

CHOOSING BETWEEN RUSSIA AND EURASIA

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Partly with a focus on becoming a World Trade Organization (WTO) member, Russia has been actively reforming its patent laws and regulations during the past decade. With WTO membership, Russia is now being seen as a state with a genuine drive towards establishing an efficient and reliable system for applying and enforcing patent rights.

While the national laws and regulations have been developed and clarified in Russia, it should be noted that there has been another, regional system working in parallel with the Russian national system since 1995 to apply for patents in Russia. This regional system is called the Eurasian Patent Convention (EAPC). Both systems, the RU national and the EA regional, have been strongly influenced by patent laws and regulations in the European territory. However, although both systems have been westernised, there exist several differences which should be taken into account when choosing between the two.

The obvious difference is that the EA-system covers eight countries: Turkmenistan, Belarus, Tajikistan, Russia, Kazakhstan, Azerbaijan, Kyrgyz Republic and Armenia. This coverage comes with a price tag as the official fees in the Eurasian Patent Office (EAPO) are significantly higher than in the Russian national office; especially since the Russian national office lowered its fees in 2012 in anticipation of WTO membership, which no longer allowed the office to maintain different fees for foreign and domestic applicants. As an example, the filing fee in the RU office is about \$60 while the filing fee in the EA office is about \$630 for Patent Cooperation Treaty nationalisations. Similar relative differences in official fees apply to other prosecutions as well.

Another important difference between the two offices is in the expertise of the examiners. The EA office has a tradition of serving foreign applicants in the pharmaceutical industry, and therefore its expertise in this field is potentially at a higher level than exists in the RU office. On the other hand the RU office, being a much bigger organisation with some 2,500 employees, has accumulated more versatile expertise across a wider range of technological fields.

In Russia, possibly for historical reasons, examiners are given a lot of power over the application under examination. This is also supported by the national patent regulations which may be considered as less definitive than their Eurasian counterparts, which have adopted the very clear formulation from the European Patent Convention. This difference has led to the fact that the EA office is commonly more applicant-friendly than the RU office where the examiners are very strict eg, in formal matters and in their requirements concerning sufficient support for and clarity of the claims. On average, prosecution through the RU national office requires about one more round of office actions than prosecution through the EA office.

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These differences together with the application itself determine which system would be the more advantageous one for a specific application. Complicated and long applications from the pharmaceutical field often run into two or more office actions before the examiner comments on the novelty and inventiveness of the claims. This naturally requires more work from the applicant or his representative to successfully prosecute the application. For the same reasons the time from requesting examination to a granting decision is about one year more through the national RU office than through the EA office.

The shorter and simpler the application is, the less of the overall prosecution cost comes from the work done by the applicant or his representative. Correspondingly, for shorter and simpler applications a relatively bigger proportion of the overall prosecution cost comes from the official fees in both the RU office and the EA office. Following this logic, which has also proved to be true in practice, looking at the mere cost of prosecution in Russia it would be wise to choose the RU office for shorter applications and the EA office for longer and more complicated applications. This is partly why the pharmaceutical industry and other chemistry-involved fields often prefer the regional EA route.

Naturally, financial aspects are not the only ones determining which of the two offices to choose. One should also take into account the wider geographical coverage of the EA patent as well as the expertise of the examiners in a specific field of technology. ■

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