

# AIPLA

American Intellectual Property Law Association

January 10, 2021

中华人民共和国  
国家知识产权局条法司条法一处  
北京市海淀区西土城路 6 号  
邮编 100088

State Intellectual Property Office  
China National Intellectual Property Administration  
Legal Affairs Department, Division One  
People's Republic of China  
*via email tiaofasi@sipo.gov.cn*

**Re: Comments Regarding the Draft Implementation Rules of the Chinese  
Patent Law 《专利法实施细则修改建议（征求意见稿）》**

Dear Sir or Madam,

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to comment on the Draft Implementation Rules of the Chinese Patent Law. Attached is a table listing our detailed comments, some of which are also summarized below.

AIPLA is a national bar association of approximately 8,500 members engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA commends the China Intellectual Property Administration (CNIPA) on its efforts to provide the draft Implementation Rules of the Chinese Patent Law for supporting the 4th amendments to the Chinese Patent Law, which are improvements of the Chinese patent system. AIPLA appreciates the opportunity to provide comments to the draft Implementation Rules. AIPLA would also welcome the opportunity to provide additional comments on any specific revisions to the language of the draft Implementation Rules that may be drafted and proposed in response to this initial round of comments.

The absence of comments on any part does not reflect support or lack of support of this part by AIPLA.

AIPLA welcomes many of the proposals in the draft Implementation Rules, including:

- The ability to revise and/or restore priority claim (new Articles 31-1, 31-2, and 110-1).
- The ability to add contents missing from the priority document(s) to the application by incorporation by reference (new Article 39-1 and revised Article 40).
- Introduction of patent term adjustment for unreasonable delay (New Articles 85-2 and 85-3).
- Introduction of patent term compensation for patents related to drug approval. (New Articles 85-4 to 85-8).
- Allowance of the use of electronic signature (revised Article 119).

AIPLA respectfully makes suggestions and seeks clarifications on the following issues, which are detailed in the attached table:

- Clarification on the deemed date of receipt of notices issued by the CNIPA, which determines the deadline to respond to such notices (Article 4).
- Exclusion from confronting bona fide third parties for license contracts not recorded at the CNIPA (revised Article 14).
- Possible exclusion of Chinese citizens with foreign residency from applying for patents (Article 16).
- Exclusion of international conventions from non-prejudicial disclosure (Article 30).
- Handling of domestic priority claim (revised Article 32).
- Minimum filing requirements (revised Article 39 and deleted Article 121).
- Potential discrepancies on handling of incorporation by reference for PCT and non-PCT applications (revised Article 40).
- Ability of CNIPA to raise new grounds *ex officio* at re-examination and invalidation (new articles 62-1 and 68-1).
- Ability of CNIPA to continue with invalidation even when the invalidation petitioner has withdrawn (revised Article 72).
- Grounds to suspend disputes handled by the CNIPA (revised Article 82).
- Issues on patent false marking (revised Article 84).
- Time limit to apply for patent term adjustment (new Article 85-2).
- Uncertainty on impact of incorporation by reference to patent term adjustment (new Article 85-3).
- Potential ambiguity on patent term compensation related to drug approval (New Article 85-4).
- Issues on use of electronic signature (revised Article 119).

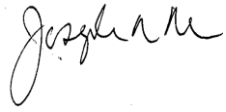
We appreciate the opportunity to provide these comments on the Draft Implementation Rules of the Chinese Patent Law, and we would be pleased to answer any questions that our comments may raise.

Comments regarding the Draft Implementation Rules of the Chinese Patent Law 《专利法实施细则  
修改建议（征求意见稿）》

January 10, 2021

Page 3

Sincerely,

A handwritten signature in black ink, appearing to read "Joseph R. Re". The signature is written in a cursive, flowing style.

Joseph R. Re

President

American Intellectual Property Law Association

Attachment: Table of Comments

*AIPLA Comment Table on draft Implementation Rules of the Chinese Patent Law  
for soliciting opinions*

1. General Comments

AIPLA welcomes many proposed changes in the draft Implementation Rules of the Chinese Patent Law for supporting the 4<sup>th</sup> amendments to the Chinese Patent Law, which are improvements of the Chinese patent system. AIPLA respectfully provide further suggestions and the relevant reasons, as follows.

Detailed Comments

Current	Draft Revision	Suggestions and/or Comments, and Reasons
<p>Article 4 ..... Where any document is sent by mail by the patent administration department of the State Council, the 16th day from the date of mailing shall be presumed to be the date on which the party concerned receives the document. .....</p>	<p>Article 4 ..... Where any document is sent by mail <u>or delivered in electronic format</u> by the patent administration department of the State Council, the 16th day from the date of mailing shall be presumed to be the date on which the party concerned receives the document. .....</p>	<p><b>Suggestion:</b>  .....<i>Where any document is sent by mail <u>or delivered in electronic format</u> by the patent administrative department of the State Council, the 16th day from the date of mailing or from the date of delivery in electronic form shall be presumed to be the date on which the party concerned received the document.</i>  ..... <b>Reasons:</b>  This article provides that a document from CNIPA can be served in electronic form, by mail, by personal delivery or by other means. This Article further provides how to calculate the date of the receipt of such document when it is delivered by mail or by personal delivery but is silent on the calculation method when delivered in electronic form. We understand that CNIPA's current system has automatically included the 15-day delivery period for those documents delivered in electronic format, for example the decision to grant. However, it is</p>

