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HOW TO EXTEND YOUR PATENT TERMS IN RUSSIA

By Satu Lehesranta

Patent term extensions (PTEs) have been available in Russia since 2003 for patents related to medicaments, pesticides or agricultural chemicals. These products typically require extensive and time-consuming tests to show that they're safe and effective before a marketing authorisation is granted. A patent term extension compensates for the time lost in conducting these tests.

"Patent term extensions in Russia are like the supplementary protection certificates we use in Europe," says Lehesranta. "Before 2015, the full scope of a patent claim could be extended in Russia, including all possible embodiments. This has since changed. Now the Russian patent office is issuing supplementary patents with a limited scope to replace the scope of the underlying patents after their 20-year term has expired."

Filing PTEs with Rospatent

Extension requests for Russian patents granted by the country's patent office, Rospatent, have to be filed with the same office. Requests must include claims for the supplementary patent, as well as accompanying documents describing in detail how the features of the claims are related to the commercial product for which the marketing authorization has been granted. Product and use claims are eligible for PTEs, but method claims are not.

Requests must be filed with Rospatent six months from the date of obtaining the marketing authorisation, or six months from the date of issue of the patent – whichever expires later. It's possible to obtain an extension for more than one patent on the basis of a single marketing authorisation.

"There's no need to select a single patent to be extended for a single marketing authorisation," says Lehesranta. "We're aware of a case where PTE requests have been filed for four different patents on the basis of the same marketing authorisation for a product that was approved in Russia in 2010. At least two of these have already been granted."

"Something that seems to be getting much stricter is that Rospatent tends to limit the claims of supplementary patents very close to the approved product. They typically do this by requesting that

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the features present in the product be included in the claims of the supplementary patents. Quite often Rospatent may issue one or more office actions during the PTE application proceedings," she says.

Dealing with amendments and rejections

To avoid the possibility of amendments being requested, supplementary patent claims should not contain alternatives. Neither should they contain Markush claims defining various compounds – claims should be limited to the specific compound used in the approved product. If a claim relates to a composition comprising an antigen, for example, then that antigen should be defined as the specific one used in the approved product.

"Rospatent may reject a PTE request if it considers that independent claims are unduly broad and cannot be narrowed in the way that they'd like. For instance, when the claims of the patent do not contain features that should be used for narrowing the claims. Or if an active agent is covered by a Markush claim, but the spec does not contain examples of its preparation and its biological activity data," says Lehesranta.

If Rospatent does reject a PTE request, the decision can be appealed to the IP court within three months. The court can then either reject the PTE or compel Rospatent to grant it, in which case the new claims are published under the original patent number.

Filing PTEs with the Eurasian Patent Office

The Eurasian Patent Office (EAPO) grants Eurasian patents that may cover Russia as well as several other Eurasian countries. EAPO also grants PTEs for patents that cover Russia.

EAPO examines and grants PTEs covering individual countries according to the national regulations of each country the patent covers. As such, for Eurasian patents in force in Russia, PTE requests have to be filed with the EAPO.

“The process of filing a PTE request with EAPO is similar to the process with Rospatent. The claims that are eligible for extension are similar too,” says Lehesranta. “One needs to supply a copy of the marketing authorisation. The request should be also be accompanied by a letter describing in detail how the features of the claims are related to the commercial product.”

There is however one major difference between the PTEs granted by EAPO and those granted by Rospatent. When a Eurasian patent that covers Russia is

extended, a supplementary patent with its own claims – which are typically limited – is not issued. Instead, the Eurasian patent office issues a supplement to the patent in which the extended claims of the patent and the approved product are indicated.

How can you improve your chances of getting a PTE?

Whether filing a claim through Rospatent or EAPO, applicants can improve their chances of being granted a PTE by keeping a divisional application pending. This allows the pursuit of PTE claims with a narrower scope that could improve the chances of the PTE being granted.

“It’s also good to keep in mind that amendments after grant are limited to the claims as granted,” says Lehesranta. “During the patent application proceedings, it’s already a good idea to include various possible embodiments in the dependent claims, so that they can be used for limiting the independent claims covering the product during PTE examination. It’s also good to include as many embodiments and as much data as possible in the application.”



Satu Lehesranta is a European Patent Attorney at Papula-Nevinpat. She is also a partner in the company.

Prior to joining Papula-Nevinpat, Satu has worked as a researcher in various projects in the bio field in 2000 – 2010, e.g. at the University of Helsinki. She has also authored a number of scientific publications and is one of the inventors in several patent applications.

Satu first started her intellectual property career in 2010 at Papula-Nevinpat. Satu is responsible for various assignments involving drafting patent applications, patenting in Finland and abroad and consulting clients in patenting matters.



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