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SPECIAL ISSUE

PANAWELL INTELLECTUAL PROPERTY



Cover: Interior of office block where Panawell locates

TABLE OF CONTENTS

SOLUTION



Panawell Intellectual Property, consisting of Panawell & Partners, LLC and Panawell & Partners Law Firm, provide full spectrum of services in all fields of intellectual property rights, such as patent, trademark, copyright, computer software, anti-unfair competition, trade secrets, custom protection, domain name, license, assignment, enforcement, administrative and civil litigation, IP consulting and management.

Summary of the Revision to the Implementing Regulations of Chinese Patent Law and the Patent Examination Guidelines:

1. The applicant of electronically-filed patent application will no longer benefit from the 15-day mailing period for official notices.
2. Violation of the principle of good faith will become the reason for rejection and invalidation request.
3. The reexamination panel can conduct examination ex officio on other contents beside the reexamination request.
4. For the invention-creation disclosed for the first time at an academic/technical conference held by an international organization, the applicant will be able to request for novelty grace period.
5. The applicant will be able to request for restoration of priority no later than 14 months from the priority date.
6. The applicant will be able to request for addition or correction of priority within 16 months from the priority date.
7. The applicant will be able to request for incorporation by reference within 2 months from the application date.
8. The requirements on partial design applications have been clarified.
9. The requirements on international design applications have been clarified.
10. The applicant will be able to withdraw the request for delayed examination.
11. The requirements on patent term compensation have been clarified.
12. The applicant will be able to order the utility model or design patent evaluation report when paying the grant fee.
13. The requirements on open license have been clarified.
14. The rules on rewards and remuneration for inventors of service inventions have been revised.
15. The process to grant foreign filing license has been revised.

Summary of the Revision to the Implementing Regulations of Chinese Patent Law and the Patent Examination Guidelines

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According to the Decision to Revise the Implementing Regulations of Chinese Patent Law issued on December 11, 2023 by the State Council, the China National Intellectual Property Administration (CNIPA) announced the Transitional Measures regarding the newly-revised Implementing Regulations on December 21, 2023, and simultaneously released the newly-revised Guidelines on Patent Examination. The newly-revised Implementing Regulations of Chinese Patent Law and the newly-revised Guidelines on Patent Examination will take effect from January 20, 2024. The revisions are mainly focused on the following aspects:

1. The applicant of electronically-filed patent application will no longer benefit from the 15-day mailing period for official notices.

Provision: In respect of the patent applications filed through the online system of CNIPA, the CNIPA will issue official notices in electronic form, and the issue date will be deemed as the date of receipt. In respect of the patent applications filed in paper form, the CNIPA will send paper official notices via post or other means, and the issue date plus 15 days will be deemed as the date of receipt.

Comment: At present, up to about 99% of Chinese

patent applications are filed through the CNIPA's online system. For an electronically-filed application, as long as the official notice is issued after the Implementing Regulations comes into effect, the time limit for responding to the notice will be calculated from the issue date. For example, if the CNIPA issues an official notice on January 20, 2024 to an electronically-filed patent application, and the official notice requests the applicant to make a response in two months from receipt of the notice, the time limit for responding to the notice will be March 20, 2024.

Scope of Effect: Any official notices issued on or after January 20, 2024 to an electronically-filed patent application will be subject to this provision.

2. Violation of the principle of good faith will become the reason for rejection and invalidation request.

Provision: It is provided in the newly-added Rule 11 of Implementing Regulations that "applications for patents should follow the principle of good faith, all types of patent applications should be based on real inventive and creative activities, and no fraud is allowed". Violation of this Rule 11 will form the basis for the Decision of Rejection issued by the CNIPA to invention/utility model/design patent applications, and be a reason for others to request invalidation of an invention/utility model/design patent. Moreover, the violator may further face administrative penalties from the market supervision and management authorities at or above the county level, including a warning and a

fine of less than CNY 100,000.

Comment: This provision mainly targets abnormal patent application behavior, that is, intentional fabrication and repeated submission of patent applications without being based on real inventive or creative activities, but for purposes like fabricating performance and defrauding subsidies. The CNIPA issued the "Measures on Regulating the Behavior of Patent Applications" in March 2021, which provided a detailed definition of such abnormal patent application behavior and stipulated specific procedures; but the punishment provided in the Measures is to require the violator voluntarily withdrawing the relevant patent application and supplementing patent fees, and to make Decision of Rejection to the relevant patent application. The CNIPA has also added the principle of good faith to the newly-revised Patent Law effective as of June 1, 2021, without prescribing the corresponding punishment in detail. Apparently, the revised Implementation Regulations stipulate more severe penalties for such behavior.

