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A potential update to the *quid pro quo* of patents? US Supreme Court to review enablement requirement in Section 112 of Patent Act



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interactive document



Paul Ratzmann and Melissa Chapman of Fishman Stewart explain the importance of having a 'proper' US patent disclosure for promoting science and the useful arts, and how a pending Supreme Court case may determine if certain disclosure strategies meet current enablement requirements.

Chinese divisional applications

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Eurasian Patent Office: Development Trends and Prospects

Dr. Alexey Vakhnin has been discussing with Dr. Grigory Ivliev, the President of the Eurasian Patent Organization, current developments in IP at EAPO. Vakhnina & Partners are glad to introduce, prepared exclusively for *The Patent Lawyer Magazine*, the summary of the essentials of the Eurasian Patent System provided by the Head of the EAPO, Dr. Ivliev, and recent innovations at the EAPO.

The Eurasian Patent Convention established the Eurasian patent system in 1994 that allowed applicants to obtain regional legal protection along with the national patent registration procedures.

The Eurasian patent system is one of the most successful integration projects throughout the Eurasian region that had been gradually developed in line with global trends, including cross-border economic links. In 2019 the competencies of the Office were broadened through the adoption of the Protocol on Industrial Designs to the Eurasian Patent Convention.

For almost 30 years the single Eurasian patent has proved itself as an important legal mechanism for the business community.

Advantages of the Eurasian patent system

The Eurasian patent system is a cost-efficient and simple procedure granting a single patent through filing a single application in a single language and paying a single set of fees, as well as involving a single Eurasian Patent attorney.

Neither additional validations nor translation of the application into national languages are required. The unified Eurasian patent for an invention is valid in eight countries since the date of its grant. It can be optionally maintained in the countries of interest to the applicant paying the annual fees only for the selected countries.

As to Eurasian designs, the regional system for industrial design protection keeps the entire advantages provided for the inventions, namely the single registration procedure and the unified



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nature of the granted patent. The protection covers seven countries (Turkmenistan is in the process of acceding the Protocol). Thus, the unified nature of the procedure remains the same for the renewal process.

Users of the system

Our regional system, with its huge geographical coverage, is being used by applicants from 133 countries around the globe.

The top-filing applicants represent the USA, Russia and European states. According to the statistics, Top-15 remains pretty stable every year. As of today, the EAPO received more than 68,000 patent applications for inventions. Annually, more than 3,600 applications are filed and more than 2,700 patents for inventions are granted. In 2022 we noted the highest patent activity level for the past 10 years.

Increasing patent activity in China is a recent trend. In terms of Eurasian applications for inventions, Chinese applicants had been 11th place three-four years ago. In 2022, China topped 5th, though the growth potential is still very significant.

The vast majority of applications, around 80%, entered the regional phase under the PCT procedure. Since July 1, 2022, the EAPO is functioning as an International Searching Authority and a Preliminary Examining Authority under the PCT which allows international applications to go through the entire lifecycle of the examination process within the regional Office.

Since June 1, 2021, the filing of applications for industrial designs is available too.

Patent quality

The Eurasian patent is a "strong" one since it is granted following the patent search and substantive examination procedures with a relevant decision. In order to guarantee the impartiality and quality of the examination results, the decision to grant a patent or refuse the application is taken by three different examiners, representing different EAPO Member States. Additional activities are implemented to ensure the diversity and the widest possible geographical representation at the EAPO. The high professional potential and qualification of EAPO examiners are provided through continuous additional training programs involving the best examiners from eight EAPO Member States.

Due to the EAPO system for managing the examination quality, as well as the opposition and appellation system, the quantity of opposition remains extremely low. Overall, we revoke around 0.04% of patents a year under the invalidation procedure.

Given the advantages of the opposition, last year we extended the deadline for submitting objections under the administrative procedure.

The Patent Law Treaty (PLT) provisions are duly implemented in the EAPO regulations. In order to increase the patent search quality, we use the Collective Patent Classification (CPC). Moreover, in cooperation with several IP Offices, EAPO implements the Patent Prosecution Highway (PPH) programs.

Digitalization

The EAPO is a highly digitalized IP Office, including the paperless patent workflow within the Office since 2015. Furthermore, in 2022, we initiated granting electronic titles of protection,

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that are available in users' personal accounts, as well as on web-portal.

