A Comparative Study on Chinese Conflicting Application System and Coping Strategies

Peng LV

Hongjie YUE

Yinhuan BAI

Chinese Patent Attorney

Mechanical Engineering Department

Abstract: A comparative study on Chinese conflicting application system and similar systems in the patent laws of Europe, Japan and the United States is conducted in this article. Based on the study, this article further discusses the difference between the Chinese conflicting application system and the conflicting application systems of other countries and proposes coping strategies for foreign applicants to avoid forming a conflicting application during a patent application in China.

Key words: conflicting application; Europe; Japan; the United States

Introduction

In light of the purpose of legislation, various countries around the world enact the patent laws for the same purpose. However, the patent laws of each country differ slightly according to the actual situation of the countries. Sometimes, whether an application for the same product is approved or rejected in different countries depends on these slight differences. Novelty is one importance standard for determining whether an applicant could be granted a patent right. In Chinese practice, conflicting application system plays a significant factor in the determination of novelty. In the following paragraphs, a comparative study on Chinese conflicting application system and similar systems in the patent laws of Europe, Japan and the United States is conducted. Based on the study, it is further

discussed the difference between the Chinese conflicting application system and the conflicting application systems of other countries.

I. Chinese conflicting application system and the conflicting application systems of other countries

1.1. Chinese conflicting application system

According to relevant regulations of the Chinese Patent Law and the *Guidelines for Patent Examination*, in general, if a prior patent or a prior patent application is to constitute a conflicting application, the following conditions will be satisfied:

(i) the prior patent or patent application is applied in China by any unit or individual;
(ii) the application date of the prior patent or patent application is prior to the application date of a subsequent application;
(iii) the publication date or issue date of the prior patent or prior application is the same date with the application date of the subsequent application or after the application date of the subsequent application.

In addition, with respect to a PCT application, the PCT application should have entered the Chinese national phase.

1.2. European system relating to conflicting application

The European Patent Convention (EPC) has substantially the same regulations on conflicting application with China.

Article 54.3 of EPC can be deemed as the prescription of "conflicting application". As compared with Chinese conflicting application, EPC prescribes in Article 54.3 that the prior art includes conflicting application. In contrast, the Chinese Patent Law prescribes in Article 22.5 that the prior art does not include conflicting application. Despite of the above different, EPC explicitly provides in Article 56 that

conflicting application is excluded from the factors affecting inventiveness while the Chinese Patent Law specifies in Article 22.3 that inventiveness is determined through comparison with the prior art, which also excludes conflicting application from the picture. Therefore, EPC and the Chinese Patent Law have substantially the same provisions.

In addition, according to the provisions of Articles 153.2 and 153.4 of EPC, a PCT application should have entered the European phase to constitute a conflicting application.

1.3. Conflicting application system of Japan

In the Japanese Patent Law, there is a system similar to the conflicting application system, which is, in Japanese, "拡大先願". However, this system has some differences from the Chinese conflicting application system.

Regarding condition (i) to be satisfied according to the Chinese conflicting application system, Japanese conflicting application system requires that the prior application has a different inventor from the present application, and that when the present application is filed, the prior application has a different applicant from the present application.

Regarding condition (ii) to be satisfied according to the Chinese conflicting application system, Japanese conflicting application system requires that the prior application is filed before the application date of the present application and is published or issued after the filing of the present application.

It should be noted that, in China, the conflicting application is "filed with the patent office before the application date and is published after the application date (including the application date)", with day as measurement of time, which is consistent with the other expressions of time in the Chinese Patent Law, the Implementation Regulations of the Chinese Patent Law and the *Guidelines for Patent Examination*, while in the Japanese Patent Law, the conflicting application is "published or issued after the filing of the present application", with moment at the measurement of time. Regarding this, the Patent and

Utility Model Examination Guidelines provides explicit explanation. Therefore, different from the provisions of the Chinese Patent Law, when determining a conflicting application according to the Japanese Patent Law, specific moment should be taken into account for the determination of the time of publication or issue of another application.

In addition, a PCT application should have entered the Japanese national phase to constitute a conflicting application in Japan.

1.4. American system relating to conflicting application

Actually, the Leahy-Smith America Invents Act (hereinafter referred to as AIA) does not include a specific conflicting application system. There is no such concept as "conflicting application" in the United States. AIA merely mentions in Article 102 (a) 2 a system that could be analogous to "conflicting application" in China.

Article 102 (a) 2 specifies a situation similar to "conflicting application" in China. Article 102 (a) prescribes in the subject "novelty; prior art". Thus, it could be deemed that AIA includes the case of conflicting application prescribed in Article 102 (a) 2 in the prior art.

