Multi-jurisdictional Patent Prosecution (US v. China)

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OUTLINE

- What is a patent?
- Types of patents in US v. China
- USPTO practice
  - US Patent and Trademark Office
- Chinese Patent Office practice
  - National Intellectual Property Administration
- PCT (Patent Cooperation Treaty)
- Patent strategy for business
WHAT IS A PATENT?

- A patent does **not** provide the right to make, use, or sell an invention.
- A patent provides the right to **exclude others** from making, using, selling, offering for sale, or importing the patented invention for the term of the patent.
- Patent right is regional!
US PATENT

- Title
- Specification
- Claims
- Drawings
- Abstract

CHINESE PATENT
# PATENT TYPE & TERM OF PROTECTION

<table>
<thead>
<tr>
<th>Patent Type</th>
<th>US</th>
<th>Patent Type</th>
<th>China</th>
</tr>
</thead>
<tbody>
<tr>
<td>Patent Term (years)</td>
<td></td>
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<td></td>
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<tr>
<td>Utility patents</td>
<td>20</td>
<td>Invention patents</td>
<td>20</td>
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<tr>
<td>Design patents</td>
<td>15</td>
<td>Utility model patents</td>
<td>10</td>
</tr>
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<td>Plant patents</td>
<td>20</td>
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</table>
USPTO PRACTICE

- Provisional v. Non-provisional
- Patent “prosecution” (examination)
  - Office Action: restriction requirement, non-final, final; Advisory Action
  - Subject matter eligibility (101); written description, enablement, indefiniteness (112); anticipation (102); obviousness (103)

- Resources:
  - Patent Tools & Links [https://www.uspto.gov/patent](https://www.uspto.gov/patent)
  - Search for patents [https://www.uspto.gov/patents-application-process/search-patents](https://www.uspto.gov/patents-application-process/search-patents)
  - Patent Application Information Retrieval (PAIR)
    - Public Pair [https://portal.uspto.gov/pair/PublicPair](https://portal.uspto.gov/pair/PublicPair)
    - Global Dossier [https://globaldossier.uspto.gov/#/]

- Examiner’s interview
CHINESE PATENT OFFICE PRACTICE

- Invention v. Utility model
- Patent “prosecution” (examination)
  - written description/clarity; novelty; inventive step
- Resources
  - Global Dossier https://globaldossier.uspto.gov/#/
  - Google patents https://patents.google.com/
- Examiner’s interview
PATENT COOPERATION TREATY/PCT

- There is **NO** international patent.

File PCT
- PCT application filed in China/US.
- That is your international filing date

Publication after 18 months
- Can argue (not necessary) to get a final International Preliminary Examination Report IPER

Completion
- 30 months in most countries
- Pursue national applications under national rules
PATENT STRATEGY FOR BUSINESS

- Multi-jurisdiction
  - PCT
  - Paris Convention
- Timing
  - First public disclosure
  - Target markets
- Patent type
  - US: Provisional v. Non-provisional
  - China: Invention v. Utility model

Start the conversation with your patent attorney early!