



Ten Things to Know About the Chinese Patent Process



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Aaron Winger is a Senior Attorney and SLW's Director of China Intellectual Property. Aaron counsels both U.S. and Chinese companies on portfolio development and preparation of their patent applications and office action responses. He has worked with clients in the areas of software, networks (wired and wireless), lasers, medical devices, semiconductors and physics.

Aaron prosecutes both Chinese and U.S. trademarks. He has also drafted and prosecuted hundreds of U.S. and international patent applications in a broad spectrum of areas, including computer hardware and software, the Internet, multimedia distribution systems, computer games, digital and analog circuitry, and semiconductor design and fabrication, to name a few.

Most recently, Aaron has counseled Chinese companies on freedom to operate analyses for their entry into the U.S., represented a U.S. gaming company with operations in China, handling Series A and IP issues in China through to IPO; a U.S. scanning electron microscope company, handling their patent portfolio from incorporation through exit via acquisition, and a U.S. wireless company through acquisition. His knowledge of both the Chinese and American markets allows him to advise his clients as they expand their patent portfolios and look for investors to help the company grow.

Aaron has been in China for more than a decade and is conversational in Mandarin. He is a frequent contributor to ZhiChanLi.

An aerial night view of a city skyline, likely Shanghai, featuring numerous skyscrapers and illuminated streets. A semi-transparent dark blue rectangular box is overlaid on the image, containing white text. The text is arranged in three lines: a bold statement, a citation, and a URL.

Presentation is based on the article:

Aaron Wininger and Xia Wu, *10 Things to Know About the Chinese Patent Process*,
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An aerial night view of a dense city skyline, likely Shanghai, featuring numerous skyscrapers and illuminated streets. A semi-transparent dark blue rectangular box is overlaid on the left side of the image, containing the word "Filing" in white. The word "Filing" is written in a large, bold, white sans-serif font, centered within the box. The background shows a mix of modern glass skyscrapers and older buildings, with a river visible in the upper left corner.

Filing

1. National Phase Entry Deadline

- The deadline to enter the national phase in China is 30 months.
- This deadline can be extended as a matter of right to 32 months¹ with the payment of a 1,000 RMB fee (about \$143).
- However, unlike the U.S., this deadline cannot be extended further with a showing of unintentional abandonment.
- Translations must be provided at the time of filing and cannot be filed later as in the U.S.

[1] Article 103 of the Implementing Rules of the Chinese Patent Law.

2. Reducing Claim Fees

- Claim fees at national phase entry are based on the number of claims published in the Patent Cooperation Treaty application. Reducing the claims at filing will not reduce the claim fees due.
- Applicants may wish to file their PCT application with fewer claims (i.e., 10 are included in the China filing fee) and list any deleted claims as examples to be added back in later.

- There are no additional claim fees for adding claims in a voluntary amendment, potentially leading to significant filing fee savings as each additional claim over 10 is 150 RMB (about \$21).
 - For example, an application filed with 10 claims and 40 claims added later via voluntary amendment would save over \$800 in additional claim fees.

3. Choosing Type of Application

- Unlike the U.S., China offers both utility models (UMs) and invention patents (similar to U.S. utility patents).
- UMs can offer significant advantages over invention patents in exchange for a shorter patent term (half of an invention patent term) including quicker grant (since there is no substantive examination) and invalidation protections since there is a lower bar for inventive step.²

[2] UMs require “substantive features and indicates advancements” vs. “prominent substantive features and indicates remarkable advancements” for invention patents. See Article 22 of the Patent Law.

- However, at national phase entry, applicants must choose one or the other.
 - File UM when:
 - Subject matter eligible – “products”
 - Low inventiveness.
 - Potentially want to enforce quickly.
- To have the best of both worlds, applicants should consider filing UMs and invention patent applications simultaneously via the Paris Convention at 12 months, as discussed further in the next section.

