Vol. 5. Is. 3

Information for citation:
Ivliev, G. P. (2022) Eurasian Court Jurisdiction – a Natural Step toward Improving the Procedures for Contesting Eurasian Patents. *European and Asian Law Review*. 5 (3), 39–44. DOI: 10.34076/27821668_2022_5_3_39.

UDC 347.779.2
BISAC LAW050020 / Civil Law
DOI: 10.34076/27821668_2022_5_3_39

Reviews and Comments

EURASIAN COURT JURISDICTION – A NATURAL STEP TOWARD IMPROVING THE PROCEDURES FOR CONTESTING EURASIAN PATENTS

GRIGORY P. IVLIEV
Eurasian Patent Organization
ORCID ID: 0000-0003-3814-3333

This paper includes a brief review of the systems for contesting decisions made by the Eurasian Patent Office regarding the issue of Eurasian patents for inventions – systems for administrative annulment of Eurasian patents for inventions and systems for invalidation of Eurasian patents for inventions by competent bodies of the Eurasian Patent Organization member states.

Based on the analysis of the two systems conducted by the author, the conclusion is drawn that it is reasonable to create a uniform regional court jurisdiction under which an efficient mechanism will be generated to appeal the decisions about issue or refusal of Eurasian patents approved by the Eurasian Patent Office, the body of the international inter-governmental organization.

Also, based on the statistics provided in the paper, the high quality of Eurasian patents for inventions issued by the Eurasian Patent Office as a result of carrying out a patent search across the global patent pool and an expert examination of Eurasian patent applications is summarized. A conclusion can be made about the need for the Eurasian Patent Office to participate in considering disputes associated with protectability of inventions protected based on the Eurasian patents that are contested in member states of the Eurasian Patent Convention. The goal of this participation will be to provide assistance to the patent owners in terms of protecting their interests regarding Eurasian patents for inventions.

Key words: *Eurasian patent, Eurasian court jurisdiction, Eurasian Patent Office, invention, appeal*

Introduction

The key task the entire intellectual property systems works on is to activate the civil circulation of the rights for results of intellectual activity.

And it is regional mechanisms for granting the rights to the results of intellectual activity, their consequent protection, including cases when the issued titles of protection are challenged by the third parties, that are critical here, particularly in the context of the common market that is currently being established within the Eurasian Economic Union.

Speaking about regional mechanisms of granting the rights to the results of intellectual activity, such an efficient mechanism was created on the territory of the Eurasian region more than twenty-five years ago based on the Eurasian Patent Convention signed in Moscow on September 9, 1994. It also embraces a mechanism for contesting decisions by the Eurasian Patent Office, which receives and considers applications for issuing Eurasian patents for inventions valid only given that there is a positive decision based on the examination results on the territory of the eight member states of the aforementioned international treaty. This paper covers their brief summary.

Discussion

It should be noted that nowadays, two systems for contesting decisions made by the Eurasian Patent Office regarding the issue of Eurasian patents for inventions are functioning: there is the system for administrative annulment of Eurasian patents and the system for invalidation of Eurasian patents on the territory of the Eurasian Patent Convention member states. The legal foundation for their existence was laid in Articles 13(1) and 19 of the European Patent Convention.

The differences between the two systems are fundamental. They manifest themselves in the bodies that adjudicate disputes regarding the protectability of inventions, in the terms during which the right for a dispute of the issued Eurasian patent can be exercised, in the applicable procedural norms, and in the legal position of a Eurasian patent in case the objection to its validity is satisfied.

In the framework of the administrative annulment procedure, a Eurasian patent for invention may be annulled in a centralized manner in all the Eurasian Patent Convention member states. To that end, an objection against issuing a Eurasian patent should be filed in the Eurasian Patent Office. The term for filing is within six months after the date when the information about the issuing the Eurasian patent was published.

Meanwhile, the norms secured in Rule 53 of the Patent Regulations under the Eurasian Patent Convention shall be considered applicable. Undoubtedly, this is a convenient system. Its main flaw in terms of protecting patent owners' rights is that the decision of the Eurasian Patent Office made based on the results of the objection consideration can be challenged only by filing an appeal with the Eurasian Patent Office itself. However, the decision made as a result of the appeal reviewed comes into force from the date it is approved by the President of the Eurasian Patent Office and it is not subject to challenge.

Within the procedure for invalidating a Eurasian patent, a Eurasian patent may be deemed invalid only on the territory of a specific state based on the results of the relevant objection considered by a competent body. The objection can be filed within the entire period of validity of a Eurasian patent, though according to Rule 54(1) of the Patent Regulations under the Eurasian Patent Convention, the norms secured in the national legislation of the relevant state, including the norms that give the right to appeal decisions made by the competent bodies judicially shall be considered applicable procedural standards.