Scope of Effect: For patent applications that are under preliminary examination, substantive examination or reexamination procedure on or after January 20, 2024, the CNIPA will conduct examination according to this provision. And starting from January 20, 2024, the public can use this provision as a reason for requesting invalidation of a granted patent.

3. The reexamination panel can conduct *ex officio*

examination on other contents beside the reexamination request.

Provision: During the reexamination procedure, if the reexamination panel deems that the reexamination request does not comply with the relevant provisions or the patent application has other obvious defects, it shall notify the applicant. If the applicant, after making observations and/or amendments, still fails to overcome the defects notified by the panel, the panel shall issue the Reexamination Decision to finally reject the application.

Comment: Before the revision of Implementing Regulations and Examination Guidelines, in practice the reexamination panel usually only examines the contents involved in the Decision of Rejection made during the substantive examination and the reexamination request submitted by the applicant, and does not review any other defect of the patent application. The revised Implementing Regulations and Examination Guidelines prescribe in detail the ways for the reexamination panel to review other obvious defects in the patent application *ex officio*. For example, in addition to the defects commented in the Decision of Rejection, the panel may further point out that the application violates the principle of good faith; if the Decision of Rejection comments that a claim is not clear, the panel may point out the defect that the relevant part in the description is not clear; if the Decision of Rejection comments a claim is not inventive, the panel may point out the claim is not clear enough

for inventiveness evaluation; and on the basis of the references and other evidences listed in the Decision of Rejection, the panel can adjust the way to use evidences, changing the closest prior art or excluding one of the evidences.

Scope of Effect: The Transitional Measures announced on December 21, 2023 do not specifically stipulate the effective scope of this provision, so typically this provision will apply to patent applications filed on or after January 20, 2024. However, given that the Examination Guidelines before revised also had a general statement to encourage "the panel to point out obvious substantive defects not mentioned in the Decision of Rejection", after this revision, even for the applications filed before January 20, 2024, there will be still possibilities to be pointed out other defects by the reexamination panel.

4. For the invention-creation disclosed for the first time at an academic or technical conference held by an international organization, the applicant will be able to request for novelty grace period.

Provision: The Patent Law stipulates the circumstances under which novelty will not be lost within six months before the application date, including "exhibited for the first time at an international exhibition sponsored or recognized by the Chinese government", and "disclosed at a prescribed academic conference or technical conference". The revised Implementation Regulations has broadened the definition of "prescribed academic/technical conference", from

merely "academic/technical conferences organized by the relevant competent authorities of the State Council or national academic groups", to also including "the academic/technical conferences convened by international organizations recognized by relevant competent authorities". Moreover, the supporting documents for the above-mentioned "exhibited for the first time at an international exhibition" or "disclosed at a prescribed academic/technical conference" are no longer required to be issued by the organizer of the international exhibition or academic/technical conference.

Comment: This revision has relaxed the conditions for novelty grace period and the requirements for supporting documents.

Scope of Effect: Because the Transitional Measures announced on December 21, 2023 do not specifically stipulate the effective scope of this provision, in principle, this provision will be applicable to the patent applications filed on or after January 20, 2024.

5. The applicant will be able to request for restoration of priority no later than 14 months from the priority date.

Provision: If an applicant files a Chinese invention or utility model patent application beyond 12 months from the priority date, he can request for restoration of priority right within 14 months from the priority date. For the Chinese national phase of a PCT international application, of which the

international application date is more than 12 months later than the priority date but no more than 14 months, if the restoration of priority has been approved in the international phase, the Chinese national phase application will be automatically deemed to have submitted a request for restoration of priority to the CNIPA; if the restoration of priority is not approved during the international phase, where the applicant has legitimate reasons, he may submit a request for restoration of priority directly to the CNIPA within 2 months from the entry date.

Comment: According to the newly-revised Examination Guidelines, any request for priority restoration shall be made "before the application is ready for publication". That is to say, for a Chinese invention application subject to earlier publication, or a PCT international application entering the Chinese national phase 18 months after the earliest priority date, any request for priority restoration shall be submitted before the CNIPA issues the Notification of Passing Preliminary Examination; for a Chinese utility model application, any request for priority restoration shall be submitted before the applicant pays the grant fee. Considering that a Chinese national phase application for invention patent is very likely to receive the Notification of Passing Preliminary Examination about one month from the entry date, where the applicant believes a request for priority restoration necessary, it shall be submitted as soon as possible.

