

Questions

Groups are invited to answer the following questions under their national laws:

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I. Analysis of current law and case law

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

Like many other of the world's national and regional patent systems, the Chinese Patent Law stipulates an 18-month time limit by which an invention patent application is made public. After the publication of the invention application, the applicant would have right to ask any entity or individual who exploiting the invention to pay an appropriate fee.

Please kindly find the related articles and rules for your reference as follows:

(Note: 1) the patent administration department under the State Council mentioned in the Articles or Regulations means State Intellectual Property Office of the P.R.C. (the "SIPO");

2) the application mentioned herein means a patent application for invention, exclusive two other types of patent application under Chinese patent practice, utility model and design, as they would not be published until granting.)

Article 13 of the Patent Law of the P.R.C.

After the publication of the application for a patent for invention, the applicant may require the entity or individual exploiting the invention to pay an appropriate fee.

Article 34 of the Patent Law of the P.R.C.

Where, after receiving an application for a patent for invention, the patent administration department under the State Council, upon preliminary examination, finds the application to be in conformity with the requirements of this Law, it shall publish the application promptly after the expiration of the eighteen months from the date of filing. Upon the request of the applicant, the patent administration department under the State Council publishes the

application earlier.

Rule 46 of the Implementing Regulations of the Patent Law of the P.R.C.

Where the applicant requests an earlier publication of his or its application for a patent for invention, a statement shall be made to the patent administration department under the State Council. The patent administration department under the State Council shall, after preliminary examination of the application, publish it immediately, unless it is to be rejected.

Rule 48 of the Implementing Regulations of the Patent Law of the P.R.C.

Any person may, from the date of publication of an application of an application for a patent for invention till the date of announcing the grant of the patent right, submit to the patent administration department under the State Council his observations, with reasons therefor, on the application which is not in conformity with the provisions of the Patent Law.

Rule 114 of the Implementing Regulations of the Patent Law of the P.R.C.

With regard to any international application for a patent for invention, if the patent administration department under the State Council, after preliminary examination, considers it in compliance with relevant provisions of the Patent Law and these Implementing Regulations, it shall publish it in the Patent Gazette; where the international application is filed in a language other than Chinese, the Chinese translation of the international application shall be published.

Where the international publication of an international application for a patent for invention by the International Bureau is in Chinese, the provisions of Article 13 of the Patent Law shall apply from the date of the international publication. If the international publication by the International Bureau is in a language other than Chinese, the provisions of Article 13 of the Patent Law shall apply from the date of the publication of the Chinese translation by the patent administration department under the State Council.

With regard to an international application, the publication referred to in Articles 21 and 22 of the Patent Law means the publication referred to in paragraph one of this Rule.

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

Yes, the publication of patent applications occurs automatically after the expiration of the eighteen months from the date of filing in China while the first step formality examination is completed.

It is regulated under the Article 34 of the Chinese Patent Law that, after receiving an application for a patent for invention, the patent administration department under the State Council, upon preliminary examination, finds the application to be in conformity with the requirements of this Law, it shall publish the application promptly after the expiration of the eighteen months from the date of filing.

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

Yes, claiming priority from or the benefit of an earlier application will affect the timing of publication for a Chinese patent application. In that case, the timing of 18-month publication for Chinese patent applications would count from the date of the first priority, instead of the date of filing.

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

No, there is not a specific point in time up to which the applicant can withdraw its application without it being published.

According to the Article 32 of the Chinese Patent Law, an applicant may withdraw his or its application for a patent at any time before the patent right is granted. Therefore it would be possible for the applicant to withdraw its application at any time if it has not been published yet.

When withdrawing an application for a patent, the applicant shall submit to the patent administration department under the State Council a declaration to that effect stating the title of the invention-creation, the filing number and the date of filing.

When a declaration to withdraw an application for a patent is submitted after the preparations for the publication of the application document has been completed by the patent administration department under the State Council, the application document shall be published as scheduled.

5. What parts of a pending patent application are published?

Abstract, Specification, Claim(s), Drawing(s), Abstract Figure(s) and Bibliography Data.

6. Does a published pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

Yes, a published pending patent application does give rise to provisional rights in China.

According to the Article 13 of the Chinese Patent Law, after the publication of the application for a patent for invention, the applicant may require the entity or individual exploiting the invention to pay an appropriate fee.

The applicant can also request the administrative authority for patent affairs to mediate the possible dispute with an entity or individual exploiting the invention.

According to Rule 85 of the Implementing Regulations of the Patent Law, the administrative authority for patent affairs may also mediate in the patent dispute over the appropriate fee to be paid for the exploitation of an invention after the publication of the application for patent but before the grant of patent right. Where the party concerned requests the administrative authority for patent affairs to mediate, the request shall be made after the grant of the patent right.

With respect to international application for a patent for invention, please be advised that where the international publication of an international application for a patent for invention by the International Bureau is in Chinese, the provisions shall apply from the date of the international publication. If the international publication by the International Bureau is in a language other than Chinese, the provisions shall apply from the date of the publication of the Chinese translation by the patent administration department under the State Council.

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

No, an unpublished pending patent application does not give rise to provisional rights in China.

