

Entitlement to the Priority Right: Discussions on Chinese Requirement of the Same Invention

A priority right, defined by the Paris Convention or multilateral agreements, allows the claimant to file a subsequent application for the same invention or design effective as the date of filing the first application. Once a priority is validly claimed, the effective filing date would be used to examine the novelty and inventiveness for the subsequent application.

For a valid claim to priority, the following criteria must be met: (i) the first application must be filed in a recognized jurisdiction; (ii) the applicant of the subsequent application must be the same as or the successor in title of the applicant of the first application; (iii) the subsequent application must be made in 12/6 (invention/design) months from the date of the first application; and (iv) the subsequent application covers the same invention as the previous one.

This short article discusses the last criterion for the “same invention” under current Chinese practice.

Law and Regulations

According to Article 29 of the Chinese Patent Law, within twelve months from the date on which any applicant first filed in a foreign country an application for a patent for invention or utility model, or within six months from the date on which any applicant first filed in a foreign country an application for a patent for design, he or it files in China an application for a patent for the same invention, he or it may, in accordance with any agreement concluded between the said foreign country and China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of mutual recognition of a right of priority, enjoy a right of priority. Where, within twelve months from the date on which any applicant first filed in China an application for a patent for invention or utility model, he or it files with the patent administration department under the State Council an application for a patent for the same subject matter, he or it may enjoy a right of priority.

It can be seen that when the establishment of priority is being verified, regardless of a foreign priority or a domestic priority, the general criterion is whether they belong to the “same invention” or not.

Part II, third chapter, section 4.1.2 of the Guidelines for Patent Examination (2010 edition) states that an invention or utility model for the same invention as referred to in Article 29 means an invention or utility model with the same technical field, technical problem to be solved, technical solution, and prospective effect. It should be noted the term “same” herein does not mean that the wording or manner of description is exactly the same.

If the difference in expression between a subsequent application and a previous

application is merely a simple text conversion, or the technical solution of the subsequent application is the technical content that can be determined directly and undoubtedly from the previous application, then they belong to the same inventions. That is, it is necessary to judge whether the technical solutions are substantially the same, while excluding “generic term and specific term”, “direct substitution of customary means” or “overlapping or partial overlapping of numerical ranges”.

Cases

[Case 1] ①

The previous application describes a magnetic material containing elemental Fe. The subsequent application claims a magnetic material containing a transition metal element.

[Case Analysis]

The technical solution containing the transition metal element in the subsequent application is not described in the previous application. Although the previous application describes a solution containing elemental Fe and the elemental Fe is a specific concept of transitional metal elements, the technical solution containing the transitional metal element cannot be directly and undoubtedly determined by the previous application, and thus the subsequent application cannot benefit from the priority of the previous application.

If the previous application describes a magnetic material containing a transition metal element and does not describe a magnetic material containing the elemental Fe, and the subsequent application claims a magnetic material containing elemental Fe, then the subsequent application cannot benefit from the priority of the previous application, either.

[Conclusion]

If a feature (or features) of the subsequent application and the previous application is in a relationship of a general concept and a specific concept, the subsequent application cannot benefit from the priority of the previous application.

[Case 2]

The previous application describes a device that is secured with a nail. The subsequent application claims the priority of the previous application, but it claims a device that is secured with a bolt.

[Case Analysis]

Although replacing a nail securing solution by a bolt securing belongs to a direct substitution of customary means, the technical solution of the subsequent application cannot be directly and unambiguously determined from that of the previous application. Therefore, the subsequent

application cannot benefit from the priority of the previous application.

[Conclusion]

If the subsequent application claims the priority of the previous application, but the technical feature(s) of the subsequent application is a direct substitution of customary means of the technical feature(s) of the previous application, then the subsequent application cannot benefit from the priority of the previous application.

[Case 3]

Table 1 lists some judgment examples to show whether the subsequent application can claim the priority of the previous application or not when the oxygen contents for the previous application are the values in the first column, the oxygen contents for the subsequent application are the values in the second column, while the other technical features are the same.

Table 1. Examples of partially overlapping numerical ranges

Previous application:	Subsequent application:	Analysis
a combustible gas, in which the volume content of oxygen is	a combustible gas, in which the volume content of oxygen is	
20%~50%	30%~60%	The oxygen content range of the subsequent application from 30% to 60% only partially overlapping with the oxygen content range of the previous application from 20% to 50%, and neither does the previous application describe the oxygen content range of 50% to 60%, nor clearly describe the oxygen content of 30%. Therefore, the technical solution that the oxygen content is in the range of 30% to 60% cannot be directly and undoubtedly determined from the previous application, so the subsequent application cannot benefit from the priority of the previous application
20%~50%、30%	30%~50%	Although the previous application does not explicitly describe that the oxygen content ranges from 30% to 50%, since the previous application describes that the oxygen content

		ranges from 20% to 50%, and further describes that the oxygen content may be 30%, it can be determined directly and undoubtedly from the previous application that the oxygen content can range from 30% to 50%, so the subsequent application may benefit from the priority of the previous application
20%~50%	30%~50%	The previous application does not describe a value of 30%, and it cannot be determined directly and undoubtedly from the previous application that the oxygen content may be in the range from 30% to 50%, so the subsequent application cannot benefit from the priority of the previous application
20%~50%、30%、35%	30%、35%、50%	The previous application already describes the two point values of 30% and 35% and endpoint value of 50%, so the subsequent application may benefit from the priority of the previous application
20%~50%、30%	30%、35%、50%	The previous application describes the technical solutions of oxygen content of 30% and 50%, thus the technical solutions of oxygen content of 30% and 50% in the subsequent application may benefit from the priority of the previous application. However, the previous application does not describe the technical solution of oxygen content of 35%, and thus such a technical solution cannot be determined directly and undoubtedly from the previous application. Thus, the technical solution of oxygen content of 35% in the subsequent application cannot benefit from the priority of the previous application
20%、50%	20%~50%	The previous application does not describe the technical solution of oxygen content in the range from 20% to 50%, and the technical solution cannot be determined directly and undoubtedly from the previous application. Therefore, the subsequent application cannot benefit from the priority of the previous application.

