



Double filing under China's new Patent Law

Applying for both patent and utility model protection is still feasible under the new Chinese Patent Law, and in many situations it could make perfect sense

One of the more significant changes introduced by the third Amendment to China's Patent Law, which came into effect on 1st October 2009, relates to double filing: the filing of applications for both invention and utility model patents. Implementing regulations, which are likely to include more detail in relation to the changes, are yet to be finalised.

Under the Patent Law, both old and new, an applicant may simultaneously pursue an application for an invention patent and an application for a utility model patent. In appropriate circumstances, intentional double filing may be pursued for the benefit of the applicant.

The following points indicate the essential differences between invention patents and utility model patents:

- The term of an invention patent is 20 years from the date of filing, whereas the term of a utility model patent is only 10 years.
- The subject matter of a utility model patent is limited to the shape and structure of a product, while the subject matter of an invention patent includes processes and chemical compositions.
- An application for an invention patent is subject to substantive examination after a prior art search, while a utility model application is not.
- A utility model patent is usually granted within eight to 12 months of filing the application. Currently, grant of an invention patent application takes between two and four years.
- Because utility model patent applications are not examined, the cost of filing is much less than the cost of filing an invention patent application.

Under the old PRC Patent Law, in certain circumstances it was, advantageous to file applications for both an invention patent and a utility model patent for the

one invention. Because the utility model application would proceed to grant more quickly than the invention patent application, the applicant would be able to obtain earlier protection. When the invention patent application subsequently proceeded to grant, however, it was necessary for the applicant to abandon one of the patents, as the law allowed only one patent right to be granted for any one invention.

Double filing was often employed when potential infringements were identified after an invention patent application had been filed. The applicant would then file an application for a utility model patent and take steps to enforce that patent as soon as it issued. Later, when the invention patent was granted, the utility model patent would be abandoned.

The main difference between the old and the new Patent Law is that both applications must be filed on the same day and notice must now be given to the Patent Office. This limits the opportunities for taking advantage of double filing: a patent applicant must now anticipate the need for it in advance.

According to currently available information, under the new law a double filing strategy may not be used in conjunction with a PCT application. However, depending on future clarification by the Patent Office, it may be possible in the future to: file both an invention and a utility model patent application within 12 months of filing a PCT international application, provided that the PCT application is the first-filed application; or file a PCT international application on the same day as filing a utility model application in China, notifying the Chinese Patent Office that the applicant is intending to file an invention patent at a later date by way of the PCT treaty. In practice, both of these routes meet the literal requirements of the patent laws and regulations. However, there has been no official recognition that these approaches will be accepted.

Advantages of adopting a double filing strategy

The advantages of adopting a double filing strategy are similar under both the old and

the new Patent law. A patent applicant can obtain a utility model patent quickly and rely on it to deal with infringers while the invention patent is undergoing examination. Although a published invention patent application can be used as a deterrent and to obtain compensation from the infringer, it cannot be used to obtain a judgment from a court ordering the infringer to stop the manufacture or sale of the infringing products. That can be done only when the patent has finally been granted.

During examination of the invention patent application, it is possible that the utility model patent may be considered to be the more valuable right. While an invention patent has a longer patent term, it is possible that during the examination of a corresponding foreign patent application certain prior art may be found that raises questions about the patentability of the invention. Because a utility model has a lower inventiveness requirement under the patent law, the utility model may be considered a valid and more valuable patent right. Instead of spending the time and money prosecuting an invention patent application in China with uncertain value, the patent applicant has the flexibility to abandon the invention patent application at a later time.

A double filing strategy can still be effectively used under the new China Patent Law. However, the flexibility of this strategy has been reduced by a requirement that the two applications be filed on the same day. Patent applicants must now think further ahead to determine whether patent infringement in China is likely to occur in the near future. If it is, it may be worth applying for both a utility model patent, which can be obtained quickly and readily enforced, and an invention patent.

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