

Patent Protection in China: Know Before You Go

It is a given that patent protection has to be requested before a respective product is introduced to the national market. However, it is less often considered how a product may appeal in other world markets, and that these may not extend automatic protection for an invention registered back home. In particular, a European registered patent has no legal effect in China.

This is of particular importance as an invention may be later mass-produced in China without even being sold there, though face equal exposure to infringement. Furthermore, **patents are granted to the 'first-to-file' rather than the 'first-to-use'**, meaning timely patent protection in China for each and every innovation is absolutely crucial.

Although a standard European patent registration does not provide recognition in China, there are now international treaties that make it simpler and quicker to register in China subsequent to doing so in Europe if certain filing routes are chosen. It is therefore a good idea to have a basic knowledge of the application and registration options as well as the types of patents available.

Application/Registration

Foreign companies without a registered office in China must use a local patent attorney to handle the filing of a patent. The quality of the patent attorney and the quality of the application is critical for the value of the protective right. **Treat your patent applications as one of your company's most valuable assets in China.**

There are three ways to file a patent:

- Directly filing a patent application in China
- Filing a patent application first in a foreign country (must be a Member State of the Paris Convention, like all EU countries), and then file a second patent application in China within 12 months (6 months for designs), claiming the priority date of the first application (the date the application process was officially started).
- Filing an international patent application under the Patent Cooperation Treaty (PCT), naming China as one of the designated states. A PCT application can be filed with the European Patent Office or any national patent office within the EU. The applicant has to initiate the 'national phase', i.e. the procedure with the Chinese Patent Office, no later than 30 months from the priority date. *It is recommended to use the PCT route to file patent applications in China.*

A very careful translation of an application is of utmost importance. A national Chinese patent application has to be in the Chinese language, and only the Chinese patent claims eventually determine the scope of protection. Remember: in China, if there are two patent applications filed for the same innovation, the patent is granted to the one who filed their application first.

Chinese patent law covers three distinct areas:

An **invention patent** is granted for innovations in the field of technology that are new and inventive over the prior art (any information relating to the invention which has already been made public), and that possess practical applicability. A **utility model patent** is granted for new technical solutions relating to the shape and/or structure of an object. In general, the degree of invention required for a utility model patent is not as high as for invention patents. A **design patent** is granted for original designs relating to the shape, pattern, colour or a combination of an object. Patent rights commence from the date of publication in the Patent Gazette. The term varies depending on the type of patent:

- Invention 20 years from the filing date
- Utility Model 10 years from the filing date
- Design 10 years from the filing date

The average duration of application/registration procedure is 3 to 5 years for invention patents while for utility/design patents it amounts to 1 year. In order to obtain enforceable protection rights as soon as possible, it is advisable to file a utility and invention patent application in parallel, and abandon the utility model patent once the invention patent has been issued.

Know before you go

All too often the Helpdesk has witnessed cases of businesses preparing to open operations in China only to find that another company is already manufacturing and marketing their innovations often with legal ownership of the patents. To then negotiate and claim the innovations back can take years of legal wrangling and expense - and this is one of the better scenarios. All inventors should be aware that where there is market potential for their innovations there is also the risk of counterfeiting and intellectual property infringement in overseas markets, and China should be among their biggest concerns. Register patents early to avoid the theft of your ideas.

CHINA IPR SME HELPDESK

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