

# Kluwer Patent Blog

## Divisional From Divisional Issue – New Insight From Russia. Part II

Kirill Osipov (ARS-Patent) · Wednesday, July 17th, 2024

**This post is continuation to the previous one published on October 27, 2023 and available [here](#). Although the approach may still be reconsidered by the Presidium of the Russian Supreme Court, the current update should already be taken into account while developing the patenting strategy in the jurisdiction.**

### Background

There are two pending court cases to relate to the raised issue: No. SIP-570/2022 and SIP-552/2022. Both of them concern Dapagliflozin patents granted on divisional-from-divisional (cascading divisional) applications. In said cases, the Presidium of the Court for Intellectual Rights as the first cassation court issued Rulings that had an effect of a bomb exploding. The Rulings reject the long-term practice of the Russian Patent Office (Rospatent) to acknowledge the priority date of cascading divisional applications on the basis of the very first (initial) application. However, the Court Board of the Supreme Court being the second cassation instance cancelled the Rulings and maintained the approach of the Rospatent.

### The position of the Presidium of the Court for Intellectual Rights

Although the position was described in detail in the first post on this topic (available [here](#)), below we repeat it briefly for the readers' convenience.

In case No. SIP-570/2022, the issue was considered to establish 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.

Having 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'.

Case No. SIP-552/2022 relates to RU 2746132 granted on RU 2020135467 (RU2020') filed on October 28, 2020 as the divisional from RU 2017131447 (RU2017') of September 07, 2017, which in turn is divisional from RU2013'. The position of the Presidium was the same in this case.

### **What did the Court Board of the Supreme Court state?**

In both cases (No. SIP-570/2022 and SIP-552/2022), the Court Board for economic disputes of the Russian Supreme Court as the second cassation court considered cassation appeals submitted by the patentee (AstraZeneca AB) and the Rospatent on the above Rulings of the Presidium of the Court for Intellectual Rights to issue its judgements in mid-June of 2024.

As a result, the Court Board drew a conclusion that the Presidium interpreted a provision of Russian patent law relating to the filing of a divisional application incorrectly. The Court Board pointed out that Article 1381(4) of the Russian Civil Code containing said provision does not include any obstacle to the filing of cascading divisional applications to inherit the priority of the initial application because:

- the same application can simultaneously be both divisional and parent (initial) for the next generation of divisional applications (Russian law does not prohibit this anyhow),
- all cascading divisional applications are bound between each other by the single application and, as a consequence, shall have the same priority date, i.e. the priority date of the very first (initial) application.

According to the Court Board, the only requirements that shall be satisfied for a divisional application to inherit the priority date are stipulated by Article 1381(4) of the Code, namely

(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 been 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.

All necessary requirements from the above provisions were satisfied when RU 2643764 and RU 2746132 were granted given RU2008' was considered parent (initial) for RU2013' (case No. SIP-570/2022) and RU2017' was considered parent (initial) for RU2020' (case No. SIP-552/2022).

Thus, the Court Board cancelled the Presidium's Rulings in both cases thereby maintaining the Rospatent's long-term practice regarding cascading divisional applications.

It is worth adding that the Court Board's judgements are not final and may be re-considered by the Presidium of the Supreme Court as the supervisory review instance. Also, the established approach on the filing of cascading divisional applications may be subject to the check by the Russian Constitutional Court.

## Conclusion

Although the Court Board's judgements are not final, now it can be stated that the established practice on the discussed issue being approved by the Supreme Court as the second cassation court remains inventor-friendly.

---

*To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please subscribe [here](#).*

## Kluwer IP Law

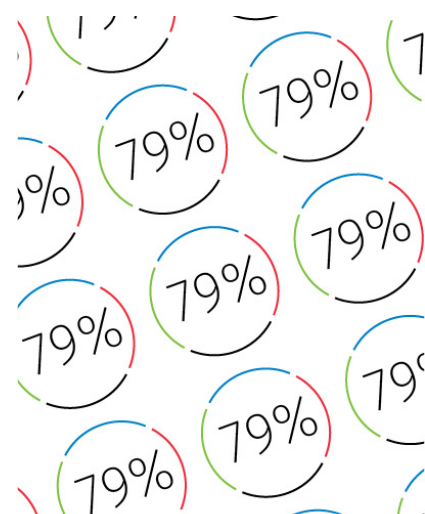
The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

---

79% of the lawyers think that the importance of legal technology will increase for next year.

**Drive change with Kluwer IP Law.**  
The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT  
The Wolters Kluwer Future Ready Lawyer  
Leading change

---

This entry was posted on Wednesday, July 17th, 2024 at 9:25 am and is filed under [Case Law](#), [Pharma](#), [Russia](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. You can leave a response, or [trackback](#) from your own site.