

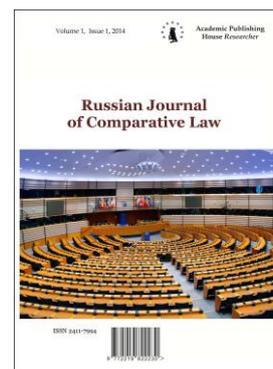
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The Comparative-Legal Analysis of the Invention and Utility Models Registry Process in Certain Brics Participants

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Abstract

In the following article the order of inventions and utility models patenting is taken under consideration. It's especially important to realize the specific of such a process for the participants of BRICS, among which there're Brazil, the Russian Federation, India, and China. The discussion here is dedicated to the comparison of the registration process, the order and peculiar features of expertise process in the countries above mentioned. We also enumerate the specific features of inventions and utility models registration, for those unique and present in the only one state. The nuclear power engineering in India serves as an example of patenting limits for certain branches.

In conclusion we demonstrate the common features of patenting in the mentioned BRICS participants: Brazil, the Russian Federation, India, and China. There're just slight differences present, and all of them are connected with the review process order and the patenting terms. The institute of development patenting restriction is considered promising. And that's why we find it demanding for the following study in order to compare the acceptability of development limit declaration within patenting and international obligations, accepted by international organizations participating countries.

Keywords: patenting, BRICS, invention, utility model, intellectual property right, patenting restrictions.

1. Introduction

It's well-known that the Russian Federation participates in BRICS. The participating countries possess commercial and economic ties between them. The intellectual property objects registration is a part of these international relationship within the organization, so each participating country should be observed in order to reveal the features of this process there. The terms, order and specific of expertise during intellectual property objects registration are of the highest importance due to revelation the stages an applicant faces in BRICS participating states. So, we're up to analyze the intellectual property right of Brazil, the Russian Federation, India and China.

As for the industrial property objects expertise, there're also several special features of patenting in the BRICS participants. Within the topic of scientific development we mention the significance of realizing what kinds of industrial property object are permitted to be patented in the countries above mentioned to build up the common patenting strategies.

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2. Materials and methods

The current article is based upon the following sources: normative legal documents of the Russian Federation, Brazil, India and China in the intellectual property area and the materials of journal publications. The comparative-legal method was chosen as the basic one. Its application revealed the common and different features of inventions and utility models registration process in the BRICS participants.

3. Discussion

According to the article 27 of the Trade intellectual property right agreement, «the patents are given for any inventions with no dependence on their being a product or a way in all industrial branches on conditions that they are characterized by novelty, level of inventiveness and possibility of industrial applicability».

The similar definitions for an object liable to patent are included in the BRICS participants' legislation: Russian ([The Russian Civil Code \(part four\), 2008](#)), Indian ([The Patents Act, 1970](#)), and Chinese (Patent Patent Law of the People's Republic of China (as amended up to the Decision regarding the Revision of the Patent Law of the People's Republic of China, 2008) one ([Patent Patent Law..., 2008](#)). Brazil conducts quite a wider definition for a patentable object: any invention can be considered patentable if possessing novelty, level of inventiveness and industrial applicability (Ley Nº 9 que regula Derechos y Obligaciones Relativos a La Propiedad Industrial, 1996, supplemented Ley Nº 10.196 de 14 de febrero de 2001 (Enmiendas a la Ley de Propiedad Industrial), Ley Nº 12.663 de 5 de junio de 2012 (Ley General de la Copa del Mundo). As a utility model in Brazil one can register «an object of practical application», or a part of it, enabling its practical application, presented by a renovated form or elements placement that lead to the functional perfection of its use or production ([Ley Nº 9..., 2012](#)).

Moreover, in the Russian Federation, Brazil and China one can apply for both invention and utility model patent. However, in India one should notice that there's no "utility model" functioning.

The patent legislation of the BRICS participants (Brazil, the Russian Federation, India and China) enumerates the common list of objects which are not liable to registration as an invention or a utility model there. The list includes the following items: discoveries, scientific theories, mathematical methods, playing rules and methods, intellectual and economic activities, computer programs, reporting, breeds and plant varieties.

