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China Intellectual Property

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China finally amends its Patent Law – Part 2: Design

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Did you know?

China's new patent law, which comes into effect on 1 June 2021, will significantly change the design patent regime and will see the introduction of **partial design protection, the extension of the design patent term** from 10 years to 15 years and the **acceptance of domestic Chinese design patent filings as a basis for priority**.

Why does this matter to you?

The introduction of partial design protection is one of the most significant changes to the design system since the establishment of China's Patent Law and will have a huge impact on China's design practice from both filing/prosecution and enforcement/litigation perspectives.

Under the old patent law, a design patent can only protect the appearance of an entire product that can be sold or used separately. As a partial design relates to a part of an entire product and, thus, cannot be sold or used separately, a partial design previously could not be registered as a design patent in China. A design patent relating to a part could only be obtained for the entire product, incorporating the part, despite the fact that the other constituent parts of the entire product were merely of conventional design with no unique or novel design features.

A consequence of this approach is that the protective scope of such a patent is unduly narrow due to inclusion of the other conventional design features alongside the unique part. This means that the patent can be readily designed around by simply replacing the conventional features with alternative common design features whilst still including the unique design features.

This practice has long been criticised, especially by fast developing industries that have been unable to adequately protect their intellectual property.

As of **1 June 2021**, it will be possible to file and register design patents directed to the unique partial design features. For the first time in China it will be possible for designers to protect original, innovative partial designs without unduly restricting the protective scope to the entire product. Full details of the partial design regime have not yet been announced, but tailor-made examination and enforcement rules are expected, in view of the numerous unique characteristics of partial designs.

And don't forget

The maximum term of a design patent, which is currently 10 years, will be extended to 15 years to tie in with China's planned accession to The Hague Agreement Concerning the International Registration of Industrial Designs.

Domestic first design filings will also qualify as a basis to claim priority for subsequent Chinese design filings. This will provide more flexibility to intellectual property owners to adjust their design filing, prosecution and protection plan by strategically combining domestic priority, with the enhanced partial design regime and multiple design mechanism, after the first filings.

We expect that this new design system will not only greatly increase the number of design filings but, given the enhanced scope of partial design protection, also stimulate an increase in civil infringement lawsuits and administrative enforcement cases which could result in more patent invalidation cases.

Want to know more?

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