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PATENTING FOREIGN INVENTIONS IN THE USSR

by
M. L. Gorodissky

Patenting foreign inventions in the Soviet Union is a rapidly developing business. Two factors account for the rate of its development; namely, expanded imports of machinery, equipment and licenses, as well as the accession of the Soviet Union to the Paris Convention for Protection of Industrial Property on 1st July, 1965. As our practice has shown, the largest part of foreign patent applications is filed by the companies and organisations engaged in selling machinery and equipment to our country. This is in line with the accepted international practice of patenting inventions, according to which a seller seeks patent protection of his rights to the inventions to be utilised in exported machinery and equipment. On the other hand, the Soviet foreign trade organisations are interested in purchasing foreign machinery, equipment and licenses answering the highest level of modern scientific and technological progress. The grant of the Soviet patent for a foreign invention certifies the fact that it has reached such a level, for in our country a patent is granted only after the alleged invention has been carefully examined for world novelty. We rest assured that, with the development of our foreign trade relations in the field of buying and selling machinery, equipment and licenses, we shall be expanding mutual co-operation in the field of patenting.

The basic juridical act regulating various aspects of inventive activities in our country is the Statute on Discoveries, Inventions and Innovation Proposals, approved by the Council of Ministers of the USSR in 1959. According to the Statute, "foreign citizens, as authors of discoveries, inventions and innovation proposals, enjoy the same rights that are granted by the present Statute to Soviet citizens, on the basis of reciprocity" (Para 14).

The Statute also provides that foreign applicants should file their applications with the Committee for Inventions and Discoveries under the Council of Ministers of the U.S.S.R. through the agency of the U.S.S.R. Chamber of Commerce. This practice is in keeping with that accepted in the majority of countries, according to which foreign citizens should conduct all their affairs pertaining to patenting through their representatives, patent attorneys.

The U.S.S.R. Chamber of Commerce serves as a patent attorney for foreign applicants in the U.S.S.R. The Chamber is best suited for the purpose because, first of all, it is a non-governmental public organisation guided in its activities by the Charter approved by the joint meeting of members, and, secondly, one of its main goals is to promote the expansion of foreign trade connections with other countries, the patenting of inventions being one of the factors stimulating the development of foreign trade.

The functions of the patent attorney in the Chamber are performed by its Patent Department consisting of two main sub-divisions, one dealing with patenting Soviet inventions abroad and the other with patenting foreign inventions in the U.S.S.R. In recent years, especially after the accession of the Soviet Union to the Paris Convention for Protection of Industrial Property, the scope of operations on patenting Soviet inventions abroad and foreign inventions in the U.S.S.R. has increased ten-fold. At present, the Patent Department of the U.S.S.R. Chamber of Commerce maintains permanent business contacts with companies and organisations of more than 60 countries.

We believe it necessary to characterise briefly the basic requirements to specifications of inventions in our country, as well as to advise foreign applicants on some aspects of patenting their inventions in the U.S.S.R.

The Specification of an invention should consist of the following parts:

The invention's title.

Introductory part.

Detailed description of the invention.

Claims (formula of the invention).

Where the invention relates to devices, designs, instruments, etc., the specification should be accompanied by graphic material, i.e. drawings and diagrams, whose brief description should be presented after the introductory part of the specification.

If the invention relates to a process of preparing a substance, material, etc., the specification should contain specific examples of realisation of the proposed process together with the description of all the embodiments of the technological process.

If the invention relates to a process of obtaining hitherto unknown novel compounds, the specification should contain, apart from the examples of realisation of the process, detailed analytical data pertaining to the composition and structure of these compounds.

Should the invention relate to a substance (non-chemically obtained), the specification should contain a number of examples pertaining to the specifically formulated composition of the proposed substance.

The invention's title should be precise, brief and specific and should correspond to the subject matter of the invention. As a rule, the title should coincide word for word with the introductory part of the formula of the invention.

