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Tips for Choosing the Hague Agreement or the Paris Convention for Design Protection in China

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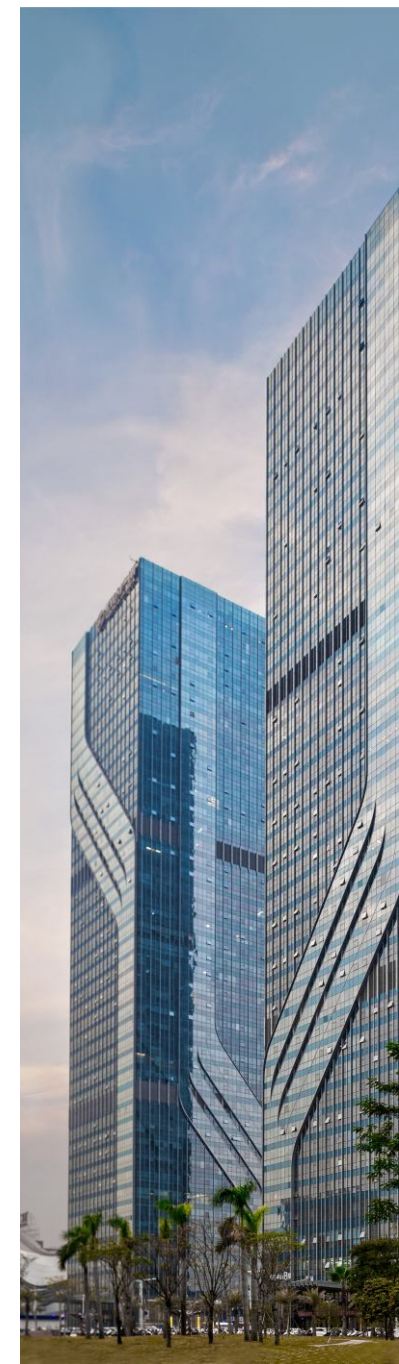
Ethan J. Zou is a Patent Attorney with Jiaquan IP Law. He graduated from the University of Electronic Science and Technology of China, majoring in mechanical design, manufacturing and automation, with a bachelor's degree in engineering.

Since joining Jiaquan in 2017, he has been mainly engaged in patent work related to mechanical structure, technological process and automation process. Responsible for domestic and foreign patent writing, translation, defense, retrieval and other practical work. Especially good at the application and defense of design patents at home and abroad.

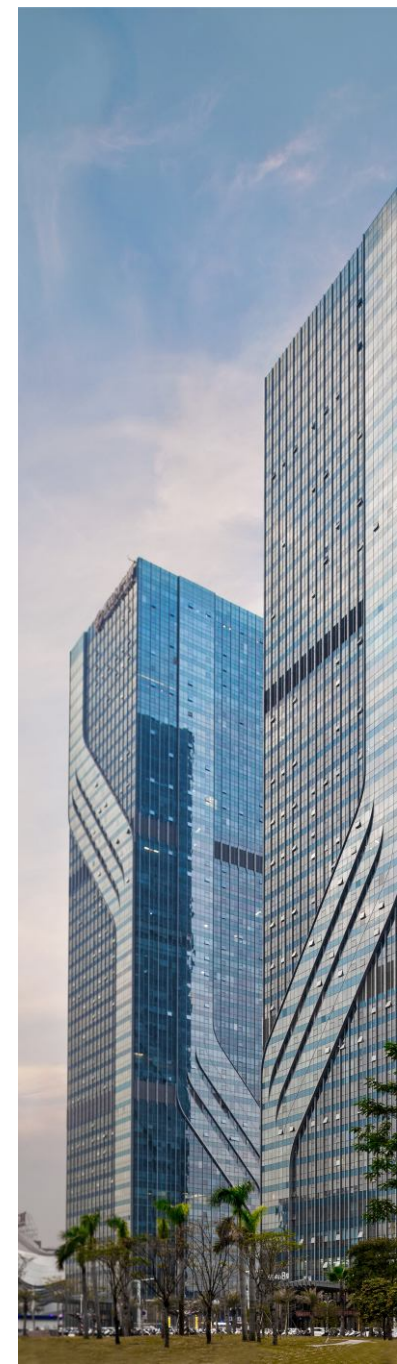
The Hague Agreement Concerning the International Registration of Industrial Designs (the "Hague Agreement") entered into force in China on May 5. Currently, there are two options to file design applications in China: the Hague Agreement (designated extension) and the Paris Convention (direct entry).