		<p>respectfully suggested to clarify this issue for avoidance of doubt, by amending Article 4 as follows:</p> <p><i>Where any document is sent by mail <b>or delivered in electronic format</b> by the patent administrative department of the State Council, the 16th day from the date of mailing <b>or from the date of delivery in electronic form</b> shall be presumed to be the date on which the party concerned received the document.</i></p>
<p>Article 14            Except for the assignment of the patent right in accordance with the provisions of Article 10 of the Patent Law, where the patent right is transferred because of any other reason, the party concerned shall, based on the relevant certifying documents or legal papers, request the patent administration department of the State Council to register the transfer of the patent right.</p> <p>Any license contract for exploitation of a patent which has been concluded by the patentee with an entity or individual shall, within three months from the date of entry into force of the contract, be submitted to the patent administration department of the State Council for the record.</p> <p>Where any patent right is put in pledge, the pledgor and the pledgee shall jointly register the contract of pledge with the patent administration department of the State Council.</p>	<p>Article 14            Except for the assignment of the patent right in accordance with the provisions of Article 10 of the Patent Law, where the patent right is transferred because of any other reason, the party concerned shall, based on the relevant certifying documents or legal papers, request the patent administration department of the State Council to register the transfer of the patent right.</p> <p>Any license contract for exploitation of a patent which has been concluded by the patentee with an entity or individual shall, <del>within three months from the date of entry into force of the contract,</del> be submitted to the patent administration department of the State Council for the record, <b>or else it cannot confront bona fide third parties.</b></p> <p>Where any patent right is put in pledge, the pledgor and the pledgee shall jointly register the contract of pledge with the patent administration department of the State Council.</p>	<p><b>Suggestion:</b>            Article 14            .....            Any license contract for exploitation of a patent which has been concluded by the patentee with an entity or individual <del>may shall, within three months from the date of entry into force of the contract,</del> be submitted to the patent administration department of the State Council for the record, <b>or else it cannot confront bona fide third parties.</b>            .....</p> <p><b>Reasons:</b>            The amendment suggests adding adverse consequence of not recording an assignment or license contract in the patent administration department of the State Council. However, AIPLA is concerned that the suggestion may be unclear.</p> <p>It is the first and only appearance of a bona fide third party in the Patent Law and its Implementation Rules. A bona fide third party in the Civil Law system is an important concept that represents transaction order and trust interest. A bona fide third party generally appears on occasions such as unauthorized agency, unauthorized representative, apparent agent, apparent representative, unauthorized sanction, and good faith acquisition. The essence is that the original right holder (including its representative) has a conflict of interest with the bona fide counterparty of a good faith transaction (due to the behavior of a third person).</p>

		<p>And the market economy chooses to conditionally give priority to protecting the interests of bona fide counterparties.</p> <p>However, the meaning of a “bona fide third party” is not clear based on the above language. If following the above meaning under the Civil Law system applies, it should refer to the transferee in a patent transaction. However, transaction is not no-right-to-dispose, especially for those general implementation license agreements, in which the patentee only needs to notify the licensee of the transaction. Therefore, it may be inappropriate to consider the transferee a bona fide third party. If it refers to a third-party implementer who is unaware of the licensing contract, the third party is a potential infringer, irrelevant to the existence of the licensing contract or whether such is recorded.</p> <p>AIPLA recommends encouraging recording patent license contracts, instead of making it compulsory. A patent license contract is a general civil action between entities in the market and is governed by the contract law, which does not require compulsory recording of the licensing contract. Either or both parties may consider the contract confidential. Compulsory recordation of license agreements is not consistent with international norms, including US and Europe.</p> <p>The current language of this paragraph mandates the "concerned parties" to "process" the transfer of patent rights at the patent administration department of the State Council (the CNIPA). It is not clear what "process" (办理) may entail. It is also not clear what the consequence of this "process" would be. Further, it is not clear what actions the concerned parties should expect CNIPA to take after registering the transfer.</p>
--	--	--

		<p>To further clarify the language of this section, AIPLA recommends amending the paragraph, starting from "the parties concerned", as follows:</p> <p>"..... the party concerned <i>may</i>, based on the relevant certifying documents or legal papers, request the patent administration department of the State Council to register the transfer of the patent right <b>for recordal, and publishing the recordal by the patent administration department of the State Council.....</b>"</p> <p>This will clarify that 1) recordation is permissive and not mandatory; 2) "process" (办理) is a registration step and not a "transfer"; and 3) CNIPA is required to publish the recorded transfer.</p>
<p>Article 16 A request for the patent application of an invention, utility model or design shall indicate: (1) the name of the invention, utility model or design; (2) if the applicant is a Chinese entity or individual, the name, address, zip code, and organizational code or resident's identify card number thereof; if the applicant is a foreigner, a foreign enterprise or any other foreign organization, the name, nationality or country or region of registration thereof; (3) the name of the inventor or designer; (4) if the applicant has entrusted a patent agency to file the application, the name and institutional code of the agency, and the name, practicing certification number and telephone number of the patent agent designated by the agency; (5) if priority right has been claimed, the application date and number of the first patent application filed by the applicant or the name of the acceptance organ;</p>	<p>Article 16 A request for the patent application of an invention, utility model or design shall indicate: (1) the name of the invention, utility model or design; (2) if the applicant is a Chinese entity or individual, the name, address, zip code, and <del>organizational code</del> <u>unified social credit code</u> or resident's identify card number thereof; if the applicant is a foreigner, a foreign enterprise or any other foreign organization, the name, nationality or country or region of registration thereof; (3) <del>the name</del> <u>true identification information</u> of the inventor or designer; (4) if the applicant has entrusted a patent agency to file the application, the name and institutional code of the agency, and the name, practicing certification number and telephone number of the patent agent designated by the agency; (5) if priority right has been claimed, the application date and number of the first patent</p>	<p><b>Suggestion:</b></p> <p>AIPLA suggests clarifying this paragraph as applied to Chinese citizens who are residents in foreign countries. Specifically, we recommend that</p> <p>a) "individual" as occurring in "where an applicant is a Chinese unit or individual" be changed to "where an applicant is a Chinese unit or <b>an individual who is Chinese resident</b>" (申请人是中国单位或者<b>中国居民个人的</b>); and</p> <p>b) insert "foreign resident" between "where an applicant is a foreigner" and "foreign enterprise", namely, "where an applicant is a foreigner, <b>a foreign resident</b>, a foreign enterprise" (申请人是<b>外国人、外国居民、外国企业</b>) ,</p> <p>so that the paragraph reads:</p> <p>(2) if the applicant is a Chinese entity or individual <b>who is a Chinese resident</b>, the name, address, zip</p>

