



# Top 5 Changes in Chinese Patent Practice Based on the Amended Implementing Regulations of the Patent Law & Examination Guidelines

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# Episode Overview

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- Conclusion





# Background





# Background

- Phase One Trade Agreement signed January 15, 2020
- Amended Patent Law Passed October 17, 2020
  - Effective June 1, 2021
- First Draft Patent Examination Guidelines released November 10, 2020
- First (only) Draft Implementing Regulations on November 25, 2020
- Second Draft Patent Examination Guidelines released August 3, 2021
- Third Draft Patent Examination Guidelines released October 31, 2022
- State Council releases amended Implementing Regulations of the Patent Law on December 21, 2023
  - Effective January 20, 2024
- CNIPA releases amended Examination Guidelines on December 21, 2023



# Forgiveness

A photograph of a modern city skyline at dusk, featuring the Oriental Pearl Tower and other skyscrapers, viewed from an elevated road with a curved overpass. The word "Forgiveness" is overlaid in white text on the left side of the image.



## Restoration of Priority – Articles 36 and 128

- Chinese invention patent applications or utility model applications filed after 12 months but on or before 14 months from the priority date.
  - Requires providing “sound reason”
- PCT National Phase Entry
  - restoration of priority claim has been accepted by the receiving office of the PCT application; or
  - the request for restoration of priority claim was not filed or not accepted at the international stage, the applicant can file a request for restoration of priority claim within 2 months after entry into the Chinese national phase
    - requires providing “sound reason”
- Designs not eligible.
- Effective January 20, 2024



## Correction of Priority – Article 37

- Add or correct priority claim within 4 months of filing a Chinese application or 16 months from earliest priority date.
- Invention or utility model only, not design.
- Effective for applications filed on or after January 20, 2024.





## Incorporation by Reference – Article 45

- Incorporation by reference is default claimed by using CNIPA forms.
- For invention patent applications and utility models.
  - Lack of or incorrect claims or specification (or part thereof) but claimed priority, can submit correct or missing claims or specification with 2 months of the filing date or date specified by CNIPA
    - But not drawings per Article 46.
  - Maintain initial filing date.

# Deadlines: 15-Day Mail Delay





## Deadlines: 15-Day Mail Delay – Article 4

- 15-day mail delay still applies for documents sent by mail from CNIPA
- Documents served electronically by CNIPA are deemed served on the date they enter the electronic system.
  - No more 15-day mail delay for most documents
  - Second and subsequent office actions have a 2-month response deadline.
  - Response to Notice of Reexamination has a 1-month deadline.



# Patent Term Compensation







## Patent Term Adjustment - Articles 77 & 78

- For invention patent applications only.
- Must file request for PTA within 3 months of grant with fee.
  - Not calculated and awarded automatically by CNIPA
- Calculated as CNIPA delay minus Applicant delay:
  - 4 years from application date; and
  - 3 years from the date of filing request for examination
  - Minus applicant delay
    - Extensions taken for office action responses;
    - Request to delay examination filed;
    - Incorporation by reference used;
    - And other unreasonable delays
- No PTA if utility model and invention patent applications filed simultaneously
- Administrative Reconsideration available to patentee and interested third party



## Patent Term Extension – Articles 81 and 82

- PTE only available for new drugs, preparation methods, and medical use.
- Can only get PTE for one patent per drug.
- Can only get PTE for one drug per patent.
- Calculation: Difference between Marketing Authorization Date and Patent Application Date minus 5 years
  - PTE is limited to 5 years maximum and total effective term can be no more than 14 years from the date of marketing approval
- Administrative reconsideration available to patentee or interested party.
- Potentially only available to drugs not marketed before internationally and domestically?

# Quantity to Quality





# Utility Model Examination – Examination Guidelines

- Utility Model grants down about 25% in 2023
- Part I, Chapter 2, Section 11, of the Examination Guidelines (page 70) introduces inventiveness examination in addition to novelty.
  - “obviously lacks novelty and inventiveness.”
- Guidelines refer to examination of utility models during invalidation.
  - Lower inventiveness requirement compared to invention patents
  - Generally, only 2 references can be combined





## Good Faith Requirement – Articles 11 and 69

- Applicants for patents shall adhere to the principle of honesty and good faith. All patent applications must be based on genuine inventive activities, and no fraudulent or deceptive practices shall be tolerated.
- Grounds for invalidity.
- Fine of up to 100,000 RMB.



# Good Faith Requirement – Articles 11 and 69

- Article 3 of the Updated Regulations Against Applying for Abnormal Patents defines abnormal behavior as:
  1. The submission of multiple patent applications with significantly identical inventive content or those formed by simply combining different inventive features or elements.
  2. Patent applications that involve the fabrication, forgery, alteration of inventive content, experimental data, or technical effects, or that plagiarize, replace, or piece together existing technology or designs.
  3. Patent applications whose inventive content is primarily randomly generated through computer technologies or the like.
  4. Patent applications with inventive content that clearly does not conform to the principles of technological improvement or design, or that degrade, amass, or unnecessarily limit the scope of protection.
  5. Applicants submitting multiple patent applications without actual research and development activities and who cannot provide reasonable explanations.
  6. The malicious dispersal or sequentially or heterogeneously filing of multiple patent applications substantially associated with a specific entity, individual, or address.
  7. The transfer or acquisition of patent application rights for improper purposes, or the fraudulent change of inventors or designers.
  8. Other abnormal patent application behaviors that violate the principle of good faith and disrupt the normal order of patent work.

# Designs





## Partial Designs – Articles 30 and 31

- Overall product views must be submitted with a combination of broken and solid lines.
- Brief description should describe the partial design.
- Both whole and partial designs can be included in a single patent application.





## Priority to Invention or Utility Model – Article 35

- Can claim domestic priority in a design from an invention or utility model on the same subject matter shown in the drawings.
- The priority application will not be deemed to be withdrawn unlike other domestic priority applications.

# Conclusion





# Conclusion

- Other Provisions
  - Open Licensing
  - International Designs
  - Patent Evaluation Report
  - Inventor Remuneration
- Regulations limit some elements of the Phase I Trade Agreement
  - PTA and PTE will be minimal for foreigners
- Update docketing systems and FAs must report faster due to elimination of 15-day mail delay
- Expect a further decrease in 2024 of utility model grants if not applications



## Resources

- Translation of the Implementing Regulations available here:  
<https://www.chinaiplawupdate.com/2024/01/translation-of-chinas-amended-implementing-regulations-of-the-patent-law/>
- Translation of the Patent Law available here:  
<https://www.chinaiplawupdate.com/2021/09/chinas-national-peoples-congress-releases-translation-of-the-amended-patent-law/>
- Join the AIPLA IP in China Committee!  
<https://www.aipla.org/>





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Thank you for your interest.

Questions?

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