

## **I. Introduction**

The Patent Law in China is designed to protect invention creations of products, methods and manufacturing processes, which are, inter alia, more advanced than existing technology and applicable to industrial use.

The term of a Chinese Invention patent is 20 years from the effective filing date of the application (rather than priority date). China has a first-to-file system, i.e., between two applicants for a patent for the same invention the first to file will be granted a patent.

## **II. Requirements For Filing In China**

An applicant in China may claim priority based upon a patent application filed in China and any other country/region (such as Hong Kong, Taiwan) that is a signatory of the Paris Convention or the Trips agreement.

A Chinese application should be filed with a copy of the description in Chinese, drawings, sequence listing, where necessary, and the following information:

- Name, nationality and address of applicant
- Name (if the inventor has Chinese name, the Chinese characters should be provided) and address of inventor(s), for Chinese inventor, the ID No. should be provided
- Priority application number, date and country
- Power of Attorney (Notarization or legalization is not required).

Please note that for the national phase application in China, the Chinese description must be filed within 30 months (two months grace period by paying official fee) from the earliest priority date, late supplement of Chinese translation version is not acceptable, which is different from Japan, and US.

### **Priority Document**

A certified priority document must be filed within sixteen (one year and four) months from the earliest filing date of the priority, alternatively, DAS code is also acceptable. While for PCT national phase in China, such document is not needed as WIPO will forward to CNIPA.

### **Adding priority**

According to Article 37 of the Implementing Regulations of the Patent Law, where the applicant has claimed priority, he may, before the Patent Office has made preparations for publication and within sixteen months from the date of priority or four months from the date of application, request to add or correct the claim for priority.

### **Restoration of Priority**

According to Article 36 of the Implementing Regulations of the Patent Law, if the subsequent application is filed after the expiration of the 12-month period from the filing date of the earlier application, the applicant may request the restoration of priority within two months from the date of expiration, before the Patent Office has made preparations for publication. This provision is similar to those in Japan and the United States.

### **Language Of Application**

All China (CNIPA) proceedings are performed in the Chinese language (simplified Chinese characters), it is not possible to file an initial patent application (or China national phase application) in English. For Taiwan Intellectual Property Office, traditional Chinese characters are required, which is different from Mainland China.

### **Electronic Filing**

Most of the patent applications are filed online in China, there is no difference on official fees between paper filing and electronic filing.

### **Specification**

CNIPA rules are rather lenient regarding the form of a specification. The specification must include a title of the invention, a brief description of any drawings that are present, a summary of the invention, and at least one claim.

According to Guidelines for Patent Examination, the Specification should contain the following format:

1. Technical field
2. Background
3. Summary (Problems that the invention is to solve, and Means of solving the problems, beneficial effects of the invention)
4. Brief description of Drawings (if applicable)
5. Detailed Description of the embodiments

Please notice that the CNIPA is very strict about the introduction of new matter in an application, which is totally different from USPTO, for example, we cannot introduce the feature that only shown on the Drawings into the claims or specification.

For national phase application in China, the requirement is not so strict, the Chinese translation of the published version of PCT is acceptable.

### **Chinese Claim Practice**

There is no limit on the number of claims that may be included in a single application. The basic official filing fee corresponds to upmost 10 claims (no more than 10 claims), no matter how many independent or dependent claims; and from the 11<sup>th</sup> claim, the applicant should pay additional fee. The additional fee only applies to the filing fee, while the examination fee is fixed.

It is important to note that, different from the other four offices in the IP5 (Europe, United States, Japan, and South Korea), the additional claim fees for entering national phase of a

PCT application in China are calculated based on the original PCT application. For example, if the original PCT application was filed before USPTO and it has 50 claims, and it has been amended to 15 claims for entering Japan, South Korea, Europe and China, these three (JP, KR, EP) Offices would charge official fees based on 15 claims; however, China will charge official fee based on the original 50 claims, resulting in an excess of 40 claims (6000 RMB). Among other countries, India has also adopts the same rule.

On the other hand, upon or after entering China, if the applicant files voluntary amendments to the claims, there will be no additional fees for increasing the number of claims beyond the original number. In addition, unlike the USPTO, after receiving the Office Action, the applicant can split the original claims (e.g. from 10 claims into 20 claims) without paying additional official fee, but cannot add new dependent claims. Currently, the requirement for divisional application in China is becoming strict, some divisional applications may be refused because the parent application does not lack the unity.

### "Provisional" Applications

While the CNIPA doesn't have a formal system for provisional application, as exists in the US, but the applicant may have the following options: 1. Claiming the priority of US provisional application; 2. Filing a simple application before CNIPA at first, then refiling the complete description claiming this application as priority. The first application merely needs to satisfy formalities such as an existence of a claim. For example, by repeating the title of the invention in claim 1, this formality can be satisfied. By disclosing the most important embodiment with such a simple claim, an earlier filing date can be obtained. This first application therefore has the same effect as a US provisional application. Please also note that this first application can be a priority base for those applications filed outside China.