<p>(6) the signature or seal affixed by the applicant or the patent agency;  (7) a list of the application documents;  (8) a list of appended documents; and  (9) other matters that shall be specified.</p>	<p>application filed by the applicant or the name of the acceptance organ;  (6) the signature or seal affixed by the applicant or the patent agency;  (7) a list of the application documents;  (8) a list of appended documents; and  (9) other matters that shall be specified.</p>	<p>code, <del>and organizational code</del> <u>unified social credit code</u> or resident's identify card number thereof; if the applicant is a foreigner, <b>a foreign resident</b>, a foreign enterprise or any other foreign organization, the name, nationality or country or region of registration thereof;</p> <p><b>Reasons:</b></p> <p>The reason for this proposed change is that the current text is unclear and permits multiple interpretations. This creates difficulties for Chinese citizens living abroad. Currently, this paragraph has been interpreted to apply to all Chinese citizens, regardless of their residence. Consequently, a Chinese citizen who is a permanent resident in another country would always be asked to submit a Chinese resident ID in order to be an applicant for a Chinese patent.</p> <p>AIPLA does not believe the inclusion of the social credit code is appropriate or necessary. The system may be used to deprive individuals of rights to participate in the patent system on factors other than the merits of their invention. Further, the system is subjective and may not provide sufficient accuracy or reliability fairly to base such decisions.</p> <p>Not all Chinese citizens are residents in China. Not every Chinese citizen who is a permanent resident in a foreign country has a valid Chinese resident ID, or ever has been issued a Chinese resident ID (for example, a Chinese citizen was born to Chinese (citizen) parents in a foreign country and never lived in China). By requiring every Chinese citizen to provide a Chinese resident ID would effectively deprive their rights to apply for Chinese patents. The clarifying amendment above could remove the</p>
--	---	---



		<p>potential for this unintended (but permissible) interpretation.</p> <p>Article 16(3)</p> <p>The proposed change, requiring an inventor's name to requirement for the inventor's "true personal identification information", renders the scope of required information under this paragraph no longer clear. If the intention is to require inventors to provide an address or any other information in addition to name, it is best to specify the requirement in this paragraph such additional requirement explicitly. The term "true personal identification information" (真实身份信息) is vague, and therefore AIPLA suggests it be removed.</p>
<p>Article 30</p> <p>An international exhibition recognized by the Chinese Government referred to in subparagraph (1) of Article 24 of the Patent Law means an international exhibition which is registered with or recognized by the International Exhibitions Bureau as stipulated by the International Exhibitions Convention.</p> <p>An academic or technological meeting referred to in subparagraph (2) of Article 24 of the Patent Law means an academic or technological meeting organized by a competent department concerned of the State Council or by a national academic or technological association.</p> <p>Where any invention-creation for which a patent is applied falls under the provisions of subparagraph (1) or (2) of Article 24 of the Patent Law, the applicant shall, when filing the application, make a declaration and, within two months from the date of filing, submit certifying documents issued by the entity which organized the international exhibition or academic or technological meeting, stating the</p>	<p>Article 30</p> <p>An international exhibition recognized by the Chinese Government referred to in subparagraph (1) <b>(2)</b> of Article 24 of the Patent Law means an international exhibition which is registered with or recognized by the International Exhibitions Bureau as stipulated by the International Exhibitions Convention.</p> <p>An academic or technological meeting referred to in subparagraph <del>(2)</del> <b>(3)</b> of Article 24 of the Patent Law means an academic or technological meeting organized by a competent department concerned of the State Council or by a national academic or technological association.</p> <p>Where any invention-creation for which a patent is applied falls under the provisions of subparagraph <del>(1)</del> <b>(2)</b> or <del>(2)</del> <b>(3)</b> of Article 24 of the Patent Law, the applicant shall, when filing the application, make a declaration and, within two months from the date of filing, submit certifying documents issued by the entity which organized the international exhibition or academic or technological meeting, stating the</p>	<p><b>Suggestion:</b></p> <p>Article 30</p> <p>.....</p> <p>An academic or technological meeting referred to in subparagraph <del>(2)</del> <b>(3)</b> of Article 24 of the Patent Law means an academic or technological meeting organized by a competent department concerned of the State Council, a national <b><i>or international</i></b> academic or technological association, <b><i>or industry organizations with international influence.</i></b></p> <p>Where any invention-creation for which a patent is applied falls under the provisions of subparagraph <del>(1)</del> <b>(2)</b> or <del>(2)</del> <b>(3)</b> of Article 24 of the Patent Law, the applicant shall, when filing the application, make a declaration and, within two months from the date of filing, submit certifying documents <b><i>issued by the entity which organized the international exhibition or academic or technological meeting,</i></b> stating the fact that the invention-creation was exhibited or published and the date of its exhibition or publication.</p> <p>.....</p> <p><b>Reasons:</b></p>