4. Filing UM and Invention Patent Applicants Simultaneously in China

- For “products” (generally, mechanical inventions), applicants can file both a utility model and invention patent simultaneously by the 12-month priority date. By filing both (they must be filed on the same day),³ applicants can get quick patent protection via the UM (often within a year or less of filing) while their invention patent applications are still pending (often for years).

[3] Article 9 of the Chinese Patent Law.

Limitations

1. If the UM and invention patent have the same scope, then the applicant must abandon one or the other when the invention patent is to grant.
 - Oftentimes, due to amendments to the invention patent application during prosecution, scopes are different so abandonment is not required.
 - If abandonment is required, usually, applicants will keep the invention patent due to the longer term (20 years vs. 10 years)⁴ and much of the UM term may have already passed.
 - While the invention patent may have a narrower scope than the UM due to amendments made during prosecution, the invention patent may also have a better chance of surviving invalidation proceedings since it has been substantively examined.

[4] Article 42 of the Chinese Patent Law.

Limitations

2. UMs aren't for all inventions. UMs have limited subject matter eligibility.

- UMs can be granted only for products. The products “shall be objects manufactured by industrial methods, having definite shape and structure, and occupying a certain space.”⁵
 - Thermometer (comprising mercury have a non-fixed shape)
 - Parachute (fixed shape in specific circumstances)
 - Engines, Fire Extinguishers, Stents, etc.
- Accordingly, mechanical inventions can usually be protected via UM but not methods, chemicals/pharmaceuticals, software, etc.

[5] Article 2 of the Chinese Patent Law.

Limitations

3. Due to an increased focus on patent quality, chances are increasing that an examiner will issue a substantive rejection for some UMs (e.g., those that appear to be blatant copies of prior inventions).

Fees

- The additional fees for filing UMs are minimal:
 - Foreign associate's fee for formatting and filing the UM
 - and the China intellectual property office official fees, including filing fee of RMB 500 (about \$71) and grant fees of RMB 200 (about \$29).
- There should be no additional translation fee, since the UM can use the same translation as the invention patent application.

An aerial night view of a city skyline, featuring a prominent skyscraper with a large, illuminated, rectangular frame structure. The city is densely packed with buildings, and the streets are lit up with orange and yellow lights. A semi-transparent dark blue rectangle is overlaid on the left side of the image, containing the word "Prosecution" in white, bold, sans-serif font.

Prosecution

5. Voluntary Amendments: Adding New Claims and Claim Fees

Adding new claims (and amending on applicant's initiative) in Chinese invention applications is only allowed at specific times:

- (1) at initial filing;
- (2) when filing a request for substantive examination;
- (3) within three months from receipt of notice of entering substantive examination from the China National Intellectual Property Administration.⁶
 - There is no CNIPA fee for adding claims during voluntary amendment after initial filing.

[6] Article 51 of the Implementing Rules of the Chinese Patent Law.

- For UMs, applicants can file voluntary amendment within two months from the filing date or date of entry of national phase.⁷
- For quicker prosecution in Chinese applications claiming priority to U.S. applications, we recommend amending Chinese claims to match examined U.S. claims.
 - Oftentimes, Chinese examiners will repeat rejections raised in the priority application, in addition to performing their own search and examination.

[7] Article 112 of the Implementing Rules of the Chinese Patent Law.

- Generally, Chinese patent examiners will usually not allow an applicant to add claims during an office action response per Chinese patent examination guidelines.¹
 - Instead, an examiner will issue a new OA rejecting the added claims, thereby delaying a potential grant of any allowed claims.
 - Applicants can, however, amend claims in response to rejections raised by examiners.

[1] Article 103 of the Implementing Rules of the Chinese Patent Law.

6. Antecedent Basis

- Chinese examiners are strict on antecedent basis.
- An examiner usually requests the Applicant to recite exactly identical terms as the previously presented term.
 - For example, if a base claim recites “a metal film resistor,” the applicant should recite in dependent claims “the metal film resistor” instead of simply “the resistor”, even if there is only one resistor recited in claims.