[Conclusion]

If the technical solution claimed in the subsequent application comprises a numerical range that is partially overlapped with the numerical range described in the previous application, the subsequent application cannot benefit from the priority of the previous application.

Attorney Comments

When determining whether the subsequent application is of the same invention as the previous application, the previous application should be analyzed and studied as a whole that includes both the specification and the claims (excluding the abstract) of the previous application, as well as the drawings. It should be noted that the drawings are part of the disclosure of the previous application. For the invention and utility model patent application with drawings, the drawings can often play an important role in disclosing the contents of the invention and accurately explaining the technical solutions.

For example, in an invalidation case referred in Examination Decision on Request for Invalidation No. 17763, the invalidation petitioner submitted that the "one side of the concave cross section is provided with a cavity with an inside shape of circle and an outside shape of square" was not described in its priority document. The collegial panel considered that according to the description of the priority document and the accompanying drawings, the priority document actually includes the content of the above technical feature in claim 1 of the present patent, and therefore, both of them belong to an invention of the same subject matter, and thus claim 1 can have the benefit of the priority^②.

In summary, when determining whether the previous application and the subsequent application belong to the same invention or not, first the previous application should be considered as a whole, and then determine whether the subsequent application can be determined directly and undoubtedly from the previous application, and whether the subsequent application is a modification, supplement or improvement of the previous application, in order to obtain a more comprehensive patent protection. This reminds us that it should be noted that in drafting a priority document, the general concept and specific concept of one or more features should be recorded in the document as much as possible; for the numerical range, as many specific values as possible should be stated within the possible numerical range; for features that may be directly substituted by customary means, as

many features that may be substituted as possible should be stated in the previous application. In this way, when the subsequent application is proposed by modifying, supplementing and improving the previous application with new technical features, rejections of introducing new matters, resulting in losing the priority of the previous application can be avoided.

It should be specially pointed out that if the benefit of priority cannot be claimed because of the modification, supplement and improvement of the previous application, it should be especially cautious for the prevalent earlier publication. Because when an earlier publication is requested (published in 3-6 months or an even shorter term), sometimes there will be cases in which the previous application has been published, but the subsequent application has not been filed yet. In this case, if the subsequent application cannot claim the priority of the previous application for the aforesaid reasons, the previous application that is already disclosed becomes the prior art of the subsequent application and may be used to evaluate the novelty and inventive steps of the subsequent application, sometimes leading to the situation that the applicant's own previous application destroys the patentability of his own subsequent application.

For example, in a patent invalidation case, a compound crystal patent (Patent No.: ZL201510398190.1, filed on July 8, 2015) includes 10 claims totally, wherein claims 1 to 3 are product claims related to the crystal of a compound, claims 4 to 9 are method claims related to the preparation of the crystal of the compound, and claim 10 is a pharmaceutical use claim of the crystal of the compound. The patent applications related to this patent include: CN104072413 (filed on July 8, 2014, and published on October 1, 2014), which is a previous application of the present patent (Evidence 1 in the invalidation); and CN1016762677 (filed on September 16, 2008, and published on March 24, 2010), which is a patent application for a compound related to the present patent of the compound crystal (Evidence 6 in the invalidation).

In the process of invalidation, the reexamination board considered that because of the addition of a technical feature in claim 3 of the patent and the deletion of several technical features of claims 4 to 9, those technical solutions are not recorded in the previous application documents and therefore cannot claim the benefit of priority. For the same reason, the technical solution of claim 10 cannot claim the priority when depending on claim 3.

Even more inconceivably, the previous

application CN104072413 of this patent has a publication date even earlier than the filing date of the patent, and thus can be used as a prior art to evaluate the novelty and inventive steps of the patent.

Finally, the reexamination board decided that claims 4 to 9 of the compound crystal patent did not possess novelty in view of evidence 1, and that claims 1 to 3 and 10 did not possess inventiveness in view of evidence 6 and common sense, and the patents were totally invalidated.

The above example also gives us an inspiration that due to the stringent requirements for the establishment of priority in Chinese patent practice, the priority of some claims may not be established (especially in the case that the priority is a U.S. provisional

application). Therefore, it is worth challenging the priority during invalidation procedures, especially in case that any intermediate document has been found.

References

- ① State Intellectual Property Office of the People's Republic China. Examination Operation Regulations [M]. Beijing: Intellectual Property Press, 2011
- ② Wang Putian, Li Yalin. Research on Judgment Criteria of Same Subject Matter in Verification of Patent Priority. Patent Agency [J] .86-90

The newsletter is not intended to constitute legal advice. Special legal advice should be taken before acting on any of the topics addressed here.

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