

IP Key

Devising a Patent Strategy in China

Giovanni F. Casucci

System

PATENTS

«*literae patentes*»

PUBLIC:stimulate the public disclosure of technical teachings devoted to solve technical issues (incremental innovation)

Aims :

PRIVATE:exclusive right of economic exploitation

System

PATENTS

«*literae patentes*»

Conditions :

- **Enabling disclosure**
- **Novelty and Not Obviousness**
- **Territorial extension claiming and tax payment**

TERRITORIAL EXTENSION of the exclusivity

Time to decide: 12 months from the filing date (Priority)

How to decide: Economic analysis :
COST (certain) / PROFIT (possible)
in a timeframe of 20 years maximum

**Predictive/Prognostic approach within the
timeframe territory by territory (i.e. market
by market)**

Identification of:

- the break even point
- the breaking/lapse point

Issues

TERRITORIAL EXTENSION of the exclusivity

**Elements for
taking decisions:** expectation of:

- **economic success of the technology patented;**
- **general respect of the patent rights;**
- **effective enforceability of the patent in case of infringement**

Issues

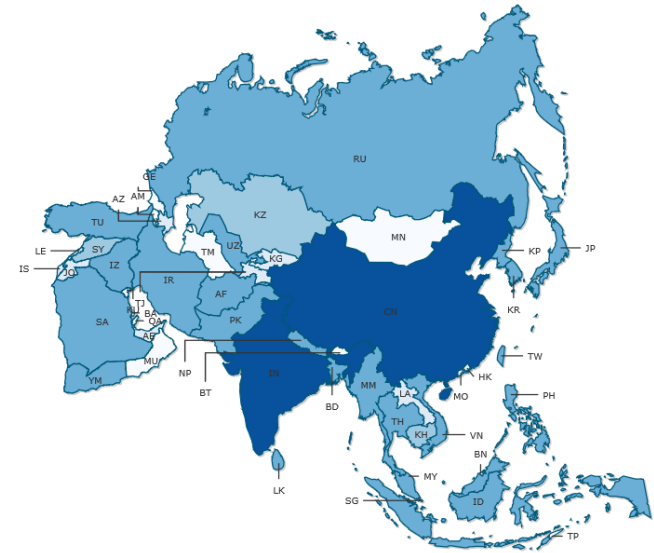
TERRITORIAL / MARKET EVALUATION

worldometers

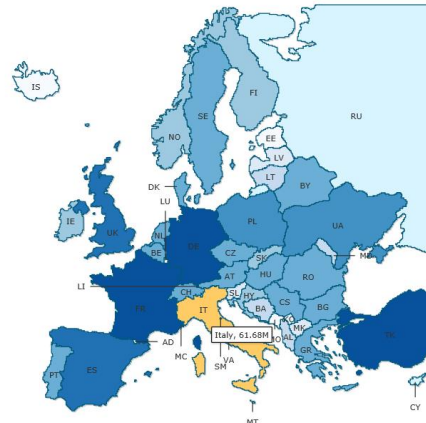
USA
327.243.358



CHINA
1.416.164.221

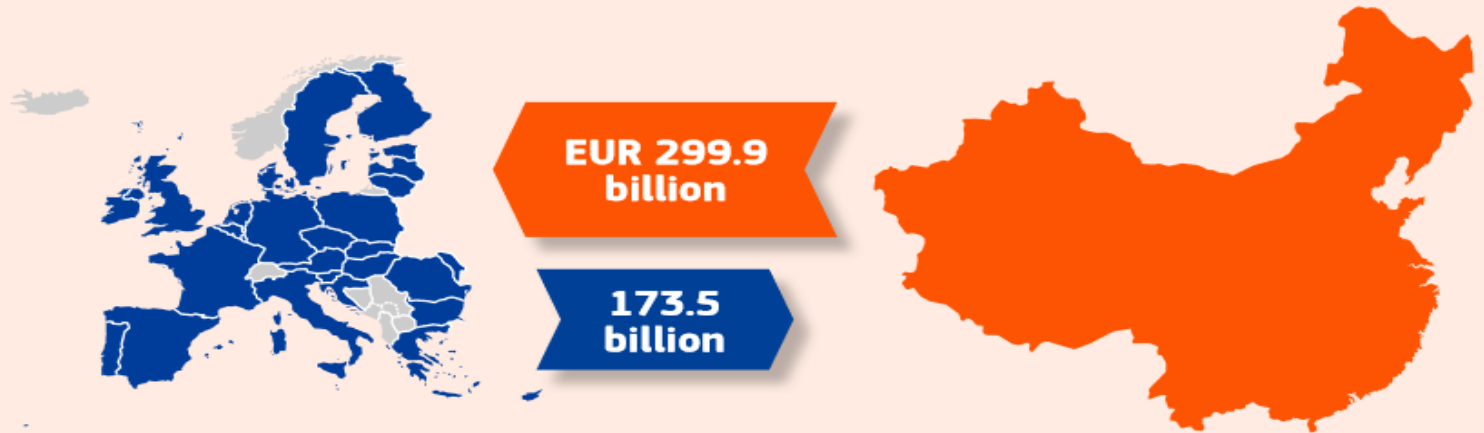


EUROPEAN UNION
742.763.933



Issues

SIZE of Market:



EU exports to Mainland China: EUR 173.5 billion
EU imports from Mainland China: EUR 299.9 billion
Total trade in goods: EUR 473.4 billion

Key INDUSTRY SECTORS:

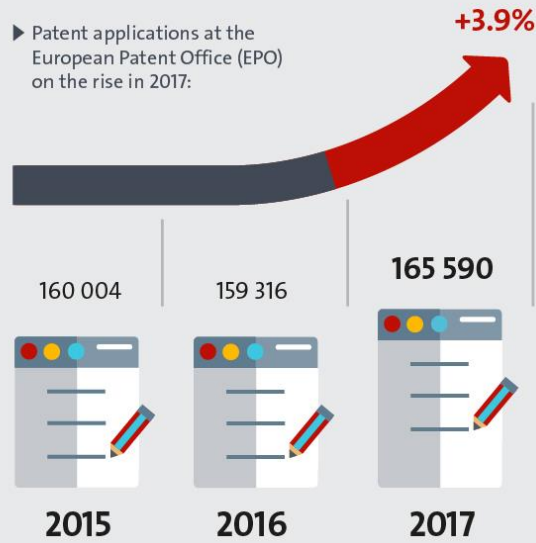
- › EU exports to Mainland China are dominated by machinery and equipment, motor vehicles, aircraft, and chemicals.
- › Mainland China's key export items to the EU include machinery and equipment, footwear and clothing, furniture and lamps, and toys.

Issues

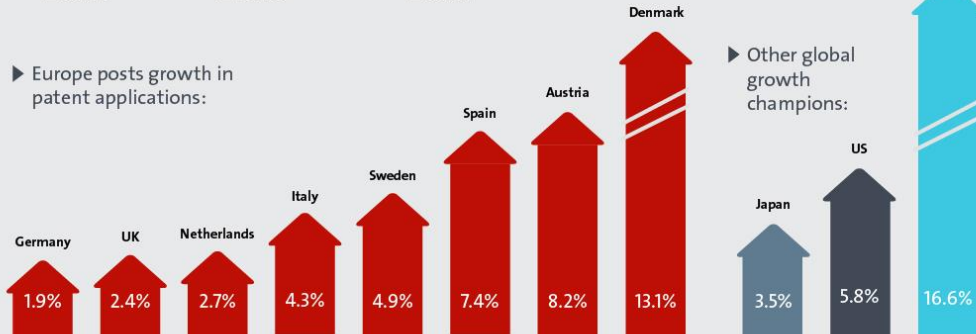
2017 Trends in patenting

Europe is a leading technology market

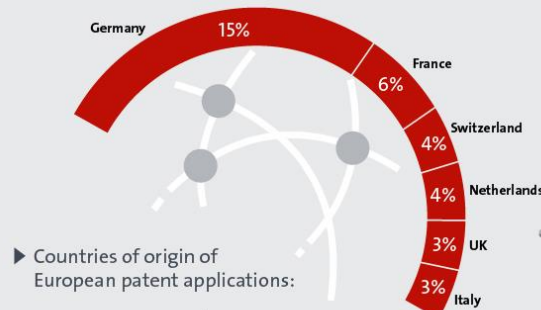
▶ Patent applications at the European Patent Office (EPO) on the rise in 2017:



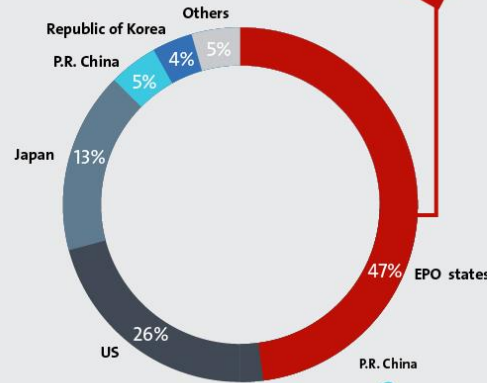
▶ Europe posts growth in patent applications:



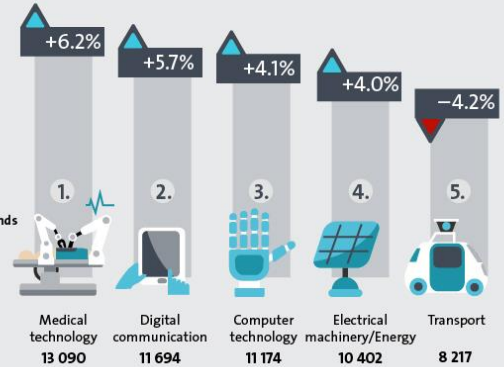
▶ Almost half of the patent applications come from Europe:



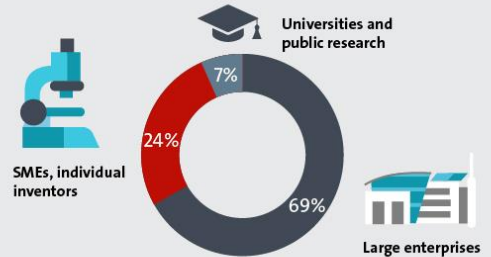
▶ Countries of origin of European patent applications:



▶ Top technology fields:



▶ The EPO serves large and small applicants:



▶ Most active patent applicants:

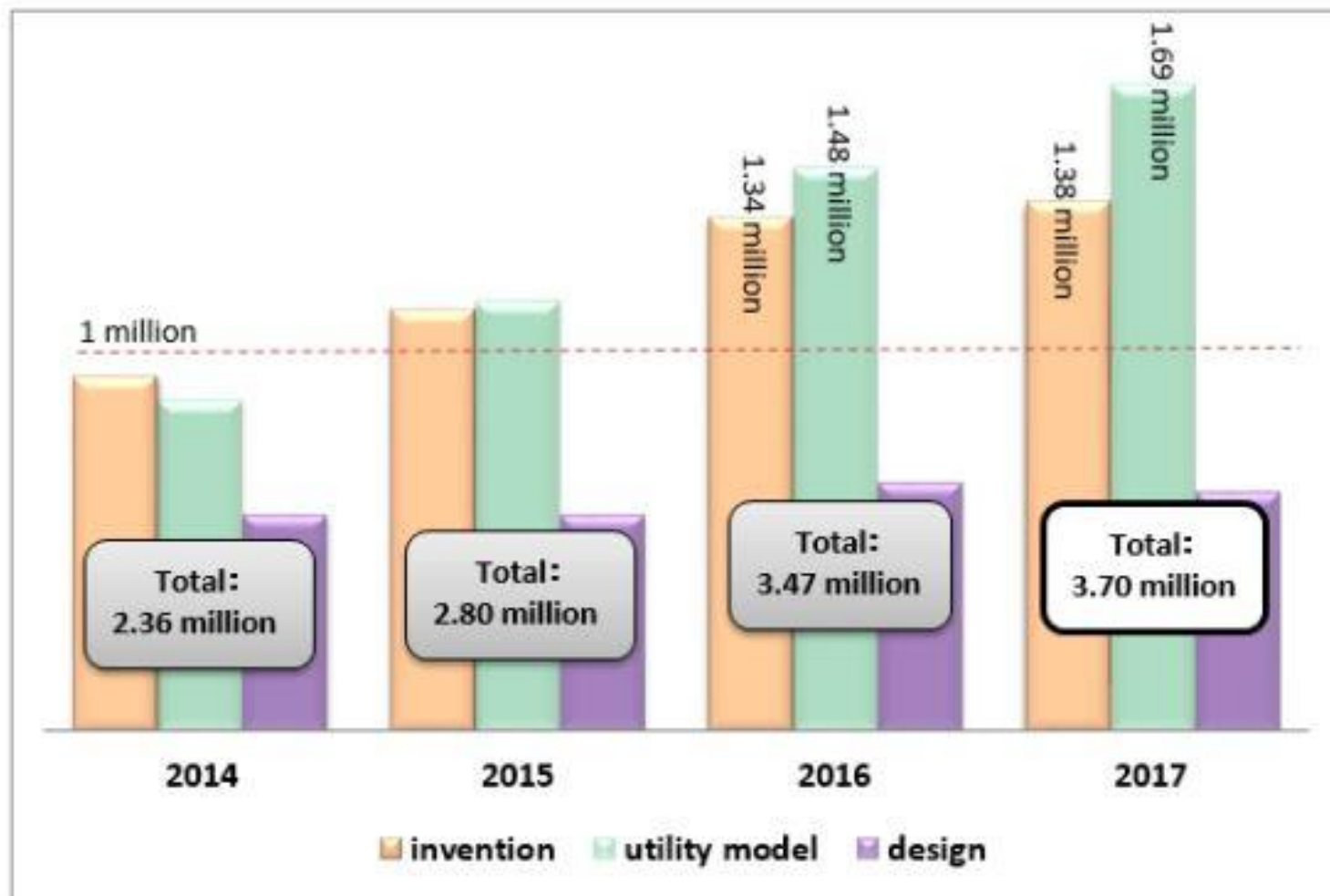


All figures are based on European patent applications.
Source: EPO, Status: 22.1.2018
epo.org/annual-report2017



Issues

【Statistics of patent applications in China 2014-2017】



China's patent applications for invention exceeded 1.38 million in 2017, up 14.2% year on year

[DEQI Intellectual Property Law Corporation](#)

Issues

China to adopt stricter IPR protection: official

dora

© 2018-09-05 15:02:08



BEIJING - China will adopt stricter intellectual property rights (IPR) protection to give impetus to its opening-up, an official said Thursday (August 30).

China will firmly uphold international rules on IPR and protect IPR owned by both domestic and foreign companies, Shen Changyu, head of the State Intellectual Property Office, said at the China Patent Annual Conference held in Beijing.

"IPR protection is key to innovation-driven development and international trade, which also plays an indispensable role in the country's opening-up," Shen said.

Since the implementation of the Patent Law, foreign applicants have applied for more than 1.77 million patents in China, an average annual increase of more than 11 percent.

In 2017, China ranked second in international patent applications, with 51,000 Patent Cooperation Treaty applications.

Shen said China will promote the transformation of intellectual property and encourage technological exchanges and cooperation between Chinese and foreign enterprises.

China will also deepen international cooperation in IPR and promote the building of open, inclusive, balanced and effective international IPR rules, Shen said.

Source: Xinhua

Editor: dora

Patents

EU	CHINA
<p data-bbox="722 379 1020 482">EU China WTO 9 May 2000</p> <p data-bbox="741 562 1000 665">IPR 1 (1999 - 2004)</p> <p data-bbox="672 745 1066 848">IPR 2 (www.ipr2.org) (2007 – 2012)</p> <p data-bbox="807 928 931 1031">IP Key (2013)</p>	
TRIPS Agreement – in force since 1/1995	TRIPS Agreement – in force since 12/2001

Patents

EU	CHINA
<p>Patents</p> <ul style="list-style-type: none">- technical teaching protection- examination through EPO- 20 years from filing date <p>Utility Model</p> <ul style="list-style-type: none">- different <u>aim</u> for each member state- no examination- 10 years from the filing date <p>Validity</p> <ul style="list-style-type: none">- before any IP court OR- before a centralised Court (Dual System (i.e. Germany))	<p>Patents</p> <ul style="list-style-type: none">- technical teaching protection- examination through SIPO- 20 years from filing date <p>Utility Model</p> <ul style="list-style-type: none">- only for <u>product</u> innovation- no examination- 10 years from the filing date <p>Parallel filing strategy</p> <p>Validity</p> <ul style="list-style-type: none">- before SIPO (Dual System)



PATENTS

ISSUES TO BE CONSIDERED

2007

Wenzhou Court (Zhejiang province) assigned damages to
CHINT against Schneider about Rmb330m (US\$48mln)

Settlement at \$23mln)