7. Lack of Literal Support

- Chinese examiners are strict on literal support.
- The examiner may object to applicant's replacement and/or deletion of quantifiers or adjectives in claim amendment.
 - For example, if a claim recites "three cylinders," and the description and drawings recite and show, respectively, three cylinders, an examiner is unlikely to accept amending claims to replace "three" with "a plurality" despite three being a plurality.
 - Similarly, replacing "three" with "at least two" would probably also not be acceptable.

8. Preambles

- While U.S. practice generally allows applicants to minimize preambles to simply “a system” or “a method,” CNIPA examiners generally require applicants to recite the technical field in the preamble.⁸
 - For example, CNIPA examiners may not accept “a method” but would be more likely to accept “a method of signal processing.”

[8] Article 21 of the Implementing Rules states that a claim must include “a preamble portion: indicating the title of the claimed subject matter of the technical solution of the invention or utility model, and those technical features which are necessary for the definition of the claimed subject matter but which, in combination, are part of the most related prior art”

9. Divisional Applications

- Unlike in the U.S., it is generally not possible to file divisional applications (equivalent to continuation or divisional applications in the U.S.) of divisional applications.
 - That is, unlike the U.S., applicants cannot usually have a long chain of divisional applications in China.
 - Generally, divisional applications can only be filed when the original Chinese application is still pending.⁹
 - The only exception is when there is a unity rejection in a divisional.
 - Accordingly, to keep a patent family pending, Applicants may try to force a unity rejection in a divisional by filing multiple independent claims with a different “special technical features” in each independent claim (different novel and inventive limitation in each independent claim).

[9] Article 42 of the Implementing Rules of the Chinese Patent Law.

10. Use Method of Manufacturing Claims

- As there is minimal discovery, include methods of manufacturing new products to switch burden of proof.⁹
 - Defendant must then prove that their manufacturing method is different from the patented method.
 - Both product and method must be new.

[9] Article 61 of the Chinese Patent Law.

An aerial night view of a city skyline, featuring a prominent skyscraper with a large, illuminated, rectangular frame structure. The city is densely packed with buildings, and the streets are lit up with warm orange lights. A semi-transparent dark blue rectangle is overlaid on the left side of the image, containing the word "Conclusion" in white text.

Conclusion

Updates to Examination Guidelines

- Examiners must prove common knowledge when challenged.
- Stem cells separated from human embryos within 14 days of fertilization are patent-eligible subject matter
- Claims including abstract features should be examined as a whole.
 - technical problems, utilized technical means, and achieved technical effects

Making Sure to Work with Chinese Counsel

- Due to the differences between U.S. and Chinese patent practices, especially in formality issues, it is advisable to allow the Chinese counsel to review and amend the claims to comply with Chinese practice for formality issues, such as antecedent basis, at the time of filing the response.
- Further, the applicant's Chinese counsel is suggested to conduct a telephone interview with the examiner to clarify rejections and sound out proposed responses before filing the response to Office Actions.

- In conclusion, by following the above strategies, the applicant can smooth patent prosecution through CNIPA.
- Further, the applicant should consider taking advantage of the Patent Prosecution Highway program to expedite examination.
- Finally, as examination is not automatic but must be requested, applicants should consider requesting examination at filing to speed prosecution.

An aerial, high-angle photograph of a city skyline at night. The image is dominated by numerous skyscrapers, many of which are illuminated with lights. The city is set against a dark background, and the lights from the buildings and streets create a vibrant, glowing effect. A semi-transparent blue rectangular overlay is positioned in the center of the image, serving as a background for the text.

Any questions?

<https://www.chinaiplawupdate.com>

An aerial, high-angle photograph of a city skyline at night. The image is dominated by numerous skyscrapers, with lights reflecting off their glass facades and illuminating the surrounding urban landscape. A semi-transparent dark rectangle is centered over the image, serving as a background for the text.

Thank you

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