

Response of the Russian Federation to WIPO Circular

C.8403 dated December 15, 2014

Summary

The legal framework for protection of inventions in the Russian Federation is established by the Civil Code of the Russian Federation¹ (hereinafter the “Code”). The Code was amended in 2014. For the first time, the requirement of sufficiency of disclosure was introduced in the Russian legislation as a criterion for granting legal protection to inventions.

Inventions are granted legal protection under certain conditions established by the Code, in particular a claimed invention must be new, industrially applicable and involve an inventive step (condition for patentability), and the essence of the claimed invention must be disclosed in application documents with sufficient detail for its implementation by a person skilled in the art (requirement of sufficiency of disclosure). Furthermore, the essence of the invention in the Russian legislation is understood to mean the totality of the essential features of the invention which should be sufficient to achieve the technical result specified by the applicant.

The requirement of sufficiency of disclosure in the application covers the description, claims and drawings (if any) submitted on the date of filing. However, Article 1375 of the Code contains general provisions concerning the content of application documents: (a) the description must disclose the essence of the invention in sufficient detail for its implementation by a person skilled in the art; (b) the claim must clearly state the essence of the invention and be fully supported by the description. Drawings, according to the current legislation, form part of documents necessary for the understanding of the essence of the invention.”

The rules for compiling such documents, as established in Administrative Regulations², are focused on the disclosure of inventions in application documents with sufficient detail for the understanding of the essence of the invention by persons skilled in the art and the possibility of its implementation. In particular, the description must specify the totality of essential features of the invention, including its purpose, as well as information about the technical result which is achieved when the invention is used or implemented, and the means and methods necessary for the implementation of the

invention in the form indicated in the claim or the source of information in which such means have been disclosed previously, before the priority date of the invention, and examples of implementation of the invention. If the set of essential features includes a generic term, the description must include examples of implementation of versions of the invention indicating particular forms of implementing the feature in question.

Non-conformity of application documents with the requirement of “sufficiency of disclosure” of the invention shall lead to refusal of legal protection of invention (Article 1387 of the Code) or to invalidation of a previously granted patent (Article 1391 of the Code).

According to existing law a person skilled in the art is understood to mean a hypothetical person with general knowledge in the art, having access to entire prior art, and having the experience and expertise typical for such art. Furthermore, general knowledge in the art is considered to be knowledge based primarily on information contained in handbooks, monographs and textbooks.

Techniques for verifying the adequacy of disclosure of the invention in the application documents, the inventive step of the invention, and its conformity with the requirement of novelty and industrial applicability are geared towards persons skilled in the art.

An invention is considered to involve an inventive step if a person skilled in the art cannot identify known solutions having features which coincide with the distinctive features of the invention. An invention is considered also to involve an inventive step if corresponding known solutions are identified, but the knowledge of the effect of the distinctive features for the technical result claimed by the applicant is not confirmed. The method of examination on the basis of distinctive features includes: (1) identification of the closest analogue (prototype); (2) identification of features which distinguish the invention from the prototype; (3) identification within existing solutions of features which coincide with the distinctive features of the invention; and (4) analysis of such solutions with the aim to discover data which may confirm knowledge of the effect of distinctive features for the technical result claimed by the applicant.

The second applicable method of examination is based on the “problem/solution” principle.

The examiner has the right to choose the most applicable method of examination.

Furthermore, according to the existing legislation, any objection by the examiner concerning, in particular, non-conformity with the requirement of sufficiency of disclosure of the invention or lack of inventive step must be supported by technical arguments with references to technical literature. References to technical literature are not required only if the arguments of the examiner are based on common knowledge in a specific field of art.

The existing practice of using the above methods of examination of inventions is described in the set forth in the document issued by the Office: “Guide on Examination of Applications for Inventions”.

Regulations and Guidance Documents

Civil Code of the Russian Federation

URL:

<http://www1.fips.ru/wps/wcm/connect/2702c7804e2e0255aa93ae4d80890bf7/gkrf.pdf?MOD=AJPERES>

Administrative Regulations on the Execution by the Federal Service for Intellectual Property, Patents and Trademarks of the Government Function of Receiving Applications for Inventions and their Consideration, Examination and Issuance of Patents for Inventions of the Russian Federation According to the Established Procedure (Approved by Resolution of the Ministry of Education and Science of the Russian Federation No. 327 dated October 29, 2008)

URL:

http://www1.fips.ru/wps/wcm/connect/content_ru/ru/documents/russian_laws/order_minobr/administrative_regulations/test_8

Guide on Examination of Applications for Inventions (Approved by Resolution of Rospatent No. 87 dated July 25, 2011 with Amendments No. 1 dated January 10, 2013 and No. 2 dated January 14, 2014)

URL:

http://www1.fips.ru/wps/wcm/connect/content_ru/ru/inventions_utility_models/ruk_ezp_iz_3_6