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Hidden Ratchet in Eurasian Patent Applications

Georgii Stoiko (Liapunov & Reznichenko) · Tuesday, June 24th, 2025

The use of divisional patent applications in order to ensure flexibility and to keep a patentee's options open as to the protection it seeks to obtain is established practice in many patent offices around the world. The use of divisionals is particularly common in the pharmaceutical field, where the exact form of an authorized medicine may not be clear at the time an original patent application is filed.

In this piece, I would like to cast light on special provisions under the **Eurasian Patent Convention (EAPC)** that regulate the scope of divisional applications. As many readers will know, the territory of the EAPC covers eight countries: Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Russia, Tajikistan and Turkmenistan.

For a long time now, it has been the practice of the EAPO that the claims of a divisional application may not have claims which are identical to claims in the parent application. However, this rule barely caused any inconvenience for patentees, as examiners routinely conducted compliance checks during substantive examination, thereby identifying and raising other patentability concerns concurrently. It was not considered a significant issue for applicants who almost always amended claims, thereby rendering double patenting issues moot.

In recent years, the EAPO has gradually integrated the double patenting check into the formal examination (in 2020) and requested that a 2-month non-extendable office action be issued in case the claims contravene the rule (in 2022). The explanations circulated by the EAPO as these rules were introduced can be distilled into the need for better determination of the examination process and a greater balance towards the public. Indeed, generic drug developers were in constant uncertainty as published divisional applications usually contained claims that were identical to the parent.

Following the implementation of the above-mentioned framework, examiners have become noticeably more rigorous in enforcing the double patenting requirements. The legislation does not elaborate on the concept of "identity", except to state that it shall be "from a viewpoint of the scope of protection". The practice has developed thus far in an incremental manner. Applicants have to swiftly work out the format of the claims that they wish to present for examination, the check is made during the formal examination, which is relatively expeditious; and in the event of an office action, the applicant cannot delay the response.

The provision pertaining to the allowable scope of divisional claims has been clarified by the formal introduction of rules prohibiting divisionals from having identical scope to the parent.

Specifically, Rule 49 of the **Regulations** stipulates that:

“The claims of a divisional Eurasian application may not contain inventions that are identical to the inventions for which legal protection is sought under the parent Eurasian application, with the exception of limiting of the parent application in accordance with Rule 4 of the Regulations in the event of a violation of the requirement of unity of invention”.

The EAPO has adopted a broad approach to this provision. In practice, examiners consider not only the allowed claims (as one may expect) but also any other claims that have entered the substantive examination (even if these claims were not actually granted). A consequence is that when the applicant cancels a claim or a part thereof, this may potentially result in the abandonment of the scope with regard to future divisional applications.

This scenario may occur on a frequent basis. It is evident that objections pertaining to the requirement for sufficient disclosure are more prevalent than unity-related objections. In light of this, applicants may opt to pursue the most straightforward approach, which involves the streamlining of claims to the allowable scope, with the subsequent intention of filing a divisional application for the cancelled embodiments.

Of course, there exist techniques for circumventing, or reducing the impact of, the double patenting issues, and obtaining local advice is recommended before amending any claims.

On the top of the above, a more explicit ratchet exists in relation to “daisy-chaining”, which is applicable under the EAPC. Specifically, divisional applications must have basis in all prior applications (parent and divisional). What is the hitch? Paragraph 2.9 of the Eurasian Patent Rules stipulates that the specification of a divisional Eurasian application may not contain information that does not relate to the inventions claimed in this application. Should a decision be taken to comply with this rule at the time of filing, and the specification be stripped from unclaimed embodiments, this may result in the “daisy-chain” being broken. It is therefore preferable to use the initial specification when filing a divisional application, despite the need to comply with the aforementioned rule down the road. To take any information out of the specification could result in the inability to divide the application subsequently.

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