

Part III

Examination of International  
Applications Entering  
the National Phase

# Chapter 1 Preliminary Examination of International Applications Entering the National Phase and Processing of Procedural Matters Therefore

## **1.Introduction**

Any international application filed in accordance with the Patent Cooperation Treaty(hereinafter called “the PCT” or “the Treaty”)and indicating the desire to obtain patent protection for invention or utility model in China,after completing the procedure of the international phase,shall according to Rules 103 and 104 go through the formalities before the Patent Office for entering the Chinese national phase (hereinafter called“the national phase”),and thus initiate the procedure of the national phase. The procedure of the national phase covers the following processes: preliminary examination to the extent as permitted under PCT,national publication,substantive examination with reference to the results of the international search and the international preliminary examination,grant or rejection and other processes as may occur.

This Chapter concerns the examination on the conditions for an international application to enter the national phase,preliminary examination on an international application in the national phase,and processing for an international application of procedural matters in the national phase,etc.Only special issues of the above contents are given explanations and made stipulations for in this Chapter; for other issues which are the same as those in national applications,if no explanations or provisions are given in this Chapter,Chapters 1 and 2 of Part I,and Part V shall apply mutatis mutandis respectively.

The main contents of preliminary examination and processing of general matters concerned in this Chapter are the following:

(1)according to Rule 105,examining whether or not an alleged international application entering the national phase satisfies the provided conditions; and processing of any application

which has no effect or the effect of which is lost in China;

(2) according to Rule 104, examining whether or not the Chinese translation (hereinafter called translation) or documents of the original application of an international application have been satisfactorily submitted at the time of entering the national phase; according to Rule 44, examining whether or not the translation and documents meet the prescribed requirements, and processing of those failing to meet the requirements;

(3) according to Rule 106, examining whether or not the time when the applicant submits translation of any amendment made in the international phase meets the provided requirements, and processing of those failing to meet the requirements;

(4) according to Rules 104, 107, 108, 109, 110, 112 and 113, and Articles 18 and 19.1, examining whether or not other documents related to the application have been submitted and meet the prescribed requirements; and processing of those having defects; and

(5) according to Rule 114, processing of such general matters as national publication for an international application.

## **2.Examination of the Formalities of International Application Entering the National Phase**

Where the applicant wishes to obtain patent protection for international application in China, he shall go through the formalities for entering the national phase within the time limit as provided for in Rule 103. Where an international application has no effect in China or the effect has lost in China, the international application can not enter the Chinese national phase. When the applicant goes through the formalities for entering the Chinese national phase, he shall fulfill the requirements in accordance with the provisions of Rule 104.

Where the applicant withdraws the priority claim at the time of going through the formalities for entering the national phase, the time limit for going through the said formalities shall be still calculated from the original earliest priority date.

Where the priority of the international application is invalid in national phase due to China's reservations to the relevant provisions of the Patent Cooperation Treaty and its Regulations, consequently, the time limit for going through the formalities for

entering the national phase shall be still calculated from the original earliest priority date.

For the location and manner of submission of documents of the international application entering the national phase, the provisions in Chapter 3 of Part V of these Guidelines shall apply.

For payment of fees of the international application entering the national phase, subject to the provisions in this Chapter, the provisions in Chapter 2 of Part V of these Guidelines shall apply.

## **2.1 Having No Effect in China**

Any international application which has been accorded a filing date must have passed the examination by the receiving Office on whether it conforms with Article 11 of the Treaty and have had an affirmative conclusion. Therefore, so long as an international application designates China, according to Rule 102, the Patent Office shall accept its effect as a regular national application. The examiner shall examine whether the designation of

China by the alleged international application entering the national phase continues to be effective.

If, for an alleged international application entering the national phase, there is no indication of the designation of China in its international publication document, then it has no effect in China, and the examiner shall issue the Notification of the Failure of the International Application to Enter the Chinese National Phase to notify the applicant that the formalities for the international application to enter the national phase are not admissible.

## **2.2 Loss of Effect in China**

### **2.2.1 Loss of Effect as Notified by the International Bureau**

PCT Art. 24 (1)  
(i) – (ii)

For an alleged international application entering the national phase, if, during the international phase, the Notification of Withdrawal of International Application (PCT/IB/307), or the Notification that International Application Considered to be Withdrawn (PCT/IB/325), or the Notification of Withdrawal of Designations (PCT/IB/307) to China of the international application has been transferred to the Patent Office by the International Bureau, the effect in China of the said international application has ceased in accordance with the

provisions of Rule 105.1(1), and the examiner shall issue the Notification of the Failure of the International Application to Enter the Chinese National Phase to notify the applicant that the formalities for entering the national phase of the international application shall not be accepted.

PCT Art. 24

(1) (iii)

### **2.2.2 Delay in Going through Formalities for Entering National Phase**

Where the applicant fails to go through the formalities for entering the national phase within the time limit as provided for in Rule 103; or where, though the formalities for entering the national phase have been gone through, the requirements of Rule 104.1(1) to (3) are not complied with, the effect of the said international application shall cease in China in accordance with the provisions of rule 105.1(2) or (3). The examiner shall issue the Notification of the Failure of the International Application to Enter the Chinese National Phase to notify the applicant that the formalities for entering the national phase shall not be accepted.

Where the formalities for entering the national phase, which the applicant goes through within the time limit as prescribed in Rule 103, fails to meet the prescribed requirements, the examiner shall notify the applicant that the formalities for entering the national phase are not acceptable due to defects in them.

Where the applicant, before the expiration of the prescribed time limit, goes through the formalities for entering the national phase again and the above-mentioned defects are corrected, the said international application shall remain valid in China.

Where, due to delay in meeting the time limit as provided for in Rule 103, the effect of an international application ceases in China, and the applicant has submitted a request for restoration of right in accordance with Rule 6.2, the examiner shall notify the applicant that the request is not acceptable according to Rule 105.2. If the applicant indicates that the delay in meeting the time limit is caused by force majeure, the examiner shall process with the reference to Rule 6.1.

### **2.2.3 Election**

PCT Rule 54 bis

Where an international application elects China within the

prescribed time limit and the election remains valid until the international application enters the national phase,the applicant shall go through the formalities for entering the national phase within the time limit as provided for in Rule 103.

As to whether or not China is elected,it depends on the Notification of Election(PCT/IB/331)sent by the International Bureau.

Where,after transmitting the Notification of Election,the International Bureau transmits the Notification of Withdrawal of Demand or Elections(PCT/IB/339)or the Notification that Demand is Considered Not to Have Been Submitted or Made (PCT/IB/350),and the above-mentioned notifications involve the withdrawal of election or the election deemed not to have been made,the election of China of the international application is invalid if there is "CN" in the indicated States.

Rule 104. 2

### **2.3 Processing of International Application Entering the National Phase**

Where any international application,which has gone through the formalities for entering the national phase according to the provisions,is confirmed its effect in China after examination, and meets the requirements of the provisions of Rule 104.

1(1)to (3),the Patent Office shall accord national application number,indicate clearly the date of entry of the international application into the Chinese national phase(hereinafter called the date of entry)and issue the Notification of International Application Entering the Chinese National Phase.The date of entry refers to the date on which the formalities for entering the national phase have been gone through before the Patent Office and meet the requirements prescribed in Rule 104.1(1)to (3).

Where the above formalities for entering the national phase, which meet the requirements,are completed on the same day,the

date shall be the date of entry.Where the above formalities for entering the national phase,which meet the requirements,are completed on different dates,the last date of completing the formalities shall be the date of entry.In the follow-up examination and approval procedures,the national application number shall be indicated when various formalities are gone through by the applicant or when the notifications are issued by the examiner.

### **3.Examination of the Application Documents Submitted at the Time of Entering the National Phase**

#### **3.1 Written Statement Concerning the Entry into the National Phase**

##### **3.1.1 International Filing Date**

Rule 102

The international filing date is accorded by the receiving Office in the international phase. Where the international filing date is amended for any reason in the international phase, the amended date shall be regarded as the right one. The international filing date indicated in the Written Statement Concerning the Entry into the National Phase (hereinafter called "the entering statement") shall be the same as the one written on the front page of the international publication document. Where the inconsistency appears, the examiner shall correct it ex officio according to the date as recorded in the international publication document and notify the applicant accordingly.

The international filing date, which has been accorded by the receiving office, is deemed as the actual filing date in China, except that the filing date in China needs to be redetermined as China makes reservations to the relevant provisions of the Treaty and the PCT Regulations.

##### **3.1.2 Kind of Protection**

Rule 104.1(1)

PCT Rule 4.9(a)

Article 9.1 stipulates that for any identical invention-creation, only one patent right shall be granted. Therefore, when an international application designating China is under the procession of formalities of entering national phase, it shall be indicated with either "patent for invention" or "patent for utility model" for kind of protection, which means the applicant can only choose one from the two. In this respect, it is not permitted to request "patent for invention" and "patent for utility model" at the same time. If the requirements are not complied with, the examiner shall issue the Notification of the Failure of the International Application to Enter the National Phase.

### **3.1.3 Title of Invention**

The title of the invention in the entering statement shall be consistent with that indicated on the front page of the international publication documents. Where the international application is published in a foreign language, the translation shall not only be exact in expressing the original meaning of the title of the invention, but also be brief. Where there are no redundant words in the translation, the number of words of the title of the invention shall not be limited by the provisions of Chapter 1, Section

### **4.1.1 of Part I of these Guidelines.**

The title of the invention indicated on the front page of the international publication document is usually derived from the request of the original international application, and a few are decided by the examiner of the International Search Authority. Where the title of the invention was decided by the examiner of the International Search Authority, the title of the invention in the entering statement shall be the translation thereof decided by the said examiner.

Where the amendment to the title of the invention is requested at the time of entering the national phase, it shall be submitted in the form of amendment to the application documents. It is not allowed to fill in directly, in the entering statement, the amended title of the invention. The national publication does not publish the amended title of the invention.

### **3.1.4 Inventor**

#### **3.1.4.1 Determination of Information on Inventor**

Rule 104.1(4)

Except that the change of the inventor has been recorded by the International Bureau in the international phase, the inventor filled in the entering statement shall be the one indicated in the request of the international application. According to the provisions of the Treaty, where there are more than one inventor in an international application, different inventors may be indicated for different designated States. Under such circumstances, the inventor to be indicated in the entering statement shall be the inventor for China. Where the international publication is in a foreign language, the name of the inventor shall be



translated into Chinese in an accurate way. The examiner shall compare the name of the inventor indicated in the entering statement with that recorded on the front page of the international publication document. If the requirements are not complied with, the examiner shall issue the Notification to Make Rectification to notify the applicant to correct it. Where no rectification is made within the time limit, the examiner shall issue the Notification that Application Deemed to be Withdrawn.