<p>fact that the invention-creation was exhibited or published and the date of its exhibition or publication.</p> <p>.....</p>	<p>fact that the invention-creation was exhibited or published and the date of its exhibition or publication.</p> <p>.....</p>	<p>Exhibitions and academic/technical conferences should be treated equally for purposes of publication. The first paragraph refers to "<b>International</b> Exhibition Recognized by the Chinese Government", and the second paragraph should also cover <b>international</b> academic or technical conferences and not be confined to domestic conferences. Domestic innovation entities presenting at international conferences on advanced technologies reflects their innovation ability and establishes their reputation. First publication at an international academic or technical conference, at least as well as an international exhibition, should be excluded for purposes of novelty under international norms.</p> <p>Article 24(2) of the Chinese Patent Law (Article 24(3) of the 4th Amendment effective June 1, 2021) provides that an invention will not lose its novelty within six months before its filing date if "Published for the first time at a prescribed academic conference or technical conference. It does not require sponsorship or recognition by the Chinese Government and does not limit the location of the conference to China.</p> <p>In the third paragraph, AIPLA suggests removing the requirement for issuance of certifications by organizing entity of the international exhibitions, academic conferences, or technical conferences. This would impose unnecessary burdens and inefficiency. Reliable web links, publication, or notarized documents if necessary establish the authenticity of the corresponding technical content at the conferences.</p>
<p><b>Article 32:</b> An applicant may claim one or more priorities for an application for a patent; where multiple priorities are claimed, the priority period for the application shall be calculated from the earliest priority date.</p>	<p><b>Article 32:</b> An applicant may claim one or more priorities for an application for a patent; where multiple priorities are claimed, the priority period for the application shall be calculated from the earliest priority date.</p>	<p><b>Suggestion:</b> AIPLA recommends removing the sentence: "Where the applicant claims the right of domestic priority, the earlier application shall be deemed to be withdrawn as of the date on which the later application is filed, except for the invention or utility model application</p>

<p>Where an applicant claims the right of domestic priority, if the earlier application is one for a patent for invention, he or it may file an application for a patent for invention or utility model for the same subject matter; if the earlier application is one for a patent for utility model, he or it may file an application for a patent for utility model or invention for the same subject matter. However, when the later application is filed, if the subject matter of the earlier application falls under any of the following, it may not be taken as the basis for claiming domestic priority:</p> <p>(1) where the applicant has claimed foreign or domestic priority;</p> <p>(2) where it has been granted a patent right;</p> <p>(3) where it is the subject matter of a divisional application filed as prescribed.</p> <p>Where the domestic priority is claimed, the earlier application shall be deemed to be withdrawn from the date on which the later application is filed.</p>	<p>Where an applicant <u>of a patent application for invention or utility model claims the right of domestic priority</u>, if the earlier application is one for a patent for invention, he or it may file an application for a patent for invention or utility model for the same subject matter; if the earlier application is one for a patent for utility model, he or it may file an application for a patent for utility model or invention for the same subject matter. <u>Where an applicant of a patent application for design claims the right of domestic priority</u>, if the earlier application is one for a patent for invention or utility model, he or it may file an application for a patent for design for the same subject matter as shown by the drawings of the patent application for invention or utility model; if the earlier application is one for a patent for design, he or it may file an application for a patent for design for the same subject matter. However, when the later application is filed, if the subject matter of the earlier application falls under any of the following, it may not be taken as the basis for claiming domestic priority:</p> <p>(1) where the applicant has claimed foreign or domestic priority;</p> <p>(2) where it has been granted a patent right;</p> <p>(3) where it is the subject matter of a divisional application filed as prescribed.</p> <p>Where the domestic priority is claimed, the earlier application shall be deemed to be withdrawn from the date on which the later application is filed, <u>except that the applicant of the patent application for design claims the domestic priority on the basis of the patent application for invention or utility model.</u></p>	<p>where the applicant claims it as the priority of a design application.”</p> <p><b>Reasons:</b> This excludes the possibility that the later filed application may contain contents and/or claims in addition to those in the first filed China priority application. The applicant should be allowed to choose whether to keep the first domestic priority application, as they do under international norms in other leading IP jurisdictions.</p> <p>AIPLA welcomes the clarification that a design patent can claim priority from a Utility Model (UM) or an Invention patent. AIPLA suggests that utility model and invention patent applications be permitted to claim priority to a design application, provided the disclosure is sufficient.</p>
---	---	---

#### Article 39

Where a patent application document falls under any of the following circumstances, the administrative department for patent under the State Council shall not accept the application and shall notify the applicant accordingly:

- (1) where the application for a patent for invention or utility model does not contain a written request, a specification (or a specification of utility model without appended drawings) or a patent claim, or the application for a patent for design does not contain a written request, drawings or photographs;
- (2) where the application is not written in Chinese;
- (3) where the application is not in conformity with Paragraph 1 of Article 120 of these Rules;
- (4) where the written request does not contain the name or address of the applicant;
- (5) where the application is obviously not in conformity with Article 18 or Paragraph 1 of Article 19 of the Patent Law; (6) where the category (for invention, utility model or design) of the application for a patent is not clear or is difficult to discern.

