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Russia Changes Law For Considering Administrative IP Disputes

By Kirill Osipov and Kseniya Ignatovich ¹

Introduction

New rules for considering administrative disputes in the field of intellectual property came into effect on September 6, 2020. This was a long-expected event because the previous version of such regulations was dated 2003, while several changes in Russian patent law and practice have occurred since 2003. The new rules reflect a number of things that were not addressed in the old rules, but took place in practice, as well as some procedural innovations. Below we present a summary of distinctions of the new rules over the old rules.

E-communication

The new rules provide for parties of a dispute to widely use electronic communications with the Chamber for Patent Disputes (CPD), a special department of the Russian Patent and Trademark Office (Rospatent) which considers nullity actions and notices of opposition. In addition to the opportunity of the parties to participate in the CPD's sessions by means of a remote (online) access, now the Rospatent shall:

- (i) publish a list of specialists who can be in the CPD board to consider disputes on the Rospatent's official web-site;
- (ii) provide the opportunity for an opposer to file a nullity action \ notice of opposition in the e-form via the Rospatent's official web-site. In case an action is filed in a hard (paper) form, the action materials shall be supplemented with a machine readable storage medium containing a copy of the action along with all annexes thereto in pdf format;
- (iii) provide access for parties to action materials on the Rospatent's official web-site; and
- (iv) notify parties of consideration of the dispute by email if the parties have filed a corresponding request. Before the new rules, any information of the dispute (notification on the date of the hearing, etc.) was provided by the Rospatent by regular mail.

Timescale and stages of prosecution

The new rules establish a strict timeline and stages for consideration of disputes. A nullity action \ notice of opposition shall be registered by the Rospatent within five business days from the filing date. The action shall then undergo formal examination, at which time the action shall

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be analyzed for compliance with formalistic requirements within five business days. In case any drawbacks are discovered, an office action shall be issued and forwarded to the party with invitation to eliminate the drawbacks within two months. Said term cannot be extended and if the party fails to bring the action materials into line with applicable law, then the action shall be rejected for further prosecution.

The duly executed action shall be admitted for consideration within five business days or ten business days (if such action was submitted in the response to the above-mentioned office action). The first session of the CPD shall be scheduled for no later than one month (in case of opposing the Rospatent's decisions such as a notice of allowance, a rejection decision, etc.) or two months (in case of challenging a patent, trademark) from the date of admitting the action for consideration.

A rightholder's response to an action shall be submitted no later than ten business days before the date of the CPD's session.

Each of the parties (e.g. an opposer and a rightholder) may file a request to have the hearing postponed. The maximal term of postponement in this case is two months. If the CPD board considering a dispute needs to seek an opinion of an independent expert on any question raised during consideration, the hearing may be postponed for three months at the most.

After the hearing at which the CPD board has made a conclusion on a nullity action \ notice of opposition, the Rospatent's written decision shall be prepared and approved by the Rospatent's Head within two months. The Rospatent's Head may reject the conclusion made by the CPD board and may forward the action for reconsideration by the other CPD board.

The consideration of a dispute may be suspended at the request of the party or by the decision of the CPD board if there are parallel proceedings (administrative or court) for another case, the decision on which may be important for results of consideration of the dispute. In this event, the dispute shall be suspended until the decision in the parallel proceedings is issued and comes into effect. The same is applicable when interim measures are in place for the intellectual property in dispute.

Rights of the parties and the CPD board

The new rules clearly arrange procedural rights of the parties and of the CPD board themselves.

Any of the parties may file a request to recuse a CPD board member. The rules prohibit membership in the CPD board for those persons who are related to one of the parties or their representatives who participated in the consideration of the relevant application at the stage of the pre-grant prosecution, as well as persons who have direct or indirect interest in the outcome of the case or about whom other circumstances are known that raise doubts about their objectivity and impartiality.

The most important (in our opinion) development is that a party filing a nullity action \ notice of opposition (an opposer) now is allowed to submit additional arguments and pieces of evidence

supporting the action, which was clearly prohibited by the old regulations. According to the newly effective rules, the opposer may make such new submissions at any time before the CPD board goes to the deliberation room to make a conclusion on the action. In the case of new submissions, the CPD board shall provide the other party with the opportunity to present a response thereto.

