

**REPORT**  
**Results of comparative analysis of**  
**patent processing proceedings of EPO and Rospatent**

Within the framework of implementing Component 3 - "Patent application, registration and processing procedure" of EU -Russia Project "Approximation of EU and RF IPR aspects" the EPO made available to Rospatent Russian translations of appropriate documents, allowing Rospatent employees to become acquainted with the entire range of EPO's procedures: from filing a patent application, its transfer to search/examination as to substance and, finally, to patent granting.

The objective of activity within Component 3 of the Project is to assist Rospatent in rationalising its patent application filing, registration and processing procedures, drawing extensively on the EPO's experience.

A workshop for EPO and Rospatent experts on patent processing and automation of document processing was held on the 26th of March 2010. EPO and Rospatent experts made presentations covering all stages of application processing: its filing, formalities examination and transferring application documents for publication.

Comparative analysis and discussion of presented information have shown that document processing procedures in the EPO and Rospatent are essentially similar. However, certain differences of procedures were identified, particularly with respect to application filing and examination as to substance.

A list of subjects which, if studied further, would allow Rospatent to use EPO' experience to the benefit of Rospatent was earlier handed over to the Project Manager, Nina Formby.

In addition, a table attached herewith shows comparison results of processing procedures in the EPO and in Rospatent. Column 3 of the Table gives comments on the differences which have been identified.

**Table of Procedures Comparison**

N p/p	Convention on the Grant of European Patents (EPC), Guide for applicants "How to get a European patent, Part 1" (Guide), Implementing Regulations to the Convention on the Grant of European Patents (Regulations)	Civil Code of the Russian Federation (Code), Part IV Administrative Regulations of the Federal Service for Intellectual Property, Patents and Trademarks on organisation of the state function on receipt of applications for inventions, their consideration, examination and Russian Federation patent grant by established procedure (Rules of Procedures for Inventions- Rules)	Comments
1	2	3	4
1.	<p><b>Guide, Paragraph 107</b>                      ... you can file European patent applications <b>online</b> or on an electronic data carrier, using software issued by the EPO (Online Filing software; <i>www.epo.org</i>). You can also file European patent applications in electronic form with the competent national authorities of the contracting states which so permit. You <b>cannot</b> file European patent applications with the EPO by e-mail, telegram, telex or teletext...</p>	<p><b>Rules, par. 13.4</b>  <b>Application filed in electronic format</b>                      An application filed in electronic form with electronic-digital signature shall be registered provided all the requirements established by Rospatent on the date of the filing are observed</p>	<p>The EPO allows filing patent applications online. It provides incentives for online filing by a considerable reduction of filing fee as compared to that on paper. In Rospatent, while Rules of Procedures for Inventions provide for electronic form applications, to date patent applications are filed on paper. The procedure for online filing is being developed by Rospatent and the study of the relevant EPO experience would be useful.</p>
2.	<p><b>Guide, Paragraph 109</b>  <b>Confirmation on paper</b>                      If you file your application electronically (online or on CD-R, DVD-R or DVD+R) or by fax you do not need to supply paper confirmation, unless you are specifically asked to do it. The EPO normally requires paper confirmation only in the case of poor-quality faxed documents</p>	<p><b>Rules, par.13.1 (2)</b>                      As stipulated by par. 13.3 of these Rules if the patent documentation is received by fax its registration number is given after the original patent application has been received.</p>	<p>The EPO experience on the application registration received by fax without its confirmation by application on paper can be put to use in Rospatent.</p>