#### Article 121

Any application document shall be typed or printed. All the characters shall be in black ink, neat and clear, and none of them shall be altered. The appended drawings shall be made in black ink with the aid of drafting instruments. The lines shall be uniformly thick and well-defined, and shall not be altered.

#### Article 39

Where a patent application document falls under any of the following circumstances, the administrative department for patent under the State Council shall not accept the application and shall notify the applicant accordingly:

- (1) where the application for a patent for invention or utility model does not contain a written request, a specification (or a specification of utility model without appended drawings) or a patent claim, or the application for a patent for design does not contain a written request, drawings or photographs;
- (2) where the application is not written in Chinese;
- (3) where ~~the application is not in conformity with Paragraph 1 of Article 120 of these Rules~~ **the draft or drawings do not comply with the related stipulations;**
- (4) where the written request does not contain the name or address of the applicant;
- (5) where the application is obviously not in conformity with Article 18 or Paragraph 1 of Article 19 of the Patent Law;
- (6) where the category (for invention, utility model or design) of the application for a patent is not clear or is difficult to discern.

#### ~~Article 121~~

~~Any application document shall be typed or printed. All the characters shall be in black ink, neat and clear, and none of them shall be altered. The appended drawings shall be made in black ink with the aid of drafting instruments.~~

#### Suggestion:

AIPLA suggests reversing the proposed changes to Article 39(3), and that any amendment, for example, those necessary for paperless filing, be made to original Article 121 instead.

#### Reasons:

AIPLA is concerned that the change from a requirement to comply with Article 121(1) to "drafted or illustrated according to requirements" renders this requirement vague and unclear. Specifically, it is unclear what requirements must be met in order for an applicant to obtain a filing date. A patent application must meet many different written description requirements and other drafting requirements. Article 18 of the Rules is one such example, which requires that a reference character not mentioned in the description shall not appear in the drawings and a reference character not shown in the drawings shall not appear in the description text. It is unclear from this revision whether a patent application would be denied a filing date simply because it failed to meet this Article 18 requirement.

In contrast, original Article 121(1) more clearly and explicitly details formality requirements (such as no change markings). AIPLA recommends that the proposed changes to Article 39(3) be reversed and any amendment, for example those necessary to establish a paperless filing system, be made to original Article 121 instead.

<p>The written request, specification, patent claim, appended drawings and abstract shall be numbered separately in Arabic numerals and arranged in numerical order.</p> <p>The script of application documents shall run horizontally. Only one side of each sheet shall be used.</p>	<p><del>The lines shall be uniformly thick and well-defined, and shall not be altered.</del></p> <p><del>The written request, specification, patent claim, appended drawings and abstract shall be numbered separately in Arabic numerals and arranged in numerical order.</del></p> <p><del>The script of application documents shall run horizontally. Only one side of each sheet shall be used.</del></p>	
<p>Article 40 Where the description states that it contains explanatory notes to the drawings but the drawings or part of them are missing, the applicant shall, within the time limit specified by the patent administration department under the State Council, either furnish the drawings or make a declaration for the deletion of the explanatory notes to the drawings. If the drawings are submitted later, the date of their delivery at, or mailing to, the patent administration department under the State Council shall be the date of filing of the application; if the explanatory notes to the drawings are to be deleted, the initial date of filing shall be retained.</p>	<p><u>Article 40</u> <u>Where partial contents of the claims or the description of a patent application for invention or utility model are missing, the applicant may furnish them by reference of the priority document(s) in accordance with the provisions, within two months from the date of filing or within the time limit specified by the patent administration department under the State Council, and the initial filing date shall be retained.</u></p> <p>Where the description states that it contains explanatory notes to the drawings but the drawings or part of them are missing, the applicant shall, within the time limit specified by the patent administration department under the State Council, either furnish the drawings or make a declaration for the deletion of the explanatory notes to the drawings. If the drawings are submitted later, the date of their delivery at, or mailing to, the patent administration department under the State Council shall be the date of filing of the application; if the explanatory notes to the drawings are to be deleted, the initial date of filing shall be retained.</p>	<p><b>Comments:</b> AIPLA welcomes the new provisions indicating that applicants can add missing contents into an application by way of incorporation by reference from priority document(s) within 2 months from filing and keep the original filing date as well as the earliest priority date for any content from the original priority document(s).</p> <p>The recent Examination Guidelines provide that, for PCT national phase entry applications, any matter added to the specification during the PCT stage will be considered new matter and result in a newly rectified filing date that is pushed back to the date at which the new matter was added. It is unclear whether this “new matter” for PCT national stage purposes includes the “missing content” in the draft Implementation Rules. If so, different standards may apply depending on whether an application is a non-PCT application or a PCT national phase entry application.</p> <p>AIPLA respectfully suggests that CNIPA clarify and update the Examination Guidelines to explicitly allow national phase entry applications to also enjoy the ability to preserve the original filing date for incorporation by reference from a priority document(s).</p>
	<p>New Article 43-1 Circumstances which do not comply with the first paragraph of Article 20</p>	<p><b>Comments:</b> AIPLA requests clarification how this Article will be interpreted. Some objective tests may be necessary to clearly delineate the boundary of what might be</p>

