

Monthly Newsletter

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Happy New Year
2024

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Holiday Notice

Please be advised that December 30th, 2023, to January 1st, 2024, has been designated as a Public Holiday. Consequently, Mainland China, Taiwan, Hong Kong, and Macao IP Offices will be closed during this timeframe.

All deadlines falling on a holiday will be automatically extended. Should you have any urgent matters, kindly provide us with instructions prior to the commencement of the holidays.

Spring Chang Honored as 'IP Lawyer of the Year' by the Legal 500

We are honored to announce that at the Legal 500 2023 China Awards, Spring Chang, the founding partner of Chang Tsi & Partners, has been awarded the "IP Lawyer of the Year", becoming the sole recipient of this prestigious accolade.

This honor not only validates Chang's exceptional capabilities and commitment in the field of intellectual property law but also fully recognizes the exquisite legal services provided by the Chang Tsi team.



As a leading global legal service rating organization, The Legal 500's annual awards aim to commend lawyers and law firms who have shown outstanding performance in various legal fields. These awards go through a stringent review process, including comprehensive evaluations of recommendations from law firms, self-nominations by lawyers, and client feedback, eventually selecting distinguished professionals in their respective domains.

With deep professional knowledge and extensive legal practice experience in intellectual property law, Spring Chang has successfully represented numerous renowned enterprises in complex IP cases. Providing precise legal strategies and achieving significant results in IP litigation and enforcement, this award is a high recognition of her professional prowess in the IP field.

Chang Tsi & Partners consistently upholds the philosophy of "being the best law firm in China, providing the finest legal services, and maximizing clients' legal rights", tirelessly striving for excellence. With rich industry experience and profound professional knowledge, Chang Tsi is committed to offering the most professional legal services. If you need assistance in foreign-related intellectual property matters, the Chang Tsi team is ready to serve you, providing comprehensive and one-stop solutions.

Partner Michael Fu Recognized Among LEGALBAND's Top 15 Foreign-Related Lawyers

As 2023 comes to a close, Chang Tsi & Partners has once again captured a significant award—our partner Michael Fu has been honored on the LEGALBAND "Client Choice: Top 15 Foreign-Related Lawyers" list, a testament to the professional prowess and market recognition of Chang Tsi attorneys.

With China strengthening its opening up and international cooperation, Chinese enterprises have a clear "going global" strategy, which has also attracted a substantial amount of foreign investment. Under this backdrop, the demand for foreign-related legal services has seen a rapid growth.

Based on meticulous reviews of recommendations from various law firms, self-nominations by lawyers, and client feedback, and combined with LEGALBAND's on-the-ground research team's long-term focus and insight into foreign-related legal services, the "Top 15 Foreign-Related Lawyers" list has been finalized, featuring 15 favored lawyers in this field.

These outstanding foreign-related lawyers have profound legal knowledge, an international perspective, and an in-depth understanding of the legal environments both at home and abroad. Our Partner Michael Fu has been dedicated to the field of intellectual property legal services for over 15 years, amassing extensive legal practice experience in trademarks, copyrights, domain names, industrial design, and IP enforcement. His portfolio of representative clients includes leading enterprises such as Mondelēz International, Tiffany & Co., Michael Kors, Under Armour, and Four Seasons.

"Michael Fu is a reliable and trustworthy attorney. He understands current legal practices and always proposes appropriate solutions to complex issues. We highly value the legal services provided by Michael Fu's team."



Client Choice:
Top 15 Foreign-related Lawyers

客户首选：涉外律师15强



Work Review of Chang Tsi Customs Training Efforts in 2023

Matt Hou

Over the years, Chang Tsi & Partners has maintained a strong relationship and close collaboration with Customs at various levels in China. Participating in intellectual property protection training organised by Customs across the country has been a crucial aspect of Chang Tsi's daily work.



