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Intellectual Property

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## CHANGES IN ACTIVITIES OF THE EURASIAN PATENT ORGANIZATION (EAPO)

Effective as of November 01, 2022, a new edition of the Patent Regulations under the Eurasian Patent Convention<sup>1</sup> (“Patent Regulations”) will come into effect, and some changes relate to inventions, some to industrial designs, and some encompass both types of intellectual property.

There have also been a number of changes to the EAPO this year that are important for planning your patent strategy and related costs.

The AGP IP team has prepared a newsletter with up-to-date information.

### I. General changes pertaining to EAPO

#### 1. EAPO – NEW INTERNATIONAL SEARCHING AUTHORITY

It is essential for the applicant to make sure that the registration process is as fast as possible and covers at once the necessary list of countries in which protection of the invention or design is required. In order to accelerate the process of obtaining legal protection in several countries simultaneously, applicants choose to file international applications under the Patent Cooperation Treaty (PCT applications) since a single application allows the applicant to proceed subsequently to the National Phase in any of the 156 countries of interest to the applicant. If the applicant is interested in obtaining the legal protection of inventions/industrial designs in the post-Soviet countries, it is more convenient not to apply to the national patent office of each individual country, but to file a single Eurasian patent application with the Eurasian Patent Office (EAPO) for obtaining the legal protection in any of the 8 member countries of the EAPO (Armenia, Azerbaijan, Belarus, Turkmenistan, Kazakhstan, Kyrgyzstan, Russia, Tajikistan).

Since 01.07.2022, the EAPO acts as the International Searching Authority. This means that it is possible to assess the chances of successful registration of Eurasian patent applications and, if necessary, to adjust the claims not only through national patent offices (for example, the Federal Service for Intellectual Property (Rospatent Agency) in the Russian Federation), but also directly through the EAPO.

In addition, there is an opportunity to reduce the cost of paying patent fees.

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<sup>1</sup> Patent Regulations under the Eurasian Patent Convention, approved by the Administrative Council of the EAPO at its 37th (10th extraordinary) meeting on April 12, 2021.



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Once the EAPO is selected as the International Searching Authority, a 40% discount is applicable to the single procedural fee for filing Eurasian applications.

For comparison, if the search is carried out by another International Searching Authority, the discount on the single procedural fee will be 25%. And if no search is carried out, the single procedural fee will have to be paid in full.

## 2. *EAPO И PPH PROGRAMS*

The PPH program is a fast-track prosecution management program that allows you to obtain a patent faster by using the results of searches, examinations conducted at patent offices of the member countries.

When planning for patenting abroad, it is essential to consider the following current information on the operation of the program.

The European and Japanese patent offices have suspended the bilateral agreements concerning accelerated prosecution with the EAPO. However, the EAPO continues operating these programs unilaterally. Applicants can use the European and Japanese patent office's products for accelerated prosecution of their applications at the EAPO.

As of December 01, 2022, the U.S. Patent and Trademark Office will suspended the PPH program with the Russian side. Filing of any new applications under the PPH program in the United States will no longer be possible and all previously filed PPH applications will be converted to regular applications, which will result in lengthened timeframes for the patenting process.

The PPH program with the Finnish Patent Office will continue until July 31, 2023.

The PPH program with the patent offices of the Republic of Korea and the People's Republic of China remains in effect.

PPH agreements with the patent offices of Brazil and India are under negotiation.

## 3. *ELECTRONIC WORKFLOW*

The EAPO is a progressive organization which is gradually transitioning to a full electronic workflow.

From May 01, 2022, the EAPO has been issuing Eurasian patents electronically concurrently with paper-based patents.



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From November 01, 2022 it will be possible to obtain a paper-based Eurasian patent only upon submission of a separate request for a hard copy. No payment of any fee or charge for submission of such request is required.

Issuance of hard copies will continue for confirmation of assignments or transfers or other disposal of the exclusive rights to inventions and industrial designs, but transition to the electronic workflow format is planned for such confirmation as well in the foreseeable future.

## **II. Changes to the Patent Regulations pertaining to inventions and industrial designs**

### *1. 3D MODELS*

One of the innovations is the option to submit 3D images together with the application documents for invention and industrial design. A 3D model can be submitted at any phase of the application.

According to the changes coming into effect, 3D models will only serve for providing additional explanatory information on the essence of an invention or industrial design through its visualization.

The EAPO's Patent Regulations stipulate the cases where a 3D model is not acknowledged as part of the application documents, namely for the purpose of preparing certified copies (1) under the procedure for converting an Eurasian application into a national application, (2) for priority claiming purposes, (3) upon a request of judicial authorities. In addition, a 3D model is not acknowledged as part of the application during examination of an invalidation action concerning an Eurasian patent.

This innovation means that a 3D model can not be used, for example, as a basis for disputing an application or an argument for making amendments to the same.

In this regard, it is crucial that any distinctive features depicted in a 3D model be shown in the claims, the description and the accompanying images of an invention or utility model.