Where, in the international phase, the Notification of the Recording of a Change (PCT/IB/306) has been transferred by the International Bureau to inform the change of the inventor or of his name, the change shall be regarded as having been reported to the Patent Office, and the changed information shall be filled in the entering statement directly. The examiner shall, based on the notifications of the International Bureau, compare the relevant contents indicated in the entering statement with the information recorded in the international publication document and the notification. If the requirements are not complied with, the examiner shall issue the Notification to Make Rectification to notify the applicant to correct it. Where no rectification is made within the time limit, the examiner shall issue the Notification that Application Deemed to be Withdrawn.

Where the inventor for China is deceased and such information is recorded by the International Bureau, his name shall still be indicated in the entering statement as the inventor.

#### **3.1.4.2 No Inventor Indicated in the International Application**

Rule 104.1(4)

Where the name of the inventor is not recorded in the international publication document of an international application, the name of the inventor shall be added in the entering statement when the application enters the national phase. If the requirements are not complied with, the examiner shall issue the Notification to Make Rectification to notify the applicant to correct it. Where no rectification is made within the time limit, the examiner shall issue the Notification that Application Deemed to be Withdrawn.

It is not necessary for the examiner to examine the qualification of the inventor.

#### **3.1.4.3 Translation of the Name of Inventor**

In the international phase, the family name of the inventor shall be indicated before the given name(s). The translation of the name of the inventor in the entering statement shall be written in a way that is consistent with the customary practice of the State to which he belongs.

Where the applicant believes that the translation of the name of the inventor filled in the entering statement is not accurate, he may request to make rectification on his own initiative before the completion of technical preparations for publication of the application for patent for invention or announcement of patent right for utility model by the Patent Office. Where, after examination, the examiner believes that the rectified translation of the name is consistent with the name in the original, the rectification shall be accepted, and the rectified translation of the name shall be used in the national publication or in the announcement. Where, after the preparations are completed by the Patent Office, the applicant requests to rectify the translation of the name of the inventor, he shall go through the formalities for change in the bibliographic data.

#### **3.1.5 Applicant**

##### **3.1.5.1 Determination of Information on Applicant**

Rule 104.1(4)

Except that the change of the applicant has been recorded by the International Bureau in the international phase, the applicant who is filled in the entering statement shall be the one indicated in the request of the international application. According to the provisions of the PCT, Where there are more than one applicant for the international application, different applicants may be indicated for different designated States. Applicants to be mentioned in the entering statement shall be the applicants for China. Where a foreign language is used in the international publication, the name or the address of the applicant shall be translated into Chinese in an accurate way. Where the applicant is an enterprise or other organization, the full name of the formal Chinese translation shall be utilized as its name. The examiner shall check the contents indicated in the entering statement with those

recorded on the front page of the international publication document. If the requirements are not complied with, the examiner shall issue the Notification to Make Rectification to the applicant for rectification. Where no rectification is made within the time limit, the examiner shall issue the Notification that Application Deemed to Be Withdrawn.

Where, in the international phase of an international application, the Notification of the record of a change (PCT/IB/306) has been transferred by the International Bureau to inform the change of the applicant or the change of the name or address of the applicant, the change shall be regarded as having been reported to the Patent Office and the changed information shall be filled directly in the entering statement. The examiner shall, based on the notifications of the International Bureau, compare the relevant contents indicated in the entering statement with the information recorded in the international publication document and the notification. If the requirements are not complied with, the examiner shall issue the Notification to Make Rectification to the applicant for rectification. Where no rectification is made within the time limit, the examiner shall issue the Notification that Application Deemed to Be Withdrawn.

Where the applicant is deceased and such information is recorded by the International Bureau, his name shall not appear in the entering statement at the time of entering the national phase, except that the inheritor of deceased applicant is not determined.

According to the provisions of the Treaty, the receiving Office, based on the national law, shall check and determine whether or not the information provided by the applicant concerning his nationality or residence is true. The information after the examination of the receiving Office shall be indicated on the front page of the international publication document published by the International Bureau. Generally speaking, the examiner shall not have questions about it any more.

#### **3.1.5.2 Qualification of Applicant**

Where the applicant is a foreign individual, enterprise or other type of organization, the provisions of Article 18 shall apply to examine whether the applicant is entitled to file an application.

Where an international application has only one applicant, the applicant is usually a national or resident of a State party of the PCT, or at least a national or resident of a country party to the Paris Convention. Therefore, if there is no change in the applicant, there is no need to examine whether or not the applicant meets the requirements of Article 18. According to the provisions of the Treaty, where an international application is filed by two or more applicants, at least one of them shall be a national or resident of a State party of the PCT. Therefore, it is possible that when the international application is filed, the applicant for China is not a national or resident of a State party to the PCT. Besides, the Treaty has requirements only for the State to which the applicant filing the international application belongs, and does not have any requirements for the State to which the assignee belongs when there is any change in the applicant.

It is possible that the States to which some or all of the applicants belong are States not party to the PCT at the time of entering the national phase. Under such circumstances, the examination shall be conducted in accordance with the provisions of Chapter 1, Section 4.1.3.2 of Part I of these Guidelines. Where all of the applicants do not meet the requirements prescribed in Article 18, the application shall be rejected. Where only some of the applicants do not meet the requirements prescribed in Article 18, the examiner shall issue the Office Action to notify the applicant to delete the applicants who are not entitled to file the application. Where the applicant refuses to do it, the application shall be rejected.

### **3.1.5.3 Translation of the Name of Applicant**

In the international phase, where the applicant is an individual, the family name shall be indicated before the given name(s). In the entering statement, the translation of the name of the applicant shall be written in a way that is consistent with the customary practice of the State to which he belongs.

Where the applicant believes that the translation of his name filled in the entering statement is not accurate, he may request to make rectification on his own initiative before the completion of technical preparations for publication of the application for patent for invention or announcement of patent right for utility

model by the Patent Office. Where, after examination, the examiner believes that the rectified translation of the name is consistent with the name in the original, the rectification shall be accepted, and the rectified translation of the name shall be used in the national publication or in the announcement. Where, after the preparations are completed by the Patent Office, the applicant requests to rectify the translation of the name, he shall go through the formalities for change in the bibliographic data.

### **3.1.6 Statement of Basis Text for Examination**

In the international phase, the applicant may make amendments to the claims under Article 19 of the Treaty after receiving the international search report. Such amendments shall be submitted to the International Bureau within the prescribed time limit. In the course of the international preliminary examination, the applicant may also amend the description, drawings and claims under Article 34 of the Treaty. Such amendments shall be submitted to the International Preliminary Examination Authority. In addition, when an international application enters the national phase, the applicant may also file amendments under Article 28 or 41 of the Treaty.

Thus, when an international application enters the national phase, in addition to the original application documents, it may contain one or more amended texts. The applicant shall indicate the text which shall serve as the basis text for subsequent procedures in the entering statement, i.e., make a statement concerning the basis for examination.

Where no amendments have been made both in the international phase and after entering the national phase, the basis for examination shall be the original application. Where there have been some amendments either in the international phase or at the time of entering the national phase and the amendments have been indicated in the statement concerning the basis for examination, the text to be used for examination shall be the original application having the corresponding part replaced by the amended

documents. Where the amendments have been made in the international phase but have not been indicated in the statement concerning the basis for examination, the amendments shall be regarded as being abandoned and shall not be taken into consideration

by the Patent Office.

The amendments made under Article 19 of the Treaty in the international phase, referred to in the statement concerning the basis for examination, shall have corresponding contents in the international publication document. The corresponding contents of the amendments made under Article 34 of the Treaty shall be attached to the international preliminary report on patentability.

Rule 106

Where it is found that the amendments made in the international phase which are referred to in the statement concerning the basis for examination do not exist, the examiner shall issue the Notification to Make Rectification to notify the applicant to correct the relevant contents in respect of basis for examination in the entering statement.

Where the amendments in the international phase have been referred to in the statement concerning basis for examination, the Chinese translation of the amendments shall be submitted within two months from the date of entry. If the documents have not been submitted at the expiration of the time limit, the amendments indicated in the statement shall not be taken into consideration, and the examiner shall issue the Notification of Non-consideration of the Amendment.

### **3.2 Translation and Drawings of the Original Application**

In accordance with the provisions of Rule 104.1(3), where an international application is filed in a foreign language, the translation of the description and the claims of the original international application shall be submitted at the time of entering the national phase. Where obvious inconsistency occurs between the translation and the original, the translation shall not be the basis for determining the date of entry.

In accordance with the provisions of Rule 104.1(5), where the international application is filed in a foreign language, the translation of the abstract shall be submitted. Where there are drawings and the drawing of the abstract, a copy of the drawings and a copy of the drawing of the abstract shall be submitted.

The text matter in the drawings, if any, shall be replaced by the corresponding text matter in Chinese.

### 3.2.1 Translation of Description and the Claims

The translation of the description and the claims shall be consistent with the contents of the description and the claims in the international publication document transferred by the International Bureau. The translation shall be complete and authentic to the original. The applicant shall not add any content of the amendment in the translation of the original.

The contents of the "replacement sheet" or "rectified sheet" marked in the international publication document are regarded as the contents of the original application in general. For the contents filed as part of the description or the claims of an international application, and which has been declared "not to be taken into consideration" after the examination of the receiving Office and has been marked as such in the international publication document, the similar mark shall be made in Chinese in the translation. For example, where the references to the drawings are made in the description with no drawings actually provided in the application.

Where the description (including the drawings) and the claims contain the contents that are contrary to social morality or public order, or contain other belittling statement which, after the examination of the International Bureau, have been deleted from the international publication, the said contents shall not be added into the translation of the original application again. If such contents appear in the translation again, the examiner shall issue the Notification to Make Rectification to notify the applicant to correct the translation errors. Where such contents have not been deleted in the international publication and appear in the translation, the provisions of Chapter 1, Section 7 of Part I of these Guidelines shall apply.

PCT Rule 49.5  
(a-bis)

Where, in the international phase, the description and the claims of an international application contain a nucleotide and/or amino acid sequence and that the sequence listing is submitted as a separate part of the description, at the time of submitting the translation, its translation shall also be submitted as a separate part of the description and the pages shall be numbered separately. The applicant shall also submit a copy in computer-readable form which is consistent with the said sequence listing. If the

sequence listing recorded in the copy in computer-readable form is not consistent with the sequence listing stated in the description, the sequence listing stated in the description shall prevail.

Where no such copy in computer-readable form has been submitted or the submitted copy is obviously not in conformity with the sequence listing stated in the description, the examiner shall issue the Notification to Make Rectification to the applicant for rectification. Where no rectification is made within the time limit, the examiner shall issue the Notification that Application Deemed to Be Withdrawn.

Where the free text of the sequence listing has been included in the main part of the description, no translation of the free text is needed for such sequence listing.