Scope of Effect: For regular Chinese invention and

utility model patent applications, starting from January 20, 2024, the applicant can request for restoration of priority within 14 months from the priority date. For example, for an invention or UM application filed on January 20, 2024, the applicant can request for restoring the priority to an earlier application filed between November 20, 2022 and January 20, 2023, and specifically he shall, within 14 months from the priority date and before the application is ready for publication, complete the procedures including submission of the restoration request, payment for the restoration fee and priority claim fee, and submission of the certified priority document (where the applicant of the priority application is different from that of the pending Chinese application, supporting documentation like the assignment of priority right will be further required).

For Chinese national phase of PCT international applications, where the Chinese national phase application is not ready for publication before January 20, 2024, if the restoration of priority has been approved during the international phase (especially if the relevant Form PCT/RO/159 is transmitted to CNIPA during the international phase), typically it will be deemed that a request for restoration of priority has been submitted to the CNIPA; if the restoration of priority is not approved during the international phase and the entry date is no earlier than November 20, 2023, the applicant can, starting from January 20, 2024, file a request for restoration of priority within 2 months from the entry date.

6. The applicant will be able to request for addition or correction of priority within 16 months from the priority date.

Provision: If the applicant makes a priority claim at the filing of a Chinese invention or utility model application, he may, within 16 months from the priority date or within 4 months from the application date, and before the application is ready for publication (i.e. before issue of the Notification of Passing Preliminary Examination to an invention application where any request for earlier publication is made, or before payment for the grant fee of a utility model application), file a request to add or correct priority claim.

Comment: In addition to the above-mentioned requirements on time limit, for the request to add or correct priority claim, there is also a prerequisite that "the applicant makes a priority claim at the filing of application". That is to say, only where at least one correct priority claim is made in the Request Form at the filing of the application, can the applicant request for addition or correction of another priority claim. And the time limit "16 months from the priority date" is calculated from the earliest priority date that has been correctly stated in the Request Form.

This provision basically only applies to regular Chinese invention/utility model applications. For the Chinese national phase of PCT international applications, if the addition or correction of priority is not completed during the international phase, it will not be allowed to add any new priority during

the Chinese national phase, and the scope of allowable correction of priority is also limited to "when there is a clerical error in one or two of the three items (priority date, number and country) of one priority claim made during the international phase, a correction request can be made within 2 months from the entry date".

In addition, it should be noted that the restoration of priority and the addition/correction of priority cannot be requested for the same application. The applicant cannot request for addition or correction of priority to an earlier application of which the priority date is more than 12 months earlier than the patent application date.

Scope of Effect: From January 20, 2024, the applicant of a pending regular Chinese invention or utility model application will be allowed to file the request for addition/correction of priority within 16 months from the priority date.

7. The applicant will be able to request for incorporation by reference within 2 months from the application date.

Provision: If an invention or utility model application lacks claims/description or was submitted with incorrect claims/description, but the applicant claims priority at the filing of the application, the applicant may, within 2 months from the application date or within 2 months from issue of the Notification to Make Rectification, request for incorporation of the correct claims or description by making reference to the priority,

without affecting the application date.

Comment: In addition to the above-mentioned requirements on time limit, for the request for incorporation by reference, there is also a prerequisite that "the applicant claims priority at the filing of the application". That is to say, only if the relevant priority has been correctly stated in the Request Form at the filing of application, can it form the basis for incorporation by reference. Incorporation by reference and restoration/addition/correction of priority are not applicable together, any restored/added/corrected priority cannot form the basis for incorporation by reference. Furthermore, divisional applications cannot request for incorporation by reference either.

To request for incorporation by reference to a foreign priority, the Chinese translation of certified priority document will be further needed. Moreover, if the excessive description fee (for the number of total pages of description and drawings exceeding 30) increases after incorporation by reference, this fee shall be supplemented within 2 months from the application date, or within 1 month from issue of the Notice to Pay the Fee.

For a Chinese national phase application, if any incorporation by reference is completed during the international phase and the applicant wishes to retain the incorporated contents, he shall, at the filing of Chinese national phase application or within 2 months from issue of the Notification to Make Rectification, submit the Chinese translation

of certified priority document, and indicate in the Request Form the position where the incorporated content locates in the Chinese translation of certified priority document.

