

Provisions on Foreign Applicant in the Guidelines for Patent Examination

Presenting Evidence in a Foreign Language

Where the party concerned submits a piece of evidence in a foreign language, he shall also submit the Chinese translation thereof. If he fails to submit the Chinese translation for the evidence within the time limit, the foreign language evidence shall be deemed not to have been submitted. The party concerned shall submit the Chinese translation in written form. If he fails to submit the Chinese translation in written form, said Chinese translation shall be deemed not to have been submitted. The party concerned may submit the Chinese translation only for part of the foreign language evidence. Other parts of the foreign language evidence without Chinese translation being submitted shall not be taken as evidence, unless the Chinese translation for the other parts are subsequently submitted at the demand of the Patent Reexamination Board.

If the opposite party has objection to the contents of the Chinese translation, he shall submit the Chinese translation for the disputed parts within a specified time limit. Failure to submit the Chinese translation shall be deemed as having no objection to the translation.

Where there is a dispute over the Chinese translation, if the both parties have reached an agreement as to the translation, the agreed translation shall be used; if the both parties cannot reach an agreement as to the translation, the Patent Reexamination Board may entrust a translator to translate if necessary. Where the both parties have reached an agreement on the translator, the Patent Reexamination Board may entrust the translator as agreed on by the both parties to translate, for the full text, the part to be used, or the part in dispute. Where the both parties cannot reach an agreement on the translator,

the Patent Reexamination Board may entrust *ex officio* a professional translation agency to translate. The both parties shall respectively bear 50% of the translation fee for the entrusted translation. The party refusing to pay the translation fee shall be deemed to acknowledge that the Chinese translation submitted by the other party is correct.

Verification Formalities for Evidence Formed Abroad or in Hong Kong, Macao, or Taiwan

Evidence formed abroad means the evidence formed beyond the territory of the People's Republic of China. The evidence shall be notarized by the notary organs in the country concerned and verified by the Chinese Embassy or Consulate to the country, or shall be subject to any verification formalities provided in a treaty between China and the country.

For evidence formed in Hong Kong, Macao or Taiwan, the relevant verification formalities shall also be gone through. However, in any of the following circumstances, the party concerned may not go through the relevant verification formalities in the invalidation procedure for the two kinds of evidence mentioned above:

- (1) the evidence can be obtained via domestic public channels (Hong Kong, Macao and Taiwan excluded), e.g. , foreign patent documents obtained from the Patent Office, or foreign literature obtained from a public library;
- (2) the authenticity of the evidence can be sufficiently supported by other evidence; or
- (3) the authenticity of the evidence is acknowledged by the opposite party.

Formalities Regarding Appointment of Representation in Requests for Reexamination

(1) As regards the appointment, dissolution or resignation of appointment in the reexamination procedure, formalities shall be settled before the Patent Office according to the provisions of Chapter 1, Section 61 of Part I. However, if the petitioner appoints a patent agency in the reexamination procedure and indicates in the power of attorney that the scope of the power entrusted is limited to matters provided in Chapter 2 of Part IV in the reexamination procedure, the formalities concerning the appointment, dissolution or resignation of appointment shall be settled before the Patent Reexamination Board and the above provisions shall apply *mutatis mutandis*, without the need to change the bibliographic data. Where the petitioner goes through the formalities concerning the appointment of a patent agency before the Patent Reexamination Board and fails to indicate in the power of attorney that the scope of the power entrusted is limited to matters in the reexamination procedure, a rectification shall be made within the specified time limit; otherwise, the appointment shall be deemed not to have been made.

(2) Where the petitioner has appointed more than one patent agency at the same time, he shall designate in written form one of the agencies as the contact person. If no agency is designated, the Patent Reexamination Board will take the agency entrusted first in the reexamination procedure as the contact person; where more than one agency was entrusted first, the Patent Reexamination Board will take the agency in the first name order as the contact person; where there is no name order (separately entrusted on the same day), the Patent Reexamination Board shall notify the petitioner to designate within a specified time limit, and if no designation is made within the time limit, the appointment shall be deemed not to have been made.

(3) Where according to Article 19.1 the petitioner shall appoint a patent agency, if he fails to appoint any agency, the request for reexamination shall not be accepted.

Formalities Regarding Appointment of Representation in Requests for Invalidation

(1) Where, during the invalidation procedure, the petitioner or the patentee appoints a patent agency, he must submit the power of attorney for invalidation procedure, and the patentee shall indicate in the power of attorney that the scope of the power entrusted is limited to matters in the invalidation procedure. In invalidation procedure, even if the patentee has appointed an agency for the whole term of the patent and continues to appoint the same one, he must also submit the power of attorney for invalidation procedure.

(2) Where, during the invalidation procedure, the petitioner or the patentee appoints a patent agency, and indicates in the power of the attorney that the scope of the power entrusted is limited to matters in the invalidation procedure, the formalities concerning appointment, dissolution and resignation of appointment shall be settled before the Patent Reexamination Board, without the need to change the bibliographic data. Where the petitioner or the patentee appoints a patent agency and fails to submit the power of attorney to the Patent Reexamination Board or the scope of the power entrusted is not indicated in the power of attorney, or the patentee fails to indicate in the power of attorney the scope of the power entrusted is limited to matters in the invalidation procedure, the Patent Reexamination Board shall notify the petitioner or the patentee to make rectifications within a specified time limit. If no rectification is made within the time limit, the appointment shall be deemed not to have been made.