CHINT

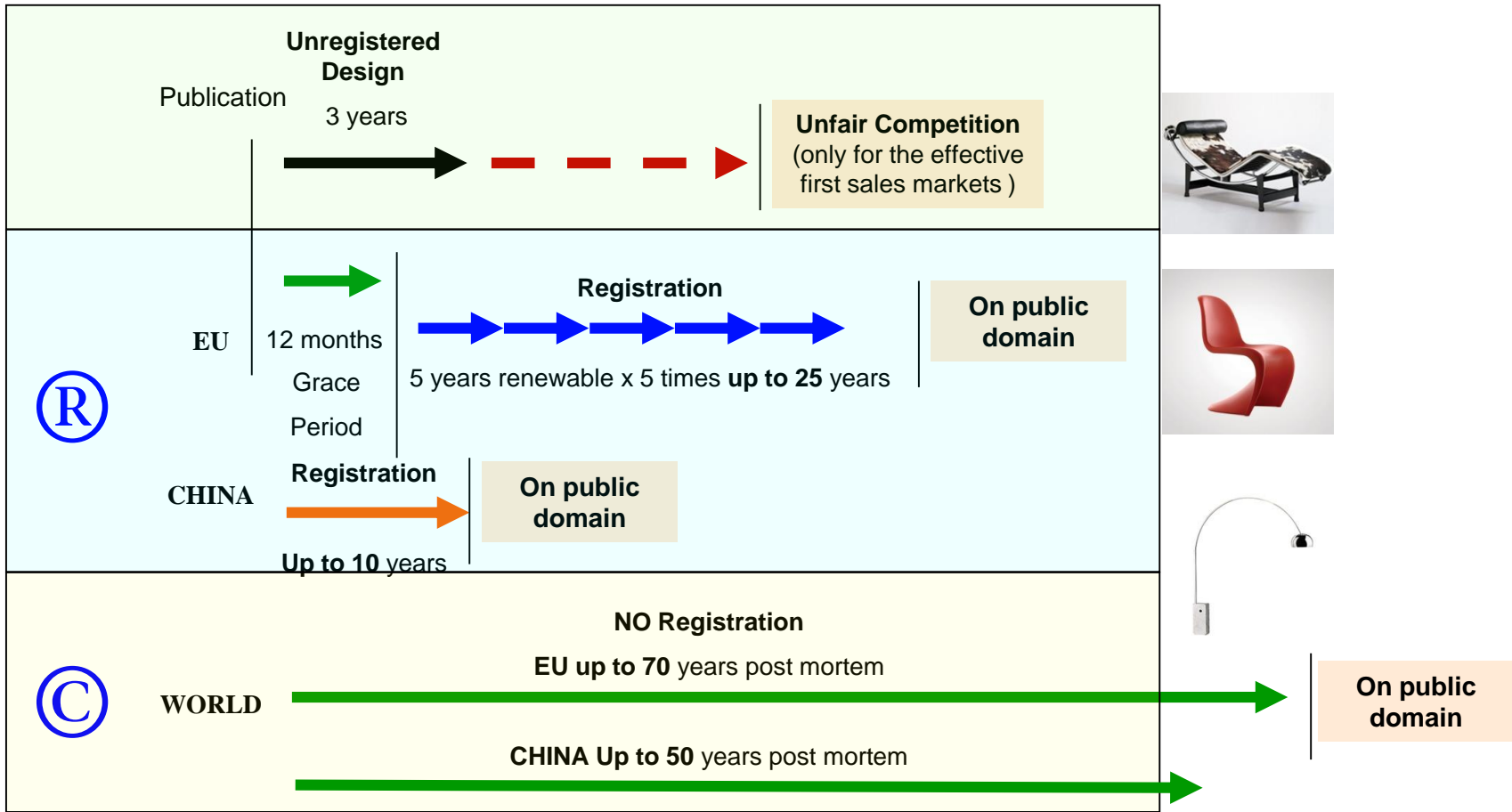
Schneider
Electric



Designs

EU	CHINA
<p>Duration - 25 years (5 years renewal periods)</p> <p>Novelty (relative) - 1 year <u>grace period</u></p> <p>Individual Character Difference from prior art</p> <p>Filing - multiple filings</p>	<p>Duration - 10 years (annual renewal)</p> <p>Novelty (absolute) - 6 months <u>priority</u></p> <p>Individual Character <u>Substantial</u> difference from prior art</p> <p>Filing - individual shapes (option of multiple filings only for the same category – max 10)</p>

Designs



Thank you !



Giovanni Francesco Casucci

Partner

Head of IP and Technology

M +39 335 21 84 33

E giovanni.casucci@dentons.com