The use of 3D models is a positive trend in the development of legal regulation. Probably, provisions on 3D models will come up in the legislation not only of the Russian Federation, but also of the other EAPO member countries in the foreseeable future.

### *2. Administrative invalidation of Eurasian patents*

The EAPO applies two patent invalidation procedures, namely when:



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- 1) a third party files with the EAPO an opposition against granting a patent. In this case, the decision will apply to all the contracting countries;
- 2) a third party files with a national patent office an opposition against granting a patent. In this case, the decision will apply to the corresponding country only.

Starting from November 01, 2022, the period for filing an opposition against granting an Eurasian Patent with the EAPO, i.e. according to procedure (1), has been increased from 6 months to 9 months of the date of publication of the information on granting of the Eurasian Patent.

If the deadline under procedure (1) has been missed, it is still possible to file an opposition with a national patent office.

### III. Changes to the Patent Regulations pertaining to inventions

#### 1. *Amending an invention patent application*

The earlier edition of the Patent Regulations allowed amending the claims before the date of (1) sending to the Applicant a notice of readiness to grant an Eurasian patent or (2) a Refusal to grant an Eurasian patent. Amendments to a description of invention were allowed before the date of issuance of a decision to grant or a Refusal to grant an Eurasian patent.

In practice, such approach led to a delay in the review of documents and the need to perform a double work, because when the Applicant made amendments to the agreed claims and description of an invention it was necessary to review anew the documents that seemed to have already been agreed.

Starting from November 01, 2022, any amendments to the claims and, if necessary, to a description of invention are allowed only in case of filing an opposition against the EAPO's Refusal to grant an Eurasian patent or an opposition against granting an Eurasian patent under the procedure of administrative patent invalidation.

We believe that such change will accelerate the final phase of the procedure for granting an Eurasian patent, while preserving the right of the Applicant to make amendments where they are objectively required for obtaining a proper Eurasian patent.

#### 2. *Divisional invention patent application*

Under Rule 45 of the Patent Regulations, if the claims of a divisional application disclose an invention which is identical in terms of the protection scope sought to invention disclosed in the claims of the originally filed application, a notice with a proposal to submit the amended claims is to be given to the Applicant.



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From November 01, 2022, the period for submission of amended claims in connection with a divisional application is 2 months from the date of the relevant notice. If no amended claims are submitted by the deadline, such Eurasian application will be considered withdrawn.

This period is not subject to the provisions of Rule 37 of the Patent Regulations pertaining to the extension of time and filing a request to continue prosecution of the application.

Therefore, an interested party has more time to review an invention application and prepare an opposition against granting the legal protection to the invention.

#### **IV. Changes to the Patent Regulations pertaining to industrial designs**

##### *1. Change to the definition of an industrial design*

Under the new edition of Rule 78 (1) of the Patent Regulations, a patentable design means a *solution of exterior appearance of an article of industrial or handicraft production*, which in its essential features is novel and original.

The previous definition also referred to the two criteria for patentability of a claimed industrial design: novelty and originality.

In fact, the change (see the *text in italics*) to Rule 78(1) does not change anything and was made just to harmonize this provision with Article 3(1) of the Protocol.

##### *2. Indication of unprotected elements*

Under the new edition of Rule 96 (3) of the Patent Regulations, an unprotected element can be indicated not only with a dotted line, as it was before, but also with color.

It is believed that such innovation will make it clearer to an examiner and a third party which part of the design is to be protected and which part of the design is to be disclaimed.

##### *3. Substantive examination*

Under the new edition of Rule 111 of EAPO's Patent Regulations, examiners will be more thorough as the scope of examination is expanded. Now, Examiners will also check, among other things:

- (1) with respect to each design claimed in an Eurasian design application, whether or not it relates to solutions or items incorporating, reproducing or imitating the official names or images of cultural (including ethnic and religious) heritage items or their recognizable parts, as well as



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- (2) with respect to each design claimed in an Eurasian design application, whether or not it relates to solutions, in respect of which it is obvious that their essential features are not due to the creative nature of the claimed specific features of an article, as provided for under Rule 78(3) of the Patent Regulations.

## V. Higher fees charged by EAPO

The EAPO will increase its fees effective as of January 01, 2023. Under the new edition of the EAPO's Statute on Fees<sup>2</sup>, such increase will extend to the single procedural fee, the fee for registration and issuance of Eurasian patents, as well as for maintenance of patents in effect.

In this regard, if you are going to file an application with the EAPO or if the deadline for payment of maintenance fees for Eurasian patents is nearing, it is highly recommended to perform relevant actions before the end of this year.

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For more details on Eurasian registrations, you are welcome to contact the AGP Intellectual Property team.

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<sup>2</sup> Statute on Fees of the Eurasian Patent Organization for legally significant and other actions performed in respect of Eurasian invention patent applications and Eurasian invention patents.