(3) Where the petitioner and the patentee have appointed the same patent agency, the Patent Reexamination Board shall notify the both parties to change their appointments within a specified time limit. If no change of appointment is made within the specified time limit, the later appointment shall be deemed not have been made; if the both appointments were made on the same date, both of them shall be deemed not to have been made (Rule 66.1).

(4) Where the petitioner shall appoint a patent agency according to Article 19.1, but fails to meet this requirement, the request for invalidation shall not be accepted.

(5) Where the petitioner has appointed more than one patent agency at the same time, he shall designate in written form one of the agencies as the contact person. If no agency was designated, the Patent Reexamination Board will take the agency entrusted first in the invalidation procedure as the contact person; where more than one agency was entrusted first, the Patent Reexamination Board will take the agency in the first name order as the contact person; where there was no made order (separately entrusted on the same day), the Patent Reexamination Board shall notify the petitioner to designate within a specified time limit, and if no designation is made within the time limit, the appointment shall be deemed not to have been made.

(6) Where a party intends to appoint a citizen as his representative, the provisions governing the appointment of a patent agency shall apply *mutatis mutandis*. The scope of power for a citizen representative shall be limited to making observations and receiving documents in oral proceedings.

(7) The agent is required to submit a specially authorized power of attorney where:

(i) the agent of the patentee admits the petitioner's request for invalidation;

(ii) the agent of the patentee amends the claims of the patent;

(iii) the agents reach a settlement;

(iv) the agent of the petitioner withdraws the request for invalidation.

(8) For other matters not described in the above, Chapter 1, Section 6.1 of Part I of these Guidelines shall apply *mutatis mutandis*.

Acceptance or Nonacceptance of Patent Application

Requirements for Acceptance

(4) Where the applicant is a foreigner, foreign enterprise or other foreign organization, the application shall be in conformity with the provisions of Article 19.1, and the country to which the applicant belongs shall be in conformity with the provisions of Article 18;

(5) where the applicant is an individual or enterprise or other organization of Hong Kong, Macao or Taiwan, the application shall comply with the provisions of Chapter 1, Section 6.1.1 of Part I.

Circumstances of Nonacceptance

(5) Where a foreign applicant is obviously not entitled to file an application for patent due to his nationality or its residence;

(6) Where, as the first named applicant, a foreigner, foreign enterprise or other foreign organization without habitual residence or business office in Mainland China does not appoint a patent agency;

(7) Where, as the first named applicant, an individual, an enterprise or other organization from Hong Kong, Macao or Taiwan without habitual residence or business office in Mainland China does not appoint a patent agency;

(8) Where the application is mailed directly from a foreign country to the Patent Office;

(9) Where the application is mailed directly from Hong Kong, Macao, or Taiwan to the Patent Office.

Special Provisions on Examination of Electronic Application

5.1 Power of Attorney

Any applicant who appoints a patent agency for applying for a patent, or for having other patent matters to attend to in electronic form, shall submit a power of attorney in electronic form and the original paper power of attorney. Any applicant who appoints a patent agency for handling formalities of reduction or postponement of the payment shall declare it in the power of attorney in electronic form. Where the general power of attorney has been deposited with the Patent Office, if the serial number of that general power of attorney has been indicated in the request when filing the application or has been indicated in the statement when going through the formality for a change of bibliographic data, the patent agency shall be exempted from submitting the general power of attorney in electronic form and the photocopy thereof.

5.2 Dissolution of Appointment and Resignation of Appointment

Where a patent agency has been appointed by the applicant of electronic application, at least one applicant shall be electronic application user when the formalities of dissolution or resignation of appointment are gone through. Where none of the applicants is the electronic application user, the formalities of dissolution or resignation of appointment shall not be gone through. The examiner shall issue the *Notification that Request Deemed Not to Have Been Made* and notify the party concerned to go through the formalities of Registration of Electronic Application User. Where the formalities of dissolution are in conformity with the requirements, the applicant who has registered as electronic application user to go through the formalities shall be representative of the patent application. Where the formalities of resignation are in conformity with the requirements, the applicant who has registered as electronic application user and has been indicated in the request shall be the representative of the patent application. Where no representative has been designated, the first name applicant who has registered as electronic application user shall be the representative of the patent application.

5.3 Changes due to Patent Agency Revoked

Where the patent agency appointed by the applicant is revoked by SIPO and the applicant appoints another patent agency, the new patent agency shall be the electronic application user. Where the patent agency appointed by the applicant is revoked and the applicant does not appoint another patent agency, if the applicant is an individual or entity in mainland China and has registered as the electronic application user, the first named applicant shall be the representative. Where none of the applicants is the electronic application user, the examiner shall notify the applicant in paper form to go through the formalities of registration of electronic application user. According to Article 19.1 of the Patent Law, where the applicant is required to appoint a patent agency which has registered as the electronic application user.