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The Unitary Patent era is about to begin: what to expect?



Marisol Cardoso, Patent Consultant at Inventa, informs us of the expectations for the implementation of the Unitary Patent across the EU member states with crucial advice for filing.



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AI patent eligibility

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**Patenting the
Metaverse**

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Unity of invention in the light of PCT, EAPC and Russian Law

Sergey Kalachev, Deputy Head of the Chemical & Life Sciences Department at Gorodissky & Partners, reviews the differing regulations of the PCT, Eurasian and Russian law to provide an overview of which lends best to which type of application.

The Patent Cooperation Treaty (PCT) and the Regulations is a flexible structure, providing vast opportunities to applicants for obtaining legal protection for inventions in many countries via a most convenient, economical, and efficient way.

According to Article 27 of the PCT, no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those provided by the PCT and the Regulations. At the same time, if the national law in respect of the form or contents of national applications is more favorable than the PCT requirements from the viewpoint of applicants, the national competent body may apply the national requirements, instead of the PCT requirements, to international applications. However, the applicant may insist on using the PCT requirements.

The unity of invention is one of the matters allowing applicants to use alternative criteria for assessing fulfilment of the requirement either

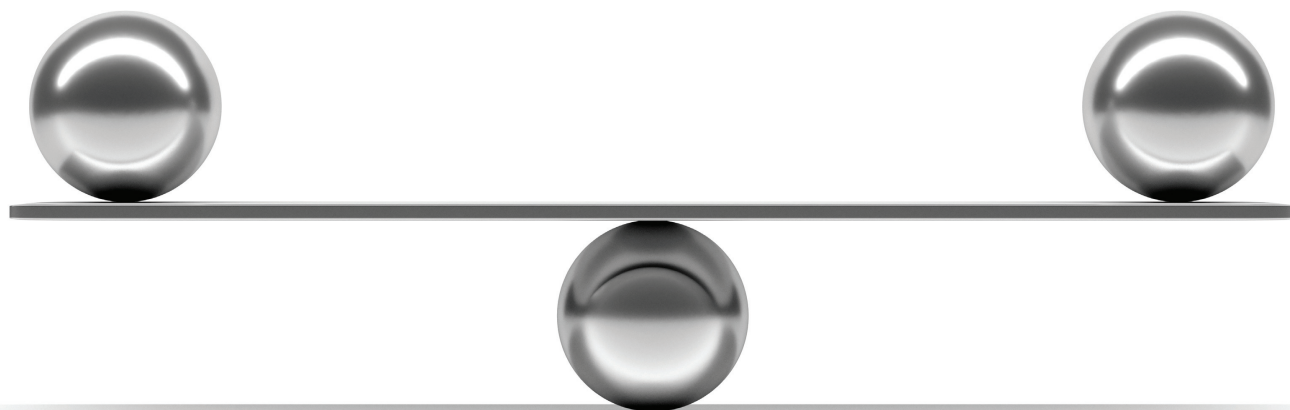
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This fact is undoubtedly sufficient for considering such features as special ones.
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under the PCT Regulations or the national legislation, which differ to some extent.

According to Rule 13.2 of the PCT Regulations, in case of a group of inventions, the requirement of unity of invention is fulfilled only when there is technical relationship between the claimed inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

According to the Russian patent regulations, the unity of invention requirement is considered to be complied with in respect to a claimed group of inventions if a set of claims characterizes a group of inventions interrelated to each other as follows:

- one of which is intended to obtain (produce) another one;
- one of which is intended for implementing another one;



- one of which is intended for the use of another one (in another one);
- claimed inventions relate to subject matters of one type, identical purpose, ensuring the attainment of one and the same technical result (variants).

PCT and Russian approaches have their own advantages and may be favorable for applicants in different circumstances.

For instance, lack of compliance of technical solutions in a claimed group of inventions with the unity of invention requirement in the PCT Regulations may be revealed at the international stage, though these inventions may comply with the unity requirement in the national law.

In particular, it relates to cases where different variants of one and the same subject-matter are claimed in an international application. Such variants usually have no common features, except a purpose, which cannot be regarded as a feature over the prior art, i.e., it cannot be considered as a special technical feature ensuring the unity of invention requirement as required by the PCT Regulations. It may be very difficult to prove features of different variants, making input over prior art correspond to each other. Thus, compliance of such group of inventions with the unity of invention according to the PCT Regulations would unlikely be recognized.

However, those variants may comply with the unity of invention requirement according to the Russian law. Moreover, processes intended for producing such variants may be claimed in the same invention group according to the national law, the processes may have no common technical features which is not admitted by the PCT Regulations. Hence, the national law provides benefits to the applicants in case of protecting a group of such kind of inventions.

At the same time, since the list of cases defining the group of inventions complying with the requirement of unity of invention in the Russian law is limited, the opposite situation is also possible, i.e., there may be a case where the use of the unity of invention criterion in the PCT Regulations is more favorable.

For instance, means of one type, having common features defining a contribution over the prior art where each has its own purpose would unlikely be recognized as complying with the unity of invention requirement in the Russian law, however they comply with the unity of invention criterion in the PCT Regulations.

Thus, selecting a more favorable criterion for assessing the unity of invention depends upon the claimed group of inventions, and which inventions in the group interest applicants most notably.

