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Divisional From Divisional Issue – New Insight From Russia

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A recently published ruling of the Presidium of the Court for Intellectual Rights may turn the issue of cascading divisional applications upside down and endanger many patents granted on such applications.

Background

A divisional patent application is a separate one that is derived from an initial (parent) application. The necessity of filing such a divisional application may be caused by, for example, the lack of unity among originally claimed inventions, or an applicant may simply want to have more patent applications to obtain a patent portfolio as a result.

Russian patent law, like many other jurisdictions, does not limit applicants for a number of divisional applications to be filed. Thus, cascading divisional applications are possible. This concept takes place when a divisional application is the basis for a next (subsequent) divisional application. At the same time, the Russian legislation does not contain detailed legal provisions to regulate all possible situations that can happen while filing divisional applications. This is relevant to the filing of divisional from divisional applications as well. That's why, case law, including the Russian Patent Office's (Rospatent's) practice and court practice, is crucial for this issue.

On October 06, 2023, having considered a cassation appeal of KRKA in AstraZeneca's Dapagliflozin case No. SIP-570/2022, the Presidium of the Court for Intellectual Rights issued a Ruling that seems to have an effect of a bomb exploding.

Before SIP-570/2022

The Russian Civil Code includes the only provision relating to the filing of a divisional application. The provision is contained in Article 1381(4) of the Code. The Article provides for the following set of requirements to a divisional application filed to inherit the priority of the initial application:

- (1) the divisional application shall relate to an invention disclosed in the initial application;
- (2) on the divisional application filing date the initial application shall not be withdrawn or recognized withdrawn, and
- (3) the divisional application shall be filed before: either

(3.1) the exhaustion of the possibility for lodging appeals against a rejection decision issued for the initial application. According to the Code, a rejection decision may be appealed within seven months from its issuance date, or

(3.2) the date of registration of the invention when a notice of allowance has been issued for the initial application. According to the Code, the registration is performed after the payment of the patent grant official fee when a notice of allowance has been received.

Thus, one of the requirements to have the initial priority established for a divisional application is to file it before a patent has been granted on the initial application. In practice, the Rospatent has stuck to the following interpretation of this requirement in the case of cascading divisional applications: a divisional application shall be filed before a patent has been granted on the initial application, a subsequent (second) divisional one shall be filed from the first divisional one before a patent has been granted on the first divisional application regardless of the fate of the initial application (it could be granted, rejected, withdrawn), i.e. the first divisional application has become the initial one in respect of the second divisional application. This approach has been used for further subsequent divisional ones accordingly. At the same time, all subsequent divisional applications have inherited the initial priority date, i.e. the priority date established for the very first application that was the basis of the first divisional application.

SIP-570/2022: reasonings and consequences

However, the above practice of the Rospatent may terminate. In case No. SIP-570/2022, the Court for Intellectual Property Rights considered the issue of establishing the priority date for an invention of RU 2643764 granted on RU 2013115635 (RU2013') being divisional from RU 2008122558 (RU2008') granted as RU 2489151 and being divisional from RU 2004137489 (RU2004') representing the Russian national phase of PCT/US03/15591 and granted as RU 2337916.

Materials of RU2013' were submitted to the Rospatent on April 08, 2013 before RU 2489151 was granted on August 10, 2013, however later than the granting date of RU 2337916, which is November 10, 2008.

Both the Rospatent and the Court for Intellectual Property Rights being the first instance court considered that the invention of RU 2643764 duly inherited the initial priority date of May 20, 2002 of PCT/US03/15591 and RU2004'. The reason was that it was RU2008' which should be considered the initial application for RU2013', and on the filing date of the latter the application RU2008' had not been granted yet.

However, the Presidium of the Court for Intellectual Property Rights being the cassation instance court drew an opposite conclusion. Thus, referred to Article 1381(4) of the Code as well as Article 11 of the PCT and Article 4(G) of the Paris Convention for the Protection of Industrial Property, the Presidium concluded that there is the only initial application, the very first application filed, because its priority date and filing date are the basis for establishing the priority for further divisional applications and the 20-year patent validity term, respectively. As a result, according to the Presidium, in the above Dapagliflozin case RU2004', rather than RU2008', should have been considered the initial application in respect of RU2013'. Since on the date of submitting RU2013' to the Rospatent (i.e. April 08, 2013) RU2004' was already granted, RU2013' could not inherit the initial priority of May 20, 2002, but the priority based on April 08, 2013 should have been

established. In this event, materials of PCT/US03/15591 and RU2004' represented the prior art defeating novelty of the invention claimed in RU2013'.

Consequently, the cited Ruling issued by the Presidium of the Court for Intellectual Property Rights opens a door leading to the opportunity to revise novelty of many inventions granted on divisional from divisional applications. However, before this, we should wait for the reaction of the Russian Supreme Court if any of the Rospatent, KRKA and AstraZeneca decides to contest the ruling in question.

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