Based on our analysis and practical experience, we summarized some tips on how to choose the Hague Agreement or the Paris Convention for design protection in China, for the reference of foreign applicants.

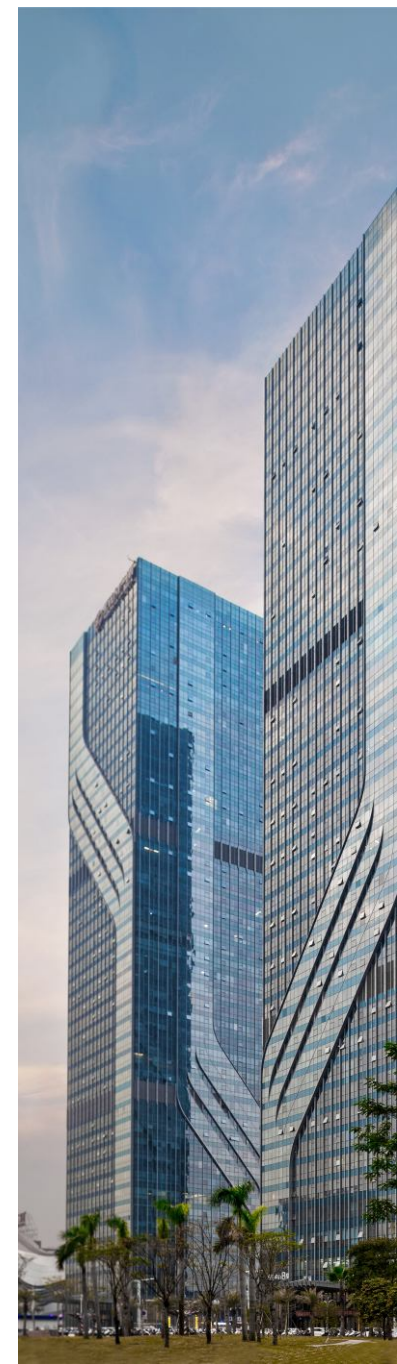
Design Applications Entering China in Two Different Ways		
Route	Hague Agreement	Paris Convention
Costs		
Official fee	Basic fee + Publication fee + Designation fee (international application stage)	Basic Fee + Priority Fee
Agency fee	Application stage: consultation fee (possible) + Submission fee + Amendment fee	Application stage: Submission fee + Amendment fee
	Examination stage: statement/correction fee	Examination stage: statement/correction fee
Additional fee	Additional Design: official fees + agency fees	Additional Design: agency fees only
Maintenance fee	Renewal stage Designation fee, every 5 years	Renewal stage Annual fee, once a year



Main procedure		
Language for filling	English/Spanish/French	Chinese
Timing of publication	1) Immediate publication: about one week after the international registration date; 2) Standard publication: 12 months after the international registration date; or 3) Publication at a chosen time: up to 30 months (not allowed in some countries)	Published after granted (about 5 - 10 months)
Special procedure	Temporarily, not clear	Deferred examination (Optional: 1 Year/2 Year/3 Year)
Examination criteria	Formal examination by WIPO and CNIPA (mainly)	Formal examination by CNIPA (mainly)
Common rejection	Drawing defects, title and product usage, unity defect	Drawing defects, unity defect
Examination period	Usually up to 15 months	Usually 3 - 8 months
Duration	15 years from the filing date (maximum renewal period)	15 years from the filing date



Advantage & Disadvantage		
Major advantage	More simplified and economical if intending to enter multiple countries.	The examination period is shorter: usually taking 3 - 8 months (only for new Chinese applications that don't involve the domestic priority or partial design)
Major disadvantage	<p>1) The examination period is longer: usually taking 12 - 16 months;</p> <p>2) The required application documents in China are different from other countries. If the drawings and descriptions do not meet China's requirements for Hague application, the applicant will likely be asked to amend the documents at the examination stage</p>	If the applicant intends to enter multiple countries at the same time, the procedure is more complicated (only for direct applicants without using foreign agencies), and the fee at the application stage is higher