According to the regulation, Chinese patent applications can claim domestic priority based on earlier filed Chinese patent applications. Embodiments, drawings, and claims can be added in new patent applications. The first application will automatically be abandoned if a new application claims a domestic priority based on the first application.

### PCT national phase Application

For PCT application filed in languages other than Chinese, it should be translated into Chinese while entering China national phase, late supplement is not acceptable. If there is amendment to the description, the translation version of original PCT description should also submitted, there is no official fee for filing voluntary amendment. There is no continuation application system in China. It's, therefore, important for those drafting PCT applications to consider the patent situation in all countries in which they intend to file, especially for the number of claims, as mentioned above, even though there is no additional fee in the PCT international stage, Chinese national phase will calculate the additional fee based on the originally filed PCT claims.

PCT rules do require that translations of all Articles 19 and 34 amendments be filed when entering a national stage, the only effect of not filing these amendments is that the amendments themselves are lost; but the applicant can also file voluntary amendment

while request substantial examination (or within 3 months from the date entering substantial examination).

For PCT national phase in China, the corresponding official fee needs to be paid before the deadline. Unlike ordinary domestic applications (e.g. claiming US priority), CNIPA does not send notice of payment, so the patent agency should calculate and pay the total fee by themselves before 30 or 32 months (with grace fee) deadline, and if the payment is insufficient or overdue, the national phase application will be refused, but there is no remedy.

The power of attorney can be filled later, at the latest within 2 months after receiving the notice of correction from CNIPA.

Please notice: starting from January 20, 2024, CNIPA has abolished the 15-day mailing time for issuing official notification (following EPO).

### **New Matter**

The CNIPA, like most patent offices around the world, won't allow applicants to introduce new matter into the application disclosure during prosecution of an application. The definition of what constitutes new matter is very strict in Chinese practice, and overseas applicants (especially US) should be aware of this when drafting their original filings with plans to file a corresponding application in China, and some parts that only shown in Drawings but not recorded in the specification are not permitted to add into the claims in the response process to Office Action.

Generally, unless specific parallel wording can be found within the specification as first filed, it's not possible to add such wording to the claims. When the applicant can show that the wording of the specification clearly infers such language, it's sometimes possible to add the language to the claims.

### **III. Prosecution**

Publication (Laying Open)

In China, all applications are laid open (published in the Patent Office Official Gazette) 18 months after their filing or priority date, whichever is earlier, while for PCT national phase application, it will be published within 3-6 months after entering China.

According to Article 48 of the Implementing Regulations of Patent Law, from the date of publication of the invention patent application to the date of notification of the grant of the patent right, any person/party may submit opinions (relevant prior art) to CNIPA on the patent application that does not comply with the provisions of the Patent Law, and state the reasons.

Provisional patent protection, based on a published application, is available in China. Please refer to, e.g., Supreme People's Court Case on Patent Interim Protection (2021) Supreme Court IP & Civil Final Judgment No. 434 (related to CN201510465803.9).

### **Request For Substantial Examination**

The CNIPA won't examine a patent application until a request for substantial examination is filed along with paying the appropriate official fee. Now, the applicant has three years from the filing date (or earliest priority date) in China to file such a request.

If a request for examination isn't filed by the deadline, the application will be deemed irrevocably withdrawn.

### Accelerated Examination

In China, there are three types of expedited examination processes:

1. **Pre-examination:** This process is very fast, if the request is accepted, most of such applications will have a chance to be granted within 3-5 months. For this process, the request must be submitted to the local IP protection center before filing application before CNIPA, and the application should be the first-time file, that is, no priority. There is also further requirement on the qualification of applicant.
2. **Priority Examination:** For priority examination, if accepted, the examination will be finished within one year, and the request should be filed after entering substantial examination, it also has requirement on the qualification of applicant.
3. **Patent Prosecution Highway (PPH):** This process allows applicant to request accelerated examination based on a positive examination result of a corresponding foreign patent office (in a patent family). When a PPH request is accepted, a first Office Action is usually issued within 1-3 months, as compared to about one year or more for normal applications.

All of the three expedited examination processes have no official fee. However, for foreign applicants, however, only PPH is available.

### Voluntary Amendments

In China, there are several opportunities for voluntary amendments to a patent application:

1. Amendments can be filed when entering the national phase in China.
2. Amendments can be filed when requesting substantive examination.
3. Amendments can be filed within three months after receiving the notification to enter substantive examination.

When responding to office actions, amendments can only address the examiner's issues and cannot introduce new claims, which is different from the practice in the United States.

### Information Providing Practice

While the US requires all patent applicants to promptly disclose any relevant prior art, China doesn't have a formal system equivalent to the US Information Disclosure Statement system. China does, however, have a procedure for requesting applicant to provide with relevant examining result from other Patent Offices for the corresponding patent family members.