	<p>When filing paper confirmation, you should indicate clearly that the document constitutes "confirmation of a document filed on ... by fax".</p>	<p><b>Rules par. 13.3. Use of fax</b></p> <p>The originals of the application documentation, sent by fax, should be submitted within one month from the date it was received by fax together with a cover letter identifying the documents earlier received by fax.</p> <p>Provided this condition is observed, the date of fax receiving shall be deemed to be that of application documentation receipt.</p> <p>If the document original is received when the above indicated time period has expired or there is no cover letter or the document received by fax is not identical to the submitted original, the date when the original document was received shall be the date of its receiving, while the contents of the documentation received by fax shall not be further considered.</p> <p>Until the original document is submitted the faxed document is not deemed received.</p> <p>If an application document (or its part), received by fax, is illegible, the document shall be deemed received on the date its original is received.</p> <p>The application can be regarded as received on the date its facsimile is received provided the applicant removes the illegible text.</p> <p>The use of fax for transmission of documents containing state secrets shall not be allowed</p>	
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3	<p><b>Regulations, Rule 55 Examination on filing</b> If the examination under Article 90, paragraph 1, reveals that the application fails to meet the requirements laid down in Rule 40, paragraph 1 (a) or Rule 40, paragraph 1(c), Rule 40, paragraph 2 or Rule 40, paragraph 3, first sentence, the European Patent Office shall inform the applicant of any deficiencies and advise him that the application will not be dealt with as a European patent application unless such deficiencies are remedied within two months. If the applicant complies, he shall be informed of the date of filing accorded by the Office.</p> <p><b>Regulations, Rule 57 Examination as to formal requirements</b> If the European patent application has been accorded a date of filing, the European Patent Office shall examine, in accordance with Article 90, paragraph 3, whether ...</p>	<p><b>Rules Par. 13.1. (1) Provision for application filing and its filing number assignment</b> The document received in Rospatent shall be registered as an application, the date of its receiving being accorded as that of its filing provided the document contains at least a patent application in Russian.</p> <p><b>Rules, par. 23.1. Provisions for examination as to formal requirements</b> Examination of an application as to formal requirements shall be carried out provided the application has been filed in accordance with sub-paragraph 1 of Par. 13.1 (1) laid down in the present Rules.</p> <p><b>Rules, par. 23.6. Fixing the date of application filing</b> (1) As stipulated by par. 3 <u>Article 1375</u> of the Code the date of patent application filing with Rospatent shall be the date of the application receiving, containing a request for patent grant, a description of the invention and drawings, if referred to in the description.</p> <p>If the said documents are not filed at the same time, the date of receipt of the last of the documents shall be deemed as the filing date.</p> <p><b>Rules, par. 23.7 Notice on a positive results of examination as to formal</b></p>	<p>The EPO first undertakes a preliminary examination before the application is registered and only after all the revealed deficiencies are remedied, the date of filing is accorded. Then the EPO will examine the application on its compliance with the formal requirements. Rospatent files the application without any preliminary examination.</p>
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4	<p><b>Guide, Paragraph 118</b></p> <p>An additional fee is payable for European patent applications comprising more than 35 pages. The amount of the additional fee depends on the number of pages over 35 and is calculated on the basis of the pages of the description, claims, any drawings and one page for the abstract, in the language of filing.</p> <p>The pages of the request for grant form (EPO Form 1001) are not counted, nor are any pages forming part of a sequence listing. The additional fee is payable within one month of the filing date of the application. If the application is filed without claims or by reference to a previously filed application, the additional fee is payable within one month of filing of the first set of claims or the certified copy (see Points 137 and 147).</p>	<p>It is not envisaged by the applicable regulatory documents.</p>	<p>EPO's practice of charging an additional fee depending on the number of pages in the application is of interest, it can be used by Rospatent.</p>
5	<p><b>Regulations, Rule 57</b></p> <p><b>Examination as to formal requirements</b></p> <p>If the European patent application has been accorded a date of filing, the European Patent Office shall examine, in accordance with Article 90, paragraph 3, whether:</p> <p>(a) a translation of the application required under Article 14, paragraph 2, or under Rule 40,</p>	<p><b>Rules, par. 23.3</b></p> <p><b>Request for amended or missing application documents</b></p> <p>(1) If the examination of the application as to formal requirements reveals that it fails to comply with the requirements, the applicant shall be notified hereof within two months from the date the</p>	<p>The EPO allows different time periods to remedy the deficiencies revealed by formalities check. If the applicant fails to pay filing and search fees in due time the application is deemed to be withdrawn.</p>

