

# 美国外观设计申请中国专利

## Registration of US designs as Chinese patents



苍雨春  
Spring Chang  
铸成律师事务所  
合伙人  
Partner  
Chang Tsi & Partners

田强  
John Tian  
铸成律师事务所  
专利代理人及律师  
Patent Agent and Attorney  
Chang Tsi & Partners

由于专利权所具有的地域属性，外国申请人的外观设计在申请了本国专利之后必须向中国专利局提出申请才有可能获得中国的专利权。因此，外国申请人如果希望一件外观设计申请快速通过中国专利局的审查，应该在申请之初就多了解中国外观设计审查制度的要求并尽可能满足这些要求。而且，各国的专利法律不尽相同，导致不同国家的外观设计申请在中国申请专利时面临的修改要求也不尽相同。

### 中美审查制度比较

从快速通过中国专利申请审查的角度来看，美国与中国在外观设计专利审查制度方面的主要区别在于：

- 美国仅容许提交线条绘制的图形作为申请文件；中国外观设计申请既接受线条绘制的图形，也接受产品的照片。
- 美国容许对产品的局部设计提交申请和使用阴影线绘图；中国外观设计制度不保护局部设计，也不容许使用阴影线等线条。

针对中美两国上述法律和审查制度上的区别，申请人应该根据自己是否要求优先权，从下文提及的几方面做好应对中国专利申请审查的准备工作。

### 要求美国优先权的申请

建议申请人遵循如下步骤提出中国专利申请，而且尤其需重视第2步的工作，否则，将导致申请人外观设计在中国得到专利保护的时间推迟，而且还会发生更多的费用。

- 首先，申请人向中国专利局提交一份与美国申请完全一致的外观设计图片，以便

确保其中国专利申请能够安全的享有美国优先权；

- 然后，申请人可依据《专利法实施细则》第51条第2款的规定，在提交中国专利申请之日（申请日）起的两个月内对原始提交的图片进行主动修改，即提交一套能够满足中国外观设计专利申请审查要求的图片。

在进行主动修改时，申请人应该注意以下问题：

1. 原有的实线通常不能够删除，除非是遇到视图之间彼此不对应的情况，才可以删除明显错误的实线条。
2. 阴影线、点划线等其他不符合中国审查要求的线条一律删除。
3. 原有的虚线通常可以直接删除，但在下述情形下的虚线不能直接删除，而只能用实线予以替代：
  - 删除虚线后导致产品不成为一件完整的产品。美国外观设计申请容许申请人对产品的外观设计区分要求保护的部分（用实线绘制）和不要求保护的部分（用虚线绘制），而中国的外观设计制度仅容许申请人就整个产品提出保护请求。中美两国的上述差异导致了要求美国优先权的申请人必须将本不希望保护的部分也纳入中国申请的保护范围，也就是说，该外观设计申请美国专利（原始申请）时用虚线表示的不要求保护部分的轮廓线也必须用实线予以替代，而不能直接将其删除。
  - 删除虚线后导致轮廓线不闭合。由于产品的轮廓线必须是闭合曲线，因此原始申请中虚线表示的轮廓线必须使用实线予以替换而不能删除。对于非轮廓线的虚线，



北京市西城区北展北街  
华远企业号A座7/8层  
7-8th Floor Tower A, Hundred Island Park,  
Bei Zhan Bei Jie Street, Xicheng District, Beijing  
邮编 Postal code: 100044  
电话 Tel: + 86-10-8836 9999  
传真 Fax: + 86-10-8836 9996  
www.ctw.com.cn  
电子信箱 E-mail: mail@ctw.com.cn

申请人可以完全删除、选择性的删除或者全部替换成实线。

- 仅删除原始申请中用虚线表示的某一图案的一部分而保留另一部分。因为这会导致修改后的形状、图案与原始申请中的形状、图案不同，从而被专利审查人员认为是超出了原始申请图片的范围，因此不被接受。举例而言，假如原始申请中虚线绘制的图案中包括一个“四叶草”的图案，申请人可以完全删除该“四叶草”或者将该“四叶草”的虚线全部替换成实线从而将其全部保留，但是申请人不能仅删除“四叶草”中的某一片叶子，而将“四叶草”改为“三叶草”。

### 不要求美国优先权的申请

事实上，申请人也可以在获得美国专利局的国外申请许可之后，不要求美国外观设计专利申请的优先权，而直接向中国专利局提交一份经过主动修改的、满足中国审查要求的外观设计申请图片。与上述申请人要求优先权的方式相比，这种提交中国申请但不要求优先权的方式更有利于申请人根据实际需要作出修改。由于不受在先申请的限制，专利审查人员不会考虑修改是否超范围的问题，而且这样的中国外观设计专利申请有可能不经过补正程序直接通过审查。