	<p>of the Patent Law shall include fabricating, forging, plagiarizing, piecing together or any other obvious improper act.</p>	<p>considered "clearly inappropriate behavior", or even what might be considered "fabricate" or "piece together", notwithstanding that new inventions may be resulted from combination of technologies in patent publications.</p>
	<p><b>New Article 68-1</b>                  In the invalidation procedure, when necessary, the Patent Administration Department of the State Council, in accordance with regulations, may examine the grounds that were not provided by the petitioner, while shall give the parties the opportunity to state their opinions.</p>	<p><b>Suggestion:</b>                  AIPLA suggests not to add this new Article 68-1,</p> <p><b>Reasons:</b>                  Unlike re-examination, ex officio examination is an exception to the upon-request principle. The Beijing Intellectual Property Court has held that, in patent invalidation procedures, the counterparty of the patent right appears, and the ruling made by the Patent Reexamination Board (i.e., the Patent Administration Department of the State Council) is not a typical administrative act, but an intermediary ruling being initiated by the petitioner. The dispute is between the petitioner and patentee over the validity of the private patent right. Therefore, the upon-request principle is fundamental to patent invalidation examination. The Patent Reexamination Board usually only examines the scope, grounds and submitted evidence provided in the invalidation request submitted by the party and does not undertake the obligation to comprehensively examine the validity of the patent.</p> <p>The Supreme People's Court confirmed in the earlier (2013) Zhixingzi No. 92 Administrative Ruling that ex officio review is an exception to the principle of upon-request invalidation examination. Thus, the provisions on ex officio examination in the "Examination Guidelines" on one hand gives the public corresponding expectations, and on the other hand limits the scope of ex officio examination by the Patent Administration Department of the State Council.</p> <p>The amendment proposal designates the patent administration department of the State</p>

		<p>Council to conduct a comprehensive review "<b>when necessary</b>". AIPLA is concerned that this is vague. Once blurred, its scope may be interpreted more casually, causing the neutral status of the State Council's patent administration department to be easily tilted, and the public's expectations of its administrative authority boundary may also be easily destroyed. AIPLA suggests this paragraph be removed, and the scope of ex officio review be determined by specific provisions in the Examination Guidelines.</p> <p>Even if this amendment is implemented, AIPLA requests clarifying in what situations CNIPA can bring these new types of rejections, what types of new rejections are allowed, and what opportunity the applicant will have to respond to it. AIPLA recommends making similar clarifications to new Article 62-1 for re-examination.</p>
<p>Article 72 The person requesting invalidation may withdraw his request before the Patent Reexamination Board makes a decision on it. Where the person requesting invalidation withdraws his or its request or where his or its request for invalidation is deemed to have been withdrawn before the Patent Reexamination Board makes a decision thereon, the procedure of the examination of the request for invalidation terminates. However, where the Patent Reexamination Board, based on the examination work it has done, finds that a decision could be made on invalidation or invalidation in part of the patent right, it shall not terminate the examination procedure.</p>	<p><b>第七十二条</b> The person requesting invalidation may withdraw his request before the Patent Reexamination Board the Patent Administration Department of the State Council makes a decision on it. Where the person requesting invalidation withdraws his or its request or where his or its request for invalidation is deemed to have been withdrawn before the Patent Reexamination Board the Patent Administration Department of the State Council makes a decision thereon, the procedure of the examination of the request for invalidation terminates. However, where the Patent Reexamination Board the Patent Administration Department of the State Council, based on the examination work it has done, finds that a decision could be made on invalidation or invalidation in part of the patent right, it shall not terminate the examination procedure.</p>	<p><b>Suggestion:</b></p> <p>AIPLA suggests not to change the responsibility for handing the request from the Patent Reexamination Board (now Patent Re-examination and Invalidation Department (RID) to the Patent Administration Department of the State Council but, rather to retain that responsibility in the Patent Re-examination and Invalidation Department.</p> <p>In the event the change is promulgated, AIPLA requests further modifying it as follows: ..... Where the person requesting invalidation withdraws his or its request or where his or its request for invalidation is deemed to have been withdrawn before the Patent Re-examination and Invalidation Department <del>the Patent Administration Department of the State Council</del> makes a decision thereon, the procedure of the examination of the request for invalidation terminates. <del>However, where the Patent Reexamination Board the Patent</del></p>

		<p><del><b>Administration Department of the State Council,</b> based on the examination work it has done, finds that a decision could be made on invalidation or invalidation in part of the patent right, it shall not terminate the examination procedure.</del></p> <p>.....</p> <p><b>Reasons:</b>          AIPLA suggests that the Patent Re-examination and Invalidation Department is the appropriate body to consider such requests for invalidation as well as any request for withdrawal. Similar to the above comments on new Article 68-1, the principle of upon-request invalidation examination is a basic principle of invalidation procedure. Once the petitioner withdraws the invalidation request, the basis for invalidation examination is eliminated. And, because there is no dispute between the challenger and rights holder, the Patent Reexamination Board should terminate the examination procedure</p> <p>The invalidation petitioner may have been withdrawn and an invalidation decision may nonetheless be issued. If the patentee is dissatisfied with the decision and initiates administrative litigation challenging it, and the invalidation petitioner does not appear, the decision should be revoked because the invalidation petitioner is no longer participating.</p> <p>Therefore, neither the invalidation procedure nor the litigation system should supports continuing the invalidation examination after the invalidation petition is withdrawn</p>
<p>Article 82          Where, in the course of handling a patent infringement dispute, the alleged infringer requests invalidation of the patent right and his or its request is accepted by the Patent Reexamination Board, he or it may request the administrative authority for patent affairs</p>	<p>Article 82          Where, in the course of handling a patent infringement dispute, the alleged infringer requests invalidation of the patent right and his or its request is accepted by <b>the Patent Administration Department of the State Council</b> Patent Reexamination Board, he or it may request the administrative authority for</p>	<p><b>Suggestion:</b>          AIPLA suggests that the change not be made because the Patent Reexamination Board is the appropriate body to consider such requests for invalidation. Additionally, there appears to be a missing word, "not", i.e., evidence presented by the alleged infringer is "<b>not</b>" sufficient to prove that the</p>