<p>paragraph 3, second sentence, has been filed in due time;</p> <p>(b) the request for grant of a European patent satisfies the requirements of Rule 41;</p> <p>(c) the application contains one or more claims in accordance with Article 78, paragraph 1(c), or a reference to a previously filed application in accordance with Rule 40, paragraphs 1(c), 2 and 3, indicating that it replaces also the claims;</p> <p>(d) the application contains an abstract in accordance with Article 78, paragraph 1(e);</p> <p>(e) the filing fee and the search fee have been paid in accordance with Rule 17, paragraph 2, Rule 36, paragraph 3, or Rule 38;</p> <p>(f) the designation of the inventor has been made in accordance with Rule 19, paragraph 1;</p> <p>(g) where appropriate, the requirements laid down in Rules 52 and 53 concerning the claim to priority have been satisfied;</p> <p>(h) where appropriate, the requirements of Article 133, paragraph 2, have been satisfied;</p> <p>(i) the application meets the requirements laid down in Rule 46 and Rule 49, paragraphs 1 to 9 and 12;</p> <p>(j) the application meets the requirements laid down in Rule 30 or Rule 163, paragraph 3.</p> <p><b>Regulations, Rule 58</b> <b>Correction of deficiencies in the application documents</b></p> <p>If the European patent application does not comply with the requirements of Rule 57(a) to (d), Rule 57(h) and Rule 57(i), the European</p>	<p>application documents were received, the letter shall indicate the revealed deficiencies, which should be properly legally grounded and a proposal to submit amended or missing documents within two months from the date the request is received.</p> <p>The grounds for request:</p> <p>(1.1) an application missing at least one document listed in par. 10.2 of the present Rules and/or the number of copies provided are fewer than required;</p> <p>(1.2) A document confirming payment of the prescribed patent fees or a document confirming the grounds for exemption from the patent fees, or reduction or deferred payment thereof, shall be attached to a patent application for an invention;</p> <p>(6) if the applicant fails in the required time to submit the required documents or a request to extend the term of documents submission as stipulated by provisions of par. 20 of the present Rules, the application shall be recognized as withdrawn.</p>	
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	<p>Patent Office shall inform the applicant accordingly and <u>invite him to correct the deficiencies noted within two months.</u></p> <p><b>Regulations, Rule 38</b>  <b>Filing fee and search fee</b>  The filing fee and search fee shall be paid <u>within one month of filing the European patent application.</u></p> <p><b>EPC, Article 78 (2)</b>  <b>Requirements of the European patent application</b>  (2) A European patent application shall be subject to the payment of the filing fee and the search fee. If the filing fee or the search fee is not paid in due time, the application shall be deemed to be withdrawn.</p>		
6.	<p><b>Regulations, Rule 137</b>  <b>Amendment of the European patent application</b>  (1) <u>Before receiving the European search report,</u> the applicant <u>may not amend the description, claims or drawings</u> of a European patent application unless otherwise provided.  (2) <u>After receipt of the European search report,</u> the applicant <u>may, of his own volition, amend the description, claims and drawings.</u>  (3) <u>After receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend <b>once</b> the description, claims and drawings, provided that the amendment is filed at the same time as the reply to the communication.</u> No further amendment may be made without the consent of the Examining Division.  (4) Amended claims may not relate to</p>	<p><b>15. Introduction of amendments to the application documents</b>  (1) The applicant can amend the application documents by replacing the deficient pages with corrected ones ...  A document confirming the payment of patent fee in the required amount shall be attached to the said documents.  If changes are made to the application documents on the initiative of the applicant within two months from the date of filing of the application, a patent fee shall not be charged for the amendments  (2) Amendments and clarification of the application documents, except those mentioned in (3) and (4) of this</p>	<p>The constraints applied in EPO with respect to introducing changes in the claim before the Search Report is received seem reasonable.</p>



	<p>unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.</p>	<p>paragraph, which are not presented as substituting pages shall not be taken into account in the published application information.</p> <p>(3) If corrections concern misprints bibliographic errors and the like and if these corrections and clarifications do not result in diminishing the clearness when the documents are reproduced, the need to introduce corrections can be expressed directly in the request. In this case there is no obligation to introduce substituting pages.</p> <p>(6) Pursuant to <u>Article 1378</u> of the Code an applicant shall be entitled to enter corrections or clarifications in application documents before a decision is made in respect of the application. Changes to the particulars of the applicant, including upon transfer of the right to obtain a patent to another person or due to a change of name or title of the applicant may be incorporated in the application documents prior to registration of the invention in the appropriate State Register. Corrections of obvious or technical errors may also be incorporated in the application documents prior to registration of the invention in the appropriate RF State Register of the Inventions.</p> <p>An error is deemed obvious, if an expert in this field of technology understands that at the date of application filing something other than what was written in the application was meant and no correction but the one that was proposed</p>	
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		<p>can be made.</p> <p>(7) The applicant shall be notified on the examination of requests, mentioned in sub-paragraphs (4), (5), (6) within one month from the date the requests are received.</p>	
7.	<p><b>Guide, Paragraph 145</b></p> <p>Immediately after it has been drawn up, the European search report is <u>transmitted to you together with copies of any cited documents</u>. If you require a second copy of the documents, you can obtain it by indicating it in the appropriate box on the Request for Grant form (refer to point 48 and section 39 of the Request for Grant) when filing the application and by paying the prescribed administrative fee.</p>	<p><b>Rule par. 26.5 (2)</b></p> <p><b>Information Search Report and procedures of making the search report results available</b></p> <p>Copies of the documents, mentioned in the Information Search Report, except copies of application, information of which is not available to any other person, can be made available to the applicant and third parties <u>provided the required payments are made</u>.</p>	<p>It is believed that the EPO experience of providing copies of cited documents together with the Search Report can be used in Rospatent.</p>
8.	<p><b>Guide, Paragraph 150</b></p> <p>If you amend the claims after receiving the European search report but before completion of the technical preparations for publication (see point 172), the amended claims will be published in addition to the claims as filed. The technical preparations are deemed <u>to have been completed five weeks before expiry of the eighteenth month after the date of filing</u> or, if priority is claimed, after the date of priority.</p>		<p>Determination of the time required for technical preparation for publication makes it possible for the EPO to determine the intended publication date from which the EPO counts off other terms. The EPO also notifies the applicant on the date the patent will be published. It is believed advisable for Rospatent to use the EPO experience and to communicate the date of publication to the applicant.</p>
9.	<p><b>Regulations, Rule 71</b></p> <p><b>Examination procedure</b></p> <p>(3) <u>Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it, and shall invite him to pay the fees for grant</u></p>	<p><b>Code, Article 1393.</b></p> <p><b>The Procedure for State Registration of an Invention, Utility Model or Industrial Design and the Grant of a Patent</b></p>	<p>The EPO experience with respect to inviting the applicant to pay the fees for patent grant and patent printing after the patent text, which the EPO intends to grant, is communicated to</p>