In the international phase, where the description of an international application contains a nucleotide and/or amino acid sequence listing part with more than 400 pages, the sequence listing in the computer-readable form in accordance with the provisions may be submitted only at the time of entering the national phase.

It is unnecessary to translate the language of a computer program cited in the description. It is acceptable if the translation of the editors' name and the title of the document in the cited reference materials are in consistency with the requirements for national publication.

### **3.2.2 Drawings**

In accordance with the provisions of Rule 104.1(5), where an international application filed in a foreign language contains the drawings, a copy of the drawings shall be submitted. The text matter in the drawings, if any, shall be replaced by the corresponding text matter in Chinese, and a new copy of the drawings shall be furnished with text matter in Chinese marked in proper place instead of the original language. Even if the contents of the text in the drawings do not comply with the provisions of Rule 18, it shall be translated according to the original application. The new drawings shall be identical with the drawings in the international publication document and shall meet the formal requirements for the drawings of Chapter 1, Section 4.3 of Part I of these Guidelines.



It may not be required to translate the word "Fig." in the drawings into Chinese. The same is for the language of a computer program or certain text for screen images in the drawings. If the requirements are not complied with, the examiner shall issue the Notification to Make Rectification to the applicant for rectification. Where no rectification is made within the time limit, the examiner shall issue the Notification that Application Deemed to Be Withdrawn.

### **3.2.3 Translation of Abstract and Figure Accompanying the Abstract**

**Rule 104.1(5)** The translation of the abstract shall be consistent with the content of the abstract on the front page of the international publication document. Where the examiner of the International Search Authority has amended the abstract submitted by the applicant, the translation of the amended abstract shall be submitted. For example, where the international search report is contained in the re-published international publication document A3 later rather than in the first published international publication document A2, and the content of the abstract on the front page of international publication document A3 is different from that of the international publication document A2, the translation shall be made on the basis of the content of the abstract in the international publication document A3.

The translation shall be brief on condition that the content of the original application is not changed. So long as there are no unnecessary words or sentences, the examiner shall not request the applicant to amend or amend ex officio the translation on the grounds of not complying with the requirement on the number of words in the abstract as provided for in Rule 23.2.

Where the international publication document contains no abstract, the applicant shall submit the translation of the original abstract of the international application at the time of entering the national phase.

Where the international application contains the drawing of the abstract, a copy of the drawing of the abstract shall be submitted. The copy of the drawing of the abstract shall be consistent with the corresponding drawing of the international publication. Where there are text matters in the drawing, they shall be

replaced by the corresponding text matters in Chinese. A new copy of the drawings shall be furnished with Chinese words marked in proper place instead of the original language. Where the search report is not contained in the first publication, and the drawing of the abstract in the first published international publication document A2 is different from that in re-published international publication document A3 later, the drawing of the abstract for re-publication shall prevail.

If the requirements are not complied with, the examiner shall issue the Notification to Make Rectification to the applicant for rectification. Where no rectification is made within the time limit, the examiner shall issue the Notification that Application Deemed to be withdrawn.

### **3.3 International Application of Which the International Publication is in Chinese**

For an international application of which the international publication is in Chinese, at the time of entering the national phase, it is necessary to submit only the entering statement, a copy of the abstract and the drawing of the abstract (if any) of the original application. It is not necessary to submit the copies of the description, claims and drawings. But, before the international publication of the international application has been completed, if the applicant requests early processing and early national publication of the international application, the applicant shall still submit the copies of the description, claims and drawings (if any).

### **3.4 Processing Before Expiration of Time Limit**

According to Article 23(1) of the Treaty, no designated Office shall process or examine the international application prior to the expiration of the applicable time limit under Article 22, and the said applicable time limit is within thirty months from the date of priority. Article 23(2) of the Treaty also provides that notwithstanding the provisions of paragraph (1), any designated Office may, on the express request of the applicant, process or examine an international application at any time. For the elected Office, corresponding stipulations are provided in Article 40 of the Treaty.

#### **3.4.1 Early Processing**

According to Rule 111, if the Patent Office is requested to handle and examine an international application before the expiration of thirty months from the date of priority, the applicant, in addition to going through the formalities for entering the Chinese national phase as provided for in Rules 103 and 104, shall also go through the following formalities:

(1) an express request shall be submitted in accordance with Article 23(2) of the Treaty.

(2) where the International Bureau has not transferred the international application to the Patent Office, a certified copy of the international application shall be submitted to the Patent

Office, the said copy is a copy of the "home copy" certified by the receiving Office or the "record copy" certified by the International Bureau.

(3) the applicant may request the International Bureau to transfer the copy of the international application document to the Patent Office in accordance with the provisions of Rule 47.4

of the PCT Regulations, or the Patent Office requests the International Bureau to transfer the copy of the international application document when the applicant files a request with the Patent Office.

Where an international application meets above-mentioned requirements, the examiner shall handle and examine it in time.

#### **3.4.2 Delaying of the Processing**

As for an international application, where, before the expiration of thirty months from the date of priority, the formalities for entering the national phase have been gone through, but the formalities provided in Rule 111 have not been gone through, in accordance with the provisions of the Treaty, the Patent Office shall not process the international application.

### **4. Examination of Translation of Amended Documents in the International Phase**

#### **4.1 Translation of Claims Amended under Article 19 of PCT**

Where, according to the statement of the applicant, the claims amended under Article 19 of the Treaty are served as the basis for examination, and the international publication of the amendments is in a language other than Chinese, the applicant shall submit its translation at the time of entering the national phase, or at the latest within two months from the date of entry. In accordance with the provisions of Rule 106, the amendments of which the translation is submitted after the said period shall not be taken into consideration. The examiner shall issue the Notification of Non-consideration of the Amendment. Where an international publication document contains the statement concerning amendments under Article 19(1) of the Treaty and the applicant requests the examiner to take the said statement into consideration, the applicant shall submit the translation of the statement

at the same time when the translation of the amended claims is furnished.

The translation of the amended claims (including amendment, addition or deletion of the claim (s)) shall be consistent with the content of the corresponding part recorded in the international publication document. For amendments which were submitted in the international phase but were refused by the International Bureau for not being in conformity with the provisions of Rule 46 of the PCT Regulations, they shall not be submitted as amendments under Article 19 of the Treaty at the time of entering the national phase.

The translation of the amendments shall be made in the form of the amendment sheet that can replace the corresponding part of the translation of the original application. The words "Claims (amended under Article 19 of the PCT)" shall be indicated on the top of the first page of the translation of the amended claims.

For the translation of the amended documents which are submitted after entering the national phase, the Form to Supplement the Translation of Amended Document or the Amended Document shall be attached. The applicant shall indicate in the Form that he intends to use the amended contents as the basis for examination.

The translation of the claims amended under Article 19 of the Treaty shall be published together with the translation of the claims of the original application. The translation of the amended claims shall meet the requirements concerning the form of publication as provided for in these Guidelines.

Where the translation of the amended documents fails to meet the requirements, the examiner shall issue the Notification of Defects of the Amended Document to notify the applicant to make rectifications. If the applicant fails to submit the rectifications within the specified time limit, the examiner shall issue the Notification of Non-consideration of the Amendment.

Where the claims amended under Article 19 of the Treaty is also used as the basis for international preliminary examination, and the applicant has submitted it as the translation of the annexes of the international preliminary report on patentability at the time of entering the national phase, the said translation shall

not be published in the national publication.

#### **4.2 Translation of Amendments under Article 34 of the PCT**

Rule 106

Where, according to the statement of the applicant, the amendments made under Article 34 of the Treaty are served as the basis for examination, and the amendments are made in a language other than Chinese, the translation shall be submitted at the time of entering the national phase, and at the latest within two months from the date of entry. The translation of the amended part submitted after the said period shall not be taken into consideration. The examiner shall issue the Notification of Nonconsideration of the Amendment.

The content of the translation of the amended part shall be consistent with the content of the amendment sheet attached to the international preliminary report on patentability transferred by the International Bureau. Where, in the international phase, the applicant declares that the amendments have been made under Article 34 of the Treaty, but the amendments fail to be accepted by the examiner, and thus have not been transferred as the annexes of the international preliminary report on patentability, the applicant shall not submit such contents to the Patent Office at the time of entering the national phase as amendments made under Article 34 of the Treaty.

The translation of the amendments shall be made in the form of the amendment sheet that can replace the corresponding part of the translation of the original application. If, as the result of the amendment, there is an addition of the content in a page, one or more pages may be inserted after that page. The pages shall be numbered as "Xa", "Xb" or "X-1", "X-2". If, as the result of the amendment, there is a cancellation of an entire page, the indication shall be made in the explanation of the amendments. Where a certain claim is deleted from the claims, the original numbering may stay, with the word "deletion" indicated. The amended claims may also be renumbered in a continuous way, with explanation attached to illustrate it. Brief explanation of the amendments shall be attached in front of the translation of the amendments. On top of that page, there shall indicate the words "translation of annexes of international preliminary report on patentability". Explanation of the amendments shall in-

dicate only the parts where the amendments are involved.

For the translation of the annexes of the international preliminary report on patentability submitted after entering the national phase, the Form to Supplement the Translation of Amended Document or the Amended Document shall be attached. The willingness to use the amendments as the basis for examination shall be indicated in the said Form.

Where the translation of the amended documents fails to meet the requirements, the examiner shall issue the Notification of Defects of the Amended Document to notify the applicant to make rectifications. If the rectifications are not submitted within the specified time limit, the examiner shall issue the Notification of Non-consideration of the Amendment.

The translation of the annexes of the international preliminary report on patentability shall not be published in the national publication.

## **5.Examination of Other Documents**

### **5.1 Appointment and Power of Attorney**

#### **5.1.1 Appointment**

Art. 19. 1

For a foreign applicant who has no habitual residence or business office in Mainland China, he shall, at the time of entering the national phase, appoint a patent agency to handle the relevant matters. If no patent agency is appointed, the examiner shall handle the matter according to the relevant provisions of Chapter 1, Section 6.1.1 of Part I of these Guidelines.

For an applicant who has habitual residence or business office in Mainland China, he is not obliged to appoint a patent agency at the time of entering the national phase.

#### **5.1.2 Power of Attorney**

Rule 15. 3

When an international application enters the national phase, in addition to meeting the requirements prescribed in Chapter 1, Section 6.1.2 of Part I of these Guidelines, the submitted power of attorney shall also indicate the international application number, and the name or title of the applicant (i.e., consignor) both in the original and in its Chinese translation. Except in cases

where there are changes, the original name or title of the applicant shall be in the same language as and be identical in content with that recorded on the front page of the international publication document; where a change has been made in the international phase, the change shall be identical with the changed content recorded in the Notification of the Recording of a Change (PCT/IB/306). The translation of the name or title shall be identical with that recorded in the entering statement.