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

Yes, 'early publication' is allowed in China.

The applicant can file a request for early publication to the SIPO. The related application would be published immediately after request is accepted upon the

formality examination has also been completed.

According to Rule 46, where the applicant requests an earlier publication of his or its application for a patent invention, a statement shall be made to the patent administration department under the State Council.

The patent administration department under the State Council shall after preliminary examination of the application, publish it immediately, unless it is to be rejected.

If one pending patent application is published earlier, it would also give rise to provisional rights earlier. It would also constitute a prior art at the earlier date.

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

Yes, non-publication is possible in China under some specific situation.

It is regulated under the Article 4 of the Chinese Patent Law that where an invention-creation for which a patent is applied for relates to the security or other vital interests of the State and is required to be kept secret, the application shall be treated in accordance with the relevant prescriptions of the State.

The applicant could request the patent administration department under the State Council to keep the application non-published, or the patent administration department under the State Council could make the non-publication decision by itself.

10. Will a lapsed, abandoned or withdrawn patent application be published? If not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

No, if a patent application has been lapsed, abandoned or withdrawn before it is published, it would not be published later while the eighteen-month is due, which is automatic.

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

Initially, please be advised that there is no continuation nor continuation-in-part applications in China. Instead, the applicant could file a divisional application

before two months from the date of receiving the Notification of Grant.

The divisional application shall be entitled to the filing date of the initial application, and will be published at eighteen months later since the filing date automatically upon the completion of the preliminary examination. If the date of filing the divisional application to the SIPO is later than the eighteen-month due, the divisional application will be published immediately while the preliminary examination is completed.

II. Policy considerations and proposals for improvements to your current system

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

Yes, there should be a requirement for automatic publication of pending applications by a particular deadline, so that the applicant would have a fixed time limit to consider further possible action, like withdrawal.

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

Yes, there should be a right for the applicant to request early publication. The provisional protection of the application can only be provided after the publication. Earlier publication could let the application give rise to provisional rights earlier. It could also constitute a prior art at an earlier date.

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

No, the applications deriving from the same priority application may also have different scopes. It should not be compulsive to publish all the applications deriving from the same priority application at the same time.

15. Should there be a right for the patentee to withdraw the application before publication?

Yes, there should be a right for the applicant to withdraw the application before publication. The right for filing a patent application is a civil right under the current Chinese Law. The applicant would have right not to publish its own

application. Withdrawing the patent application is one of the method for the applicant not to publish its application.

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:

a. with respect to the patentee's own subsequent patent applications;
and

If the applicant withdraws its application before publication, the applicant can re-draft the original application and file it with the SIPO later without any novelty problem.

b. with respect to third party patent applications?

If the applicant withdraws its application before publication, the application would not constitute prior art or conflicting application against the later-filed application relating to the identical or similar invention-creation.

17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?

The SIPO needs not to provide its initial assessment of the validity of the patent under this situation.

18. In light of your answers to the previous policy questions, what would be appropriate time limits for:

a. the patent office to provide the results of its initial assessment?;

Before publication of the application.

b. the applicant to decide whether to withdraw the application?; and

After receiving the office action from the SIPO.

c. the application to be published?

A fixed time counting from the date of filing but after passing preliminary examination.

19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:

a. on the initiative of the patentee;

Yes, if the applicant thinks its application is related to the security or other vital interests of the State, a request for secret patent can be filed at the same time of the new filing. The secret patent will not be automatically published by the eighteen-month due date.

b. on the initiative of the patent office; or

Yes, if the application is deemed as a relating to the security or other vital interests of the State by the patent office, the examiner will start the secret patent examination immediately. The secret patent will not be automatically published by the eighteen-month due date.

c. on the initiative of third parties (such as other governmental agencies)?

Yes, other competent governmental agencies should also have a right to request the patent office not to publish an application relating to the security or other vital interests of the State.

20. If your answer to question 19 is yes, who should decide on whether such exception is applied?

The responsible examiner of the SIPO.

21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?

No.

22. What proposals would you make to improve your current system?

The publication practice of a patent application has been well-established in China.

Just to mention one point, that is, more detailed provisions should be stipulated concerning the provisional protection right of a published application to ensure the related rights of the applicant.

III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

No, we do not suggest patent offices to provide examination results or search results prior to publication of the patent application.

The period for substantive examination is quite long. If the application is published after the substantive examination, the possibility of repeated studies, repeated investments or repeated applications would be higher. And the search work would also take some time.

24. Should there be any exception to publication of applications, for example by the applicant's opt-out?

Yes, there should be exceptions to publication of applications. If the applicant would not like to continue the application before publication under further considerations, the applicant should have right to withdraw the application. And, if the application is deemed as relating to the security or other vital interests of the State and is required to be kept secret, it should not be published.

25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication? To what extent should these exceptional circumstances be specifically defined?

Exceptional circumstances should be defined according to the relevant prescriptions of the State.

26. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?

We think 18 months since the filing date would be an appropriate period, which is also harmonious with the current international practice.

27. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.

We suggest a latest publication date of a patent application, based on the current 18-month publication due date.

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