<p>concerned to suspend the handling of the matter.</p> <p>If the administrative authority for patent affairs considers that the reasons set forth by the alleged infringer for the suspension are obviously untenable, it may not suspend the handling of the matter.</p>	<p>patent affairs concerned to suspend the handling of the matter.</p> <p>If the administrative authority for patent affairs considers that the reasons set forth by the alleged infringer for the suspension are obviously untenable, it may not suspend the handling of the matter <b><u>under the following circumstances.</u></b></p> <p><b><u>(1) The search report or patent evaluation report provided by the requester of the patent infringement dispute does not show any defects in the patent right for utility models or designs that do not meet the requirements for issuance of the patent;</u></b></p> <p><b><u>(2) The evidence provided by the alleged infringer is sufficient to prove that the technology used by it is publicly known;</u></b></p> <p><b><u>(3) The evidence or grounds provided by the alleged infringer for requesting the invalidation of the patent right are obviously insufficient;</u></b></p> <p><b><u>(4) A previous invalidation decision has maintained the validity of the utility model or design patent;</u></b></p> <p><b><u>(5) Other circumstances where the patent administrative department believes that the infringement handling procedures should not be suspended.</u></b></p>	<p>technology it used was already publicly known. In other words, add “不” to change the Chinese text to read:</p> <p>.....</p> <p>If the administrative authority for patent affairs considers that the reasons set forth by the alleged infringer for the suspension are obviously untenable, it may not suspend the handling of the matter <b><u>under any of the following circumstances.</u></b></p> <p>.....</p> <p><b><u>(5) Other circumstances where the patent administrative department believes that the infringement handling procedures should obviously not be suspended.</u></b></p> <p><b>Reasons:</b></p> <p>The proposal in Article 82 regulates the specific circumstances that the patent infringement dispute may not be suspended. The original intention is assumed to be that at least one of the circumstances in items (1) ~ (5) is met.</p> <p>In addition, AIPLA Suggests that the language be revised to make clear that item (5) is consistent with "the reason for the suspension is obviously untenable."</p>
<p>Article 84</p> <p>The following acts are acts of passing off patents as stipulated in Article 63 of the Patent Law:</p> <p>(1) Mark the patent mark on the product or its packaging for which the patent right has not been granted, continue to mark the patent mark on the product or its packaging after the patent right is declared invalid or terminated, or mark</p>	<p>Article 84</p> <p>The following acts are acts of passing off patents as stipulated in Article <del>63</del> <u>68</u> of the Patent Law:</p> <p>(1) Mark the patent mark on the product or its packaging for which the patent right has not been granted, continue to mark the patent mark on the product or its packaging after the patent right is declared invalid <del>or terminated</del>, or mark the product or product packaging without permission The patent number of others;</p> <p>(2) Sell the products mentioned in item (1);</p>	<p><b>Comments:</b></p> <p>AIPLA generally supports the amendments. AIPLA seeks clarification on how long after a patent has been invalidated that the patent number must be removed from the product.</p> <p>AIPLA seeks further clarification whether products may be marked virtually, for example, by affixing a webpage listing patents and associated products in place of affixing a patent number directly on a product.</p>

<p>the product or product packaging without permission The patent number of others;</p> <p>(2) Sell the products mentioned in item (1);</p> <p>(3) In the product specification and other materials, the technology or design that has not been granted patent rights is called patented technology or patent design, the patent application is called patent, or the patent number of others is used without permission, so that the public will be involved The technology or design is mistaken for patented technology or patented design;</p> <p>(4) Forging or altering patent certificates, patent documents or patent application documents;</p> <p>(5) Other acts that confuse the public and mistake the technology or design for which a patent has not been granted as patented technology or patented design.</p> <p>Before the termination of the patent right, the patent mark is marked on the patented product, the product directly obtained in accordance with the patented method, or its packaging according to law, and the sale or sale of the product is promised after the termination of the patent right, which does not constitute a counterfeit patent.</p> <p>If you sell a product that is not known to be a counterfeit patent and can prove the legal origin of the product, the patent management department shall order it to stop the sale, but exempt from fines.</p>	<p>(3) In the product specification and other materials, the technology or design that has not been granted or the patent right has been invalidated is called patented technology or patented design, and the patent application is called a patent, or the patent number of another person is used without permission to make the public misunderstand the involved technology or design as patented technology or patented design;</p> <p>(4) Forging or altering patent certificates, patent documents or patent application documents;</p> <p>(5) Other acts that confuse the public and mistake the technology or design for which a patent has not been granted as patented technology or patented design.</p> <p><del>Before the termination of the patent right, the patent mark is marked on the patented product, the product directly obtained in accordance with the patented method, or its packaging according to law, and the sale or sale of the product is promised after the termination of the patent right, which does not constitute a counterfeit patent.</del></p> <p>If a product that is not known to be a counterfeit patent is sold, and the legal source of the product can be proved, <del>the patent enforcement department</del> of the administrative department responsible for patent enforcement shall order the suspension of sales, but shall be exempted from <del>fin</del>es and other administrative penalties.</p>	<p>Regarding virtual marking, removing patent application numbers and issued patent numbers from products tends to be expensive. For instance, some products require new molds to be created, costing the patent owner thousands of dollars to correct, affix, or remove a patent number from a product. Virtual marking decreases costs for the patent owner.</p>
	<p><b>New Article 85-2</b></p> <p>Where a request is made for compensation for the term of a patent right of an invention in</p>	<p><b>Suggestion:</b></p> <p>Where a request is made for compensation for the term of a patent right of an invention in accordance with the second paragraph of Article 42 of the Patent</p>

