

Provisions Concerning Implementation of Patent Cooperation Treaty in China

Chapter 1 General Provisions

Rule 1 These Provisions are formulated to implement the Provisions of the Patent Cooperation Treaty.

Rule 2 In these Provisions,

(1) "PCT" means the Patent Cooperation Treaty;

(2) "Regulations" means the Regulations under the Patent Cooperation Treaty;

(3) "Administrative Instructions" means the Administrative Instructions under the Patent Cooperation Treaty;

(4) "International Bureau" means the International Bureau of the World Intellectual Property Organization;

(5) "International application" means an international application for a Patent for invention or utility model filed under the PCT.

(6) "Patent Office" means the Chinese Patent Office;

(7) "Patent Law" means the Patent Law of the People's Republic of China;

(8) "Implementing Regulations" means the Implementing Regulation of the Patent Law of the Peoples' Republic of China.

(9) for the purposes of computing time limits, where the international application contains a priority claim, "priority date" means the filing date of the application whose priority is so claimed; where the international application contains several priority claims, the filing date of the earliest application whose priority is so claimed; or where the international application does not contain any priority claim, the international filing date of such international application.

Rule 3 The provisions of the PCT, the Regulations, the Administrative Instructions and these Provisions shall apply to the international application filed with the Patent Office or designating or electing China. The provisions of the Patent Law and the Implementing Regulations shall apply to the international application once the procedure has started before the Patent Office as the designated office or the elected Office, unless the PCT, the Regulations, the Administrative Instructions or these Provisions provide otherwise.

Chapter 2 Procedure Concerning Filing of the International Application

Rule 4 The Patent Office acting as a receiving Office shall receive the international application filed by any Chinese national or any foreigner, foreign enterprise or other foreign organization having habitual residence or business office in China, and shall check and process such international application in accordance with the provisions of the PCT, the Regulations and the Administrative Instructions.

In accordance with any agreement concluded between China and another Contracting State of the PCT, the Patent Office may also receive international applications filed by any national or resident of the said Contracting State.

Rule 5. The international application shall be filed with the Patent Office in Chinese or English- The international application shall contain a request, a description, one or more claims, one or more drawings where required, and an abstract.

Rule 6. The Patent Office shall accord as the international filing date the date of receipt of the international application filed in accordance with PCT Article 11(1).The second sentence of Article 28 of the Patent Law shall not apply to the determination of the international filing date.

Where it is found that the international application did not fulfill the requirements listed in PCT Article 11 (1), the Patent office shall invite the applicant to file the required correction within the time limit fixed by the Patent office under PCT Rule 20.6. If the correction is filed as required, the Patent Office shall accord as the international filing date the date of receipt of the required correction. If the Patent Office does not, within the time limit, receive a reply to its invitation, or if the correction offered by the applicant still does not fulfill the requirements provided for under PCT Article 11 (1), it shall Promptly notify the applicant that his application Will no be treated as an international application.

If the international application refers to drawings which, in fact, are not included in that application, the Patent Office shall notify the applicant accordingly and he nay furnish them within 30 days from the date on which the incomplete papers were filed. If the drawings are so furnished, the international filing date shall be the date on which the drawings are received by the Patent Office; otherwise, any reference to the said drawings shall be considered non-existent.

Rule 7 When filing an international application with the Patent Office, the applicant may, as provided for in PCT Article 8, claim the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property. Where such priority is claimed, the Provisions of PCT Rules 4.10 and 17.1 shall apply in so far as the formalities in relation to such priority claims are concerned.

Rule 8 If the Patent Office finds in the international application any of the defects referred to in PCT Article 14(1)(a), it shall invite the applicant to correct the international application as provided for in PCT Rule 26, failing which the international application shall be considered withdrawn and the Patent Office shall so declare.

Chapter 3 Procedure Concerning International Search

Rule 9 The Patent office acting as an International Searching Authority shall carry out international search in respect of international applications in accordance with the provisions of the PCT, the Regulations, the Administrative Instructions, and the agreement concluded under PCT Article 16 (3) between the Patent Office and the International Bureau.