The introductory part of the specification should contain the following information:

(i) the field of technology to which the alleged invention relates, and specific technical objects in which it can be employed;
(ii) prior art solutions of the technical problem of the alleged invention; the closest prototype, e.g. a machine, process or substance, of the invention;
(iii) disadvantages and deficiencies of the prototype eliminated or made up for by the invention;
(iv) the objects attained through the realisation of the invention;
(v) distinguishing features of the alleged invention which ensure the achievement of said objects.

In the introductory part, as well as throughout the specification, the scope of the invention and the disclosure of its object and distinguishing features should be in strict agreement with the formula of the invention. This part should also reveal the optional nature of techniques disclosed in the subsidiary claims.

The detailed description of a device should open with the presentation of its design or diagram in a static position. This should include the account of all the units and parts, necessary for a proper understanding of the device operation and realisation thereof. After describing the device in a static state, the principle of its operation or manner in which it is to be employed should be disclosed, and reference numerals should be provided in the drawings for the respective parts of the device.

The detailed description of a process (technology) should contain the enumeration of the process techniques (operations), as well as indications to the sequence and conditions (temperature, pressure, etc.) under which these techniques are to be performed. The description of a process should include specific examples of the realisation thereof, as well as data pertaining to the results of experimental tests, if any.

The detailed description of a substance should include the characteristics thereof and enumeration of its components (composition of substance), as well as the limit per cent ratios of the components (from. . . to . . .) in the substance. Besides, note should be made of the physical state and quality of these components in their initial form. The ratios of components in examples illustrating the detailed description of a substance should be within the range of the limiting ratios of components, as disclosed in the claims, including the boundary values.

When describing inventions consisting of the use of known devices, processes or substances for a new purpose and in another field of technology, the novel designation of the device, process or substance should be disclosed, as well as the factors which made it possible to use same for the new purpose and the new field of technology in which it is to be used, the positive effect yielded by the invention.

The specification should end with the formula of invention (claim or claims), i.e. a brief disclosure of the features of the alleged invention made in accordance with the established rules and characterising the scope of the invention, its novelty and object. The formula of invention is usually a multi-claim one, a single-claim formula being a particular case thereof.

The first claim of the multi-claim formula should disclose the basic (essential) features characteristic of a given subject of invention. The second (and subsequent) claims of the multi-claim formula should further develop and supplement the features disclosed in the first claim directly or indirectly, i.e. through the subsequent dependent claims.

When drafting the claims, the following should be borne in mind:

(i) the object of the invention cannot be introduced as a distinguishing feature;
(ii) the invention's title should not reflect the distinguishing features thereof.

Applications compiled in accordance with the above recommendations should be sent to the Patent Department of the U.S.S.R. Chamber of Commerce. Each application should be presented complete with the following documents:

1. An Order-Letter indicating the date of Convention priority and the date on which the applicant wishes his application to be filed with the Committee for Inventions and Discoveries. The Order-Letter must state the name of the applicant; the name and citizenship of the inventor; where the invention has been made by a group of people several names at least should be given, for, according to the Statute, true inventors should always be named in an issued patent.

2. The specification of the invention in duplicate if in a foreign language, or in quadruplicate if in the Russian language. If the specification is presented in a foreign language, translation is to be made by the Patent Department of the U.S.S.R. Chamber of Commerce. The application should be presented to the Patent Department one month before the expiration of the filing term, to provide time for translating the specification into Russian. Otherwise, additional expense for urgency will be incurred. If the applicant so wishes, the Department will send him the translated text for preliminary approval prior to filing.

3. Five copies of the drawings (if necessary).

4. Power-of-Attorney, Assignment Deed and Inventor's Declaration. These may be sent later, within one month from the date of filing the application. The Power-of-Attorney submitted by the applicant is valid for three years from the date of issue for all the applications filed in the U.S.S.R. in the name of the applicant.

