback, i.e. nationalisation after the grant of a patent. The Eurasian Patent Organisation decided from the very beginning that the Eurasian patent should be a unitary patent valid in all member countries after the grant.

The Eurasian Patent Office has been operating successfully since then though it was apparent that it could provide more services.

Industrial Designs

Industrial design is a subject matter that is gaining popularity among applicants. Hence, the administration of the Eurasian Patent Office gave thought to extend its reach to industrial designs. Talks were held for a number of years and culminated in a diplomatic conference in Kazakhstan in 2019. A “Protocol on Protection of Industrial Designs to the Eurasian Patent Convention” was signed during the conference. Initially, the Protocol was signed, but five countries (Azerbaijan, Armenia, Kazakhstan, Kyrgyzstan, Russia) though all eight were among the participants. Tajikistan signed the Protocol later. Belarus and Turkmenistan have not signed the Protocol so far.

Several months later, the countries that signed the Protocol ratified it and deposited the instrument of accession with WIPO. Kazakhstan and Russia deposited the instrument of accession later; therefore, the Protocol became effective for these countries on April 11 and 12, 2021, respectively.

Patents to be issued for industrial designs will be valid after the grant in all the countries in the same way as patents for invention.



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The applications will be subject to preliminary and substantive examination. Further to the positive result of the preliminary examination, the application will be published. No deferral of publication is allowed. Once the application is published, all interested persons, including patent offices of the member countries, will be able to send their observations to EAPO against the grant of a patent.

Patent regulations establishing rules for the examination of such observations are being drafted. The EAPO will consider decisions for those observations. The decisions may be appealed at the EAPO.

If the EAPO refuses to grant a patent on the application, the applicant will be able to convert the application into a national application or several national applications (in the member countries) with the same priority date.

The duration of the patent may be 25 years on the condition of payment of a renewal fee every five years. Currently, only national laws of Russia and Armenia provide for a 25 years duration of the design patent. In other countries, (Azerbaijan, Belarus, Kyrgyzstan, Tajikistan) duration of a design patent is 15 years. The duration of the design patent in Kazakhstan is 20 years. Hence, either those countries will change their laws to adapt it to the new Eurasian design, or the new design will be more attractive for applicants.

The Protocol also foresees invalidation of the Eurasian design. The first option is its “administrative invalidation” by the Eurasian Patent Office in response to an appeal by a third person (including also a national patent office). In this case, the design will be invalidated in all the member countries.

Another option is to go to court or another competent body of the member country. In that case, the decision of the competent body will concern that country only, and the patent will be retained in all other countries.

If there is a case of infringement, the law of the relevant country will be applied with respect to that country only.

The advantage of the Eurasian design is that the applications will be filed, and correspondence will be conducted in the Russian language, which will cut expenses for translation. Translation will be required only in case of a dispute regarding infringement of the design or its invalidation in a given country.

In fact, all procedural steps have been made, and the Eurasian Patent Office announced that applicants may file design applications from June 1, 2021.

Trademarks

The Eurasian Patent Office does not deal with trademarks though the issue of a Eurasian trademark has been discussed for quite a while. Without the connection to the Eurasian Patent Office, the Eurasian Trademark Treaty has been recently signed by several countries. These are Armenia, Belarus, Kazakhstan, Kyrgyzstan and Russia. These countries are members of a separate organisation - the Eurasian Economic Union. As may be noticed, all these countries are also members of the Eurasian Patent Organisation. The members of the Eurasian Economic Union are focused on economic cooperation. Availability of a common trademark will enhance their economic interaction and will be welcome by applicants.

The “**Treaty on Trademarks, Service Marks and Appellations of Origin of the Eurasian Economic Union**” was signed in Moscow on February 3, 2020

As of March 2021, all five countries ratified the Treaty.

One may notice that the process of implementation of the Treaty is steady but relatively slow. Though they understand the importance of moving forward with the common trademark, the participating countries have other pressing issues that get ahead of the implementation of the Treaty.

Procedures described in the Treaty may seem cumbersome. Not so much for the applicant but for the patent offices of the member countries because the patent offices will have to do duplicating work associated with the examination of a trademark application.

The Eurasian Economic Commission will handle the registration of the Eurasian trademarks.

In theory, the registration procedures may be streamlined. There was a conference at the Russian patent office in November 2020. Mrs Tlevlesova, head of the Eurasian Patent Office, took part in the conference; she was one of the speakers. In her report, she carefully voiced a proposal to take the Eurasian Trademark under the aegis of the Eurasian Patent Office. She said that the way to implementation of that idea might be too long. It should also be noted that there are more countries in the Eurasian Patent Organisation than in the Eurasian Economic Union which may be an additional hurdle towards the realisation of that idea.