

Patent Application 101 – the US to China Version

Generally, the US applicants file patent applications in China under Paris Convention or PCT. In this article, we will introduce the formality matters at the filing stage of these applications.

Applications under Paris Convention

1. Filing Deadline: 12 months from the priority date, late filing of Chinese translation is not possible
2. Application Type: invention patent/utility model/both invention patent and utility model

*In China, the invention patent is equivalent to the utility patent in the US. With regard to a utility model, it can be simplified as an invention with less strict requirements in inventiveness compared to a utility patent. Utility models enjoy a protection period of 10 years and substantive examination is not required. Generally, a utility model shall be granted in 7 to 12 months from filing.

*When a patent application enters into China under Paris Convention, the applicant may choose to file A. an invention patent, B. a utility model or C. both on the same day. It is not possible for applications under PCT to file both kinds of applications. However, if the applicant chooses both, the utility model shall be abandoned after the invention patent is granted. It is helpful for an applicant who is seeking a fast granted patent.

3. Documents Required for Filing:

1) Power of Attorney (simply sign, a scanned copy is sufficient)

2) Certified Copy of the Priority Document

If the document is available by the WIPO Digital Access Service, providing the DAS CODE will be sufficient. Otherwise, the applicant could provide either a scanned copy of the document in full or the original one.

3) Assignment

According to the Filing Receipt of the priority application, if the applicant of the US priority application is an individual while that of the CN application is a company, an assignment is required. On the other hand, if the applicant listed in the Filing Receipt is a company, the same as the CN application, an assignment is not required.

4. Official Filing Receipt: one to three days after filing

5. Substantive Examination: The request for substantive examination shall be filed within three years from the earliest priority date. The application will enter into the examination stage a little earlier if the examination is requested upon filing.



Applications under PCT

1. Filing Deadline: 30 months from the priority date (a two-month grace period is possible), late filing of Chinese translation is not possible
2. Application Type: invention patent/utility model
Either an invention patent or a utility model can be chosen when an applicant nationalizes a PCT application into China.
3. Documents Required for Filing: Power of Attorney only
4. Official Filing Receipt: about one month after filing, Official Filing Receipt will not be issued if the PCT application has not been published by WIPO
5. Substantive examination: The request for substantive examination shall be filed within three years from the priority date.

Two deadlines you should remember

1. Filing Amended Claims:
There are altogether three opportunities that amended claims could be filed.
 - 1) upon filing;
 - 2) when filing the request for substantive examination;
 - 3) within three months after receipt of the Notice of Entering into Substantive Examination Stage.
2. Filing Divisional Application:
The applicant could file divisional applications at any time after receiving the Official Filing Receipt and before the due date for paying the allowance fees/the deadline for filing an appeal before the court for the Decision on Reexamination of the original application.

Hope it helps.

- Allen G. Zhou