5. A copy of the original application may be sent within three months from the date of filing the Convention application. The copy of the original application is to be translated only when necessary, at the request of the Committee for Inventions and Discoveries.

An application filed with the Committee for Inventions and Discoveries is first examined to ascertain whether unity of invention has been preserved and formal requirement observed.

The conclusions drawn after the preliminary examination are sent to the applicant, while the applica-

tion with all the documents pertaining thereto is directed to the Examiner for further examination.

If the materials on file are insufficient to enable a definite conclusion to be drawn, the applicant must at the Examiner's request submit, within a set period of time, additional material clarifying the application. The applicant has the right to amend his application within one month from the date of filing, without making essential changes in the application materials.

Having carefully examined the application materials, the Examiner decides either to grant an inventor's certificate or patent, or to reject the application. As a rule, the granting Official Action is accompanied by a preliminary version of the specification for the Applicant's approval. Should the applicant disagree with the claims suggested by the Examiner in the Official Action, he may file his objections, together with arguments. These will be considered additionally and, provided they prove essential, may be taken into account by the Examiner when drafting new claims, together with the applicant's objections to the text of the detailed description of the invention.

If, as a result of the examination, the application is rejected as unpatentable in view of certain printed publications, copies of the latter are sent to the applicant together with the rejecting Official Action. Foreign patents, cited in opposition, may likewise be sent to the applicant at his request.

The Applicant has the right to file his objections to the rejection of his application by the Committee, or objections to the claims, within one month from the date of receiving the Official Action.

The objections should be compiled in accordance with the respective paragraphs of the action. They should contain precise answers to each paragraph of the action, on the basis of a thorough analysis of the cited reference.

After a decision has been taken to grant a protective document, and the applicant has given his consent to the wording of the claims, the specification of the invention is sent for publication to the Bulletin of inventions published by the Committee for Inventions and Discoveries four times a month. The name of the bulletin has been changed several times. Since January, 1969, it has been cited "Discoveries, Inventions, Industrial Designs and Trademarks". The Patent Department informs the applicant of the date of the publication.

State fees are paid annually to keep the patent in force. The first payment of State fees usually covers the publication fee for the issue of a patent in the amount of 45 roubles. Upon the publication of the patent in the Official Bulletin the applicant is informed of the necessity to pay the official granting fee as well as the due annuities. A renewal fee in respect of a particular year must be paid before the expiry of the preceding year or, on favourable terms, within the first two months of the particular year. During the next four months, should the applicant still wish his patent to be protected, he is charged 0.2 per cent fine for each overdue day.

If the fees are not paid within six months, the patent lapses.

These are the main aspects of the Soviet patent legislation and of the operating procedures for the patenting of foreign inventions in the U.S.S.R.

**About the Speaker: M. L. Gorodisskii is a lawyer with a technical education background. For thirteen years he has held different posts with the USSR Ministry for Foreign Trade, and for the last eight years he has been Head of the Patent Department as well as a member of the Presidium of the USSR Chamber of Commerce. He has more than twenty publications on different problems connected with patenting and licensing.*

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SOME DATA ON THE WORK CARRIED OUT BY V/O "LICENSINTORG", USSR, IN THE FIELD OF LICENSING

by
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The All-Union Export-Import Association "Licensintorg", or as it is abbreviated V/O "Licensintorg" is a commercial foreign trade organization engaged in trading licenses. V/O "Licensintorg" enjoys the right of a juridical person and, as such, acts in its own name. V/O "Licensintorg" acts on the basis of its Articles of Association affirmed in accordance with the procedures established by Law.

In conformity with its Articles V/O "Licensintorg" owns property and bears material responsibility for its activities. The State bears no responsibility for commercial agreements made or other operations carried out by V/O "Licensintorg", just as the Association bears no responsibility for the obligations of the State or of other Soviet organizations. V/O "Licensintorg" has the right to carry out the various legal acts connected with the fulfilment of its operations.