

◇ Newly Amendment of the Rules for the Implementation of the Patent Law

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## Newly Amendment of the Rules for the Implementation of the Patent Law

On December 11, 2023, Premier Li Qiang of the State Council signed the Decree No. 769 of the State Council to promulgate the Decision of the State Council on Amending the *Rules for the Implementation of the Patent Law*, which will be effective **from January 20, 2024**.

The amendment to the *Rules for the Implementation of the Patent Law* made this time is intended to adapt to the Amendment IV of the *China Patent Law* approved on October 17, 2020. The amended *Rules* (hereinafter referred to as "new *Rules*") involve various aspects and terms regarding Chinese patent system. This article highlights key changes or amendments made to the *Rules* and would like to help you comb and understand main points of the new *Rules*.

## **I. Determination of Date of Delivery of Documents in Electronic Form**

According to the new *Rules*, if a document is served electronically by the patent administration department under the State Council, the date the document enters into the electronic system approved by the party concerned shall be regarded as the date the document is served, which means that an official document will be deemed as having been received on the day it is served through the electronic system without a grace period of 15 days of mailing. Compared to the *Rules* before the amendment, this change will advance the official time limit of various replies/requests, thereby shortening the actual proceeding time.

## **II. Restoration, Addition and Correction of Priority**

The new *Rules* stipulate that where there is a justified reason, an applicant of an invention or utility model application can apply for restoration of the priority **within 2 months from the date of the expiration of that time limit**. This provision endows the applicant more procedural flexibility.

The new *Rules* further stipulate that where an

applicant of an invention or utility model application has claimed priority, he or it may request to add or correct the priority **within 16 months from the priority date** or **within 4 months from the filing date of the application**.

In other words, under the new *Rules*, in principle an invention or utility model application may be filed within 14 months from the priority date with claiming the right of priority; where priority has been claimed, the priority may be added or corrected within 16 months from the priority date or within 4 months from the filing date of the application. The premise for restoration/addition/correction of the priority prescribed in these provisions is that the applicant should submit a justified reason. At present, we do not know how to exactly measure the justified reason, and will keep an eye on any practical references.

In addition, the new *Rules* also specify that the accompanying drawings of an invention or utility model application can serve as a priority basis for a design application.

## **III. Incorporation by Reference**

According to the new *Rules*, if an applicant missed some content at the time of filing the

application and such content has been described in the priority document, the missing content may be incorporated into the present application by reference, and the original filing date can be reserved on the condition that the time limit (**within 2 months from the date of filing** or **within a date specified** by the patent administration department under the State Council) and the documents submitted meet relevant provisions.

According to the current practice, a PCT international application has the right to incorporate by reference, i.e., if a PCT international application missed some content at the time of filing, the missing content may be incorporated by invoking the corresponding part of the earlier application (the priority application of that PCT international application), in which case the application date of the original international application can be reserved. However, when the PCT international application enters into the national phase in China, the CNIPA as a designated office will re-determine the application date in accordance with the content that has been incorporated by reference.

According to the new *Rules*, the missing content can be incorporated by reference no matter the application is an application claiming domestic priority or an application entering into the national phase in China through PCT route or an application filed in China through Paris Convention route.

Although the "incorporation by reference" may remedy the benefits lost due to missing contents, the most appropriate way is to file an application in China accurately and comprehensively, so as to ensure non-omission as much as possible.

#### **IV. Examination on Obvious Inventiveness of Applications for Utility Model and Design**

The new *Rules* stipulate definitely that **examination on obvious inventiveness will be included** in the preliminary examination of applications for utility model and design. According to the new *Rules*, the examination of a utility model application will no longer be confined to novelty and practicability, but be extended to novelty, inventiveness and practicability. The examination of a design application will take into account whether the design application "has distinguishing features

over a prior design or over a combination of features of a prior design" (a requirement similar to inventiveness).

Through the amendments, the new *Rules* have laid a legal basis for the examiners to reject a utility model or design application that obviously lacks inventiveness. It can be seen that the addition of such article is to uplift the threshold of utility model or design applications and guide the applicants to pay more attention to patent quality, which will help to promote technological innovation and industry upgrade.

#### **V. Request for Deferment of Examination**

Although the CNIPA issued *Guidelines for Deferment of Examination of Patent Applications* in 2023, in which a deferred examination system for patent applications was introduced, the current *patent law* does not explicitly provide that an applicant can request for a deferred patent examination procedure. The new *Rules* for the first time specify that an applicant may make a request for deferred examination of a patent application.

#### **VI. Requirements on Partial Design**

Although the Amendment IV of China *Patent*

*Law* which has been enforced since June 1, 2021 specified that a partial design is patentable, no provisions have been made on requirements of the partial design application documents.

According to the new *Rules*, where an application for a patent for partial design is filed, **a view of the whole product shall be required**, and a part of the product for which protection is sought shall be indicated **by a combination of dotted lines and solid lines or by other means**; and the claimed part shall be specified in the brief description of the design.

#### **VII. Patent Term Adjustment (PTA) Involving Examination Delay Caused by CNIPA**

The Amendment IV of China *Patent Law* which has been enforced since June 1, 2021 introduced the system of patent term adjustment (PTA). In the new *Rules*, the calculation of the PTA, the situations of unreasonable delay and the situations of reasonable delay are specified.

#### **VIII. Timing and Qualified Party for Requesting Patent Right Evaluation Report for Utility Model and Design Patents**

According to the new *Rules*, the party qualified

for requesting patent right evaluation report for utility model and design patents shall include **a patentee, an interested party or an alleged infringer**; the patentee is allowed to request the patent right evaluation report **at the same time of going through the formality procedures of patent grant**.

The new *Rules* enlarges the scope of party qualified for requesting the patent right evaluation report, clarifying an alleged infringer may request for the report, and also the patentee can request for the report at the same time of going through the **formality procedures of patent grants**, thereby improving the efficiency.

## **IX. Provisions Regarding International Design Applications**

China accessed to the *Hague Agreement Concerning the International Registration of Industrial Designs* (1999 Act) in 2022. When making the Amendment IV to the *Patent Law*, some adaptive provisions have been made in advance. For instance, the protection of design is extended to partial design, and the protection term of design patent is prolonged from 10 years to 15 years. In order to meet the

requirements of the *Hague Agreement* in practice, the new *Rules* make some adaptive provisions to link-up with international design applications with domestic application procedures.

The new *Rules* stipulate that an international application for design of which the international application date has been established according to the *Hague Agreement* and with China being designated, shall be deemed as an application for design filed with the patent administration department under the State Council, and the international application date shall be regarded as the application date of the application for design filed in China. After the international application for design is published by the international bureau, the patent administration department under the State Council shall initiate examination of the international design application. If the reason of objection the international design application is not found, the patent administration department under the State Council shall issue a Decision to Grant. No matter whether the international design application is granted or not, the Decision shall be notified to the international bureau.

In conclusion, the amendments of the *Rules for the Implementation of the Patent Law* is of great significance, which helps China's patent system to be in line with the international standards, enhances China's status and influence in the global intellectual property governance system, effectively stimulates the innovation vitality of the society, promotes the scientific and technological progress and industrial upgrading, and guarantees the healthy and stable development of the economy and society. By amending the *Rules*, it will better serve the innovation-driven development strategy, thus forming a more scientific and reasonable, efficient and fair rule of law environment.

Sources:

Official Website of Ministry of Justice

Answers to Questions of Journalists by Ministry of Justice and CNIPA

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