The objective of participating in IP protection training for Customs officers is to enhance their comprehension of the brand owners' fundamental IP rights and core products, thereby enabling them to execute their responsibilities more effectively during import and export inspections, safeguarding the rights of the brand owners by crackdown on counterfeit goods. Based on our experience and data analyzed, the participation in Customs training shown a significant enhancement in border protection for brand owners. The Customs seizure cases will increase a lot at certain Customs after the training is conducted in the same Customs. Thus, the seats on behalf of brand owners to participate in the Custom training are very limited, many brand owners would like to join the training to increase their border protection.



The Customs trainings on IP protection typically encompass the following aspects:

1. Introduction of brand owners: Chang Tsi shall act as the representative of its clients, and serve as the speaker to acquaint Customs officers with the various types of IP rights owned by its clients. Chang Tsi shall provide a comprehensive overview of its clients' key IP rights and core products.
2. Identification of IP Infringement: Furthermore, Chang Tsi, in its role as the speaker, shall also provide guidance to Customs officers responsible for import and export inspections on how to identify suspicious infringing products. In the event that any suspicious infringing products are discovered, immediate notification of such information shall be relayed to Chang Tsi or the brand owners.
3. Case Studies and Discussions: Chang Tsi shall engage in in-depth communication with Customs authorities to gain insights into their attitudes and approaches towards handling IP infringement issues. This shall entail studying authentic cases of IP seizure cases handled by Customs, researching relevant laws and regulations, and understanding how Customs officers address IP infringement issues during their frontline inspection works.

In 2023, Chang Tsi has participated in Customs IP protection trainings held by 6 different Customs, namely Shenzhen Customs, Qingdao Customs, Kunming Customs, Changsha Customs, Harbin Customs and Chongqing Customs. These Customs are pivotal in China's import and export trade, spanning across the northeastern, central, southwestern, northern coastal, and southeastern coastal regions of China. Their role in border protection for brand owners is of paramount significance. Chang Tsi, on behalf of a total of 30 brand owners, delivered presentations at the aforementioned customs offices, significantly deepening the customs' impression of their brands and products.

In 2024, Chang Tsi will continue to strengthen communication with Customs throughout China and actively participate in customs training programs on IP protection. This will enable us to assist our clients in continuously enhancing their efforts in IP border protection. If you have any questions or specific requirements regarding Customs trainings, please feel free to contact us at any time.

Analysis and Brief of "Guidelines on Patentable Subject Matter of Chinese Utility Model Patent" issued by the China Patent Office

David Liu

Utility model is one of the three types of patents in China. Determining what subject matter of a utility model is patentable is an important part of the practice of utility model prosecution. Recently, the State Intellectual Property Office in China (hereinafter referred to as the "SIPO") issued the "Guidelines on Patentable Subject Matter of Chinese Utility Model Patent" (hereinafter referred to as the "Guidelines"). In the Guidelines, the SIPO published the relevant provisions on patent-eligible subject matters of utility model and gave relevant examples. Reviewing and understanding the Guidelines will help patent practitioners accurately understand the boundaries of the subject matters protected by utility model patents, and promote the improvement of the quality of utility model patent prosecution.

Generally speaking, **Article 2, Paragraph 3 of the China Patent Law stipulates that a utility model refers to a new technical solution proposed for shape, structure or combination of shape and structure that is suitable for practical use.** From this point of view, "product", "shape/structure" and "technical solution" constitute the three elements of a utility model. Generally speaking, in a claim set of a utility model patent application, if any one of the above three elements is not satisfied, it is not a patent-eligible subject matter of utility model. The Guidelines start from the patent law and patent examination guidelines, and discuss the above three elements one by one. I will analyze and summarize the key contents of the Guidelines as follows:

1. Regarding the first element - "product"

The Guidelines emphasize that the "product" protected by a utility model should be an object that can be manufactured through industrial methods, has a definite shape, structure, and occupies a certain space. All methods and naturally existing items that have not been artificially manufactured are non-patentable subject matters of utility model patents.

1.1 Regarding subject name

A utility model does not protect "method". If the subject name of a claim in a utility model application is drafted as "a method for ...", then it is not a patentable subject matter of utility model.