The new rules reflect the following rights of the patentee already provided for by the effective Russian Civil Code, part IV (concerns intellectual property issues):

- to request amendment of the patent protection scope in an attempt to keep the patent partially, if the patent shall be deemed invalid entirely without such amendment. The rules state that such amendment shall be in line with Article 1378 of the Russian Civil Code provided that the amendment does not result in extension of the patent protection scope;
- to request conversion of an invention patent being contested into a patent on a utility model, e.g. in an attempt to overcome the inventive step objection, which, under Russian law, is not applicable for utility models in contrast with inventions. The opportunity for such a conversion is stipulated by Article 1398(3) of the Russian Civil Code.

The first of the mentioned rights is of special interest. It is established with reference to Article 1378 of the Code, which Article relates to amending patent application materials, i.e., it concerns amendments at the pre-grant prosecution stage. According to the Article, in case of amending the application materials, amendments shall not change the essence of the application, the amended materials being deemed to change the essence of the application if:

- a new invention which lacks unity with the initially claimed invention(s) is claimed;
- a new feature introduced into the claims does not have literal support in the original application materials;
- a new technical result is declared as provided by the claimed invention, which technical result is not connected with the initially indicated technical result(s).

Thus, Article 1378 of the Code envisages the opportunity to amend claims on the basis of the specification. It is worth noting that the old rules also referred to Russian legal acts which related to the pre-grant prosecution stage and, as a consequence, which stipulated that claims might be amended given features disclosed in the specification. However, the Russian IP Court limited said provision to be applicable at the post-grant prosecution and established that granted claims of a patent under contesting might be amended only with features of the claims (e.g. to specify an independent claim with a feature of a dependent one) because specifying claims of a granted patent on the basis of the specification would have resulted in claiming new subject matter (e.g. the Court's rulings in cases of 2013 and 2015, namely SIP-436/2013, SIP-32/2015 as well as in later cases SIP-240/2015, SIP-751/2016, SIP-109/2017, etc.). Whether or not that case law will be kept in force when applying the new rules will become clear after some practice of the Rospatent and the IP Court.

The rules also arrange rights that the CPD boards have during consideration of a dispute. Among them, it should be emphasized that the new regulations enable the CPD board to find by themselves grounds to revoke IP rights, which was not covered by the old law, as the established court practice limited the CPD board to consider only arguments set down in a nullity action (SIP-67/2014, SIP-102/2016, SIP-158/2016, SIP-162/2016, SIP-263/2016, SIP-151/2019). If the CPD board finds such grounds, they shall require the parties to submit their opinions thereon.

Apart from this, the CPD board may seek an opinion from an independent expert skilled in the field of art to which the disputed intellectual property relates. It is to be noted that previously the boards were reluctant to take such independent specialists' opinions into account when forming conclusions on the action.

At the same time, the new rules seem to deny parties a particular right to submit a special opinion at/after a hearing with comments on discussion that took place at the hearing (which right was clearly provided for by the old regulations); however, it is likely the opportunity for such commenting is covered by the parties' general right to present explanations on circumstances of a case, including explanations in written form, as set forth in the new rules. The CPD board's members keep their right to provide a special (dissenting) opinion.

Conclusion

It can be seen from the above summary that the new regulations significantly adjust the procedure of considering intellectual property disputes at the Russian Patent and Trademark Office by specifying procedural rights of rightholders, opposers and the CPD board itself, making consideration terms well-established and the consideration itself more transparent. This eliminates certain drawbacks and ambiguity from the proceedings as regulated by the old rules. We believe that the new rules will contribute to setting an optimal balance between the rights of all persons involved in such actions concerning intellectual property in Russia.

References

Order of the Russian Ministry of Science and Higher Education No. 644 and of the Russian Ministry of Economic Development No. 261 of April 30, 2020 "On Adopting the Rules for Considering and Resolving by the Federal Executive Authority on Intellectual Property Disputes in an Administrative Manner."