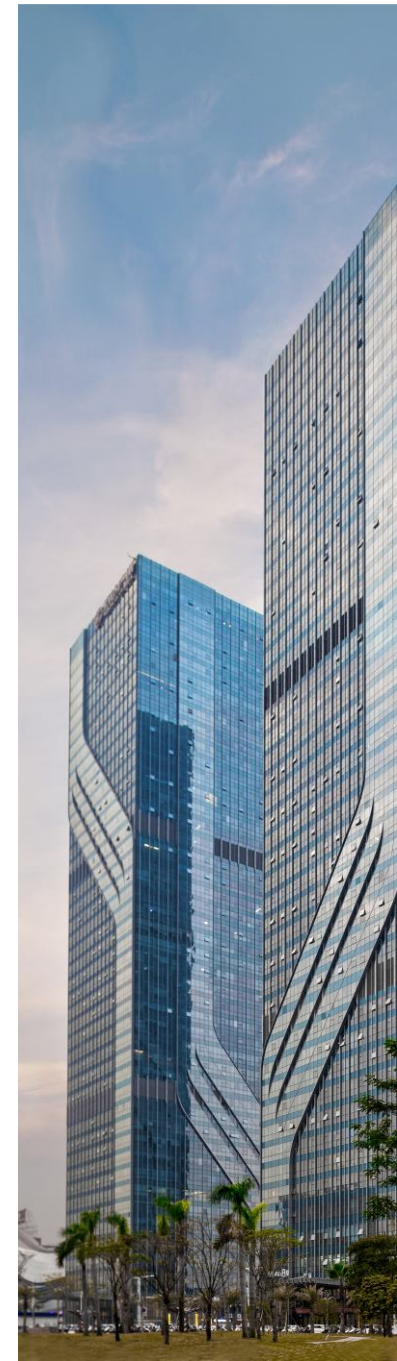
Facts and Suggestions

Basic facts:

- Major countries have different requirements for design application documents
- The drawing requirements of China and the U.S. are quite different. It is basically impossible for the drawings of a single design application to meet the requirements of both countries at the same time
- The drawing requirements of Japan and South Korea are also special and should be exactly the same as the drawings of the priority application (omitted views without design points can be added)
- Specification requirements: China has special requirements for product names and product uses

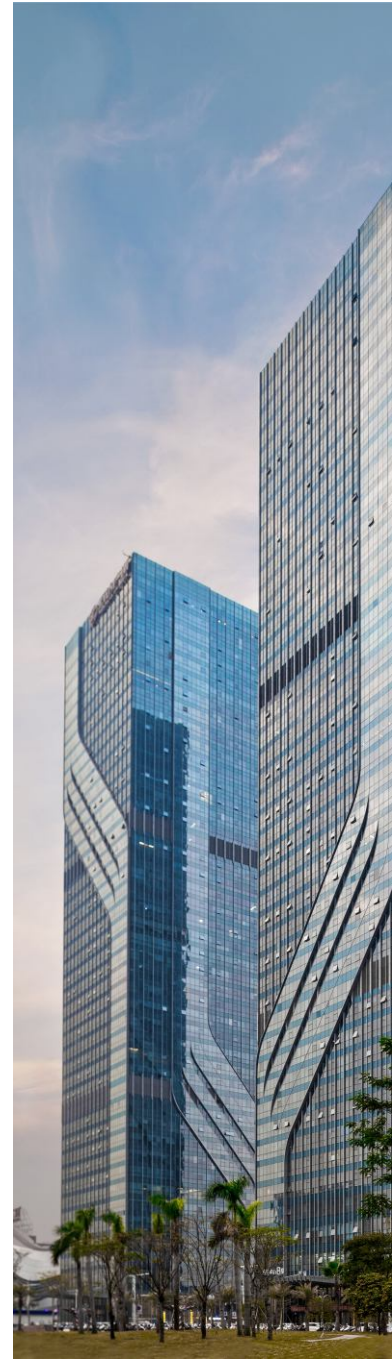
Our suggestions:

- 1) If the designated countries are less than three, regardless of including the U.S. and China or not, it is recommended to apply separately through the Paris Convention
- 2) If there are less than 5 but more than 3 designated countries, including both the U.S. and China, it is recommended to apply for other countries and U.S./China through Hague Agreement, and separately apply for China/U.S. via the Paris Convention. When applying through Hague Agreement/Paris Convention, the applicant should prepare filing documents based on the specific requirements of China or the U.S.
- 3) If there are less than 5 but more than 3 designated countries, including either the U.S. or China or including neither of them, it is recommended to apply through the Hague Agreement;
- 4) For more than 5 designated countries, regardless of including the U.S. and China or not, it is recommended to apply through the Hague Agreement.



Special note:

- 1) For new applications entering China through the Hague system, it is still not clear whether the "designation fee at the international application stage" in the official fee will be charged or not. According to the China Office of WIPO, although the fee is likely to be charged, it wouldn't be higher than the official fee for directly filing in China through Paris Convention. More details will be announced soon.
- 2) For new applications entering China through the Hague system, it is still not clear whether the "delayed publication time" is up to 30 months for all applications, because the regulations of different countries are not the same. Likely, all publications can be delayed for 30 months. The specific regulations will be announced soon.