We adapt the processing and examination of applications as well as our administrative procedures taking into account digital technological capabilities. Since November 1, we provide another high-tech opportunity for disclosing the nature of inventions and industrial designs in Eurasian applications, based on the World Intellectual Property Organization (WIPO) Standard ST. 91 on 3D models and 3D images. Thus, the application materials can contain 3D visual representations of objects for IP rights protection. This provides applicants with a great opportunity to demonstrate the unique features and properties of their IP rights more accurately and clearly.

We develop and enhance our information systems to make e-services as convenient as possible and meet the needs of applicants.

Development prospects

We aim to reveal the entire potential of the regional integration related to IP. The EAPO possesses ambitious development plans based on the interests of its Member States. We rely on their support and reflect the needs and demands of applicants from all over the world.

The EAPO adopted measures to optimize the examination of Eurasian applications, improve examination quality and make the process of regional patenting more attractive to Eurasian and foreign applicants. We are currently expanding the EAPO Pharmaceutical Register (Pharm Register) by adding national patents – the relevant decisions have already been taken by the EAPO governing bodies and national patents have already been included in the Register.

We are now working on joining the Hague System for the International Registration of Industrial Designs. Its Geneva Act permits the accession to the Hague System by an inter-governmental organization. The EAPO's accession to the Hague System will increase the worldwide accessibility of the Eurasian System for the Legal Protection of Industrial Designs. The EAPO Member States had already expressed their support of this initiative and we are now carrying out consultations with WIPO on the procedural and legal aspects of the accession.

Furthermore, we are ready, with the support of the EAPO Member States, to expand the number of regionally protected IP rights, i.e. to create a Eurasian registration system for trademarks and utility models.

The Eurasian Economic Union (EAEU) regional trademark registration system is currently under development. The relevant Treaty came into force in April 2021, at the same time, the procedural framework is still on the way. We believe that the system has a significant

Résumés

Dr. Grigory Ivliev

Dr. Grigory Ivliev has served as the EAPO President since February 11, 2022. He is a Former Head of the Federal Service for Intellectual Property (Rospatent).

Eurasian Patent Office (EAPO) is an executive body of the Eurasian Patent Organization, administering the regional patent registration system, covering eight countries of the Eurasian region.

Member States: **Azerbaijan, Armenia, Belarus, Kazakhstan, Kyrgyzstan, Russia, Tajikistan, Turkmenistan.**

Objects for IP rights protection: inventions and industrial designs.

Dr. Alexey Vakhnin

Dr. Alexey Vakhnin is a Eurasian Patent Attorney, Patent and Trademark Attorney of the Russian Federation, Partner and Managing Director of Vakhnina and Partners.

Dr. Vakhnin is Vice-president of the Chamber of Patent Attorneys of the Russian Federation; member of INTA, FICPI, AIPPI, LES Russia/LESI, PTMG, ECTA etc.



Dr. Grigory Ivliev,
President of the Eurasian
Patent Organization

potential for further development, since the EAEU trademark, in its current state, has no single nature – each of the five competent national Offices decides on whether to grant protection or not and collects its national fees according to the rates specified in the Treaty.

From our perspective, it is vitally important to identify a single Office to administer this System. The EAPO could play the role of such an Office.

Ensuring the regional judicial protection of IP rights is now crucially important. With the growing number of objects for IP rights protection and related transactions, the number of disputes increases as well, and their technical complexity also steadily rises. We are promoting initiatives aimed at improving the dispute resolution system for Eurasian IP rights and creating a single jurisdiction for their consideration. We are not limited to judicial mechanisms and also studying the modalities of introducing Eurasian arbitration and mediation to resolve IP-related disputes.

The EAPO is cooperating with Uzbekistan and Mongolia to engage them in integration projects and further expand the coverage of the Eurasian patent system.

Since 2022, the EAPO has been holding its international conference entitled "IP Eurasia". On September 21, 2022, the Office held a large-scale conference dedicated to the protection of innovations in healthcare. We plan to make this conference an annual event and bring up relevant topics for discussion.

The EAPO is happy to cooperate with all interested organizations. We are convinced that the IP system is the basis for the development and progress of society in all countries. The Office offers the applicants a convenient regional patenting service. Now we can proudly say that we built a single Eurasian ecosystem with a population of more than 208 million and more than 1.8 trillion US dollars GDP. The needs and demands of the



applicants and rightsholders are our priority. In our work, we strictly adhere to the provisions of international treaties related to IP, and we are ready to collaborate with the applicants and rightsholders to ensure strong IP protection in the Eurasian region.

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