

## What's New



### The Amendments to the Provisions of the Supreme People's Court on Issues Concerning the Application of the Law to the Trial of Patent Disputes

On December 23<sup>rd</sup>, 2020, the amendments to the eighteen Judicial Interpretations of Intellectual Property was adopted at the 1823<sup>rd</sup> Session of the judicial committee of the Supreme People's Court, which has come into force from January 1<sup>st</sup>, 2021.

This article focuses on one of the Interpretations, *Provisions of the Supreme People's Court on Issues Concerning the Application of the Law to the Trial of Patent Disputes* (hereinafter referred as "The Provision"), which mainly includes the following 3 amendments:

#### 1. Expanding the acceptance of scope of patent infringement dispute cases

The Provision (2015)	The Provision (2021)
<p><b>Article 1</b> The People's Court shall accepted the following patent dispute cases:</p> <ol style="list-style-type: none"> <li>1. Where any dispute arises from the right of patent application;</li> <li>2. Where any dispute arises from the attribution of the patent right;</li> <li>3. Where any dispute arises from a transfer contract of the patent right or the right of patent application;</li> <li>4. Where any dispute arises from infringing the patent right;</li> <li>5. Where any dispute arises from impersonation of another person's patent;</li> <li>6. Where any dispute arises from the exploitation fee during the period from the publication of the patent application for invention to the grant of patent right;</li> <li>7. Where any dispute arises from a reward or a remuneration of the inventor or creator of a service invention-creation;</li> </ol>	<p><b>Article 1</b> The People's Court shall accepted the following patent dispute cases:</p> <ol style="list-style-type: none"> <li>1. Where any dispute arises from the <b><u>attribution of right</u></b> to apply for a patent;</li> <li>2. Where any dispute arises from the attribution of the patent right;</li> <li>3. Where any dispute arises from <b><u>a patent contract</u></b>;</li> <li>4. Where any dispute arises from <b><u>violating</u></b> the patent right;</li> <li>5. Where any dispute arises from impersonation of another person's patent;</li> <li>6. Where any dispute arises from the exploitation fee during <b><u>the period of temporary protection</u></b> of the patent application for invention;</li> <li>7. Where any dispute arises from a reward or a remuneration of the inventor or creator of a service invention-creation;</li> </ol>

8. The cases of petitioning the preliminary injunction or property preservation before any legal proceedings are instituted;
9. Where any dispute arises from qualification of the inventor or creator;
10. The cases of dissatisfaction with the decision of the Patent Reexamination Board upholding the rejection of the application;
11. The cases of dissatisfaction with the decision of the Patent Reexamination Board concerning the request for invalidation;
12. The cases of dissatisfaction with the decision of the patent administration department under the State Council exploiting the compulsory license;
13. The cases of dissatisfaction with the award of the patent administration department under the State Council concerning the exploitation fee for exploiting the compulsory license;
14. The cases of dissatisfaction with the administrative reconsideration decision of the patent administration department under the State Council;
15. The cases of dissatisfaction with the administrative decision of the administrative authority for patent affairs;
16. Other patent dispute cases.

8. Where any dispute arises from petitioning the **preservation of acts** before any legal proceedings are instituted;
9. **Where any dispute arises from petitioning property preservation before any legal proceedings are instituted;**
10. **Where any dispute arises from liability for damage caused by petitioning the preservation of acts;**
11. **Where any dispute arises from liability for damage caused by petitioning the property preservation;**
12. **Where any dispute arises from the right to be named of the inventor or creator of a invention-creation;**
13. **Where any dispute arises from the confirmation of non-violation of the patent right;**
14. **Where any dispute arises from returning the fee after the patent right has been declared invalid;**
15. **Where any dispute arises from liability for damage caused by initiating a lawsuit for the patent right with malicious intention;**
16. **Where any dispute arises from the exploitation fee of the standards-essential patent;**
17. The cases of dissatisfaction with the decision of **the patent administration department under the State Council** upholding the rejection of the application;
18. The cases of dissatisfaction with the decision of **the patent administration department under the State Council** concerning the request for invalidation;
19. The cases of dissatisfaction with the decision of the patent administration department under the State Council exploiting the compulsory license;
20. The cases of dissatisfaction with the award of the patent administration department under the State Council concerning the exploitation fee for exploiting the compulsory license;
21. The cases of dissatisfaction with the administrative reconsideration decision of the patent administration department under the State Council;
22. **The cases of dissatisfaction with the other administrative decisions of the patent administration department under the State Council;**
23. The cases of dissatisfaction with the administrative decision of the administrative authority for patent affairs;
24. **Where any dispute arises from the confirmation of whether it falls into the protection scope of the patent right;**
25. Other patent dispute cases.

## 2. Further clarifying the requirements for not granting a design

The Provision (2015)	The Provision (2021)
<b>Article 16</b> In the Article 23 of the Patent Law, “the legitimate right obtained before” includes trademark right, copyright, the right to enterprise name, the right to likeness, the right to use the specific packaging or decoration of well-known goods, etc.	<b>Article 12</b> In the <u>Paragraph 3</u> of the Article 23* of the Patent Law, “the legitimate right” includes <u>the enjoyed legitimate right or interest of works, trademarks, geographical indications, names, enterprise names, likeness, names of goods which have certain reputation, packaging and decoration, etc.</u>

\* Paragraph 3 of the Article 23 of the Patent Law Any design for which patent right may be granted must not be in conflict with the legitimate right obtained before the date of filing by any other person.

## 3. In accordance with the provisions of the higher level law Civil Code, extending the limitation of action for patent infringement to three years

The Provision (2015)	The Provision (2021)
Article 23 The limitation of action for the infringement of patent right is two years, begins from the date on which the patentee or any interested person knows or should have known the tortious act. Where the right holder institutes legal proceedings for more than two years, if the tortious act still continues at the time of instituting the legal proceedings, the people's court shall, within the duration of such patent right, adjudicate the defendant to stop the tortious act, and the amount of compensation for infringement damages shall be calculated from two years before the date when the right holder institutes legal proceedings to the people's court.	Article 17 The limitation of action for the infringement of patent right is <u>three years</u> , begins from the date on which the patentee or any interested person knows or should have known that <u>his right has been harmed and that who is the obligor</u> . Where the right holder institutes legal proceedings for more than <u>three years</u> , if the tortious act still continues at the time of instituting the legal proceedings, the people's court shall, within the duration of such patent right, adjudicate the defendant to stop the tortious act, and the amount of compensation for infringement damages shall be calculated from <u>three years</u> before the date when the right holder institutes legal proceedings to the people's court.

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