## Rejection By The Examiner (Office Action)

After reviewing an application, a CNIPA examiner will issue either a notice of allowance or an office action citing reasons why the application was rejected. Grounds for rejecting an application are listed below. Similar grounds may also be used in opposition and invalidity proceedings.

- New matter was introduced into the application by amendment;
- Non-patentable subject matter, including: methods of intellectual activities, and methods of diagnosis and treatment of diseases.;
- Lack of novelty, inventive step or industrial applicability;
- The invention is liable to contravene public order, morality or public health;
- The specification does not describe the invention in a manner sufficiently clear and complete for the invention to be carried out by a person having ordinary skill in the art to which the invention pertains;
- The allowed claims are not (i) supported by the specification; and (ii) clear, concise, and written according to patent rules;
- Unity of the invention is not satisfied (not applicable for opposition or invalidation);
- conflicting application;
- double patenting;
- confidentiality review for foreign patent application.

The response deadline for the first Office Action (OA1) is 4 months, and for the second and subsequent OAs, it is 2 months, from the issuing date. Extensions of time can be requested (with corresponding fees required), and upmost to twice extensions can be requested for each reply. If there is no reply before the deadline, the application will be deemed to withdraw, and the applicant has two months to restore the patent application right, by paying the corresponding fee.

Examiner has the right to reject an application after at least one Office Action; some invention patent applications may be granted without any Office Action issued, but recently there has been an increase in cases where examiners proactively call patent attorneys to request amendments before granting the patent, and most of the time the examiner will propose to narrow the protection scope, if the applicant does not accept this proposal, it can request the examiner to issue an Office Action.

In CNIPA's Office Action, the examiner will not point out which claim(s) is/are allowable, and maybe in the second Office Action, a new prior art (X or Y document) is cited, and sometimes the examiner decides to issue the notification of grant, but this application then is subject to a random inspection and undergoes a quality check, it has the chance that the senior examiner denies and withdraws the grant, and requires the former examiner to do further search. This examination system is different from other countries.

China also has an abnormal review process, it may take place in the formal examination or substantial examination stage. Based on our current practice experience, this process does not involve foreign applicant (only excluding foreign applicant, but not inventor). Hundreds of thousands of domestic applications (inventions, utility models, and designs) are marked as abnormal applications each year, and CNIPA notifies the applicants to

withdraw them voluntarily. Some applicants file argument, and if success, CNIPA will withdraw the label and continue the examination of the application.

### Interviewing The Examiner

Interviewing the examiner (by telephone) is often an excellent way to help the Examiner understand the invention. Often the examiner will propose amendments that will clarify the claims to make them allowable.

### Re-examination Procedure

If the application is rejected by the examiner, the applicant may request re-examination before CNIPA within 3 months from the notification date of rejection. After the request for reexamination is filed, it is initially subject to a pre-examination, which is usually conducted by the original examiner (though in some cases, the examiner may be changed, there is no official notification about the pre-examination), and if the application document has been amended to meet the grant standard, the rejection will be withdrawn, and the examiner will either continue the search or proceed directly to grant the patent. If the pre-examination further confirms the rejection, then a collegial panel typically consisting of three examiners will establish to review this requirement, which process often takes more than one year.

If the rejection is withdrawn, the original examiner may continue supplementary search, and if new prior art document is found, a new Office Action (OA) can be issued, then continue to the end of a new round of examination (grant or reject). If the application is rejected again, another re-examination request can be filed. On the other hand, if the collegial panel upholds the rejection, a lawsuit can be filed before the Beijing Intellectual Property Court, which is the first instance. After the first instance, a further appeal can be filed before the Supreme People's Court for the second instance, which is the final review.

### Registration And Publication

Once a decision to grant a patent right is issued, the applicant should pay the corresponding annual fee (calculated from the filing date) to get the Certificate of Patent (E-form, no hard copy). After registration of the patent right, the patent number is the same as the application number, but only has ZL (refers to "patent") before the number.

The contents of the patent right as entered in the Patent Register will be published in the Patent Gazette.

## IV. Opposition Procedure

In China, there is no post-grant opposition procedure.

## V. Invalidity Procedure

In China, anyone (including the patentee) can file an invalidation request against a patent right. If the patentee files such request, only a partial invalidation can be requested, which strategy is usually employed to enhance the stability of their own patent right.

Grounds for initiating an invalidity process are similar to the grounds for an examiner's rejection of an application as mentioned above.

After the patentee receives the notification of invalidation request, it has one month to amend the claims. What is different from the re-examination is: the invalidation procedure often has one oral hearing (the attorney must go to Beijing to attend this oral hearing).

Upon receiving the invalidation decision, the losing party may file a lawsuit within 3 months before the Beijing Intellectual Property Court, which is the first instance. After the first instance, a further appeal can be filed before the Supreme People's Court for the second instance, which is the final review.