

The USPTO Should Give Ukraine Even More Help

By **David Kappos, Teresa Summers and Andrew Baluch** (July 18, 2022)

In response to Russia's unprovoked and unjustifiable war against Ukraine, facilitated by the Belarusian government, the U.S. Patent and Trademark Office commendably imposed a slate of sanctions against the aggressor states.

First, the USPTO terminated engagement with officials from Russia's intellectual property office, known as Rospatent; Belarus' intellectual property office; and the Eurasian Patent Organization.[1]

Second, the USPTO will no longer grant requests to participate in the Global Patent Prosecution Highway based on work performed by Rospatent.[2]

Third, and most significantly, the USPTO notified Rospatent that it will terminate the bilateral agreement under which Rospatent functions as an international searching authority, and international preliminary examining authority, for international applications received by the USPTO under the Patent Cooperation Treaty.

The USPTO-Rospatent agreement will terminate effective Dec. 1.[3]

But, in addition to sanctioning Ukraine's aggressors, the USPTO should also take the following concrete steps to directly help Ukraine's patent office, or Ukrpatent, and Ukraine's economy.

Recognize Ukrpatent as an International Searching and Preliminary Examining Authority

In recent years, Rospatent has annually collected from \$1.1 million to \$1.7 million to conduct international PCT searches on approximately 1,900 to 2,800 applications received annually by the USPTO.[4]

When the USPTO-Rospatent agreement terminates this coming December, all the money and work which normally flowed to Rospatent will go elsewhere. No longer able to select Rospatent to do this work, applicants will need to select another patent office. Ukrpatent should be that office.

Specifically, the USPTO should authorize Ukrpatent to act as an international searching and preliminary examining authority for international applications received by the USPTO.

Not only is Ukrpatent morally entitled to this work because of Russia's war on its neighbor, Ukrpatent has also earned this work on its own merits: Ukrpatent was the only patent office in the world last year to receive a perfect score from the World Intellectual Property Organization for the timely transmittal of both international search reports and international preliminary reports on patentability to the International Bureau.[5]

To help ease Ukrpatent's onboarding as an international searching authority and international preliminary examining authority for the USPTO, initial limits can be set on the



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number of applications and search classes Ukrpatent will handle, similar to the limits initially set in the agreement between the USPTO and the Israel Patent Office.[6]

Initiate a PPH Pilot Program With Ukrpatent

The USPTO should initiate a Patent Prosecution Highway pilot program with Ukrpatent to speed up the examination of any patent application filed in one office based on a favorable patentability determination in the other.[7]

Such a PPH program will increase domestic and foreign demand for patent filings in Ukraine, including when applicants select Ukrpatent as their international searching authority as proposed above.

Provide Capacity Building and IT Support to Ukrpatent

The European Patent Office has announced an enhanced package of support measures and cooperation activities for Ukrpatent.[8] The USPTO should do the same.

Among the EPO's package of personnel assistance and IT support, the EPO has offered an ad hoc program for Ukrpatent staff, based on secondments and internships, as well as support for Ukrpatent's IT infrastructure.

The USPTO can similarly provide capacity building and training to Ukrpatent staff through the USPTO's Global Intellectual Property Academy office space in Alexandria, Virginia, and offsite data storage and cyber resiliency capabilities.

Conclusion

Without more assistance to Ukraine, we worry that the ongoing war will cause Ukrpatent's patent application workload to fall, leading to staff cuts and a weakened patent system in Ukraine.

A weakened patent system in Ukraine will harm the country's long-term economic outlook by discouraging investment in Ukraine's knowledge-based industries that are so critical to rebuilding the country after the war.

The USPTO, for its part, has the means to help Ukraine by conferring upon Ukrpatent the very benefits it had previously granted to Rospatent.

The three recommendations above are aimed at boosting patent filings in Ukraine, stabilizing Ukrpatent's workforce and workload and supporting the country's long-term economic recovery.

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[1] USPTO statement on engagement with Russia, the Eurasian Patent Organization, and Belarus, <https://www.uspto.gov/about-us/news-updates/uspto-statement-engagement-russia-and-eurasian-patent-organization>.

[2] Termination of Global Patent Prosecution Highway With Rospatent, 87 FR 19486 (Apr. 4, 2022).

[3] Update on termination of Rospatent as an ISA and IPEA for international applications, <https://www.uspto.gov/subscription-center/2022/update-termination-rospatent-isa-and-ipea-international-applications>.

[4] Rospatent Annual Reports 2019–2021; USPTO warns users on paying Russia for patent services using sanctioned banks, Intellectual Asset Magazine (Apr. 11, 2022) (noting payments to Rospatent under Fee Code 1714).

[5] PCT Yearly Review 2022, Tables C21, C27, <https://www.wipo.int/edocs/pubdocs/en/wipo-pub-901-2022-en-patent-cooperation-treaty-yearly-review-2022.pdf>.

[6] Israel Patent Office to Act as an ISA and IPEA for International Applications Received by the USPTO, https://www.uspto.gov/sites/default/files/patents/law/notices/ilpo_isa-ipea.pdf.

[7] USPTO Patent Prosecution Highway, <https://www.uspto.gov/patents/basics/international-protection/patent-prosecution-highway-pph-fast-track>.

[8] EPO-Ukrpatent Meeting (May 18, 2022), <https://www.epo.org/news-events/news/2022/20220518.html>.