Where, at the time when the international application enters the national phase the formalities for the change of applicant are gone through, the applicant may submit only the power of attorney signed by the changed applicant.

Where, for an international application, no power of attorney is submitted at the time of entering the national phase, or the submitted power of attorney has some defects, the relevant provisions of Chapter 1, Section 6.1.2 of Part I of these Guidelines shall apply.

## **5.2 Claiming Priority**

### **5.2.1 Declaration of Claiming Priority**

According to Rule 110.1, where the applicant claims one or multiple priorities in the international phase and such claims remain valid at the time when the application enters the national phase, the applicant shall be deemed to have submitted the written declaration in accordance with the provisions of Article 30.

As China makes reservations to the relevant provisions of the Treaty and its Regulations, the Patent Office shall not recognize the priority restored in the international phase of the international application (for example, the international filing date is later than twelve months but within fourteen months from the priority date), and the corresponding priority claim will lose effect in China, in respect of which the examiner shall issue the Notification that Claim to Priority Deemed Not to Have Been Made.

The applicant shall accurately indicate in the entering statement the date of filing, the application number of the earlier application and the title of the authority with which the earlier application was filed. Except for cases mentioned in the next paragraph,



the indicated contents shall be consistent with that recorded on the front page of the international publication document. Where any inconsistency is found in the entering statement, the examiner may correct it ex officio according to that recorded on the front page of the International publication document, and notify the applicant promptly.

The priority claim referred to in the Notification of Withdrawal of Priority Claim (PCT/IB/317) or Notification that Priority Claim Considered not to Have Been Made (PCT/IB/318) transferred by the International Bureau to the Patent Office shall be regarded as having lost its effect and shall not be included in the entering statement. If the requirements are not complied with, the examiner shall issue the Notification that Claim to Priority Deemed Not to Have Been Made regarding the priority claim.

Where, in the international phase, the receiving Office has already conducted an examination on the validity of the priority claim, i.e., whether or not the earlier application serving as the basis of the priority has been filed in a contracting state to the Paris Convention or the World Trade Organization (WTO), whether or not the applicant is a national or resident of a contracting state to the Paris Convention and whether or not the filing date of the earlier application is within twelve months before the international filing date, and has declared that the priority claim is deemed not to have been made for the reason of failing to meet above-mentioned requirements, the Patent Office will not doubt the decision.

Where, in the international phase, the applicant fails to provide the application number of the earlier application, he shall indicate the application number in the entering statement. If the requirements are not complied with, the examiner shall issue the Notification to Rectify Formalities. Where no rectification is made within the time limit or the rectification is still not in conformity with the requirements after the applicant makes rectification, the examiner shall issue the Notification that Claim to Priority Deemed Not to Have Been Made regarding the priority claim.

Where the applicant believes that there is a clerical error somewhere in the written declaration of priority claim made in

the international phase, the applicant may file a request for correction at the time of going through the formalities for entering the national phase or within two months from the date of entry. Such request shall be submitted in the written form, and the corrected priority claim shall be indicated. At the time when the request for correction is submitted, where the applicant has not submitted a copy of the earlier application to the International Bureau, a copy of the earlier application shall be attached to serve as the basis of correction. If the requirements are not complied with, the request for correction shall be deemed not to have been made.

A new priority claim shall not be allowed to submit after entering the national phase.

### **5.2.2 Submission of a Copy of the Earlier Application**

Rule 110.3

In accordance with the provisions of Rule 17 of the PCT Regulations, where the applicant has submitted a copy of the earlier application to the receiving Office or requested the receiving Office to prepare a copy of the earlier application, the Patent Office shall not request the applicant himself to submit the copy of the earlier application. The International Bureau shall be requested to provide the said copy by the Patent Office. Where the

examiner of the Patent Office deems necessary to check the copy of the earlier application, he shall request the International Bureau to transfer the copy of the earlier application. For example, where, under the item of relevant documents in the international search report, there are documents marked with "PX" or "PY", etc. or where documents of "PX" or "PY" are not found by the examiner of the International Search Authority, but are found by the examiner of the Patent Office who is responsible for the substantive examination in the process of supplementary search.

Where the Patent Office is notified by the International Bureau that the applicant has not submitted a copy of the earlier application according to the provisions in the international phase, the examiner shall issue the Notification to Rectify Formalities to notify the applicant to submit them within the prescribed time limit. Where such documents have not been submitted at the expiration of the time limit, the examiner shall issue the Notifi-

cation that Claim to Priority Deemed Not to Have Been Made in respect of the corresponding priority claim.

### **5.2.3 Examination of a Copy of Earlier Application**

Where the International Bureau has provided a copy of earlier application or where the applicant has supplemented a copy of earlier application, the examiner shall conduct the examination to the copy of earlier application.

#### **5.2.3.1 Inconsistent with Declaration of Priority**

The examiner shall examine each item contained in the declaration of priority based on the earlier application documents.

If one or two items are inconsistent with that recorded in the earlier application documents, the examiner shall issue the Notification to Rectify Formalities. Where no rectification is made within the time limit or the rectification is still not in conformity with the requirements after the applicant makes rectification, the examiner shall issue the Notification that Claim to Priority Deemed Not to Have Been Made.

#### **5.2.3.2 Submission of Certification of Enjoying Right of Priority**

The examiner shall check whether or not the applicant of the international application has right to claim the right of priority of the earlier application indicated in the application at the filing date. Where the earlier application is not filed with the Patent Office, the applicant shall be considered to have right to claim the right of priority if one of the following requirements has been met:

(1) the applicant of the later application is the same as that of the earlier application;

(2) the applicant of the later application is one of the applicants of the earlier application;

(3) the applicant of the later application enjoys the right of priority as the result of assignment or gift of the applicant of the earlier application or transfer of right in other form.

For cases under item (3), except that the applicant has made a declaration of enjoying the right of priority in the international phase and the declaration meets the requirements, the applicant shall submit the relevant certifying documents. The certifying

documents shall be signed or sealed by the assignor. The certifying documents shall be the original documents or the certified copy of the original documents.

Where, through examination, the applicant of an international application is found not in conformity with the requirements mentioned in (1) or (2), the examiner shall check whether or not a declaration of having the right to claim priority of the earlier application made by the applicant is included in the international publication document. If there is such a declaration, and the examiner believes it is true and credible, the applicant shall not be asked to submit the certifying documents. If there is no such declaration or if the declaration fails to meet the requirements, the examiner shall issue the Notification to Rectify Formalities. Where no rectification is made within the time limit or the rectification is still not in conformity with the requirements after the applicant makes rectification, the examiner shall issue the Notification that Claim to Priority Deemed Not to Have Been Made.

Where the earlier application is filed in China, the provisions of Section 5.2.6 of this Chapter shall apply for examining whether the applicant of the later application has the right to claim the priority of the earlier application indicated in the application.

#### **5.2.4 Fee for Priority Claim**

Rule 110.2

Where any priority claim is made, the applicant shall pay the fee for priority claim within two months from the date of entry. If the fee is not paid or not paid in full within the time limit, the priority claim shall be deemed not to have been made, and the examiner shall issue the Notification that Claim to Priority Deemed not to Have Been Made.

#### **5.2.5 Restoration of Claim to Right of Priority**

Where an international application occurs the circumstance under Rule 26bis.2 of the PCT Regulations in the international phase, and the International Bureau or the Receiving Office declares that the priority claim is considered not to have been made, the applicant may, at the time of going through the formalities for entering the national phase, request for restoration of

the priority claim, pay the restoration fee and where the applicant has not submitted a copy of the earlier application to the International Bureau, in the meantime attach the copy of the earlier application as the basis of restoration, provided that the information concerning the priority claim considered not to have been made has been published together with the international application. The request for restoration submitted after entering the national phase shall not be taken into consideration.

After the international application enters the national phase, the applicant may request to restore the right of claiming priority in accordance with the provisions of Rule 6 if the priority claim is deemed not to have been made due to the following circumstances:

(1) where the applicant fails to provide the application number of the earlier application in the international phase, and still fails to indicate it in the entering statement;

(2) where the declaration of claiming priority is in conformity with the provisions, but the copy of the earlier application or the document certifying the assignment of the right of priority has not been submitted within the prescribed time limit;

(3) where in the declaration of claiming priority, one or two items of the date of filing, the filing number and the title of the receiving authority with which the earlier application was filed are inconsistent with the copy of the earlier application; and

(4) where the declaration of claiming priority is in conformity with the provisions, but the fee for claiming priority is not paid or not paid in full within the prescribed time limit.

The provisions of Chapter 7, Section 6 of Part V of these Guidelines shall apply concerning dealing with the request for restoration of right.

Except for the above circumstances, the right of priority that is deemed not to have been made due to other reasons shall not be restored.

#### **5.2.6 Earlier Application Being Filed in China**

Where the earlier application is a national application filed in China, of which the priority has been claimed by an international application, the requirements to be satisfied in the preliminary examination of the priority of the said international application

shall be, except the provisions of Section 5.2.3.2 of this Chapter, the same as those of other international applications.

Where the earlier application was filed in China, the applicant of the later application claiming the priority shall be the same as that of the earlier application, or the person to whom all of the applicants of the earlier application have assigned the right of priority. Where these requirements are not satisfied, the priority shall be considered not to have been made.

Where the earlier application was filed in China, when an international application claiming the priority of the earlier application enters into the Chinese national phase, it shall be considered as claiming domestic priority. If, at the time of filing, an international application claims the priority of an earlier application, and the subject matter of the earlier application falls into one of the situations listed in Rules 32.2(1)-(3), the examiner shall issue the Notification that Claim to priority Deemed not to Have Been Made. Due to special proceedings for the international applications, the examiner shall not handle the earlier application of which the priority is claimed according to the provisions of Rule 32.3. Similarly, the examiner shall not handle the situation concerning the grant of patent right to the earlier application after the international application is filed, though it may lead to double patenting of both the earlier application and the later application. All these issues shall be left to be handled during the subsequent procedures.

### **5.3 Incorporation by Reference**

According to the provisions of the PCT Regulations, where some elements or parts, which are missing when the applicant files the international application, they may be incorporated by reference of the corresponding parts in the earlier application, and the original filing date shall be retained. Here, "elements" refer to all the description or claims, and "parts" refer to part of the description, part of claims or all or part of drawings.

As China makes reservations to the above provisions of the Treaty and its Regulations, when the international applications enters the Chinese national phase, where the original international filing date is retained through incorporating the missing elements or parts by reference from earlier application, the Patent

Office shall not recognize it.