然而，当采用这种申请方式时，申请人唯一需要注意的问题就是，在向美国提交申请之后以及向中国提交申请之前，绝对不能向公众公开此设计。我们建议申请人一旦获得美国专利局的国外申请许可，就立刻向中国专利局提交申请；如果由于疏忽或其他原因造成设计图片在美国申请日之后被公开，申请人则只能通过第一种要求优先权的方式寻求在中国的专利保护。■

**D**ue to the territorial nature of patents, foreign patent-holders who have already applied for patents for their designs in their own countries must also apply to the State Intellectual Property Office (SIPO) for protection under a PRC patent. If a foreign applicant wants a speedy patent registration process at the SIPO, it must first understand the process and seek to satisfy its requirements as far as possible. Moreover, as different countries have different patent laws, designs from different countries may need to be altered when a PRC patent is being applied for.

### The PRC and US systems

For the purpose of achieving a quick Chinese patent registration, the main differences between the Chinese and US patent application systems are:

- in the US, only line drawings can be submitted, whereas in China, both line drawings and photographs of the product are acceptable;
- in the US, application for approval of part of a product is allowed, and so is using hatched lines in the drawings. In China, neither is acceptable.

In view of the differences between the law and registration process of the two countries, applicants should prepare themselves for the Chinese patent application in the ways described below, depending on whether they are applying for a right of priority.

### US right of priority

In order to benefit from a US right of priority, it is recommended that applicants follow the steps below, especially the second step. Otherwise, the application may be delayed and costs may increase.

- first, the applicant must submit to the SIPO an identical copy of the drawings it submitted to the US authorities, to ensure that the Chinese patent application will fully enjoy the priority date set in the US;
- after that, an applicant may amend the drawings originally submitted to the Chinese authorities within two months of the filing date, in accordance with rule 51(2) of the *PRC Patent Law Implementing Rules*,

in order to ensure that it can provide the authorities with a set of drawings which comply with the requirements of the PRC patent registration system.

The applicant should be aware of the following when it submits amendments:

1. Solid lines in the original submission normally cannot be deleted, unless leaving them in will cause the drawings to be inconsistent with each other, in which case solid lines which are obviously incorrect can be deleted.
2. Lines which do not conform to PRC requirements, such as hatched lines and dotted lines, must be removed.
3. Dotted lines in the original submission can normally be removed. In the following circumstances, dotted lines cannot be removed but must be replaced by solid lines:

- If removing the dotted lines will result in the product being incomplete. US applications allow applicants to differentiate between parts which they claim (drawn by solid lines) and parts which they disclaim (drawn by dotted lines). The Chinese system only allows applicants to submit applications for the whole product. This difference in law results in applicants who want to enjoy the US right of priority having to apply for protection of parts that it would not otherwise seek protection for. Practically, this means that outlines represented by dotted lines in the original US application must be replaced by solid lines, and must not simply be removed.
- If gaps will be created in the outlines after the removal of dotted lines. Because the outlines of products must be represented by closed curved lines, any dotted lines used in the original application's drawing must be replaced by solid lines, and not simply deleted. For dotted lines which are not outlines, applicants can remove them completely or selectively, or replace them all with solid lines.
- Deletion of the dotted lines in part of a design, while keeping other parts unchanged. This is because the design's shape and pattern will become different from its original (pre-amendment) shape and pattern, leading to rejection on the basis that the scope of the original application

has been exceeded. As an example, if the original application contains a four-leaf clover pattern drawn by dotted lines, the applicant can completely remove the clover, or replace all the dotted lines of the clover with solid lines and thus retain the clover, but it cannot remove just one leaf of the clover and turn it into a three-leaf clover.

### Applications without US priority

After having obtained the permission from the United States Patent and Trademark Office to register abroad, an applicant can forgo the priority established by the US patent application, and instead directly file with the SIPO an application consisting of drawings which have been amended in a way which satisfies the requirements of the PRC system. Compared to the above method, this method facilitates practical amendments to be made by the applicant. Because the registration authorities are not constrained by prior applications, they will not have to address the issue of whether amendments have exceeded the original scope. In addition, this kind of application may be granted without having to go through the amendment stage.

The only thing to bear in mind when using this method is that, during the time between the applicant submitting an application in the US, and the time it submits one in the PRC, it must not disclose its design publicly.

We recommend that once the applicant has permission from the United States Patent and Trademark Office to register abroad, it submit its application in China immediately. If, due to omission or any other reason, the design was made public after the US application has been filed, the applicant must use the first method – i.e. applying for a right of priority of the US application – to obtain protection in China. ■

苍雨春是铸成律师事务所的创始合伙人，知识产权业务负责人

*Spring Chang is a co-founder of and partner at Chang Tsi & Partners. Her practice focuses on intellectual property*

田强是铸成律师事务所的专利代理人及律师

*John Tian is a patent agent and attorney at Chang Tsi & Partners*