Nevertheless, every certain state can possess its own peculiarities an applicant should take of. For example, in India a person is prohibited to patent objects of nuclear power engineering. This restriction was stated by the Indian «The Atomic Energy Act» ([The Atomic Energy Act, 1962](#)). The article 20 restricted patenting for the inventions utility or connected with nuclear power production, control, use or utilization according to the Indian government. The act discussed also provided Indian government with ability to check any patent application for the criteria mentioned in the article 20 of «The Atomic Energy Act» (usefulness or connection with nuclear power production, control, use or utilization). This restriction is resulted by the strategic importance of nuclear power for India. It's considered that individuals' and foreigners' patent approval may lead to the threat to the national Indian interests.

As for the patenting specifics in BRICS countries (Brazil, the Russian Federation, India and China), let's observe the invention expertise process in India. As opposed to the Russian Federation, India demands duty-paid obligatory application for expertise to initiate application processing ([Manual of Patent..., 2010](#)). In the Russian Federation the application for expertise isn't considered obligatory if duty-paid according to p.1.1 (Invention patent application registry in the Russian Federation and consideration due to formal expertise results) and p.1.8 (Invention substantive examination process and consideration upon the results) Regulation upon the patent and other duties for legally relevant activity ([Russian Newspaper, 2008](#)) and signature in invention patenting application. In this case the applicant applies for substantive examination while filing the application for their invention registry. The terms for application for expertise since priority date or application date are also surprising for a Russian applicant. In India they are 48 months.

After consideration about the expertise the application for patent is attached to an expert. So, the specialist is to make formal and substantive review according to the area of invention and the expert's specialization. After that, the expert analyzes the application materials thoroughly,

conducts a preliminary search to state the novelty, and makes up a report upon the invention patentability. They are also to find out whether the invention possesses the level of inventiveness and is industrially applicable. The prior art is closely related to these criteria, as it includes all the data open for general use all over the world before the priority date of the invention applied, all the national patents and the filed applications with the earlier priority dates (The newsletter..., 2013).

Generally, the review process seems to be alike for all the BRICS participants (particularly, for inventions; and in Brazil and The Russian Federation – for utility models as well). On the first stage the application is to be filed to the Patent Office (in The Russian Federation this stage is not considered obligatory, and it can be conducted after the substantive review, consideration and signature duty is paid; in this case the application is filed while applying for patent). After that the experts of the Patent Office are to check whether the objects applied can be patented as inventions or utility models in their state. Consequently, an expert checks the objects for the patentability criteria according to the prior art. During any of the stages an expert can make a request for the applicant to respond and comment upon some details. In dependence upon the review results the patent application is getting either approved or denied.

Moreover, it should be noted, that the reasons for denial can be rather peculiar for a patenting country. For example, the Indian practical guide for the Patent office activity p. 08.03.06.01 runs: any invention can be declined if obviously fancied and contradicts the legislation. For instance, a machine with 100 % efficiency, a machine producing without input, or a perpetual motion machine serve as good examples of gadgets of this sort. Nevertheless, p. 08.03.06 of the Guide states, that these examples are just illustrations and aren't considered the final ones. The objective decision upon patent approval is taken individually anyway.

Also, one should take into account the fact that India doesn't approve the applications on plants and animals in general and their parts (including seeds, sorts and kinds), but the micro-organisms. For example, in The Russian Federation a person can register various sorts of plants and animals as the result of selection.

Consequently, the expert's report is checked by a supervisor within a month since received. If some objections are made, they are sent to the applicant as the expertise report form with annexes and specification if required. If there's no objections made the patent gets approved.

More than that, according to p. 08.04 of the Practical guide upon the Patent office activity if there're objections towards conformity of the invention with patentability criteria, the applicant receives a complete report from the expert. We draw the readers' attention to the fact that it functions in contrast to the Russian Federation legislation, for example, where the expert just sends a request for explanation and clarification to the applicant.

