

# PATENTS

## OPPOSITION



### Papula-Nevinpat is one of the leading patent firms in Finland; why do you think this is?

During its 40 years in business, of which 25 years in Russia, Papula-Nevinpat has grown into a well-known international agency with offices in St. Petersburg, Munich, Kiev, Minsk, Tashkent and Almaty. Since 1990 we have been one of the leading Western intellectual property agencies in Russia and Eurasian countries, currently filing more than 2500 patent and trademark applications a year and representing a wide range of clients, from local emerging and mid-sized enterprises to Fortune500 companies.

### What is the most important piece of advice you give your clients who consider protecting their intellectual property in Russia?

Russia is a party in all the relevant international treaties and agreements on intellectual property. The legislation has been harmonized with the standards set forth in e.g. TRIPS. However, the interpretation of the rules and practice of the Patent Office, Rospatent, tend to constantly change. Therefore, the advice of an experienced patent or trademark attorney is invaluable. Since pirate trademark registrations are still an issue in Russia, it is advisable to register company's trademarks at an early stage and before entering the Russian market.

### What are the most important things to consider during patent opposition litigation?

The current practice of the Russian Patent Office does not permit to add to the claims features from the description during the opposition proceedings. This obviously limits the patent holder's options to amend the claims, and therefore it is recommendable to include the features providing valuable fallback positions to dependent claims during prosecution of a patent application.

**You are responsible for drafting and prosecuting patent applications and conducting patent searches in Russia and Eurasian countries. How do the rules and practice in these jurisdictions differ to those in other countries?**

Substantive issues of both the Russian patent legislation

and Eurasian Patent Convention comply with the EPC on a general level. Compared to Russia or Eurasia, the EPC with its abundant case law is clearer and leaves less room for interpretation. However, in Russia and especially Eurasia the applicant has more options to extend time limits and reinstate applications or patents. Also, an application-friendly general grace period is provided in both Russia and Eurasia, while in the EPC the grace period is given in very exceptional cases.

### What are the most common problems your clients face when prosecuting patent applications in Russia?

Adding to claims new features not having a literal support in the application as filed and paraphrasing existing features based on the amendments made in e.g. the corresponding US application is a typical problem. According to the Russian patent regulations, a feature not literally found in the original application cannot be introduced into the claims. The Russian examiners observe this rule very strictly, and paraphrasing any features is generally not allowed. Unsupported features added to amended claims are not taken into account by the examiner when assessing novelty and inventive step of a claim.

Another issue is that the examiner often requests to restrict the scope of invention to one which is sufficiently disclosed by the application materials. Previously, this requirement was referred to as industrial applicability in the Russian regulations and is similar to the requirement of sufficiency of disclosure in Western jurisdictions.

### What are the pros and cons of patent enforcement in Russia?

Although not as developed as in US or Europe, the

Continuing with our feature on Patent Oppositions, we speak to Erik Goussev, a patent attorney at Papula-Nevinpat's head office in Helsinki. The firm is a globally recognized patent, trade mark and design agency established in 1975. During Erik's seven years with Papula-Nevinpat, he has specialized in Russian and Eurasian patent legislation and patenting processes. Currently he helps the company's international clientele in prosecuting patent applications in Eurasian countries.

patent enforcement system in Russia has the benefits of being rather efficient and not very costly, even when a case goes through appeal instances – in general, each instance issues the decision within 2-4 months. A specialized IPR Court in Moscow, established in 2011 and in operation since 2013, is dedicated exclusively to IP protection cases. The IPR Court acts as a court of first instance and cassation instance for the IP cases handled by the Russian Patent Office or heard by the arbitration courts, such as patent infringement cases.

On the downside, damages and compensation awarded in Russia are rather small compared to the Western standards, and it is very difficult to sue the infringer for indirect or contributory infringement. Also, preliminary injunctions are not easily granted.

### Is there anything else you would like to add?

The accelerated examination via the Global Patent Prosecution Highway (GPPH) is a highly effective and recommendable procedure, if fast patent protection in Russia is sought. Usually the GPPH request leads to a granted Russian patent within about 4-8 months from requesting examination. There are several requirements for the procedure; most important being full correspondence of the Russian claims with the accepted claims of the foreign application filed in any other patent office participating in the GPPH program. In addition, the GPPH request shall be filed at the latest shortly after the substantive examination request, which is due three years after the international filing date. We recommend filing the GPPH request in Russia together with the substantive examination request. **LM**



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