If the Patent Office considers

(i) that the international application relates to situations or to a subject matter which the Patent Office is not required, under PCT Rule 13ter.1(c) or 39, to search, and in the particular case decides not to search, or

(ii) that the description, the claims, or the drawings, fail to comply with the requirements of the Regulations to such an extent that a meaningful search could not be carried out, it shall so declare and shall notify the applicant and the International Bureau that no international search report will be established. If any of the situations referred to in (i) or (ii) mentioned above is found to exist in connection with certain claims only, the international search report shall so indicate in respect of such claims, whereas, for the other claims, the said report shall be established.

If the Patent Office considers that the international application does not comply with the requirement of unity of invention as set forth in PCT Rule 13, it shall invite the applicant to pay additional fees, as provided for in PCT Rule 40. The Patent Office shall establish the international search report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention") and, Provided the required additional fees have been paid within the time limit provided for in PCT Rule 40.3, on those parts of the international application which relate to inventions in respect of which the said fees were paid.

Rule 10 The Patent Office shall, within 3 months from the receipt of the search copy of the international application or within 9 months from the priority date, whichever time limit expires later, establish the international search report or make a declaration to the effect that no international search will be carried out.

Rule 11 The applicant has one opportunity to file with the International Bureau amendments to the claims of the international application under PCT, Article 19, as provided for in PCT Rule 46. Such amendments shall be filed within 2 months from the date of transmittal of the international search report to the International Bureau and to the applicant by the Patent Office, or within 16 months from the priority date, whichever time limit expires later. However, any amendment made under PCT Article 19 which is received by the International Bureau after the expiration of the applicable time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed. Such amendments shall not go beyond the disclosure in the international application as filed.

Chapter 4 Procedure Concerning International Preliminary Examination

Rule 12 Any applicant whose international application has been filed with the Patent Office, and any person who is referred to in the agreement concluded between the Patent Office and the International Bureau for the purposes of international Preliminary examination, may file with the Patent Office a demand for international preliminary examination.

The demand for international preliminary examination shall be made in written form, in the language in which the international application was published, and shall be in conformity with the Provisions of PCT Rule 53.

The demand for international preliminary examination shall indicate at least one Contracting State bound by Chapter II of the PCT in which the applicant intends to use the results of the international Preliminary examination. The election shall relate only to Contracting States already designated in the international application.

Rule 13 The Patent Office acting as International Preliminary Examining Authority shall carry out international preliminary examination in respect of international applications in accordance with the PCT, the Regulations, the Administrative Instructions and the agreement concluded between the Patent office and the International Bureau under the PCT Article 32.

If the Patent office considers

(i) that the international application relates to situations or to a subject matter on which the Patent office is not required, under PCT Rule 66.2(a)(Vi) or (vii) or 67, to carry out an international preliminary examination, and in the Particular case decides not to carry out such examination, or

(iii) that the description, the claims, or the drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the novelty, inventive step (non-obviousness), or industrial applicability, of the claimed invention, it shall not go into the questions referred to in PCT Article 33(1) and shall inform the applicant of this opinion had the reasons therefore. If any of the situations referred to in (i) or (ii) mentioned above is found to exist in, or in connection with, certain claims only, the Provisions of the previous sentence shall apply only to the said claims.

If the Patent office considers that any of the situations referred to in PCT Rule 66.2(a) exists in an international application, it shall notify the applicant in writing and shall invite the applicant to submit a written reply. The applicant may respond to the invitation by making amendments or if he disagrees with the opinion of the Patent Office by submitting arguments, as the case may be, or do both. Such amendments shall not go beyond the disclosure in the international application as filed.

Where the Patent Office finds that an international application does not comply with the requirement of unity of invention as provided for in PCT Rule 13, it shall proceed in accordance with PCT Article 34(3) and PCT Rule 68. The applicant may choose, at his own option, to restrict the claims or to pay additional fees. If the applicant fails to make the choice within the specified time limit, or if the applicant restricts the claims but not sufficiently to comply with the requirement of unity of invention, or if the applicant pays additional fees but not sufficient to cover all additional inventions, the Patent Office shall establish an international preliminary examination report on those parts of the international application which relate to what appears to be the main invention or to any additional inventions for which additional fees have been paid.