Also the substantive review terms are to be discussed in the ongoing article as far as the expected expertise term and patenting term as well are of the considerable interest for the applicants.

In the Russian Federation, according to p. 140 of the Order of the Ministry of Russian Economic Development dated 25 May 2016 № 315 «About approval of the Administrative regulations of Federal Service of Intellectual property invention registry and patenting service» (The order..., 2016), the maximum term of substantive review numbers 24 months since the date of receipt of the substantive expertise application approval. In general, the patent approval or the first expert's request can be expected to be received within one year since the very moment of the application for the substantive review. The same terms function for the Chinese Patent office as well. To sum it up, the Russian Federation and China possess the shortest invention patent terms among all the BRICS participants (Brazil, the Russian Federation, India and China). In India an applicant should be waiting for about two or three years, in Brazil even about ten years may pass (The newsletter..., 2013). Consequently, the most long-term patent processing is there in Brazil.

It's also relevant to mention the Indian institute of patenting restrictions in certain areas and whether it is admissible for the international organizations participation. According to the Indian legislation, the nuclear power engineering is a strategically important area there. Consequently, that kind of patenting is restricted here in order to prevent national interest threat from both foreigners and Indian individuals.

Moreover, it should be noted that India is one of the World Trade Organization participants since 1 January 1995. So we have to contend with the situation in which an international organization participant has unilaterally restricted the patent possibility in certain area for both

foreigners and Indian applicants.

However, the Institute mentioned is considered promising. That's why, in our opinion, it demands the following observation in order to state the acceptability of patent limits and international obligations taken by international organizations participants. It's also relevant to consider whether it's possible and acceptable to establish patent restriction Institute for some areas in the Russian Federation too and how to justify such a decision (for example, there's an opportunity to declare an area strategically important and to prohibit patenting within such an area for individuals and, especially, foreigners as the process leading to national interests threat).

4. Results

To sum all the above mentioned up, we can conclude the patenting process analysis for such BRICS participants as Brazil, the Russian Federation, India and China in the following way:

1. Any possible invention in any technological area has an opportunity to be patented regardless of being either a product or a way. Despite that, the demands for the process are the same there: the invention applied should be characterized by its novelty, the level of inventiveness and should possess practical application.

2. The list of objects which are not liable to patenting as an invention or a utility model in the BRICS participants (Brazil, the Russian Federation, India and China) is quite common. It includes the following items: discoveries, scientific theories, mathematical methods, gaming rules and methods, intellectual and economic activity, computer programs, reporting, breeds and plant varieties. Nevertheless, in India there's invention patenting prohibition for the nuclear power engineering area.

3. The order of the substantive review is quite similar for the BRICS participants (Brazil, the Russian Federation, India and China). In the beginning, an applicant files the application to the state Patent Office, and then the experts check the patentability of the object as an invention or a utility model. Consequently, a specialist checks the conformity of the object applied with patentability criteria according to the prior art. On any presented stage of the review an expert may send a request to the applicant to respond or comment upon some details. As the result of substantive review, the patent application is getting either approved or denied.

4. The terms of expectation for patenting process finished in the BRICS participants (Brazil, the Russian Federation, India and China) are rather different. For instance, in The Russian Federation and China the consideration of the application is the most short-term and takes just about one year. Meanwhile, in India the process of the application takes about two or three years. Finally, Brazil is characterized by the most long-term expectation period, which numbers about ten years.

5. Conclusion

To sum it up, the inventions and utility models patenting in the BRICS participants (Brazil, the Russian Federation, India and China) is quite similar in general features. However, there're some peculiarities which can be established by certain state legislation. Of course, that fact should be taken into account in order to patent one's object successfully in each of these countries.

For example, before application for invention or utility model registry a person is recommended to check whether the object is liable to registry in the country chosen. For instance, one will be denied to patent seeds, sorts and kinds of plants in India, while in the Russian Federation they may be approved as the result of selection.

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