In light of this, the concept of prior art according to AIA is substantially corresponding to a collection (with some exceptions) of the prior art and conflicting application (excluding self-collision) as prescribed in the Chinese Patent Law.

Further, AIA specifies inventive step in Article 103. However, only the prior art is cited for the assessment of inventive step in the United States. Therefore, the prior art specified by AIA could also be used for the assessment of inventive step. It is proper to say that regardless of novelty or inventive step, the assessment is made based on the prior art in the United States.

As shown above, according to AIA, an application corresponding to Chinese "conflicting application" is

applicable not only as a standard for determining novelty, but for the assessment of inventive step. In addition, a conflicting application in the United States shall not be an application filed by the same applicant or a patent application filed by others but not published.

Furthermore, the term "patent application" or "granted patent" in Article 102 (a) 2 of AIA indicates American patent, published American patent application and published PCT application designated to the United States. A foreign patent document cannot be used as the prior art specified by Article 102 (a) 2 of AIA. Herein, the PCT application designated to the United States could be a PCT application filed with a patent office other than the U.S. Patent Office. Therefore, different from Chinese practice, a PCT application that has not entered the national phase could also form a conflicting application in the United States.

1.5. Comparison of conflicting application systems of various countries

Table 1 shows a comparison of the conflicting application systems of China, Europe, Japan and the United States.

Compared item / Country or region	Whether conflicting application prejudices inventiveness	Whether the applicant and/or the inventor could be the same
China (Europe)	NO	YES
Japan	NO	NO
U.S.	YES	NO

In the above comparison, it should be noted that, as compared with Japan and the U.S., the main body of a conflicting application in China and Europe is "any unit or individual", which includes self-collision. Therefore, an applicant from Japan or the U.S. who wants to apply for a patent in China or in Europe would like to pay particular attention to prevent its own patent application from forming a conflicting application.

II. Reasons why the provisions on conflicting application is amended in 2008

The main body of conflicting application is amended from "other people" as "any unit or individual" in the third amendment to the Chinese Patent Law in 2008. The amendment intends to prevent double patenting to a more strict extent and to make it easier to determine whether double patenting is formed.

Specifically, according to the provisions before the amendment, to prevent double patenting of multiple applications of the same applicant, a comparison is required for the claims of the prior application and the subsequent application; while according to the provisions after the amendment is made, the comparison is conducted between the whole set of application document of the prior application and the claims of the subsequent application (i.e., the requirement of novelty).

According to the ideas put forward in the “Guide of the Third Amendment to the Chinese Patent Law” published by Department of Treaty and Law of the State Intellectual Property Office, the above two ways of assessment differ in the following two aspects: first, in terms of difficulty of the assessment, the requirement of novelty is specified in the patent laws of various countries throughout the world, and is thus easy to implement; second, in terms of the effect achieved regarding preventing double patenting, the requirement of novelty is, apparently, more strict, and thus functions well to prevent double patenting fundamentally.

III. Teachings of the Comparison for Applicants

3.1. On avoiding self-collision when filing an application in China

For an applicant from a country such as Japan and the U.S. where there is no such concept as conflicting application, it would be better to realize that China implements self-collision as soon as possible in the stage of preparing a patent application to be filed in China. To avoid self-collision, it would be better that correlated patent applications are filed on the same date (if a priority right is claimed, the application is a priority application, hereinafter referred to as the first application).

However, it would be difficult for a Japanese or American applicant to ensure that correlated patent

applications are filed on the same date with the first application. In such cases, the applicant would want to pay particular attention to avoid self-collision in China. The situation is described with reference to an example in the following paragraphs.

Example description: an application X claiming an invention A and an application Y claiming an invention B are two applications filed on the same application date by the same applicant (applications filed by an American or Japanese applicant with the U.S. Patent Office or the Japan Patent Office, both being a first application); in light of the contents, the application X satisfies the conditions of forming a conflicting application against the application Y; it is assumed that the publication date of the application X is one year later than the application date of the application Y.