Nonetheless, when insisting on using the PCT



Thus, the Eurasian rules expand the list of possible combinations of inventions that may be recognized as complying with the unity of invention requirement over the PCT and Russian Regulations.



requirements, applicants may face problems with recognizing the unity of invention. It is caused by the fact that Russian examiners have no uniform understanding of the term "special technical feature". Nor Rospatent has set any common approach concerning this matter.

In these circumstances, Rospatent examiners often believe that features defining a contribution, which the claimed inventions make over the prior art, should not be known from the state of the art *per se*. In this regard, they rely on the criterion provided by Rule 13.2 of the PCT Regulations and conclude that a claimed group of inventions does not meet the unity of invention requirement in cases where they reveal documents disclosing features common for all inventions of a claimed group, or have doubts about novelty of one or some of the claimed inventions (in the latter case Rospatent examiners consider the whole invention as a special technical feature).

However, such interpretation of the term "special technical features" seems to be incorrect.

Definition given in Rule 13.2 of the PCT Regulations does not stipulate that such features shall not be known from the prior art at all. They shall define a contribution over the prior art. The contribution cannot be considered without taking into account the effect produced by the features. For instance, known features may produce a new technical result or serve for a new purpose, which were not previously known and can be achieved due to these features. This fact is undoubtedly sufficient for considering such features as special ones.

Furthermore, in the course of assessing novelty of inventions, the law of any country does not take into account the achieved technical result. Therefore, it is incorrect to draw a conclusion about compliance or non-compliance of the claimed group of inventions with the unity of invention requirement based on information obtained in the course of assessing compliance of inventions with the "novelty" criterion. This is also confirmed by the Russian patent regulations.

Despite the obvious incorrectness of such approach, it may be difficult to convince Rospatent examiners that the claimed group of inventions complies with the requirement of unity in the said circumstances. It is one of the main disadvantages of using the criterion provided by the PCT Regulations when assessing the unity of invention in the course of prosecution of international applications at the national stage.

Even in cases where Rospatent examiners take into account special technical features in accordance with the definition given in Rule 13.2 of the PCT Regulations, i.e., in connection with the contribution they provide over the prior art, or where the examiners agreed to take such

contribution into account upon assessing the unity of invention, problems still may arise.

Specifically, Rospatent examiners often consider special technical features of the claimed inventions and a contribution they provide over the prior art in isolation from other features, despite the fact that Rule 13.2 of the PCT Regulations explicitly states that when considering a contribution, which each of the claimed inventions makes over the prior art, each of the inventions shall be considered as a whole. This means that the whole combination of its essential features will be taken into account. In such cases, Rospatent examiners conclude that the claimed group of inventions fails to comply with the unity of invention requirement as set forth in the PCT Regulations, if they find a piece of information in the prior art that reveals special technical features of the claimed inventions and their impact on the results indicated in the application materials. This is true even if such information is related to a different field. At the same time, it may be noted that Rospatent examiners sometimes do not take into account other features of the claimed invention that could affect attaining these results.

It appears this problem results from the fact that in such cases Rospatent examiners apply the procedure foreseen by the Russian regulations for assessing the inventive step of inventions, when they assess the unity of invention. However, the unity of invention has nothing to do with the inventive step. Therefore, it seems unacceptable to apply the procedure for assessing the inventive step, when assessing the unity of invention. With all that, it may be very difficult to convince examiners to adopt this view.

As to the provisions of the Eurasian legislation, which are applicable upon entering international application into the regional Eurasian stage, they combine benefits provided by the PCT Regulations and the Russian patent law.

The Eurasian rules, when they define cases where the unity of invention requirement shall be fulfilled, almost completely correspond to those provided in the PCT Regulations. According to Rule 4 of the Patent Regulations under the Eurasian Patent Convention, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features, i.e., those technical features that define a contribution which each of the claimed inventions makes over the prior art.

At the same time, according to Clause 5.3 of the Eurasian Rules for compiling, filing and prosecuting applications variants also comply

Résumé

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Sergey graduated from the Dmitry Mendeleev University of Chemical Technology and the Russian State Academy of Intellectual Property. Sergey has been with Gorodissky & Partners since 2012, where he deals with representation of Russian and foreign chemical, petrochemical, metallurgical companies before Russian and Eurasian PTOs, advises on patenting strategy in Russia and Eurasia. His areas of particular experience include: general and non-organic chemistry and technology, physical chemistry, electro chemistry, chemistry of steel and alloy, oil chemistry, crystallography. Sergey represents clients before the Russian and Eurasian PTOs in objection cases against patent grants.



Sergey Kalachev

with the unity of invention requirement, if the technical result is attained by the claimed inventions based on the same principle.

Thus, the Eurasian rules expand the list of possible combinations of inventions that may be recognized as complying with the unity of invention requirement over the PCT and Russian Regulations.

It should be noted that sometimes the Eurasian examiners as well as their Russian colleagues consider special technical features of the claimed inventions and a contribution they provide over the prior art in isolation from other features. It appears that these problems may be caused by the absence of any indication to the necessity of considering an invention as a whole upon revealing the contribution according to Rule 4 of the Eurasian Patent Regulations. However, said Rule stipulates the contribution made by the invention, not by the features. Thus, such approach also seems to be incorrect in view of the Eurasian patent regulations. However, it may be almost impossible to persuade the Eurasian examiners to the contrary in view of absence of a common approach to this matter.

Thus, despite wide opportunities for claiming different combinations of invention in a single application, further steps are needed to harmonize the Russian and Eurasian legislation with the existing international legal systems.

“However, the unity of invention has nothing to do with the inventive step.”

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