Scope of Effect: For regular Chinese invention/UM applications filed on or after January 20, 2024, if the applicant wishes to request for incorporation by reference, he shall take the initiative to file the request within 2 months from the application date. For PCT international applications having contents incorporated by reference during the international phase, and entering the Chinese national phase on or after January 20, 2024, the applicant shall, at the filing of the Chinese national phase application, complete the request for incorporation by reference before the CNIPA in accordance with the newly-revised Examination Guidelines. Moreover, if the examiner finds any defect in the application documents that needs to be solved by incorporation by reference, the applicant will be able to request for incorporation by reference within 2 months from issue of the corresponding Notification to Make Rectification.

8. The requirements on partial design applications have been clarified.

Provision: The partial design application shall be filed with the overall view of the product, and indicate the part to be protected by combination of dotted lines and solid lines. or other means (such as covering the part not to be protected with a single-color translucent layer); if there is no clear dividing line between the part to be protected and

other parts, the dividing line shall be represented by a dot-dash line. And the part to be protected shall be specified in Brief Description, except where it has been indicated in the overall view of the product by combination of dotted lines and solid lines.

Comment: According to the Patent Law revised in 2020, applicants can file partial design applications from June 1, 2021. According to the "Interim Measures Related to the Implementation of the Revised Patent Law" announced by the CNIPA at that time, for partial design applications filed on or after June 1, 2021, the CNIPA will examine them after the revised Implementing Regulations takes effect. Per our experience, partial design applications have already started receiving office actions since 2023. Nevertheless, the release of the revised Implementation Regulations and Examination Guidelines has clarified the CNIPA's examination standards for partial design applications.

Scope of Effect: From January 20, 2024, the CNIPA will examine the partial design applications filed on or after June 1, 2021 in accordance with the above provision.

9. The requirements on international design applications have been clarified.

Provision: An international design application filed under the Hague Agreement (1999 Act) designating China and having a determined international registration date, shall be deemed as

a design patent application filed with the CNIPA, and the international registration date shall be considered as the application date of this Chinese design application. The CNIPA shall conduct examination on the international design application designating China, and notify the International Bureau of the examination results. Through examination, if the CNIPA decides to grant the design patent right, the design patent shall be announced and take effect in China from the date of announcement; if the CNIPA finds defects in the design application, a Notification of Refusal will be issued and the applicant will need to make a response within 4 months, in case the defect cannot be solved through the applicant's response, the CNIPA will reject the design application.

Comment: Since the Hague Agreement came into effect in China on May 5, 2022, a large number of international design applications designating China have been filed. Starting from January 11, 2023, CNIPA began examination on those with a determined international registration date in accordance with the relevant interim measures announced on January 4, 2023. Now that the revised Implementing Regulations and Examination Guidelines elaborate the provisions on the examination standards and procedures for international design applications, the previous interim measures will be abolished from January 20, 2024.

For an international design application designating China, the following non-extendable time limits

shall be noted: (1) if any priority is claimed, the time limit for submitting the certified priority document will be no later than 3 months from the international publication date; (2) if the applicant decides to file a divisional application on his own initiative, the time limit for filing the divisional will be no later than 2 months from the international publication date of the parent application; and (3) if the applicant needs to file a divisional application in accordance with the examiner's Notification, the time limit for filing the divisional will be no later than 2 months from the grant announcement date of the parent application (where the parent application has been rejected or deemed to be withdrawn, no divisional application can be filed). These time limits are not extendable, or restorable.

Scope of Effect: From January 20, 2024, the CNIPA will examine the international design applications filed on or after May 5, 2022 designating China in accordance with the above provision.

10. The applicant will be able to withdraw the request for delayed examination.

Provision: The applicant can request for delayed examination for 1, 2 or 3 years at the filing of substantive examination request for an invention application, can request for delayed examination for 1 year at the filing of a utility model application, and can request for delayed examination for up to 36 months at the filing of a design application. Before the delayed period expires, the applicant can withdraw the request for delayed examination, and once such a request is approved, the patent

application will start to wait for examination in order.

Comment: After the Examination Guidelines was revised in 2019, the applicant have been allowed to request for delayed examination of invention and design applications, but not allowed to request for delayed examination of utility model applications, nor offered a way to withdraw the request for delayed examination; in practice, once a request for delayed examination is made, there is no procedure for the applicant to withdraw it. The revision of the Examination Guidelines this time clearly stipulates that the applicant can withdraw his request for delayed examination and can request for delayed examination of UM application, which will bring convenience to the applicants.