The main drawback of this procedure is its intricacy: to contest the validity of a Eurasian patent on the territory of each Eurasian Patent Convention member state where it is in force and, therefore, to protect the rights for the patent during the dispute, one needs to appeal to the relevant competent body of each member state with an objection (application) and to undergo the procedure established by national legislation. However, a competent national body can overturn a decision by the supranational body the patent has been issued by – to deem the patent invalid or to keep its validation with an amended invention claim.

It should be said that in this case, there is no more talk about further uniformity of the Eurasian patent for an invention in terms of both its validation and the extent of protection it ensures.

The procedure for contesting decisions by the Eurasian Patent Office described above has existed for more than twenty-five years. However, the record shows the need for its further improvement, at least by establishing a uniform regional court jurisdiction within which an effective mechanism will be created to appeal the decisions made by the regional office.

It is worth emphasizing that a Eurasian patent is a patent of real validity issued based on a patent search across the global patent pool and an expert examination of Eurasian patent applications. However, in accordance with Article 15(7) of the Eurasian Patent Convention, a decision about issue or refusal of Eurasian patent shall be made by a panel of three experts who are citizens of different Eurasian Patent Convention member states. And they should be the best experts sent for work in the Eurasian Patent Office by Eurasian Patent Organization member states.

The high quality of Eurasian patents for inventions is confirmed by the statistics of applications for dispute.

As for the procedure of administrative annulment, on the average, only 0.1 % of all the Eurasian patents issued during a year are contested with an objection filed in the Eurasian Patent Office. For example, in 2021, only three objections against issuing Eurasian patents for inventions were filed in the Eurasian Patent Office. Over the first five months of 2022, only one objection was filed per the procedure of administrative annulment.

Eurasian patents for inventions are contested a bit more often in certain Eurasian Patent Convention member states, but not by much. In 2021, nine Eurasian patents were contested. Over the first five months of 2022, proceedings against three Eurasian patents were initiated.

In the period since 2017 till the present day, seventy-six objections (applications) against issuing Eurasian patents for inventions have been filed in Eurasian Patent Convention member states. Meanwhile, forty-five Eurasian patents were contested.

Eurasian patents are contested most actively on the territory of the Russian Federation. During the specified period, sixty-one objections (applications) against issuing a Eurasian have been filed in Russia. Eurasian patents are contested a bit less often on the territory of the Republic of Belarus and the Republic of Kazakhstan (in the period since 2017 to the present day, eight objections (applications) have been filed in each country).

In the Kyrgyz Republic, during the entire period of functioning of the Eurasian patent system, only one case over the dispute of a Eurasian patent for an invention has been initiated. As for other Eurasian Patent Organization member states, debates regarding protectability of the inventions protected with Eurasian patents have never arisen.

Out of forty-five Eurasian patents contested in the period since 2017 to the present day, sixteen Eurasian patents have remained valid, twenty-one Eurasian patents have been considered completely invalid, three Eurasian patents have been considered partially invalid. Five cases over Eurasian patents are currently under consideration by competent bodies (one case is in the Republic of Belarus, one – in the Republic of Kazakhstan, three – in the Russian Federation).

The analysis of practical consideration for objections resulting in invalidation of Eurasian patents by competent bodies of the Eurasian Patent Convention member states indicates the need for participation of the Eurasian Patent Office experts in considering these objections.

The reason is simple – a Eurasian patent is issued based on the regional legal norms, not national ones. Therefore, a dispute about invalidation of a Eurasian patent should be settled based on the substantive rules of the Eurasian patent law, and their application should be justified from a methodological point of view. There should not be different approaches to interpreting and applying regional legal rules on the territory of certain Eurasian Patent Convention member states.

Particular attention should be paid to these disputes in such a sensitive area as pharmaceutics. The dispute about Eurasian Patent No. 031260 for 'A Treatment for Arthritis-Caused Conditions' adjudicated on the territory of the Republic of Belarus can be cited as an example here. This Eurasian patent was deemed invalid under the pre-trial procedure in the Republic of Belarus, and currently the relevant decision by the Board of Appeals of the National Center of Intellectual Property is being appealed by the patent owner in the Supreme Court of the Republic of Belarus.

It should be noted that during the entire period of its existence, the Eurasian Patent Office as a body of the international inter-governmental organization has always adhered to the position of monitoring without direct interference into the proceedings over deeming invalid the Eurasian patents it has issued. The same position has been supported by the provisions of the national legislation of the Eurasian Patent Convention member states that do not require mandatory participation by the Eurasian Patent Office in the disputes adjudicated under the pre-trial procedure while providing judicial immunity to the Eurasian Patent Organization for the disputes adjudicated through judicial procedures.