For the application documents which contain the elements or parts incorporated by reference, where, at the time of going through the formalities for entering the national phase, the applicant indicates it in the entering statement and requests to amend the filing date for China, the elements or parts incorporated by reference can be retained in the application documents. The examiner shall redetermine the filing date in China based on the records in the Notification on Decision of Confirmation of Incorporation by Reference of Element or Part (Form PCT/RO/114) delivered by the International Bureau, and issue the Notification of Redetermination of the Filing Date. With regard to the application whose filing date exceeds twelve months from priority date due to redetermination of the filing date, the examiner shall issue the Notification that Claim to Priority Deemed Not to Have Been Made in respect of the relevant priority claim. For the application documents which contain the elements or parts incorporated by reference, where, at the time of going through the formalities for entering the national phase, the applicant does not indicate it, or does not request to amend the filing date in China, the elements or parts incorporated by reference are not permitted to be retained in the application documents. The examiner shall issue the Notification to Make Rectification to notify the applicant to delete the elements or parts incorporated by reference. Where no rectification is made within the time limit, the examiner shall issue the Notification that Application Deemed to be Withdrawn. The applicant cannot request to retain the elements or parts incorporated by reference by the means of requesting to amend the filing date in China in subsequent procedures.

#### **5.4 Non-Prejudicial Disclosures**

In accordance with the provisions of Rule 107, where any invention-creation to which the international application relates has one of the events referred to in Article 24(1) or (2), and where statements have been made in this respect when the international application is filed, the applicant shall indicate it in the entering statement, and furnish the relevant certifying documents as prescribed in Rule 30.3 within two months from the date of entry. If the applicant fails to indicate it or furnish the relevant

certifying documents within the time limit, the provisions of Article 24 of the Patent Law shall not apply to his international application.

Where the applicant indicates in the entering statement that the grace period for keeping novelty has been requested at the time of filing the international application, there shall be corresponding indication on the front page of the international publication document, which includes the date and venue of the disclosure, kind of disclosure and the name of the exhibition or meeting

in respect of the non-prejudicial disclosure. The exhibition indicated in the entering statement shall fall under Rule 30.1, and the academic or technological meeting indicated shall fall under Rule 30.2. If the requirements are not complied with, the examiner shall issue the Notification that Grace Period Concerning Novelty Deemed Not to Have Been Claimed.

Where the indication is contained in the international publication document other than the entering statement, the applicant may rectify it within two months from the date of entry.

Because of the special procedure for the international application, the time limit for submitting the certifying materials is within two months from the date of entry. For requirements for the certifying materials, the provisions in Chapter 1, Section 6.3 of part I of these Guidelines shall apply.

## **5.5 Matter Relating to Deposit of Sample of Biological Material**

### **5.5.1 Indication in the Entering Statement**

In accordance with the provisions of Rule 108.1, where the reference has been made to the deposit of sample of biological material according to the provisions of the Treaty, the applicant shall indicate such reference in the entering statement. The indication shall include the kind of documents in which the particulars of the deposit are recorded, and, where necessary, the accurate location of the relevant content in the said documents.

Where the particulars of the deposit are included in the description in a way other than the form, the applicant shall indicate, in the entering statement under the specified items, the location, i.e., the page number and number of lines of the content concerning the deposit in the translation of the description. The



examiner shall check the corresponding content of the translation. Where the particulars of the deposit are indicated in the Indications Relating to Deposited Microorganism or Other Biological Material(PCT/RO/134)or other separate sheet,such form or sheet shall be included in the international publication document. Where the examiner finds,after verification,that there is no indication concerning the particulars of the deposit in the corresponding location of the translation indicated in the entering statement,or where the Indications Relating to Deposited Microorganism or Other Biological Material(PCT/RO/134)or other separate sheet indicated in the entering statement is not included in the international publication document,the Notification that Biological Material Sample Deemed Not to Have Been Deposited shall be sent,and the reference to the deposit of sample of biological material shall be considered not to have been made.

Rule 108. 2

Where the reference to the deposit of sample of biological material has been made in the international phase according to the provisions of the Treaty,but such reference is not indicated or is not accurately indicated in the entering statement,the applicant may rectify it on his own initiative within four months from the date of entry.Where no rectification is made at the expiration of the time limit,such reference shall be considered not to have been made,and the examiner shall issue the Notification that Biological Material Sample Deemed Not to Have Been Deposited to notify the applicant that the said sample of biological material shall be considered not to have been deposited.

### **5.5.2 Reference to Deposit of Sample of Biological Material**

In accordance with the provisions of Rule 108,where the applicant has made reference to the deposit of sample of biological material according to the provisions of the Treaty,the requirements in Rule 24(3)shall be deemed to have been satisfied.

PCT Rule 13 bis. 3

(a) & 13 bis. 4(a)

According to the provisions of the PCT Regulations,the reference to deposited biological material shall include the title and the address of the depositary institution,the date on which the sample of biological material is deposited,the accession number given to the deposit by that institution.So long as the reference reaches the International Bureau before the preparations for the international publication have been completed,such reference

shall be considered to have been furnished in time. To this end, where the reference to the deposit of the sample of biological material indicated in the entering statement is included in the international publication document as part of the description or in the form of separate sheet, and the content of the reference includes the above prescribed particulars, the examiner shall regard the reference as meeting the requirements. Where the applicant makes no reference to the deposit of the sample of biological material in the international phase, but declares in the entering statement that the application relates to the deposit of sample of biological material, the examiner shall issue the Notification that Biological Material Sample Deemed Not to Have Been Deposited to notify the applicant that the sample of biological material shall be deemed not to have been deposited.

Where the certificate of deposit of the biological material sample is submitted by the applicant on the filing date, and it is included as part of the international application in the international publication document by the International Bureau, when a request is made by the applicant to make rectification to the missing part of the reference to the deposit of the sample of biological material, the examiner may allow the applicant to make supplement or correction based on the certificate of deposit in the international publication document.

Where it is found that the reference to the deposit of the sample of biological material is not in conformity with the particulars of the deposit recorded in the certificate of deposit, and it can be assured that the inconsistency is caused by the clerical error in the reference, the examiner shall issue the Notification to Rectify Formalities to notify the applicant to make rectification. Where no rectification is made at the expiration of the time limit, the examiner shall issue the Notification that Biological Material Sample Deemed not to Have Been Deposited and the sample of biological material shall be considered not to have been deposited.

Where the reference to the deposit of the sample of biological material is submitted in the form of the Indications Relating to Deposited Microorganism or Other Biological Material (PCT/RO/134) or in the form of separate sheet other than the description, it shall be translated into Chinese as part of the international

application at the time of entry into the national phase. Where no Chinese translation is submitted, the examiner shall issue the Notification to Rectify Formalities to notify the applicant to rectify it. Where no rectification is made at the expiration of the time limit, the reference to the deposit of the sample of biological material shall be deemed not to have been made and the examiner shall issue the Notification that Biological Material Sample Deemed Not to Have Been Deposited to notify the applicant that the said sample of biological material is deemed not to have been deposited.

### **5.5.3 Certificate of Deposit of Biological Material Sample**

**Rule 108.3** Because of the special procedure of the international application, the time limit for submitting the certificate of deposit and the certificate of viability of the biological material is within four months from the date of entry. For examination of the contents of the certificate of deposit and the certificate of viability of the biological material, the provisions in Chapter 1, Section 5.2.1 of Part I of these Guidelines shall apply.

### **5.6 Source of Genetic Resources**

**Art. 26.5**  
**Rule 109** Where an invention-creation has been developed relying on the use of genetic resources for which the international application is filed, the applicant shall indicate the fact in the entering statement, and fill in the Registration Form of Indicating Source of Genetic Resources. If the requirements are not complied with, the examiner shall issue the Notification to Make Rectification to notify the applicant for rectification. Where no rectification is made within the time limit, the examiner shall issue the Notification that Application Deemed to be Withdrawn. Where it is still not in conformity with the requirements after rectification, the patent application shall be rejected.

### **5.7 Amendment to the Application Documents after Entering the National Phase**

According to Rule 112, the applicant may file requests to amend the patent application documents within the prescribed time limit after going through the formalities for entering the national phase, and such amendments are called the amendments in

the national phase.

For an international application pursuing a patent right for utility model, the applicant may file a request on his own initiative to amend the patent application documents within two months from the date of entry.

For an international application pursuing a patent right for invention, the applicant may amend the application documents on his own initiative according to Rule 51.1.

When an international application enters the national phase, if the applicant requests definitely that the amendments made under Article 28 or 41 of the Treaty serve as the basis of examination, the amendments may be submitted together with the translation of the original application, and such amendments are considered as the amendments submitted on the applicant's own initiative according to Rule 112.

The applicant shall enclose the detailed explanation of the amendments when submitting the amendments. The explanation may be in the form of a table of comparison on the contents before and after amendment or the marked notes of amendments on the copy of the original. Where the amendments are submitted at the time of entering the national phase, the words of "amendments made under Article 28 (or 41) of the Treaty" shall be marked on top of the explanation of the amendments.

The contents of the amendments shall be submitted in the form of replacement sheets. The contents of the replacement sheets shall correspond with those of the replaced sheets and shall be consistent with the context in meaning.

### **5.8 Correction of Translation Errors**

PCT Art. 11 (3)

In accordance with the provisions of the Treaty, an international application shall have the effect of a regular national application in each designated State from the international filing date. Thus, the international application transferred by the International Bureau to the designated Office or the elected Office is the text which has the legal effect. Where, on the basis of the said text, it is found that there are translation errors submitted at the time of entering the national phase, the applicant shall be allowed to correct the translation errors provided that the provisions of Rule 113 are fulfilled.

The translation errors refer to cases where terms, sentences or paragraphs of the translation text are omitted or inaccurate compared with the original text transferred by the International Bureau. Where the obvious inconsistency appears between the translation text and the original text transferred by the International Bureau, the rectification in the form of correcting the translation errors shall not be allowed.

The applicant may go through the formalities for correcting the translation errors before the completion of technical preparations for publication of the application for the patent for invention or announcement of the patent for utility model by the Patent Office.

At the time of correcting the translation errors, in addition to submitting the corrected sheet, the applicant shall file a written request for correcting the translation errors and pay the prescribed handling fee for correction of the translation. If the requirements are not complied with, the examiner shall issue the

Notification that Request Deemed Not to Have Been Submitted.

The corrected sheet of the translation and the corresponding sheet of the original translation shall be mutually replaceable, i.e., the corrected content shall be consistent with the context in meaning.

If inconsistency exists in the nonverbal part, such as in a mathematical or chemical formula, etc., it shall not be handled as a translation error. The applicant shall be asked to make rectification only.

## **5.9 Request for Substantive Examination**

Art. 35

For an international application which enters the national phase and designates China for a patent for invention, the request for substantive examination shall be submitted within three years from the date of priority, and the fee for substantive examination shall be paid. The examiner shall conduct the examination in accordance with the provisions of Chapter 1, Section 6.4 of Part I of these Guidelines.