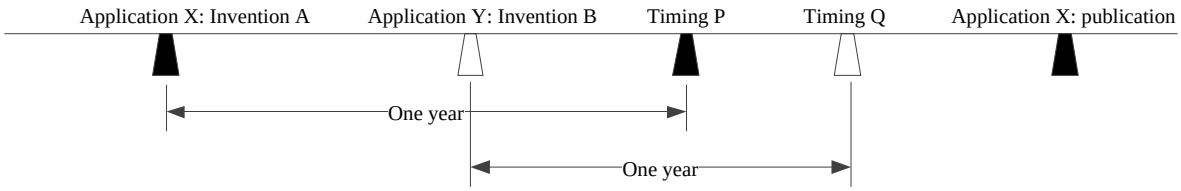

Fig. 1 situation of each application

In order to avoid self-collision in China, the American or Japanese applicant may employ different prevention options according to each stage of the application (taking non-PCT application as an example):

i. At the stage where the application X is filed while the application Y is not yet filed

The applicant may consider taking the initiative to withdraw the application X and then filing an application X' including the invention A on the same date when the application Y is due to be filed, or filing an application Z including both of the invention A and the invention B and then filing in China under the Paris Convention two application C1 and C2 claiming the priority right of the applications X' and Y or an application C3 claiming the priority right of the application Z.

Thereby, the priority dates of the invention A and the invention B included in the applications C1 and C2 or C3 filed in China are the same, which completely avoids self-collision. However, in this option, the application date of the invention A will be postponed.

ii. At the stage after the application Y is filed and prior to the timing P (including the timing P, i.e., the expiry date of the priority right of the application X)

The applicant may consider filing in China an application C4 claiming the priority rights of the applications X and Y under the Paris Convention. In this way, the invention A and the invention B are included in a single application C4 entering China.

This method can substantially avoid self-collision without changing the application date of the application X. Yet there may still have a possibility of self-collision in a particular case as analyzed in the follows.

If the inventions A and B are closely correlated, generally there will not be a defect in unity. Thus, when the inventions A and B are disclosed in the same Chinese patent application C4, the problem of self-collision does not arise. However, if, after a search, the examiner finds out that the correlated technical feature of the inventions A and B is disclosed by a prior art, the defect in unity will be pointed out. In this case, when the method of filing a divisional application is employed to overcome the defect in unity, if the invention B based on the priority of Y is split to form a divisional application, the parental application remaining the invention A based on the priority of X may form a conflicting application against the divisional application.

iii. At the stage after the timing P (excluding the timing P, i.e., the expiry date of the priority right of the application X) and prior to the timing Q (including the timing Q, i.e., the expiry date of the priority right of the application Y)

The applicant may consider filing in China an application C5 including both of the inventions A and B

under the Paris Convention, claiming the priority right of the application Y. In this way, the inventions A and B are included in the same application C5 entering China.

In this option, the priority right of the invention A is not claimed while the priority right of the invention B is claimed. Therefore, there is a problem similar to prevention option ii.

④ At the stage after the timing Q (excluding the timing Q, i.e., the expiry date of the priority right of the application Y) and prior to the publication date of the application X

The applicant may consider filing in China an application C6 including the inventions A and B, without claiming any priority right.

The advantage is that conflicting application is completely avoided. However, the application date of the inventions A and B will be postponed.

3.2. Coping Methods in Case That the Chinese Examiner Points Out Self-Collision

With reference to the above example, if the applicant did not take prevention measures and files in China an application CX claiming the priority right of the application X and an application CY claiming the priority right of the application Y under the Paris Convention, at receipt of a notification issued by the examiner on self-collision, the applicant could respond as follows.

Option 1: amending the claims of the application CY so that the application CY possess novelty over the application CX

Option 1 is applicable only when the application X contains few disclosures involving the invention B. If the application X discloses details of the invention B, it will be less possible to bring novelty to the application CY by amending the claims of the application X; that is, Option 1 could be ineffective.

Option 2: where Option 1 is not applicable, which is when the application X discloses details of the

invention B, and it comes to a period when a divisional application can be filed based on the application CX or amendments can be made to the application CX on the applicant's own initiative, the applicant may file a divisional application DX based on the application CX or file a request of amendment to the application CX on the applicant's own initiative to protect the invention B.

It should be noted that no matter the applicant files a divisional application or takes the initiative to amend the application document, the examiner will perform a strict review on the amendments to make sure that the amendments do not go beyond the scope. Therefore, the result of Option 2 may not be good.

Therefore, there may be a problem in the practice which neither of Option 1 and Option 2 can cope with, for example:

Assuming that application X discloses a subordinate concept of the invention B and that the application Y intends to protect a superordinate concept of the invention B, in this case, Option 1 cannot be employed, which is to amend the claims of the application CY to bring novelty to the application; nor can Option 2 be applied, which is to have the superordinate concept of the invention B to be granted a patent right in the application CX or the divisional application DX thereof (due to the problem of amendments going beyond the scope). Eventually, the application could only abandon the invention B or obtain a patent right of the subordinate concept of the invention B, which is obviously disadvantageous for the applicant. Therefore, it is recommended that the applicant takes prevention measures described in the preceding paragraphs to avoid self-collision.