Jiaquan info - Dr. Xiuping Ou Designated National Experts on Overseas Intellectual Property Disputes and IIPCC

Dr. Xiuping Ou, a senior counsel at Jiaquan IP Law, was among the second batch of officially designated National Experts on Overseas Intellectual Property Disputes and has also become a member of the Executive Advisory Committee of the International IP Commercialization Council (IIPCC).

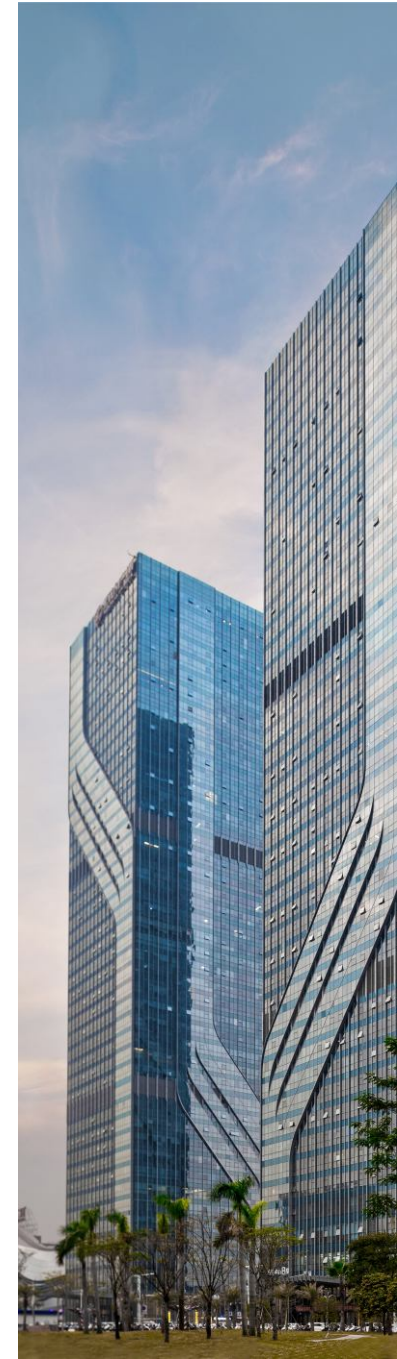
The second batch of National Experts on Overseas Intellectual Property Disputes was selected by the National Overseas IP Dispute Response & Guidance Center ("Center"), a public welfare organization jointly established by the China National Intellectual Property Administration and China Council for the Promotion of International Trade. All National Experts on Overseas Intellectual Property Disputes are committed to providing guidance and services to Chinese entities regarding the resolution of overseas IP disputes. Their responsibilities include:

- (1) Providing relevant information such as local intellectual property rules and regulations required to deal with overseas IP disputes.
- (2) Providing suggestions on strategies and precautionary measures for dealing with overseas IP disputes.
- (3) Participating in events organized by the Center (especially for influential or difficult overseas IP disputes), including discussions between experts, guidance or counseling seminars, and industry mentoring programs.
- (4) Providing expert opinions on overseas IP early

warning reports and practical guidance to be issued by the Center.

- (5) Participating in other work related to overseas IP disputes arranged by the Center or its local sub-centers.

IIPCC is a global, non-profit, non-partisan, non-government organization. It was first established in 2014 and is headquartered in Hong Kong. It is the first global IP commercialization multidisciplinary NGO based in Asia, providing an "IP-Innpreneurship" platform for enterprises, entrepreneurs, professionals, and innovators around the world. It acts as a permanent observer of the World Intellectual Property Organization (WIPO) and is widely supported by numerous governments and NGOs. IIPCC currently has eighteen chapters and over 2,000 expert committee members worldwide. As a member of the IIPCC Executive Advisory Committee, Dr. Ou will assist in tasks such as promoting the organization, strengthening its goal of promoting IP commercialization, participating in its events, and providing the leadership, wisdom, and creativity necessary for formulating IIPCC's future policies and direction throughout the next two years.



Patent practice - Filing Divisional Applications in China

During the process of patent examination, many applicants are required to revise their applications on the ground of lacking unity of invention, because the examiner decides that the application contains multiple inventions. Under such circumstances, the applicant may file divisional applications per the examiner's requests. The initial patent application will thus be divided into two or more applications in order to meet the unity requirement, and these divisional applications may retain the initial application filing date. The priority date may be retained as well if priority had been claimed in the initial application.