<p><u>and printing</u> and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within a period of four months. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the text intended for grant.</p> <p>(4) If the applicant, within the period laid down in paragraph 3, requests amendments under Rule 137, paragraph 3, or the correction of errors under Rule 139, he shall, where the claims are amended or corrected, file a translation of the claims as amended or corrected. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the grant of the patent as amended or corrected.</p> <p><sup>38</sup> See decision of the Enlarged Board of Appeal G 10/93, G 1/02 (Annex I). 43</p> <p>(5) If the Examining Division does not consent to an amendment or correction requested under paragraph 4, it shall, before taking a decision, give the applicant an opportunity to submit, within a period to be specified, his observations and any amendments considered necessary by the Examining Division, and, where the claims are amended, a translation of the claims as amended. If the applicant submits such amendments, he shall be deemed to have approved the grant of the patent as amended. If the European patent application is refused, withdrawn or deemed to be withdrawn, the fees for grant and printing, and any claims fees paid under paragraph 6, shall be refunded.</p> <p>(6) If the European patent application in the text intended for grant comprises more than ten claims, the Examining Division shall invite the applicant to pay claims fees in respect of each additional claim within the period under</p>	<p>1. Based on a decision to grant a patent for an invention, utility model or industrial design, the Federal executive authority for intellectual property shall record the invention, utility model or industrial design in the corresponding register – the Official Register of Inventions of the Russian Federation, the Official Register of Utility Models of the Russian Federation or the Official Register of Industrial Designs of the Russian Federation and shall grant a patent for the invention, utility model or industrial design.</p> <p>If the patent is claimed in the name of several persons, they shall be granted one patent.</p> <p>2. An invention, utility model or industrial design and the grant of a patent shall be registered, provided that the corresponding patent fees have been paid. If the applicant has not produced the required document confirming payment of the patent fees, the invention, utility model or industrial design and the grant of a patent shall not be registered and the corresponding application shall be deemed to be withdrawn.</p>	<p>the applicant, is of interest to Rospatent in view utilizing such an approach in its practice.</p>
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	<p>paragraph 3, and, where applicable, paragraph 5, unless the said fees have already been paid under Rule 45 or Rule 162.</p> <p>(7) If the fees for grant and printing or the claims fees are not paid in due time, or if the translation is not filed in due time, the European patent application shall be deemed to be withdrawn.</p> <p>(8) If the designation fees become due after the communication under paragraph 3, the mention of the grant of the European patent shall not be published until the designation fees have been paid. The applicant shall be informed accordingly.</p> <p>(9) If a renewal fee becomes due after the communication under paragraph 3 and before the next possible date for publication of the mention of the grant of the European patent, the mention shall not be published until the renewal fee has been paid. The applicant shall be informed accordingly.</p> <p>(10) The communication under paragraph 3 shall indicate the designated Contracting States which require a translation under Article 65, paragraph 1.</p> <p>(11) The decision to grant the European patent shall state which text of the European patent application forms the basis for the decision.</p>		
10.	<p><b>Guide, Paragraph 168</b></p> <p>Before a patent can be granted, you must also have paid <u>any renewal fee and additional fee due</u> (see point 213 et seq.). If a renewal fee falls due before the expected date of publication of the mention of grant of the European patent, you will be informed accordingly. Mention of grant will not be published until you have paid the renewal fee. If you fail to pay the renewal fee and any</p>	<p><b>Code, Article 1399</b></p> <p><b>Early Termination of a Patent for an Invention, Utility Model or Industrial Design</b></p> <p>A patent for an invention, utility model or industrial design shall be terminated early:</p>	<p>RF Patent legislation does not prevent patent grant if there default on annual fee payment, annual fee should be paid at the same time as the patent grant fee, this results in a certain conflict, because the patent can be terminated even before the patent is granted.</p>