Rule 14 The applicant may, at the time when the demand for international preliminary examination is filed or before the international preliminary examination reports established, submit amendments to the Patent Office in respect of the claims, the description, and the drawings under PCT Article 34, as provided for in PCT Rule 66. Such amendments shall not go beyond the disclosure in the international application as filed.

Rule 15 The time limit for establishing the international preliminary examination report shall be:

(i) 28 months from the priority date, if the demand for international preliminary examination was received by the Patent Office prior to the expiration of 19 months from the priority date;

(ii) 9 months from the start of the international preliminary examination, if the demand for international preliminary examination was received by the Patent Office after the expiration of 19 months from the Priority date.

Chapter 5 Procedure Concerning Designation and Election

Rule 16 An international application designating China shall, as of the international filing date accorded under PCT Article 11(1), have the effect of a Chinese national application for patent filed with the Patent Office on the same date.

Rule 17 Where the applicant of an international application designating China intends to seek the grant of a patent for utility model by the Patent Office, he shall so indicate in the request of his international application.'

Rule 18 Where the international publication of an international application for a patent for invention designating China is effected by the International Bureau in accordance with PCT Article 21 in Chinese, the applicant shall have the right provided for in Article 13 of the Patent Law from the date of the international publication; where the international publication is effected in a language other than Chinese, the applicant shall have the right provided for in Article 13 of the Patent Law from the date of the publication in the Chinese Patent Gazette of a translation into Chinese of the international application submitted by the applicant to the Patent Office.

Rule 19 Subject to Rule 20 of these Provisions, for an international application designating China which was filed in a language other than Chinese, the applicant shall furnish the Chinese translation of the international application to the Patent Office not later than the expiration of 20 months from the Priority date. If the Chinese translation was not furnished within the applicable time limit the effect of the international application in China shall cease.

Rule 20 Where the applicant of an international application has elected China prior to the expiration of 19 months from the Priority date, if that application was filed in a language other than Chinese, he shall furnish the Chinese translation of the international

application to the Patent Office not later than the expiration of 30 months from the Priority date. If the Chinese translation was not furnished within the applicable time limit, the effect of the international application in China shall cease.

Rule 21 The translation of the international application submitted by the applicant under Rule 19 or 20 of these provisions shall include the request, the description, the claims, any text matter of the drawings on a copy of the drawing and the abstract, all in two copies. Where amendments have been made to the claims in accordance with PCT Article 19, the translation shall also contain the amended claims and any statement made under that Article; where amendments have been made to the international application in accordance With PCT Article 34, the translation shall also contain any amendment annexed to the international preliminary examination report.

Where the applicant, while furnishing a translation of the international application referred to in the previous paragraph, fails to furnish, in respect of the amendments, a translation both as originally filed and as amended, the Patent Office shall invite the applicant to furnish the missing translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. Where the applicant fails to comply with the invitation to furnish the missing translation of the international application as originally filed, the international application shall be considered withdrawn. Where the applicant fails to comply with the invitation to furnish the missing translation of amendments, the amendments shall be disregarded.

Where the applicant furnishes only one copy of the translation, the Patent Office shall invite the applicant to furnish another copy within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. Where the applicant fails to comply with the invitation, the international application shall be considered withdrawn.

Where the applicant does not furnish a translation of any statement made under PCT Article 19, such statement shall be disregarded.

Rule 22 Where the international application has designated China, the applicant may submit to the Patent Office amendments to the claims, the description and the drawings within one month from the performance of the acts under Rule 19 of these Provisions, provided that, if the communication under PCT Rule 47.1 has not been effected by the expiration of the time limit applicable under Rule 19 of these Provisions, the applicant may submit such amendments within 4 months from the expiration of that time limit. Such amendments shall not go beyond the disclosure in the international application as filed.

Rule 23 Where the international application elects China prior to the expiration of 19 months from the Priority date, the applicant may submit to the Patent Office amendments to the claims, the description and the drawings within one month from the performance of the acts under Rule 20 of these provisions, provided that, if the transmittal of the international preliminary examination report has not taken place by the expiration of the time limit as Provided for in Rule 20 of these Provisions, the applicant may submit such

amendments within 4 months from the expiration of that time limit. Such amendments shall not go beyond the disclosure in the international application as filed.