## **5.10 Changes in Bibliographic Data**

### **5.10.1 Changes Recorded by the International Bureau**

#### **5.10.1.1 Effect of Notification of the International Bureau**

In the international phase, upon the request of the applicant or the receiving Office, the International Bureau records the change of the applicant or his name, residence, nationality or address in the request, or the change of the inventor or his name in

the request and notifies the designated Office in a written form. So long as the Patent Office has received the Notification of the Recording of a Change (PCT/IB/306) from the International Bureau, the applicant shall be considered to have reported the change in the bibliographic data to the Patent Office. This means there is no need for the applicant to submit a statement for the change in the bibliographic data and pay the handling fee

for such change. When the international application enters the national phase, the changed bibliographic data shall be used directly.

#### **5.10.1.2 Supplement of Certifying Materials**

Where a change is made under the item of "applicant" (entity only) as indicated in the Notification of the Recording of a Change (PCT/IB/306) transferred by the International Bureau, the applicant shall, at the time of entering the national phase, in accordance with Rule 104.1(6), submit the contract on the assignment or gift of the right to apply for a patent, the certifying document on the merger of the company provided by the administrative authority of industry and commerce, or other certifying documents relating to transfer of right. The certifying documents may be the original or the copy certified by the public notary organ. The examiner shall examine the validity of the certifying documents. Where the certifying documents are not provided, the examiner shall issue the Notification to Make Rectification to notify the applicant to supplement them. If no documents are supplemented at

the expiration of the time limit, the examiner shall issue the Notification that Application Considered to Be Withdrawn.

Where, in the Notification of the Recording of a Change (PCT/IB/306) transferred by the International Bureau, the recorded change refers to the assignment of the right to apply for a patent by an entity or individual of Mainland China to a foreign individual, enterprise or other type of organization, the provisions

prescribed in Chapter 1,Section 6.7.2.2(3)(ii)of Part I of these Guidelines shall apply.

Where,in the Notification of the Recording of a Change (PCT/IB/306)transferred by the International Bureau,the indicated change refers to the change in name,address of the applicant, and the name of the inventor,no certifying documents are necessary.The change shall be deemed to have taken effect.

### **5.10.2 Changes in Bibliographic Data in the National Phase**

Where the formalities of the change in the bibliographic data are gone through at the time of or after entering the national phase,Chapter 1,Section 6.7.1 of Part I of these Guidelines shall apply.

In addition to the certifying documents of the several kinds of changes in the bibliographic data as indicated in Chapter 1, Section 6.7.2 of Part I of these Guidelines,under the following two circumstances,the statement made by the party concerned himself (applicant or inventor)may also be used as the certifying documents for request for change.

(1)The applicant states that the wrong name of the applicant, or the wrong name of the inventor is filled at the time of filing the international application,and a request is filed to correct the error after entering the national phase.

(2)The applicant states that different titles or names of the applicant or inventor of an international application are used for different States(not just the language difference)and he intends to use a title or name different from that recorded in the international publication for China,and files the request for change in China.For example,a Chinese American uses the name of "xxx,Tom" in the U.S.A.and has filed an international application in this name,but requests to use "xxx" as his name at the time of entering the Chinese national phase.

## **5.11 Request for Review**

### **5.11.1 Submission of Request for Review**

PCT Art. 25

According to the provisions of the Treaty,the circumstances under which submission of a request for review to the Patent Office as designated Office or elected Office by the applicant may

be allowed are as follows:

(1)where the receiving Office has refused to accord an international filing date or has declared that the international application is considered withdrawn; and

(2)where the International Bureau has declared that the international application is deemed withdrawn because it has not received the registered copy of the application within the prescribed time limit.

Rule 116

PCT Rule 51

The request for review shall be submitted to the Patent Office within two months from the date of receiving the notification of the above-mentioned decision. In the request, the reason for the request for review shall be indicated and the copy of the decision which is the subject for review shall be attached. Upon the request of the applicant, the copy of the relevant documents of the file will be transferred by the International Bureau to the Patent Office later.

### **5.11.2 Other Formalities**

At the time of submitting the request for review according to Section 5.11.1 of this Chapter, the applicant shall go through the formalities for entering the national phase prescribed in Rules 103 and 104 before the Patent Office. He shall indicate in the entering statement the fact that the request for review has been submitted.

### **5.11.3 Review and Follow-Up Processing**

Where the examiner believes the request for review is submitted in accordance with the provisions of the Treaty and its Regulations, and the formalities for entering the national phase have been gone through in accordance with the provisions, he shall review the decision made by the International Bureau or receiving Office to find whether or not it is correct.

Where the examiner believes the decision made by the said International Authority is correct and the effect of the said international application in China has ceased, the provisions of Section 2.2.1 of this Chapter shall apply.

Where the examiner believes the decision made by the International Authority is incorrect, he shall confirm that the international application has effect in China, and continue the process-



ing and examination of it in the national phase. For the international application of which the international filing date has not been accorded by the receiving Office, the examiner shall notify the applicant that the application is deemed to be filed with the Patent Office on the date on which the international filing date shall be accorded.

Where the international application has not been published in the international publication because of interruption of the proceedings in the international phase, the examiner, at the time of conducting the examination prescribed in this Chapter, shall use the copy of the registered copy of the documents in the files transferred by the International Bureau instead of the international publication document mentioned in these Guidelines.

## **5.12 Rectification of Errors Made by the International Authority**

### **5.12.1 Statement on Rectification of Errors Made by the International Authority**

Where, in the processing of the international application, as the result of the error of the International Authority, a wrong notification is issued, the wrong record appears in the international publication document, the wrong text is published concerning the international publication, or there is an omission in issuing a notification or an omission in making a record, therefore, after entering the national phase, the examiner has made the decision of "effect of the international application ceases in China", "rectification", or "right of priority deemed not to have been made", etc., the applicant may request for rectification of errors made by the International Authority within six months from the date of the issuance of the corresponding notification by the examiner. The request may be submitted in the form of observations.

### **5.12.2 Appendix**

At the time of submitting the statement of observation requesting the rectifications of errors made by the International Authority, the applicant shall furnish a copy of the corresponding document showing that the International Bureau has rectified or has agreed to rectify the said errors as the appendix, such as

the rectified copy of the international publication document, or the rectified sheet of the Notification of the Recording of a Change (PCT/IB/306), the rectified sheet of the Notification of Election (PCT/IB/331), etc. The request for rectification without the said appendix shall not be acceptable.

### **5.12.3 Processing after Rectification**

Where it is confirmed after examination or contact with the International Bureau that it is indeed an error made by the international authority and has been rectified by the International Bureau, the Patent Office shall acknowledge the rectified conclusion.

Where the decision of "effect of the international application ceases in China" has been made out of the errors caused by the International Authority, the Patent Office shall accept again the translation and the fees, and the date on which the formalities for entering the national phase are gone through and in conformity with the requirements under Rules 104.1(1) to (3) for the

first time shall be regarded as the date of entering the national phase. Where during the process waiting for the International Authority to rectify the errors, the time limit for going through certain formalities has expired, and the said formalities can not be gone through in time because the errors are not rectified (such as the submission of the request for substantive examination, the submission of the certificate of deposit and the certificate of viability of the biological material sample, the submission of the certifying materials of non-prejudicial disclosure, etc.), the applicant shall, at the time of submitting his observation of requesting the rectifications of errors made by the International Authority, complete the various formalities that have been delayed. The examiner shall consider such formalities being completed within the prescribed time limit.

For other conclusions made out of errors caused by the International Authority and leading to the loss of rights of the applicant, the corresponding rights shall be restored after the International Bureau notifies that the errors have been rectified.

## **6. National Publication**

National publication applies only to the international application for patent for invention which has entered into China. In

accordance with the provisions of Rule 114.1,with regard to any international application for a patent for invention,if after the preliminary examination,the Patent Office considers it in compliance with the provisions of the Patent Law and its Implementing Regulations,it shall be published in the Invention Patent Gazette. Where the international application is filed in a language other than Chinese,the Chinese translation of the international application shall be published.

Before entering the national phase,the international publications of most of the international applications have been completed by the International Bureau at the expiration of eighteen months from the date of priority.According to the provisions prescribed in the Treaty,where the language used in the international publication is different from that used for publication in the designated State according to the national law,as far as the protection of right is concerned,the designated State may provide that the publication does not take effect till the translation using the latter language is published according to the national law.It is clearly prescribed in Rule 114.2 that for the international application filed in a language other than Chinese,the right for requiring provisional protection as provided for in Article 13 shall begin after the national publication.

Another purpose of the national publication is to notify the public the information on the entry into the national phase of the application.

#### **6.1 Time of Publication**

Except for the situations described in Section 3.4 of this Chapter,most international applications enter the national phase after the expiration of eighteen months from the date of priority, and the provisions of Article 34 shall not apply to them. Where,after the preliminary examination to the international application which has entered the national phase,the Patent Office believes that all the requirements are met,the preparatory work for national publication shall begin in time.The time for the Patent Office to complete the preparatory work of the national publication of an international application shall not be earlier than two months from the date of entering the national phase.

## **6.2 Form of Publication**

### **6.2.1 Application of Which International Publication is in a Foreign Language**

The national publication shall be in the form of the publication in the Invention Patent Gazette and the pamphlet of the application for Patent for invention.

### **6.2.2 Application of Which International Publication is in Chinese**

The national publication shall be in the form of publication in the Invention Patent Gazette. Where, before the international publication of the international application filed in Chinese is completed, the applicant request early processing and early national publication of the international application, the national publication shall be in the form of the publication in the Invention Patent Gazette and the pamphlet of the application for Patent for invention.

## **6.3 Contents of Publication**

### **6.3.1 Contents of National Publication in Invention Patent Gazette**

The national publication of the international application is an independent part in the Invention Patent Gazette, which is separated from the publication of the national application. The national publication of the international application consists of the bibliographic data, abstract and drawing of the abstract (when necessary). The bibliographic data includes the IPC symbol, application number, publication number, filing date, international application number, international publication number, date of international publication, priority matters, matters of patent agent, matters of applicant, matters of inventor, title of the invention, and nucleotide and/or amino acid sequence listing information published in electronic form, etc.

The index of the Invention Patent Gazette is compiled in the prescribed order in which the published international applications and the published national applications are combined.

### **6.3.2 Contents of the Pamphlet of the Application for Patent for Invention**

The contents of the pamphlet of the application for Patent for invention of an international application consists of the front page, the translation of the description and claims, the translation of the abstract, as well as the drawings and the translation of the text matter of the drawings. Where necessary, it shall contain a nucleotide and/or amino acid sequence listing part, the translation of Indications Relating to Deposited Microorganism or Other Biological Material (PCT/RO/134) in which the particulars of the deposit of the sample of biological material are recorded, the translation of the claims amended under Article 19 of the Treaty and the translation of the statement concerning the amendment. The translation of the amended claims shall follow the translation of the original ones. The contents on the front page shall be the same as the published contents of the same application in the Invention Patent Gazette which is published at the same time.