Scope of Effect: The Transitional Measures announced on December 21, 2023 do not specifically stipulate the effective scope of this provision, which implies that, in principle this provision will be applicable to the patent applications filed on or after January 20, 2024. However, as there was no express prohibition on withdrawing requests for delayed examination in the Examination Guidelines before revision, there will be possibility that the applicant may have a way to withdraw the delayed examination requests also for the previously-filed applications.

11. The requirements on patent term compensation have been clarified.

Provision: For an invention patent that is granted

after 4 years from the application date and 3 years from the issue date of Notification of Entering Substantive Examination Proceeding, the patentee can file a request for patent term compensation within 3 months from the grant announcement date of the patent. The number of days that can be compensated shall be calculated as: grant announcement date, minus "the date when is 4 years from the application date and 3 years from the issue date of Notification of Entering Substantive Examination Proceeding", minus the days occupied by any special procedures like reexamination (where the applicant amends the application documents), suspension, preservation and litigation, then minus the number of days for unreasonable delay caused by the applicant.

For a new drug that has been approved for marketing in China, the patentee can request for patent term compensation for one patent related to the new drug (which can be a product, manufacturing method or medical use patent) within 3 months from the drug approval date. The compensation period is calculated based on the days between the patent application date and the new drug marketing approval date minus 5 years, but the final compensation period shall not exceed 5 years, and the total patent term after the new drug is approved for marketing shall not exceed 14 years.

Comment: The "the number of days of unreasonable delay caused by the applicant" mentioned in the calculation method of patent term

compensation based on delay in the examination process, refers to the applicant's requests for extension or restoration of time limits, for delayed examination, for incorporation by reference, and for utilizing the 2-month grace period for entering the Chinese national phase. In addition, if the applicant applies for both a utility model patent and an invention patent for the same invention-creation on the same day, he cannot apply for patent term compensation for the invention patent.

In a request for patent term compensation based on a new drug marketing authorization, the patentee shall specify the claims related to the new drug, submit supporting materials to explain the reason why these claims cover the technical solution related to the new drug and the calculation way for the requested compensation period, and clarify the technical solution to be protected during the compensation period. In other words, this kind of patent term compensation only applies to the claims related to the new drug, and does not mean that the entire patent can automatically enjoy the patent term compensation.

Scope of Effect: Starting from June 1, 2021, the patentee can submit a patent term compensation request within three months from the date of approval of the new drug marketing authorization request, and can request for patent period compensation if the grant announcement date is no earlier than June 1, 2021. Starting from January 20, 2024, the CNIPA will start to review the requests for patent term compensation submitted on or after

June 1, 2021, in accordance with the above provision. Even if the relevant patent expires before January 20, 2024, if the CNIPA determines that the patent term compensation is approvable, it will still make a decision to grant the compensation and announce the decision, the compensation period will be started from the initial expiration date.

12. The applicant will be able to order the utility model or design patent evaluation report when paying the grant fee.

Provision: The patentee, interested parties, or any alleged infringers may request the CNIPA to issue a patent evaluation report after the grant announcement date of the utility model or design patent; the CNIPA shall issue the report within 2 months after receiving such a request. The applicant of a UM or design patent application may request the CNIPA to issue the patent evaluation report when paying the grant fee in accordance with the official notice of allowance; after receiving such a request, the CNIPA shall issue the report within 2 months from the grant announcement date.

Comment: Compared with the previous Implementing Regulations, this revision not only further clarifies that the accused infringer has the right to order the patent evaluation report, but also allows the applicant to order the patent evaluation report as soon as the grant fee is paid.

Scope of Effect: Although the Transitional Measures announced on December 21, 2023 do not

specifically stipulate the effective scope of the above provision, and typically this provision will apply to the applications filed on or after January 20, 2024; from the perspective of practice, if the applicant pays the grant fee after January 20, 2024 for a UM or design application and simultaneously orders the patent evaluation report, there will be still possibility for the CNIPA issue the report within 2 months after the grant announcement date.

13. The requirements on open license have been clarified.

Provision: If the patentee voluntarily declares in writing to the CNIPA that he is willing to allow any person or entity to exploit his patent in China, and clearly specifies the payment method and standard of royalties and the license period, the CNIPA will announce the open license; if any person or entity is willing to exercise the open license patent, the license will become effective upon the licensee notifies the patentee in writing and pays the royalty in accordance with the announced payment method and standard. After the open license becomes effective, both the licensor and licensee shall record the open license agreement before the CNIPA, by submitting the supporting documents like the licensee's written notice to the patentee, and the proof of licensee's payment of the royalty to the patentee. The request to record the open license agreement before the CNIPA will be regarded as the patentee simultaneously makes a request for patent annual fee reduction. If the CNIPA approves the recordal for open license

agreement, the patentee can enjoy the annuity reduction since the date of recordal of the open license agreement.