Rule 24 Where some parts of an international application designating or electing China have not been searched or subjected to international preliminary examination because of lack of compliance with the requirements of unity of invention, the applicant shall pay a special fee as provided for in PCT Article 17(3)(b) or 34(3)(b) within the time limit fixed by the Patent Office. If the fee is not paid or not paid in full within the said time limit, those parts of the international application relating to inventions which have not been searched or subjected to international preliminary examination shall be considered withdrawn.

Rule 25 Where, in accordance with the Patent Law and the Implementing Regulations, any documents and evidence under PCT Article 27(2) and (6) are required to be furnished to the Patent Office in respect of an international application designating or electing China, those documents and evidence shall be furnished before the expiration of the applicable time limit provided for in Rule 19 or 20 of these Provisions, failing which, the Patent Office shall invite the applicant to furnish them within the time limit specified in the invitation.

Rule 26 Where the international application designates China and claims the Priority of one or more earlier applications filed under the Patent Law, the provisions of Rule 33 of the Implementing Regulations shall apply.

Chapter 6 Fees

Rule 27 In the international phase of an international application, the applicant shall be subject to the payment of the following fees as provided for in the Regulations:

- (1) the transmittal fee;
- (2) the international fee, including the basic fee and the designation fees;
- (3) the search fee and the additional search fee;
- (4) the handling fee;
- (5) the Preliminary examination fee and the additional preliminary examination fee;
- (6) the confirmation fee;
- (7) the late payment fee;
- (8) any other fees as provided for in the Regulations.

The amounts of the fees mentioned in the preceding paragraph, the currencies in which they are Payable and the Permitted methods of payment shall be published by the Patent Office.

Rule 28 The applicant shall, within the time limit of one month from the date of receipt of the international application by the Patent Office, Pay the transmittal fee, the basic fee and the search fee. If the said fees are not paid or not paid in full within the time limit, the Patent Office shall invite the applicant to Pay within one month from the date of the

invitation, the missing fees and the late payment fee, failing which the international application shall be considered withdrawn.

The applicant shall, within the time limit of one year from the priority date or one month from the date of receipt of the international application by the Patent Office, whichever expires later, pay the designation fee. If the said fee is not Paid or not paid in full within the applicable time limit, the Patent Office shall invite the applicant to pay, Within one month from the date of the invitation, the missing fees and the late payment fee, failing which the designations concerned or, if no designation fee has been paid, the international application shall be considered withdrawn.

Where a designation is confirmed under PCT Rule 4, 9(c), the applicant shall pay the designation fee and the confirmation fee before the expiration of 15 months from the priority date.

The applicant shall pay the handling fee and the Preliminary examination fee when filing the demand for international preliminary examination with the Patent Office. If the said fees are not paid or not paid in full, the Patent Office shall invite the applicant to pay the missing fees within one month from the date of the invitation, failing which the demand shall be considered as if it had not been submitted.

Where the international application does not comply with the requirements of unity of invention, the applicant shall pay the additional search fee and the additional preliminary examination fee within the time fixed by the Patent Office under PCT Rule 40.3 or 68.2.

Rule 29 Where an international application designates or elects China, the applicant shall, within the time limit applicable under Rule 19 or 20 of these provisions, Pay the application fee. If the fee is not paid or no paid in full within the applicable time limit, the effect of an international application in China shall cease.

If, in respect of the international application designating or electing China, the right of Priority is claimed, the applicant shall, within the time limit applicable under Rule 19 or 20 of these Provisions, pay the fee for claiming priority. If the fee is not Paid or not paid in full within the applicable time limit, the Patent Office shall invite the applicant to Pay the missing fees within the time fixed in the invitation, failing which, the priority claim shall be considered not to have been made.

Rule 30 Where an international application designating or electing China applies for the grant of a patent for invention, the applicant shall Pay a fee for the maintenance of the application for the third year before the expiration of 25 months from the filing date of the international application.