Filing a divisional application is a fairly common practice for patent filing in China. Some relevant requirements and rules have been summarized below for reference:

1. Types of Divisional Applications

There are two main types of the divisional application. One is the involuntary divisional application (mentioned above). This type of divisional application is generally required due to the examiner pointing out unity defects in the initial application.

The other type is the voluntary divisional application. Even when a unity defect is not raised by the examiner, an

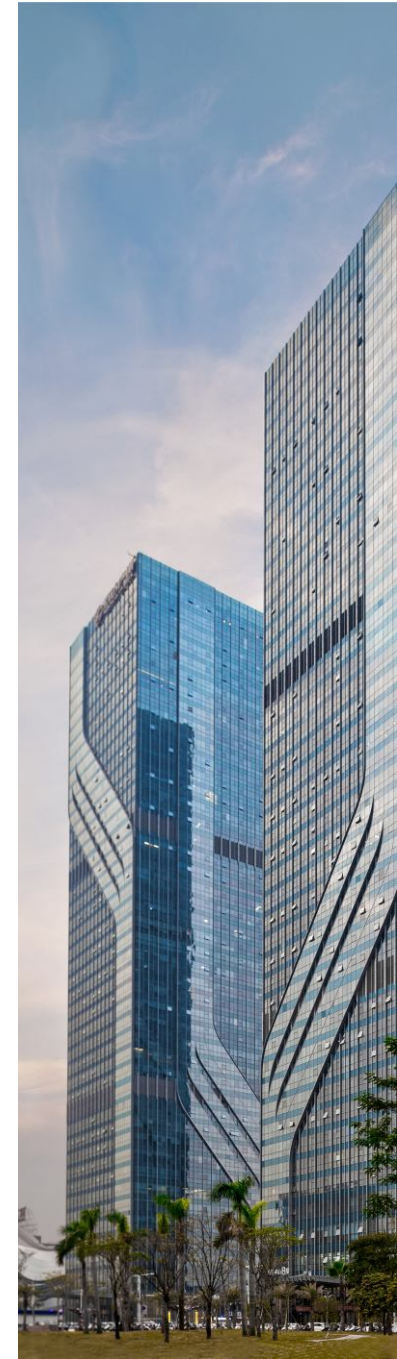
applicant may still file divisional applications voluntarily, usually as a patenting strategy. For example, when an applicant and an examiner have differing opinions regarding certain claims, the applicant can delete the debatable claims and have the allowable claims granted, in order to occupy the market as quickly as possible. The applicant can later pursue the deleted claims via filing divisional applications.

Needless to say, there are many other reasons and strategies for filing divisional applications. You are always welcome to contact our patent attorneys at Jiaquan IP Law Firm for additional information and further discussion. We would be happy to provide you with a customized patent application strategy.

2. Requirements for Filing a Divisional Application

When a single patent application is deemed to include multiple inventions, the applicant may file divisional applications up until two months after the receipt date of the initial application's Notice of Allowance. This means that the divisional application should be filed with the following five preconditions:

- 1) The initial application must contain two or more utility



inventions, utility models, or designs.

2) The deadline to file a divisional application is two months following the receipt date of the initial application's Notice of Allowance. After this deadline, the applicants will have automatically waived their right to file a divisional application.

3) No divisional applications may be filed if the initial patent application has been rejected, withdrawn, or deemed to be withdrawn.

4) If the examiner finds that filed documents of the initial patent application do not conform to existing patent laws and rules, the examiner will request that the applicant amend the application within a specified time limit. If the applicant fails to respond appropriately within this time limit, no divisional application may be filed.

5) Divisional applications cannot change the initial application's patent type.

3. Schedule for Filing a Divisional Application

When filing divisional applications, timing is critical. Missing a deadline often results in applicants losing the opportunity to file a divisional application.

Pursuant to Article 42 of the Implementing Regulations of

the Chinese Patent Law, the time limit for filing divisional applications depends upon the status of the initial application itself.

1) If certain claims are allowed, a divisional application must be filed prior to the deadline defined in Article 54 of the Implementing Regulations. Accordingly, the applicant may file divisional applications within two months from the receipt date of the Notice of Allowance for the initial application.

2) If the Notice of Allowance for the initial application has not been issued, divisional applications may be filed at any time, provided that the initial application has not been rejected, withdrawn, or deemed to be withdrawn.

In summary, so long as the initial application is pending, divisional applications may be filed voluntarily or involuntarily, during any time between the filing date and closing date of the initial application. Furthermore, the applicant may also file divisional applications (based upon the initial application) after filing a request for reexamination or during the administrative lawsuit (if the applicant is dissatisfied with the reexamination decision).