## **7. Special Provisions for Payment of Fees**

### **7.1 Filing Fee, Printing Fee for Publishing the Application, Additional Fee for Filing Application, and Surcharge for the Late Entry**

The filing fee, printing fee for publishing the application, and surcharge for the late entry shall be paid within the time limit prescribed in Rule 103.

After the applicant receives the Notification of International Application Entering the Chinese National Phase, relevant fees shall be paid with the national application number. Otherwise, relevant fees may be paid with the international application number.

Where the additional fee for filing the application is not paid or is not paid in full by the applicant at the time of going through the entering formalities, the examiner shall notify the applicant to pay the said fee within the prescribed time limit. Where the fee is not paid or not paid in full at the expiration of the time limit, the application shall be deemed to be withdrawn.

## **7.2 Reduction and Exemption of Fees**

### **7.2.1 Exemption of Filing Fee**

The filing fee and the additional fee for filing the application of an international application filed with the Patent Office as receiving Office shall be exempted at the time of entering the national phase.

### **7.2.2 Reduction and Exemption of the Substantive Examination Fee**

When an international application enters the national phase and the applicant submits the request for substantive examination, if the international search report and international preliminary report on patentability of the international application are made in China, the substantive examination fee shall be exempted.

When an international application enters the national phase and the applicant submits the request for substantive examination, if the international search report of the international application is made by one of three International Searching Authorities, the European Patent Office, Japanese Patent Office and Swedish Patent Office, the applicant only needs to pay 80% of the substantive examination fee.

Where the request for substantive examination is submitted while the Patent Office does not receive the international search report, the substantive examination fee shall not be reduced and exempted. However, where the applicant submits the international search report accomplished by one of the above-mentioned three International Search Authorities, i.e., the European Patent Office, Japanese Patent Office and Swedish Patent Office, before the Patent Office issues the Notification of Entering the Substantive Examination Stage of the Application for Invention, the applicant may request the refund of overpaid fee.

### **7.2.3 Reduction or Postponement of Reexamination Fee and Annual Fee**

Rule 100

Where the applicant of an international application has difficulties in paying the re-examination fee and the annual fee, he

may submit a request to the Patent Office for a reduction or postponement of the payment in accordance with the measures for the reduction and postponement of patent payment.

### **7.3 Other Special Fees**

During the proceedings of the national phase for an international application, in addition to the fees indicated in Chapter 2,

Section 1 of Part V of these Guidelines and the surcharge for the

late entry indicated in Section 7.1 of this Chapter, there are some kinds of special fees as the following:

(1) handling fee for correction of translation errors (i.e., fee for correction of translation), which shall be paid at the time of submitting the request for correction of translation errors;

(2) restoration fee for unity, which shall be paid within the time limit prescribed in the Notification Concerning the Payment of Restoration Fee for the Unity Sent by the Examiner (see Chapter 2, Section 5.5 of this Part for details of restoration fee for unity); and

(3) where the description contains a nucleotide and/or amino acid sequence listing with more than 400 pages and the applicant only submits the sequence listing in computer-readable form at the time of entering the national phase, the additional fee for the description of the said nucleotide and/or amino acid sequence listing shall be charged as that of 400 pages.

# Chapter 2 Substantive Examination of International Applications

## Entering the National Phase

### 1.Introduction

Substantive examination of an international application entering the national phase refers to the substantive examination of an international application seeking for patent protection for invention which has entered the national phase in accordance with the Patent Law and its Implementing Regulations. An international application entering the national phase may be an international application which has not gone through the international preliminary examination under Article 22 of the Treaty, or an international application which has gone through the international preliminary examination under Article 39 of the Treaty.

### 2.Principles of Substantive Examination

#### 2.1 Basic Principles of Substantive Examination

In accordance with the provisions of Article 27(1) of the Treaty, no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in the Treaty and its Regulations. It is further stipulated in Article 27(5) of the Treaty that nothing in the Treaty and its Regulations is intended to be construed as prescribing anything that would limit the freedom of each contracting State to prescribe such substantive conditions of patentability as it desires. In

particular, any provision in the Treaty and its Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art.

On the basis of the provisions of the Treaty, the examination of the international application which has entered the national phase shall be conducted according to the following principles.



(1) For the form and contents of the application, in principle, the provisions of the Patent Law, its Implementing Regulations and these Guidelines shall apply. Where there is a difference between the above provisions and the provisions of the Treaty and its Regulations, the latter shall apply.

(2) For substantive requirements for granting of patent right, the provisions of the Patent Law, its Implementing Regulations and these Guidelines shall apply.

## **2.2 Provisions Having Relevance with Substantive Requirements for Grant of Patent Right**

“Substantive requirements for grant of patent right” provided for in Section 2.1(2) of this chapter relates to the following provisions of the Patent Law and its Implementing Regulations:

Article 2.2: definition of invention;

Article 5: invention-creation that is contrary to the laws, social morality or that is detrimental to public interest; invention-creation where the acquisition or use of the genetic resources, on which the development of the invention-creation relies, is not consistent with the requirements of the laws and administrative regulations

Article 9.1 and Rule 41: avoidance of double-patenting;

Article 9.2: principle of first-to-file;

Article 20: confidentiality examination;

Article 22: novelty, inventive step and practical applicability;

Article 25.1(1)-(5): subject matters excluded from patentability;

Article 26.3: sufficient disclosure of an invention;

Article 26.4: claims shall be supported by the description and shall define the extent of the patent protection asked for in a clear and concise manner;

Article 26.5, Rules 26 and 109: disclosure of source of genetic resources;

Article 29: the right of priority;

Article 31, Rules 34 and 42: unity;

Article 33 and Rule 43.1: an amendment and a divisional application shall not go beyond the scope described in the initial description and claims;

Rule 20.2: an independent claim shall contain all of the essential technical features of an invention.

### **3.Determination of Text Forming Basis for Substantive Examination**

#### **3.1 Request of Applicant**

At the time of entering the national phase, the applicant of an international application shall indicate, in the written entering statement, the text which he wishes the Patent Office use for examination.

The substantive examination of the international application in the national phase shall be performed, upon the request of the applicant, on the basis of the text indicated in the written entering statement and other texts submitted in a later stage which meet the relevant requirements.

#### **3.2 Text Forming Basis for Substantive Examination**

The texts used as the basis for substantive examination may include:

(1) where the international publication of an international application is in Chinese, the international application as originally filed; where the international publication of an international application is in a foreign language, the Chinese translation of the international application as originally filed;

(2) where the international publication of an international application is in Chinese, the claims as amended and submitted under Article 19 of the Treaty; where the international publication of an international application is in a foreign language, the Chinese translation of the claims as amended and submitted under Article 19 of the Treaty;

(3) where the international publication of an international application is in Chinese, the claims, description and drawings as amended and submitted under Article 34 of the Treaty; where the international publication of an international application is in a foreign language, the Chinese translation of the claims, description and drawings as amended and submitted under Article 34 of the Treaty;

(4) the text as rectified and submitted under Rule 44 and /or

Rule 104;

(5) the text as amended and submitted under Rule 112.2 or Rule 51.1;

The claims, description and drawings as amended and submitted under Articles 28 or 41 of the Treaty is considered as amended and submitted text under Rule 112.2 or Rule 51.1.

The text used as the basis for substantive examination shall be the one indicated in the statement concerning the basis for examination.

The statement shall contain indications in the prescribed items of the Written Statement Concerning the Entry into

the National Phase (hereinafter called the entering statement) at the time of entering the national phase, and complementary indications in the complementary statement concerning the basis for examination after the international application has entered the national phase. The latter is a complement and a correction to the former.

If the applicant indicates in entering statement that there are elements or parts incorporated by reference in the application documents and the filing date for China has been redetermined in the preliminary examination stage, the elements or parts incorporated by reference shall be considered as part of the application documents originally submitted. The applicant shall not be permitted to retain the elements or parts incorporated by reference by the means of requesting to amend the international application date for China in the process of substantive examination.

Where, the amendments made in the international phase fail to be indicated as the basis for the examination at the time of entering the national phase, or where the Chinese translation of the amendments is not submitted according to the provisions although the indication has been made, it shall not be used as the basis for substantive examination.

Rule 112.2

Furthermore, after an international application has entered the national phase and at the time when a request for substantive examination is made, or within three months from the receipt of the Notification of Entering the Substantive Examination Stage of the Application for Invention issued by the Patent Office, the applicant may amend the application documents according to Rule 51.1.

For the determination of the text to be used as the basis for the examination, the provisions of Chapter 8, Section 4.1 of Part II of these Guidelines shall apply. For the examination on abovementioned amended document or the amended document submitted according to the provisions of Rule 51, the provisions of Chapter 8, Section 5.2 of Part II of these Guidelines shall apply.

### **3.3 Legal Effect of International Application Documents as Originally Filed**

Where the international publication of an international application is in a language other than Chinese, the substantive examination shall be conducted according to its Chinese translation. The examiner, generally speaking, need not check the original. Nevertheless, the international application documents as originally filed shall have legal effect and form the basis for any amendment to the application documents.

For an international application, the original description and claims indicated in Article 33 refer to the claims, description and drawings of the international application as originally filed.

## **4. Search in Substantive Examination**

### **4.1 General Principles**

Generally, a comprehensive search shall be conducted with an international application entering substantive examination in the national phase. For requirements concerning the search, the provisions of Chapter 7 of Part II of these Guidelines shall apply.

### **4.2 Principle of Practicing Economy**

From the principle of practicing economy, the examiner shall take into consideration the information provided in the international search report and the international preliminary report on patentability. However, attention needs to be paid to whether the text which the applicant requests to be used as the basis for substantive examination is consistent with the text used as the basis for the international search report and the international preliminary report on patentability and whether the subject matters for which protection is sought is searched all-roundly in international phase.

If, compared with the text which the applicant requests to be used as the basis for substantive examination, there are amendments to the text which form the basis for the international search report and the international preliminary report on patentability so far as the claimed subject matter is concerned, or the subject matter for which protection is sought is not searched allroundly in the international phase, instead of just simply using the results of the international search report and the international preliminary report on patentability in the examination, the examiner shall reconsider the results of the search and conduct supplementary search when necessary.

Where the reference documents listed in the international search report and the reference documents introduced by the international preliminary report on patentability are sufficient to destroy the novelty or inventive step of a patent application, there is no need to conduct further search in respect of the patent application.

It is to be noted that the meanings of certain document categories listed in the international search report are different from

the corresponding document categories listed in the search report made in the procedure of substantive examination in the Chinese

national phase, e.g. documents of category P and category E. In the international search report, the letter "P" represents documents published prior to the international filing date but later than the priority date as claimed; the letter "E" represents patent documents of which filing date is earlier than the filing date

(not priority date) of the international application, and published on or later than the international filing date, and which contents relate to the novelty of the international application.