	<p>additional fee in due time, the application is deemed to be withdrawn.</p>	<p>From the date of expiry of the time limit for payment of the patent maintenance fee, if the fee for maintenance of the invention, utility model or industrial design patent has not been paid.</p> <p><b>Par. 9 Instruction on Fees Payment</b></p> <p><b>9.</b> Payment of the fees specified in subparagraphs 1.15.1 and 1.15.2 of the Annex to the present document (<i>annual fees for patent maintenance</i>) for each year the patent (certificate) is in force, and filing the document confirming the payment of an appropriate fee should be made within a previous year or within the term specified in the first sub-par. of par.8 of the present Instruction (<i>i.e. the patent grant fee should be paid within the required time</i>), if this period starts later.</p> <p>An additional time period of 6 months is accorded to pay the indicated fees starting from the expiry date specified in the first sub-par. of this paragraph, provided the fee paid is 50% higher.</p> <p>The document confirming payment of the required fee shall be filed together with the notice from the person indicated in par. 4 of the present Instruction that the fee has been paid, but not later than one month before the additional term expires.</p> <p>If the document confirming the payment of the required fee and the notice of the payment are not filed in due time, the fee shall be deemed unpaid in the</p>	<p>The EPO experience in this respect is useful for further studies in Rospatent.</p>
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		<p>required time.</p> <p>Maintenance fee for the year following the year during which the request on patent renewal was filed shall be paid in the same term as the patent renewal term. The document confirming payment of this fee shall be filed at the same time as the request.</p>	
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**Differences in document management procedures revealed during a Russian Delegation visit to the EPO Headquarters**

	<b>In EPO</b>	<b>In Rospatent</b>	<b>Comments</b>
1.	Chemical formulae, drawings, tables and other similar elements of graphics are stored in the automated system in the facsimile format, being forwarded to the publication in the same facsimile format.	Chemical formulae, drawings, tables and other similar elements of graphics are converted into electronic format.	It is believed reasonable to use the EPO experience, this would result in lower labor costs
2.	Letters prepared by an examiner in the automated system can be supplemented with a letter by another examiner from a different department (e.g. Formalities) and forwarded to the printer in the Mail room, where they can be printed out and sent to the applicant.	A letter stored in the automated system called «Electronic applications archive» can be compiled only by one employee. In a number of cases such practice results in several letters from various departments being sent as answers to the same in-coming letter (e.g. a document compiled by an examiner and another one written by a person responsible for getting fees).	EPO experience is believed advisable and it is reasonable to use it for reducing working time in writing letters as well as for reducing physical costs of the mail sent.
3.	Information on applications is placed (published) on the EPO website 18 months after the application is filed, it includes Search Report, Claim, Description and Abstract (after the decision is made to grant) as well as the Refusal to grant and all the correspondence relevant to	The Rospatent website shows published information on the Applications and the Patent	It seems reasonable to consider a possibility to place on the Rospatent website after the patent data is published, all the correspondence related to patent, and its related Search Report to allow anybody

	the application.		interested to familiarise oneself with these data.
4.	Prior to the patent information publication its draft is sent to the applicant.	Decision to grant a patent and its Abstract is sent to an Applicant	The EPO practice seems useful, i.e. an applicant is provided with an opportunity to correct errors in the texts of Description and Abstract as well as in the patent bibliography
5.	In the EPO practice an applicant has a possibility to apply for an advanced search and examination as to substance.	Rospatent does not provide an applicant with the service of advanced search and examination as to substance.	Rospatent does not plan currently to introduce such procedure in its practice.
6.	On-line filing is made with the use of a smart card; an applicant can obtain such smart card by post either from the EPO or a National Patent Office. The smart card with a necessary document packet is sent to an applicant by post.	On-line filing can be made after an applicant gets a Certificate on Electronic Signature (CES) from Rospatent. The RF Law on CES does not stipulate the use of smart cards.	The use of on-line filing is limited in Rospatent since not all the applicants are able to get CES because they are located too far from Rospatent.