

Upcoming amendments affecting Part IV of the Civil Code will bring some major changes to the Russian IP practice relating to patents, utility models and designs

On 25 February 2014, the Russian State Duma passed Federal Law № 35-FZ, which introduces amendments to the provisions of Parts I, II and IV of the Russian Civil Code. The amendments were approved by the Federational Council, the upper house of the Parliament of the Russian Federation, on 5 March 2014 and will be effective from 1 October 2014.

The amendments relate to such topics as patents, utility models, designs, trademarks and license agreements. This article will give an overview of the most important changes relating to patent, utility model and design patent prosecution from the applicant's point of view. It should be noted that the amended provisions will apply only to new applications filed on or after 1 October 2014. Pending applications will be examined according to the current legislation.

PATENTS AND UTILITY MODELS

Utility models – term and examination

Currently, a Russian utility model provides a reasonably strong form of protection for a new and industrially applicable product. Utility models are granted on the applicant's responsibility without examination, and can be kept in force for 13 years – which is longer than the typical maximum term of protection in European countries. After the upcoming amendments, utility models filed on or after 1 January 2015 will have a maximum term of protection of 10 years, without the possibility

of a term extension. In addition, the Russian Patent Office will conduct a substantive examination of utility model applications in order to determine the novelty.

The substantive examination will be conducted automatically, and filing a separate request for examination will not be required. Based on the examination results, the Patent Office will issue either an acceptance or a rejection decision. There will be no Office Action or any other notifications from the examination division requiring action from the applicant, so the prosecution will be kept as streamlined as possible. The applicant's possibility to appeal a rejection decision will not be changed.

The above new provisions will make utility models less attractive than before. We recommend the applicants to file utility models now to get them registered before the new provisions take effect. After the provisions have taken effect, we recommend the applicants to conduct their own search prior to filing in order to avoid a rejection decision.

Insufficient disclosure

One major addition is introduced in Art 1398, which stipulates the grounds for invalidation of a patent or utility model. After the upcoming amendments, an insufficient disclosure of the claimed invention will serve as grounds for invalidation. According to the addition, a patent or utility model application must disclose the invention in complete and sufficient details for a skilled person to implement the invention. This requirement is similar to that of article 83 of the EPC. At the moment, a patent or utility model cannot be invalidated solely on the grounds of insufficient disclosure.

Voluntary amendments

Another amendment inspired by the EPC is limiting the applicant to only one opportunity to make voluntary amendments to the description and claims. After receiving a search report relating to a Russian patent application, the applicant will have the right to amend the description and claims once. However, no time limit for the voluntary amendment has currently been given. After the voluntary amendment, only the amendments necessary to overcome the objections raised in an Office Action are allowed.

Support in drawings

Good news for all the applicants is that it will finally be possible to amend the claims based on features indicated in the drawings. At present, the addition of any features without literal support in the description is not accepted.

Office Action responses

The upcoming amendments also clarify the Office Action response due dates. A new strict term is introduced, which is three months from the issuance date of the Office Action. Thus far, the response term to an Office Action was vaguely defined and was calculated from the date of receipt of the Office Action by the applicant or their representative (patent attorney). According to the upcoming amendments, additional material, such as copies of the cited publications, can be requested by the applicant from the Patent Office within two months from the issuance date of the Office Action.

Further, the applicant will not be allowed to argue for inventiveness by showing a new, unexpected technical result provided by the invention, if that result is not indicated in the application as filed or connected to such indicated result. This provision limits the applicant's possibilities to argue for the inventiveness of the claims.

Other changes

Extension of a patent term will lead to the issuance of a new supplementary patent. The supplementary patent will differ from the original patent in that it will contain only the claims defining the product for which a marketing authorization, which serves as the grounds for the term extension, is issued. The other claims will be deleted.

One particularly interesting new provision is the amendment of Article 1379, which gives the applicant an opportunity to convert a patent or utility model application to a design patent application and vice versa. At this stage, no details are available regarding the formalities of the conversion. However, any addition of new subject matter will not be accepted when converting applications.

DESIGNS

At the moment, the scope of protection conferred by a design patent in Russia is determined by the sum of the essential features as shown in the pictures of the design and listed in the list of claimed essential features. From the beginning of October 2014, the scope of protection will be determined only on the basis of the pictures enclosed with the application and no list of claimed essential features is required anymore. This will mean that a protected design will be considered infringed if the

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infringing article comprises all essential features of the design shown in the pictures or a sum of the features of the design which give to an informed consumer the same general impression as the protected design. Another requirement of infringement will be that these articles have a similar purpose.

The definition of originality has also been revised. In addition, the grace period will be 12 months from the disclosure instead of the current grace period of 6 months.

In future, the applicant can amend the application material only in response to an Office Action, and Office Actions will have an exact response time which will be three months from the issuance date of the Office Action, in the same way as patents and utility models.

For design patent applications filed on or after 1 January 2015, the term of protection will be five years and can be renewed four times. The maximum protection period will continue to be 25 years.

SUMMARY

The forthcoming changes to the Russian Civil Code relate to patents, utility models and

designs. In the amended provisions, several terms and time limits are changed.

As for the patents, one of the most significant changes is that the applicant can now make amendments to the application based on the drawings, while being limited to only one voluntary amendment. On the other hand, the possibilities to argue for the inventiveness of a claim will be somewhat restricted. In addition, certain currently unclear provisions are clarified.

The design protection system, on the other hand, will undergo radical changes, as no list of claimed essential features will be required anymore, and the protection will be based on the pictures only.

The amendments of the Civil Code articles serve only as one further step in an attempt to modernize the Russian IP legislation and bring it closer to that of the Western jurisdictions. The practice will be largely defined by the amended regulations and it will take quite some time for things to settle down, as it was shown in 2008 when the Civil Code part IV in its present form came into force.

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