Divisional Practice in the BRICs and other Countries
- Part 5 of a 9-Part Series: Russia

Wednesday, December 18, 2013

Divisional Practice in Russia

In Russia, a divisional patent application can be filed voluntarily without any connection to any rejection contained in an Office Action (such as a lack of unity rejection). In other words, a divisional application can be filed for any reason.

Time Period for Filing a Divisional Application

A divisional application can be filed at any time:

1. Up until the date of issuance of a patent in a parent application (which typically occurs within 2-3 months following payment of the Grant fee); or
2. Within 6 months from the date of receipt of a Final Rejection in a parent application.

Requirements for Filing a Divisional Application

According to Articles 1374 and 1375 of the Russian Civil Code Part IV (“Code”), the requirements for filing a divisional application are as follows:

1. Submission of a copy of the specification (including the abstract), claims and drawings of the divisional application as well as an entry form indicating the name and address of the Applicant and the inventor(s);
2. The divisional application cannot include any subject matter not disclosed in the parent application; and
3. The parent application and the divisional application cannot claim identical subject matter.

More than one divisional application can arise from a parent application.

Additionally, in accordance with current patent practice in Russia, a divisional application can be filed from a divisional application (meaning “cascading” divisionals are permitted). The priority and filing dates of each cascading divisional application will be identical to the priority and filing date of the very first (original) parent application.

Claims of a Divisional Application

A divisional application may be filed with the claims as originally filed in the parent application or PCT application. However, the claims of a divisional application filed containing the claims of a parent or PCT application will need to be amended at some point prior to issuance to ensure that neither the parent or divisional application claim identical subject matter. In other words, there should be no overlapping of claimed subject matter in the parent and the divisional application.

Double Patenting

Any patent issuing from a parent and a divisional application cannot claim the identical subject matter as this would present a double patenting problem. In order to determine whether or not double patenting exists, the claims as allowed are examined to determine whether or not identical subject matter is being claimed. Specifically, claimed subject matter will be recognized as being identical if:
1. The independent claims in the parent and divisional application are completely (100%) identical with one another; or
2. One or more independent claims in the parent or divisional application recite one or more alternatives and the one or more alternatives are identical with one or more alternatives claimed in the parent or (another) divisional application.

If two applications claim identical subject matter, an Examiner is likely to raise the issue of double patenting during the first stage of prosecution in both applications. In the situation where two applications claiming identical subject matter have the same priority date and are filed by the same Applicant, an Examiner will issue an Office Action setting a period of 12 months for the Applicant to decide which of the two applications should be allowed to proceed to grant (assuming there are no other rejections). If the Applicant does not respond to the Office Action, both applications will become abandoned.

If two applications claiming identical subject matter are owned by different Applicants, a patent may be issued with respect to only one of these applications provided that the Applicants agree to such an arrangement and execute an agreement to that effect. The agreement must be concluded within 12 months from issuance of an Office Action raising the issue of the identity of the subject matter being claimed in the two applications. The term for executing the agreement and submitting it to the Patent Office can be extended for an additional 10 months. In the absence of an agreement between the Applicants, both applications will be abandoned.

Unfortunately, there are no specific regulations that address the situation where identical subject matter is claimed in an issued patent and a pending divisional application owned by different Applicants. However, the Code contains regulations that address a situation where identical subject matter is claimed in an issued patent and pending divisional application owned by the same Applicant. In this situation, no Decision of Grant will be issued for the divisional application until the time the issued patent is revoked by the Applicant (owner).

Unfortunately, Examiners generally do not check to see whether or not identical subject matter is being claimed in a pending parent and divisional application or an issued patent and pending divisional application, especially if the identical subject matter is being claimed as one or more alternatives. Therefore, it is possible that multiple patents may issue to the same Applicant (or different Applicants) claiming identical subject matter. Thereupon, it is important for Applicants to be diligent when prosecuting divisional applications in Russia to ensure that the claims being pursued in any divisional application are not identical to any parent or other divisional application owned by the Applicant (or others).

The issuance of two patents claiming identical subject matter can be challenged in the revocation tribunal known as the “Chamber for Patent Disputes”. A revocation action can be filed by a third party at any time during the term of the patent. We are not aware of any revocation actions that have been filed on the ground that two patents claim identical subject matter. In the absence of such case law, we cannot predict the approach the tribunal might take to resolve such an action.

Examination of Divisional Applications

A divisional application is accorded the same filing date as the first parent application. However, a divisional application is treated as a new patent application filing and thus:

1. Is allotted its own (new) application number;
2. Requires payment of certain own fees (separate from the fees paid in the parent application);
3. Requires the filing of a request for examination (separate from the filing of a request for examination in the parent application);
4. Is prosecuted separately from the parent application; and
5. Results in a patent that is independent from the parent application.

The fees for a divisional patent application are the same as for any parent application. Additionally, the term of a patent issuing off of a divisional application is twenty years from the filing date of the first (original) parent application.

A divisional application is examined only when a Request for Examination (“Request”) is filed within the prescribed period (namely, thirty six months from the date of filing of the application). If a Request is not filed within time, the application will be considered withdrawn.

This is Part 5 of a nine-part series examining divisional practice in the BRIC as well as several non-BRIC countries.

To view Part 1 (Divisional Practice in Mexico), click here.

To view Part 2 (Divisional Practice in Brazil), click here.
To view Part 3 (Divisional Practice in the United States), click here.

To view Part 4 (Divisional Practice in India), click here.

To view Part 6 (Divisional Practice in China), click here.

Vladislav Ugryumov and Tatiana Lyu from Gowlings also contributed to this article.

©2018 MICHAEL BEST & FRIEDRICH LLP