A dispute about the application by PSK Farma Limited Liability Company regarding the refusal to extend the period of validity of Eurasian Patent No. 007251 for the invention '3-{(3R,4R)-4-methyl-3-[methyl-(7H-pyrrol[2,3-d]pyrimidine-4-yl)amino]piperidine-1-yl}-3-oxopropionitrile and its pharmaceutically acceptable salts' on the territory of the Russian Federation.

The essence of the dispute is as follows. The plaintiff considered extension of the period of validity of the indicated Eurasian patent by the Eurasian Patent Office illegal, since the validity period extension also covered the invention that went beyond the framework of the permit for application of the product protected by the patent issued by the authorized body of the Russian Federation. Without filing their own complaint regarding the dispute issue, the third party filed a request to terminate the proceedings on the case due to the lack of jurisdiction of the court for the dispute. According to them, the case was to be considered not by the court, but by the Eurasian Patent Office based on Rules 16(7) and 16(8) of the Patent Regulations under the Eurasian Patent Convention.

It should be noted that this dispute was adjudicated twice by the judicial panel of the Intellectual Property Court of original jurisdiction. For the first time, on May 26, 2021, the judicial panel of the Intellectual Property Court ruled the termination of the proceedings on the case, since the filed claim was not subject to consideration by the court according to the aforementioned rules of the Patent Regulations under the Eurasian Patent Convention. For the second time, on May 20, 2022, it adjudicated to reject the

claim by the plaintiff and to deem the previously made decision of the Eurasian Patent Office regarding extending the validity period of Eurasian Patent No. 007251 justified and legitimate.

Second trial for case No. SIP-1030/2020 by the panel of the Intellectual Property Court of original jurisdiction was determined by the decision made by the Intellectual Property Court Presidium as a result of considering the cassation appeal against the aforementioned ruling of the Intellectual Property Court regarding terminating the proceedings on the case.

In the judgment on the case dated November 22, 2021, the Intellectual Property Court Presidium, based on the provisions of Article 79 of the Constitution of the Russian Federation, noted that disputes of that category fell within the jurisdiction of the judicial authority of the Russian Federation. This position was based on the constitutional norm that did not allow executing the decisions of inter-governmental bodies within the Russian Federation made based on provisions of international treaties of the Russian Federation if interpreted in a way that contradicted the RF Constitution. As for the case in question, the Intellectual Property Court noticed a contradiction between the provisions of Rules 16(7) and 16(8) of the Patent Regulations under the Eurasian Patent Convention that provide for the administrative procedure exclusively to challenge the decision of the Eurasian Patent Office regarding extending the validity period of a Eurasian patent and Article 46 of the Constitution of the Russian Federation that guarantees judicial protection of everyone's rights and freedoms.

Aside from the aforementioned conclusion that had predetermined re-consideration of the dispute regarding Eurasian patent No. 007251 in the Intellectual Property Court of original jurisdiction, the Decree of the Presidium of the specified Court stated the conclusion that seemed no less interesting in the context of this review. The Intellectual Property Court summarized that the European Patent Organization, in accordance with cl. 7, Art. 2 of the Eurasian Patent Convention and Part 1 of Art. 251 of the Arbitration Procedural Code of the Russian Federation has judicial immunity as an international inter-governmental organization. Therefore, it may not act as a defendant or a third party in any cases associated with validity of Eurasian patents as well as with extension of their validity period.

Conclusion

Despite the conclusion provided as an example, substantiated by the legal norms and specified in the Decree of the Intellectual Property Court Presidium with regard to case No. SIP-1030/2020 dated November 22, 2021, the following is worth noting in conclusion.

Recent disputes regarding the issues of protectability of inventions protected based on Eurasian patents that had been adjudicated on the territory of the Eurasian Patent Convention member states, have shown the need for the Eurasian Patent Office to participate in their consideration. However, the Eurasian Patent Office operates on the premise of the need for active protection of the decisions it makes and for advocacy of patent owners. Therefore, it does not consider its involvement in the proceedings initiated to settle the aforementioned cases as a violation of its rights as a body of an international inter-governmental organization.

Besides, currently, the objective need for harmonizing practical application of the norms of Eurasian patent law (in particular, the norms that define protectability of inventions) by administrative and judicial bodies of the Eurasian Patent Convention state members has become urgent. It is assumed that this issue can be resolved only if the disputes regarding inventions and other item of commercial property protected based on the norms of regional law are handed over to be considered by one and the same supranational judicial authority, i.e., by creating a uniform regional court jurisdiction.

Information about the author

Grigory P. Ivliev – Honored Lawyer of the Russian Federation, Candidate of Juridical Sciences, Associate Professor, President of the Eurasian Patent Office of the Eurasian Patent Organization (2 Maly Cherkassky Lane, Moscow, 109012 Russian Federation; e-mail: Ivliev@eapo.org).

Date of Paper Receipt: August 22, 2022
Date of Paper Approval: November 1, 2022
Date of Paper Acceptance for Publishing: November 30, 2022