1.2 Regarding names of known methods

Utility model claims can use the "name" of a known method to define the shape and structure of a product. However, it should be noted that the following claims are not able to be granted as utility model:

- a) a claim for a method or process;
- b) a claim for improvement of a method/process; and
- c) a claim including both shape/structural features of a product and improvements to a method.

1.3 Regarding computer programs

A summary of the relevant descriptions on computer programs in the Guidelines is as follows:

Description	Patentable Subject Matter?
A claim including the name of a known computer program	√
A claim that includes (1) improvements to computer hardware and (2) a known computer program	√
A claim that includes (1) improvements to computer hardware and (2) improvements to a computer program	×
A claim that is formally written as a product claim, but is essentially a program module claim	×

2. Regarding the second element- "shape/structure"

According to Article 2, Paragraph 3 of the China Patent Law, a utility model should be an improvement in the shape and/or structure of a product.

The shape of a product refers to the definite spatial shape that the product has and can be observed from the outside. The structure of a product refers to the arrangement, organization, and interrelationship of the various components of the product. Mechanical structure, circuit structure, and composite layer structure belong to the structure of the product.

2.1 Regarding shape

A summary of the relevant descriptions on shape in the Guidelines is as follows:

Description	Patentable Subject Matter?
Biological or naturally occurring shapes which are used as shape features of product	×
Non-deterministic shapes (e.g., shapes obtained by placing, stacking, etc.) which are used as shape features of product	×
A certain technical feature in the product is a substance with no definite shape (such as gaseous, liquid, granular substances), and the substance with no definite shape in the product is limited by the structural characteristics of the product	√
A product has a definite spatial shape under certain circumstances	√

2.2 Regarding layered structure and circuit structure

Generally speaking, layered structure and circuit structure belong to the structure of a product. The circuit structure usually includes electrical circuits, gas circuits, hydraulic circuits, optical circuits, etc. The determined connection relationship between the various components of the circuit can be a wired connection or a wireless connection. However, the printed layer of a product does not belong to its structure, that is, the information layer containing patterns, texts, symbols, etc., formed on the surface of the product through printing or drawing process does not belong to the structure of the product.

2.3 Regarding material features

A summary of the relevant descriptions on the material features in the Guidelines is as follows:

Description	Patentable Subject Matter?
A solution improving the shape of a product solely for aesthetic purpose which does not solve technical problems	×
A solution improving the shape of a product which not only aims at aesthetics, but also objectively uses technical means that conform to the laws of nature to solve technical problems and produces technical effects.	√

2.4 Regarding food

Whether a food item is a patent-eligible subject matter lies in whether it includes improvements to its food material. If it includes improvements to the food material, then it is not a patentable subject matter of utility mode.

3. Regarding the third element - "technical solution"

The Guidelines point out that the technical solution mentioned in Article 2, paragraph 3, of the China Patent Law refers to a collection of technical means that utilize the laws of nature to solve the technical problem. Technical means are usually reflected by technical features. Solutions that do not use technical means to solve technical problems to obtain technical effects that conform to the laws of nature are non-eligible subject matters in terms of utility model.

3.1 Regarding surface pattern and color

A summary of the relevant descriptions on surface pattern and color in the Guidelines is as follows:

Description	Patentable Subject Matter?
A solution for text, symbols, graphics or their combination on product surface	×
A solution for patterns, colors or their combinations on product surface which does not solve technical problems	×

3.2 Regarding aesthetic purpose

A summary of the relevant descriptions on aesthetic purpose in the Guidelines is as follows:

Description	Patentable Subject Matter?
A solution improving the shape of a product solely for aesthetic purpose which does not solve technical problems	×
A solution improving the shape of a product which not only aims at aesthetics, but also objectively uses technical means that conform to the laws of nature to solve technical problems and produces technical effects.	√



David Liu

Partner
Patent Attorney

David Liu, a New York attorney and Chinese patent agent, has more than 10 years of legal experiences in both the U.S. and China. David has significant experience representing multinational clients in patent litigation, patent prosecution and trade secret litigation throughout IP Courts, CNIPA and PRB in China, and USPTO and PTAB in the United States. He graduated from the Pace University School of Law with a JD degree.