Comment: The newly revised Examination Guidelines also stipulate other requirements for applying for patent open license: (1) The patent for open license should be in a valid state, not under any exclusive license, and has not been suspended, pledged or invalidated; a utility model or design patent for open license shall not be considered unpatentable in the patent evaluation report. (2) The royalties in the open license declaration shall not be too high. For example, if it is paid by a fixed fee standard, generally it shall not exceed CNY 20 million; while if it is paid by a commission fee, generally the net sales commission shall not exceed 20%, and the profit commission shall not exceed 40%. (3) If a Chinese citizen or entity declares open license, and a person or entity from foreign countries or Hong Kong/Macao/Taiwan regions are willing to obtain the license, they shall also comply with the provisions of the "Technology Import and Export Contract Registration and Management Measures".

Scope of Effect: Starting from January 20, 2024, the CNIPA will examine the open license declarations submitted on or after June 1, 2021, in accordance with the above provision.

14. The rules on rewards and remuneration for inventors of service inventions have been revised.

Provision: After a patent for a service invention is

granted, the entity to which the patent right is granted shall reward the inventor of the service invention. If the method and amount of such rewards have not been agreed upon with the inventor or stipulated in the rules and regulations of the entity before, a bonus shall be paid to the inventor within 3 months from the grant announcement date of the patent. The minimum bonus for an invention patent shall not be less than CNY 4,000, and the minimum bonus for a utility model or design patent is not less than CNY 1,500.

After the service invention patent is licensed, the entity to which the patent right is granted shall provide reasonable remuneration to the inventor. If the method and amount of such remuneration have not been agreed upon with the inventor or stipulated in the entity's rules and regulations before, the inventor shall be remunerated in accordance with the provisions of the "Law on Promoting the Transformation of Scientific and Technological Achievements".

Comment: Comparing with the Implementing Regulations before revised, the bonus to the inventor after the service invention patent is granted has been increased. As for the remuneration to the inventor after the service invention patent is licensed, the "Law on Promoting the Transformation of Scientific and Technological Achievements" provides that, "if a service invention is implemented by oneself or in cooperation with others, it shall be paid to the inventor continuously for 3 to 5 years after the

implementation is successfully transformed and put into production, in the amount of no less than 5% of the profits from the implementation every year".

Scope of Effect: The transitional measures announced on December 21, 2023 do not specifically stipulate the effective scope of the above provision, so typically the above provision will apply to the patent applications filed on January 20, 2024 and later.

15. The process to grant foreign filing license has been revised.

Provision: Any person or entity that files a foreign patent application for an invention or utility model made in China, shall obtain the foreign filing license from the CNIPA in advance. After receiving the request for foreign filing license, the CNIPA shall make a decision on whether to grant it within 4 months (which may be extended by 2 months in complex cases); and before making the decision, if the examiner believes that the invention or utility model shall not be filed abroad, a notice shall be issued to the applicant within 2 months from the date of submission of the request (which may be extended by 2 months in complex cases).

Comment: Although this revision shortens the time limit for issuing a notice to "within 2 months from the date of submission of the request", it also deletes the statement that "the applicant will be deemed to have granted the foreign filing license, in case no notice is issued by the CNIPA within four

months from the date of submission of the request" from the Implementation Regulations. In other words, one will need to wait for the notice or decision from the CNIPA before applying for a patent in foreign countries. Nevertheless, in practice, mostly one can obtain the foreign filing license in about half a month from filing the request.

The process for foreign filing license related to PCT international applications has not changed. That is, if the applicant files a PCT international application with CNIPA, it will be deemed to have submitted a request for foreign filing license at the same time; if CNIPA deems the application meets the requirements for foreign filing license, the application will be automatically processed under the regular international phase procedures, and the applicant will not need waiting for any notice from CNIPA. If the CNIPA deems the application fails to meet the requirements for foreign filing license, a notice of non-transmittal of record copy and search copy will be issued within 3 months from the international application date.

Scope of Effect: Starting from January 20, 2024, the CNIPA will examine all ongoing requests for foreign filing licenses in accordance with the above provision.

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