

Administrative Revocation and Invalidation Mechanisms

Russian Federation

According to Article 1398 (1) of the Russian Civil Code¹ (hereinafter “Code”), a patent for an invention, utility model or industrial design shall be recognized as invalid in full or in part in the following cases:

- 1) Incompliance of the invention, utility model or industrial design to the criteria of patentability established by the Code or to the requirements provided for by Paragraph 4 of Article 1349 of the Code, as well as incompliance of the industrial design to the requirements provided for by Article 1231.1 of the Code;
- 2) Incompliance of the application documents for an invention or utility model submitted at the date of its filing to the requirement regarding disclosure of the invention or utility model to an extent sufficient to implement the invention or utility model by a person skilled in the technical field;
- 3) Availability in the claim of an invention or utility model which is contained in the decision on granting of a patent, of the features that have not been disclosed at the filing date of application in the documents submitted to this date (Paragraph 2 of Article 1378), or availability of images of the item in the materials goods attached to the decision on granting of a patent for an industrial design which reflect essential features of an industrial design that have been absent in the images submitted at the filing date or of images of the item from which the essential features of the industrial design have been removed as compared to the images submitted at the date of filing date of the application (Paragraph 3, Article 1378);
- 4) Granting of a patent in case of several applications for identical inventions, utility models and industrial designs that have the same priority date in violation of conditions provided for by Article 1383 of the Code;
- 5) Granting of a patent with indication as an author or a patent holder of a person that is not such a person in accordance with the Code or without indication in the patent as an author or a patent holder of a person that is such a due person in accordance with the Code.

Article 1398 (2) of the Code states that patent for an invention, utility model or industrial design during its validity term established by Paragraphs 1 - 3 of Article 1363 of the present Code may be challenged by filing an objection to the federal executive authority for intellectual property by any third party that learned about breaches foreseen by subparagraphs 1 - 4 of Paragraph 1 of this Article.

Patent for an invention, utility model or industrial design during its validity term established by Paragraphs 1 - 3 of Article 1363 of the present Code may be challenged at court by any third party that learned about violations set out by subparagraph 5 of Paragraph 1 of this Article.

Patent for an invention, utility model or industrial design may be challenged by any third party after expiration of its validity term on the grounds that are given in paragraphs 1 and 2 of the present Paragraph.

¹ Article 1398 of the Civil Code of the Russian Federation (Part Four), as amended by Federal Law dated 12.03.2014 № 35-FZ.

In the period of challenging the validity of a patent for invention the right holder has a right to file an application for conversion of a patent for invention into a patent for utility model provided that the term of a patent for invention has not exceeded the term of a patent for utility model established by Paragraph 1 of Article 1363 of the Code. Federal executive authority for intellectual property affords satisfaction of the application for conversion of a patent for invention into a patent for utility model providing that a patent for invention is recognized as invalid in full and provided that the utility model complies to the requirements and criteria of patentability applicable to utility models and foreseen by Paragraph 4 of Article 1349, Article 1351, subparagraph 2 of Paragraph 2 of Article 1376 of the Code. Conversion shall not be fulfilled if a patent for invention is granted for application with regard to which a request was filed to conclude an assignment contract of the Patent as established by Paragraph 1 of Article 1366 of the Code and such application is not withdrawn in accordance with Paragraph 3 of Article 1366 of the Code at the filing date of application for conversion of a patent.

In case of conversion of a patent for invention into a patent for utility model the priority and the filing date are maintained.²

A patent for an invention, utility model or industrial design shall be recognized as invalid in full or in part on the basis of a decision of the federal executive authority for intellectual property adopted in accordance with Paragraphs 2 and 3 of Article 1248 of the present Code or of a decision of a court that has entered into force.

In case of recognition of a patent for an invention, utility model, or industrial design as invalid in part, a new patent shall be granted. In case of approval of application for conversion of a patent for invention into a patent for utility model a patent for utility model shall be granted.³

A patent for an invention, utility model or an industrial design that is recognized as invalid in full or in part shall be voided as of the filing date of the application for a grant of a patent.

License contracts concluded on the basis of a patent for invention, utility model or industrial design later recognized as invalid shall maintain their effect to the extent that they were performed by the time of the decision on the invalidity of the patent.

Recognition of a patent for invention, utility model or industrial design as invalid shall signify the reversal of the decision of the federal executive authority for intellectual property on the grant of the patent for the invention, utility model or industrial design (Article 1387) and deletion of the record in the corresponding official register (Paragraph 1 of Article 1393).⁴

Granting legal protection to an industrial design in the territory of the Russian Federation in accordance with an international treaty of the Russian Federation may be declared invalid completely or partially on the grounds and in accordance with the procedure provided by Article 1398 of the Civil Code.

Renewal of an exclusive right to an invention and the validity of an additional patent certifying this right, in case of violation of Article 1363(2) of the Civil Code, may be challenged via submitting an objection with the Federal Executive Body on Intellectual Property, in accordance with the procedure established by Article 1398(2) of the Civil Code.

The rules for handling administrative disputes by the Rospatent Chamber of Patent Disputes came into force on September 6, 2020. Rules for Administrative Review and Resolution of

² Article 1398(3) of the Civil Code of the Russian Federation.

³ Article 1398(4) of the Civil Code of the Russian Federation.

⁴ Article 1398(7) of the Civil Code of the Russian Federation.

Disputes by the Federal Executive Body on Intellectual Property have been approved by the Order N 644/261 of the Ministry of Science and Higher Education and the Ministry of Economic Development of the Russian Federation on April 30, 2020 and amended by the Order N 1140/646 of the Ministry of Science and Higher Education and the Ministry of Economic Development of the Russian Federation dated November 23, 2022.