The documents of category E listed in the international search report may change into documents of category PE or E in the search report of national phase.

## **5. Contents of Substantive Examination and Requirements of Examination**

This section focuses mainly on the differences between substantive examination of an international application which has entered the national phase and that of a regular national application. For the same points of their substantive examination, references

are made to the corresponding sections that are applicable.

### **5.1 Exploitation of International Preliminary Report on Patentability**

The international preliminary examination of an international application is to formulate a preliminary and non-binding opinion in accordance with Article 33(1) of the Treaty as to whether the claimed invention appears to be novel, to involve an inventive step (be non-obvious) and to possess practical applicability. Article 33(2)-(4) of the Treaty set specific criteria for requirements of novelty, inventive step and practical applicability. At the same time, Article 33(5) of the Treaty indicates clearly that the criteria provided in Article 33(2)-(4) merely serve the purpose of international preliminary examination. Any contracting State may apply additional or different criteria in deciding whether or not, in that State, the claimed invention is patentable.

From the principle of economy, for an international application which is accompanied by an international preliminary report on patentability, the examiner shall make reference to the opinions provided in the report. However, attention needs to be paid to whether the text which the applicant requests to be used as the basis for examination is consistent with the text used as the basis for the international preliminary report on patentability. If, compared with the text which the applicant requests to be used as the basis for examination, there are amendments to the text which form the basis for the international preliminary report on patentability so far as the claimed subject matter is concerned, the examiner usually does not need to make reference to the judgment made in the international preliminary report on patentability on whether the invention meets the criteria of novelty, inventive step, practical applicability as well as other requirements for granting of patent right.

It is to be emphasized that the examiner shall not simply take the suggestive opinion provided in the international preliminary report on patentability as the conclusive opinion for the substantive examination in the national phase. He shall pay attention to whether other prior art documents which have not been listed in the international search report are cited in the international preliminary report on patentability.

For the substantive examination of an international application which has entered the national phase, the examiner shall make independent judgment on whether the patent application is in conformity with the substantive requirements of the Patent Law and its Implementing Regulations.

## **5.2 Examination as to Whether an Application Falls into Inventionscreations for Which No Patent Right shall be Granted**

At the time of performing the substantive examination on an international application which has entered the national phase, the examiner shall first examine whether the subject matter of the application falls into the scope of Article 5 and Article 25, and whether it meets the requirements of Article 2.2. In case where an international application falls into the invention-creations for which no patent right shall be granted as provided for in

Article 5 and Article 25 (such as tool for gambling or method of nuclear transformation), the application shall not be granted the patent right, even if the subject matter does not belong to the contents excluded in Rule 39 of the PCT Regulations.

For requirements of examination on this aspect, the provisions of Chapter 1 of Part II of these Guidelines shall apply.

## **5.3 Examination of Right of Priority**

Where the reference documents indicated as category PX or PY have been listed in the international search report, the examiner shall verify the priority right of the international application.

Where the priority right of the international application cannot be established, the examiner shall notify the applicant accordingly. In such cases, the reference documents indicated with letters of PX or PY shall be used as the prior art to evaluate the novelty and inventive step of the international application when the examination of novelty and inventive step of the international application is performed.

Where the right of priority can be established, verification shall be conducted to the reference documents indicated with letters PX. Where a reference document indicated with letters PX is

a Chinese patent application (or patent) or an international application designating China and its filing date is earlier than the

priority date of the international application, the examiner, at the time of performing the examination of novelty, shall estimate whether the reference document constitutes a conflicting application.

Where a reference document indicated as category E is listed in the international search report, and the reference document is a Chinese patent application (or patent) or an international application entering the Chinese national phase, and its filing date is between the filing date and priority date of the international application, the right of priority of such international application shall also be verified. Where the right of priority of the international application cannot be established, at the time of performing the examination of novelty of the international application, the examiner shall estimate whether the reference document constitutes a conflicting application.

Where, after search in the course of substantive examination of an international application entering the national phase, a reference document is found which was published between the priority date and the international filing date of the international application and is prejudicial to its novelty or inventive step, or where a published application or patent is found which was filed between the priority date and the international filing date of the international application by any entity or individual with the Patent Office and is prejudicial to its novelty, the examiner shall verify the right of priority of the international application.

It shall be noted that, because the Patent Office has made reservation to some provisions of the Treaty and its Regulations, such as, provisions relating to the priority restored in international phase with respect to international application and Incorporation by reference (see Section 5.2.1 and 5.3 of Chapter 1 of this part), it is possible that the priority of the international application acknowledged in international phase is not accepted after having entered national phase.

#### **5.4 Examination of Novelty and Inventive Step**

Where there are certain published documents and non-written disclosure which have been listed in the international preliminary report on patentability but are not taken into consideration in the opinion of the international preliminary examination, they



shall be considered when novelty and inventive step of the invention are judged in the substantive examination of the international application after the entering of the national phase.

The non-written disclosure listed in international preliminary report on patentability refers to the disclosure to the public by means of oral disclosure, use, exhibition or other non-written means which occurred before the filing date or the valid priority date of the international application, and the date of such non-written disclosure is indicated in the written disclosure which is available to the public on a date which is the same as, or later than, the filing date or the valid priority date of the international application. Such non-written disclosure does not constitute prior art at the phase of international preliminary examination.

The certain published documents listed in the international preliminary report on patentability refer to the application documents or patent documents which were filed before the filing date or the valid priority date of the international application but published on or later than such date, or the published documents of a patent application claiming the priority of an earlier application which was filed before the said date. Such published applications or patents do not constitute prior art at the phase of international preliminary examination.

For the examination of novelty and inventive step of the international application after entering the national phase, the provisions of Chapter 3 and Chapter 4 of Part II of these Guidelines shall apply respectively.

### **5.5 Examination of Unity**

The examiner shall pay attention to whether, in the application documents submitted and requested to be used as the basis for the examination by the applicant, there are multiple claimed inventions between which unity does not exist. For multiple inventions lacking unity, the following aspects shall be checked:

(1) whether the multiple inventions lacking unity contain any invention for which an international search or international preliminary examination has not been conducted because the applicant failed to pay the additional search or examination fee upon

the request of the examiner;

(2)whether the multiple inventions lacking unity contain any invention which has been abandoned by the applicant due to failure to pay the additional search or examination fee in the international phase (such as an invention abandoned by an applicant in the international phase by restricting certain claims);and

(3)for situations indicated in point (1)or (2),whether the decision of lacking unity made by the International Authority is correct.

**Rule 115.2**

Where,after examination,it is confirmed that the decision made by the International Authority is correct; the examiner shall issue the Notification to Pay Restoration Fee for Unity to notify the applicant to pay the restoration fee for unity within two months.If the applicant fails to pay or pay in full the restoration fee for unity within the prescribed time limit,and fails to delete the invention(s)lacking unity,the examiner shall issue an Office Action to notify the applicant that the invention(s)for which an international search has not been conducted shall be deemed to have been withdrawn,and invite the applicant to submit an amended text after deleting such invention(s).The examiner shall continue the examination based on the text without such invention(s).

As for the invention(s)deleted due to failure to pay the restoration fee for unity by the applicant,according to the provisions of Rule 115.2 and Rule 42.1,the applicant shall not request

for divisional application(s).Except for above circumstance, where the international application contains more than two inventions, the applicant may file a divisional application in accordance with Rule115.1.

Where,it is held after examination that there is no objection of unity between the claimed subject matters of the application in the text requested by the applicant as the basis for examination, and this conclusion is inconsistent with the decision made by the International Authority,the examination shall be conducted on all the claimed subject matters.

For circumstances where the International Authority has not raised an objection of unity during the search and examination in the international phase,but actually there is a defect of lacking unity in the application,the provisions in Chapter 6 of Part

II of these Guidelines shall apply mutatis mutandis.

### **5.6 Examination to Avoid Double Patenting**

Where an international application entering national phase requests the priority of a previous application filed in China or that of a previous international application having already entered the Chinese national phase, double patenting may be caused. In order to avoid double patenting, the provisions in Chapter 3, Section 6 of Part II of these Guidelines shall apply to the examination of the two patent applications.

It shall be noted that, under the above two circumstances, if there appears circumstance that the claim for priority is deemed not to have been made or is not established, the previous application may become the prior art, or conflicting application, which may destroy the novelty of this international application.

Rule 113

### **5.7 Correction of Translation Errors**

Where the applicant finds by himself there are errors in the Chinese translation of the claims, the description or the text matter of the drawings as filed, he may request to correct the errors within the following time limit:

(1) before the completion of technical preparations for publication of an application for a patent for invention by the Patent Office;

(2) within three months from the date of receipt of the Notification of Entering the Substantive Stage of the Application for Invention issued by the Patent Office.

Where the applicant intends to correct the translation errors, he shall file a written request for correction, submit a rectified sheet of the translation and pay the prescribed handling fee for correction of the translation errors. Where the fee is not paid as prescribed, the request for correction shall be deemed not to have been filed. Where the request for correction is filed and the handling fee is paid, the examiner shall determine whether it is a translation error (see Chapter 1, Section 5.8 of this Part). If not, the request for correction shall be refused. If it is a translation error, the examiner shall check whether or not the corrected translation is accurate. Where it is confirmed that the corrected translation is accurate, such corrected text shall be used as the

basis for the further examination. Where the corrected translation is still inconsistent with the original, the examiner shall notify the applicant to submit the corrected translation in conformity with the original.

Where a divisional application is filed after the international application has entered the national phase, if, in the substantive examination stage, the applicant realizes by himself that the translation errors of the original application result in the translation errors of the divisional application, the applicant may go through the formalities of the correction of the translation errors, and correct the translation errors based on the international application text submitted at the time of filing the patent application. The examiner shall conduct the examination to the corrected translation text in accordance with above-mentioned provisions.

Where the international publication of an international application is in a foreign language, the substantive examination shall be conducted according to its Chinese translation. The examiner, generally speaking, need not check the original. However, where the examiner finds, in the course of substantive examination, that defects due to translation errors do not exist in the international application as originally filed or in the original which has been amended in the international phase, but exist in the translation, he shall indicate the existing defects in the Office

Action, for example, the description is not in conformity with the provisions of Article 26.3, or the claims are not in conformity with the provisions of Article 26.4, and invite the applicant to clarify or go through the formalities of request for correction of the translation errors. Where the applicant submits the amended text beyond the scope described in the original Chinese translation when replying, but fails to go through the formalities of request for correction of the translation errors, the examiner shall issue the Notification of Correcting Translation Errors. Where the applicant fails to go through the formalities of correcting the translation errors within the prescribed time limit, the application shall be deemed withdrawn.