	<p>accordance with the second paragraph of Article 42 of the Patent Law, the patentee shall submit a request to the Patent Administration Department of the State Council within 3 months after the announcement of the patent right.</p>	<p>Law, the patentee shall submit a request to the Patent Administration Department of the State Council within 36 months after the announcement of the patent right.</p> <p><b>Reasons:</b></p> <p>For a patentee owning a large patent portfolio, the period of maintaining the patent package is likely to be longer, thus, the three-month period from the date of authorization announcement may impose and undue burden. Therefore, AIPLA recommends extending the requesting opportunity to 6 months, so that more patentees can avoid losing the compensation opportunity of their patent right period.</p>
	<p><b>New Article 85-3</b></p> <p>Where patent term is compensated on the granting of a patent, the term of patent is compensated according to the actual days of delays.</p> <p>Unreasonable delays caused by the applicant described in Article 42 paragraph two of the Patent Law comprise the following circumstances:</p> <p>(1) not responding to the notifications issued by the patent administration department under the State Council within the specified time limit;</p> <p>(2) requesting to defer the examination;</p> <p>(3) incorporation by reference;</p> <p>(4) other circumstances;</p> <p>The circumstances described in Rules 86 and 87 of the Implementing Regulations do not belong to unreasonable delays.</p>	<p><b>Comments:</b></p> <p>With respect to items that are considered “applicant’s unreasonable delay”, AIPLA requests further explanation on how “incorporation by reference” could impact the patent term adjustment is required.</p> <p>AIPLA also seeks clarification whether patent term adjustment from an applicant’s reasonable delay would impact the patent term extension from administrative delay when both exist.</p>
	<p><b>Article 85-4</b></p> <p>The compensation of the term of a drug patent may be given to those patents related to new drugs of chemical drugs, biological products and traditional Chinese medicine which are approved for marketing in China, covering new drug products, preparation methods or medical</p>	<p><b>Comments:</b></p> <p>Patent Term Compensation for drugs applies to patents protecting pharmaceutical chemical compositions, biological products, and traditional Chinese medicines (TCM). It seems to imply that processes of preparation and medical uses (for all three of the above) are also included. However, the language is unclear and it could also be interpreted</p>

	<p>uses, where the term compensation requirements of drug patents are met. The new-drug-related patents referred to in the previous paragraph refer to patents related to active ingredients of new drugs approved for marketing for the first time by the drug supervision and management department under the State Council. The new drug patents of traditional Chinese medicine include patents related to innovative drugs of traditional Chinese medicine and patents related to improved new drugs of traditional Chinese medicine with added functions/indications.</p>	<p>to mean that the processes and medical uses only apply to TCMs. AIPLA seeks clarification on this important point.</p> <p>AIPLA also recommends clarifying the mechanism and/or time limit within which to challenge a decision to grant patent term extension.</p>
<p>Article 119</p> <p>Any application which is filed with, or any formality which is gone through with, the patent administration department of the State Council, shall be signed or sealed by the applicant, the patentee, any other interested person or his or its representative, and shall be sealed by a patent agency if such agency is appointed.</p> <p>Where a change in the name of the inventor, or in the name or title, nationality and address of the applicant or the patentee, or in the title and address of the patent agency or the name of the patent agent is requested, a request for a change in the bibliographic data shall be submitted to the patent administration department of the State Council, together with the relevant certifying documents.</p>	<p>Article 119</p> <p>Any application which is filed with, or any formality which is gone through with, the patent administration department of the State Council, shall be signed or sealed by the applicant, the patentee, any other interested person or his or its representative, and shall be sealed by a patent agency if such agency is appointed.</p> <p><b><u>Signature or seal in electronic form refers to electronic signature.</u></b></p> <p>Where a change in the name of the inventor, or in the name or title, nationality and address of the applicant or the patentee, or in the title and address of the patent agency or the name of the patent agent is requested, a request for a change in the bibliographic data shall be submitted to the patent administration department of the State Council, together with the relevant certifying documents <b><u>when necessary.</u></b></p>	<p><b>Suggestion:</b> Article 119 ..... <b>Signature or seal in electronic form refers to electronic signature <i>which could be identified.</i></b> .....</p> <p><b>Reasons:</b> AIPLA applauds the proposed revision to Article 119 to increase the use of electronic signatures. This has become more than a matter of convenience with increased remote work due to the disruptions of the Covid-19 pandemic. It is critical to ensure the smooth and efficient operation of business and Government. AIPLA suggests that, where certifying documents are required, uncertified documents be accepted provisionally, pending submission of such certifying documents.</p> <p>Electronic signatures enhance convenience and efficiency. Nonetheless, due diligence should be applied to the use of electronic signatures. The electronic signature must be distinguished from the signatures that other signers can provide for the same content. For example, a scanned copy of a handwritten signature, a signature design (professional software design is also available) for the disabled who cannot sign by hand, etc., are</p>

		<p>examples of signatures that can be distinguished from others with the same content.</p> <p>However, some office software (such as Adobe) supports the function of automatically generating electronic signatures. A user providing the same input will generate a same electronic signature. Extending the electronic signature to this degree would introduce uncertainty as to the validity and legal effect of the signature because verification of the suspicious electronic signature is not feasible.</p>
--	--	---