If the time limit specified in the previous paragraph expires earlier than the time limit applicable under Rule 20 of these Provisions, the applicant shall pay the fee for the maintenance of the application for the third year before the expiration of the time limit prescribed in Rule 20 of these Provisions. If the maintenance fee is not paid or not Paid

in full, the Patent Office shall invite the applicant to Pay it Within the time limit of 6 months from the expiration of the time limit due for the Payment of the maintenance fee, and at the same time pay a surcharge Which amounts to 25% the of the maintenance fee.

Rule 31 For an international application designating or electing China, after the acts specified in Rule 19 or 20 of these Provisions have been performed, and the fees specified in the first paragraph of Rule 29 of these Provisions have been paid, unless otherwise Provided for in Rules 29 and 30 of these Provisions, the applicant shall pay the other fees in accordance with the provisions of the Patent Law and the Implementing Regulations.

Chapter 7 Other Provisions

Rule 32 For the filing of an international application With the Patent Office, for the procedure before the Patent Office as the International Searching Authority or as the International Preliminary Examining Authority and as the designated Office or the elected Office as well as other matters related to the international application, the applicant shall appoint a patent agency designated by the Patent Office to act as his agent.

Rule 33 Any Chinese entity or individual intending to file an international application shall obtain the approval of the competent department concerned of the State Council.

Any Chinese entity or individual intending to file an international application may first file a national application with the Patent Office and. within 12 months from the filing date, file an international application designating or electing any other State party to the PCT, or file with the Patent Office directly an international application designating or electing China and any other State party to the PCT.

Rule 34 Where the receiving Office has refused to accord an international filing date or has declared that the international application is considered withdrawn, or where the International Bureau has made a finding under PCT Article 12(3), the applicant may, after having performed the acts specified in Rule 19 or 20 of these Provisions, and having paid the fees specified in the first paragraph of Rule 29 Of these Provisions, in accordance with PCT Article 25(2)(a), request the Patent Office to decide whether that refusal, declaration or finding was justified under the Provisions of the PCT and the Regulations. If the Patent Office finds that the refusal or declaration was the result of an error or omission on the Part of the receiving Office, or that the finding was the result of an error or omission on the part of the International Bureau, the international application shall be treated for the purpose of these Provisions as if such error or omission had not occurred.

Rule 35 Where the effect of an international application designating or electing China ceases in China for having not performed the acts specified in Rule 19 or 20 of these Provisions and having not paid the fees specified in the first paragraph of Rule 29 Of these Provisions, the applicant may request for the restoration of right within two months from the expiration Of the applicable time limit under Rule 19 or 20 of these Provisions.

When the applicant requests for the restoration of right, he shall pay the restoration fee and, at the same time, perform the acts specified the Rules mentioned above.

Unless these Provisions provide otherwise, after the acts have been performed in accordance with Rule 19 or 20 of these Provisions and the fees paid in accordance with the first paragraph of Rule 29 Of these Provisions, in respect of an international application designating or electing China, if because of force majeure or other justified reason, the time prescribed in the Patent Law or the Implementing Regulations or specified by the Patent Office, is not observed, resulting in the loss of any right, the Provisions of Rule 7 of the Implementing Regulations shall apply.

Rule 36 Where an international application designating or electing China concerns a new microorganism, a microbiological process or a product thereof and involves the use of a microorganism which is no available to the public, the applicant shall' at the latest, deposit on the filing date of the international application a sample Of the microorganism with a depositary institution designated by the Patent Offibe or with any depositary institution who has acquired the status of "international depositary authorities" in accordance with the "Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure". In the latter case, the applicant shall deposit a sarnple of the microorganism with the depositary institution designated by the Patent Office before the expiration of the time limit referred to in Rule 19 or 20 of these Provisions.

When the sample Of the micro-organism is deposited with a depositary institution designated by the Patent Office in accordance with the provisions of the Previous paragraph, the applicant shall furnish a receipt of deposit and the viability proof from the depositary institution within three months from the expiration of the applicable time limit under Rule 19 or 20 of these Provisions, failing which, the sample of the micro-organism shall be considered not to have been deposited.

Rule 37 The Chinese Patent Office shall be responsible for interpreting these Provisions.

Rule 38 These Provisions shall enter into force on January 1, 1994.