

Monthly Newsletter

Issued by Chang Tsi & Partners | www.changtsi.com | Jan 2024



Holiday Notice

Our office and IP Administration in regions below will be closed for Chinese New Year as follows:

Mainland, China: 10 -17 February 2024

Taiwan: 8-14 February 2024

Hong Kong: 10-13 February 2024

Macao: 9-14 February 2024 (Macao Office will be still open on the morning of 9 Feb 2024)

All deadlines falling on a holiday will be automatically extended. Should you have any urgent cases, please let us have your instructions ahead of the holidays.

Simon Tsi and Spring Chang Acknowledged by China Business Law Journal on The A-List 2023-24: Growth Drivers

Recently, after extensive research, the renowned legal rating agency China Business Law Journal (CBLJ) released its "The A-List" for 2023-2024.

To align with the evolving dynamics of the legal industry and respond to market feedback and suggestions, CBLJ has expanded The A-List awards this year by introducing three distinct categories. Each category recognises elite lawyers for their outstanding performance in the past year.

Among the winners, Founding Partners of Chang Tsi & Partners, Simon Tsi and Spring Chang were honored as "**Growth Drivers**". Growth Drivers represent the key players in law firms - the stalwarts with rich practice experience and profound legal acumen. These seasoned lawyers are active at the forefront of the market, boasting outstanding reputations and robust revenue-generating capabilities.

Chang Tsi & Partners Recognized by Chambers Greater China 2024

Chambers and Partners has recently released its annual ranking report - Chambers Greater China 2024, recognizing Chang Tsi & Partners and its lawyer for excellence in the practice areas of IP.

Chang Tsi & Partners has been listed in both Intellectual Property: Litigation and Intellectual Property: Non-Litigation as a leading Chinese law firm. Highlighted by Chambers and Partners, Chang Tsi & Partners' "performance is a testament to their excellence in the field of Chinese patent law, and we are grateful for their unwavering dedication and commitment".



Spring Chang, Founding Partner of Chang Tsi & Partners, has been also ranked as Eminent Practitioners in Intellectual Property (non-litigation). The Guide emphasized that "Spring has a good understanding regarding the IP needs, especially for international clients".

The Chambers rankings are based on in-depth analysis, facilitated by our team of experienced researchers. Chambers rankings offer reliable recommendations on the best law firms and lawyers in Asia-Pacific, providing you with the information necessary to make an informed decision when buying legal services.



CBLJ comments, 'with impressive track records, they excel in business development and drive intense market competition. Battle-tested and armed with acute insights, they can swiftly comprehend and master the dynamic changes in the legal landscape. Renowned for their exceptional professional capabilities, they not only create tangible value for clients but also contribute significantly to the sustained growth of their respective law firms'.

Simon Tsi and Spring Chang have earned the trust of clients and established a good reputation in the industry with their solid professional skills and extensive experience. The upgraded awards by China Business Law Journal further refine the positioning of the winning lawyers. The "Growth Drivers" represent the best practitioners and business leaders of the industry. Therefore, this award is a high recognition of the comprehensive abilities, rich practice experience, and profound legal skills of Simon Tsi and Spring Chang.

Chang Tsi & Partners has always adhered to the philosophy of "being the best law firm in China, providing the most outstanding legal services, and maximizing the legitimate rights and interests of clients." We continuously strive for excellence and will continue to uphold the excellence, providing comprehensive intellectual property legal support to clients, and helping them succeed in the global market.

Introduction to Multiple Design Patent Application in China

Bing Xiao/Emma Ma

1. Legal Basis

Article 31 paragraph 2 of the Chinese Patent Law reads "An application for a patent for design shall be limited to one design. Two or more similar designs of the same product or two or more designs which are incorporated in products belonging to the same class and being sold or used in set, may be filed as one application."

2. Introduction

In China, there are three scenarios where the applicant can put a plurality of designs (up to 10 designs) into one application as follows, and the plurality of designs contained in an application shall at least belong to the same main class.

Assembled Product

An Assembled product refers to a single product consisting of several components. However, a design application of an assembled product could not protect each component independently.

Take an electronic kettle assembly as an example, it comprises two components, i.e., a kettle and a heating base. If we file the kettle and the heating base in one application as an assembled product, the competitors who produce the kettle or the heating base would not fall into the protection scope of the filed application.

Given the very limited protection scope, we generally do not recommend filing design applications as assembled products just for cost-saving purposes.

Products in Set

Products in set mean that two or more products belong to the same main class, but are independent of each other. Moreover, two or more products could be customarily sold or used at the same time, and the designs of these two or more products have the same concept. The whole design of the set as well as the independent design of each product are all within the scope of protection.

Take a coffee set as an example, it consists of a coffee cup, a coffee pot, a milk pot, and a sugar pot. If we file the coffee cup, the coffee pot, the milk pot, and the sugar pot in one application as "products in set," we could seek to protect the coffee cup, the coffee pot, the milk pot, and the sugar pot independently, and also protect the coffee set as a whole.

Kindly note that a design patent application of "products in set" shall not include similar designs of one or more products of the set of products. Put differently, similar designs of the same product shall not be mixed with the designs of "products in set."

Similar Designs for the Same Product

Similar designs for the same product could be filed in one application on the condition that they are related to the same product and the differences therebetween are subtle. Generally, the applicant may file a single application containing multiple designs for the same product. If the Examiner holds that the designs are not similar to each other during prosecution, the applicant may delete one or more of them and file the deleted one(s) as one or more divisional applications.

Bearing in mind that similar designs shall belong to the same product, and the number of similar designs in a multiple application should not exceed 10.

3. How to save money by utilizing multiple design patent application

Notably, the newly introduced "domestic priority claiming" rules for design patents can be combined with the mechanism of multiple design application filing, providing the applicants of design patents with the benefits of flexibility and cost-saving.

For instance, in case the applicant has filed several design applications for the same product for the first time in China, which are similar to each other but were initially not filed as a multiple application, by claiming the priority of these filed design applications, the applicant would be able to combine these similar designs into a subsequent "multiple" application.

Key Numbers in China's IP in 2023

The National Heads of IP Administrations Meeting was held in Beijing recently. The meeting reviewed the main intellectual property work in the fruitful year of 2023, released some key numbers regarding Intellectual Property and deployed the key tasks in 2024.

In the outgoing year, IP legislation had marked advancements. IP legal protection was strengthened. The legislative process was sped up with the completion of the amendment of the Rules for the Implementation of the Patent Law, and the legislation and amendment of other policy and legal documents. The examination policy system was further improved with the amendment of the Patent Examination Guidelines and other agency regulations.

IP examination quality and efficiency were continuously upgraded resulting in the growing satisfaction of innovators. Profited from better examination capacity, examination pendency has constantly declined with the average period for examination of invention patents cut to 16 months. Examination quality also went up with the examination completion accuracy rate for invention patents hitting **94.2%**, and the patent examination satisfaction index reaching **86.3** reading points, staying within the satisfaction perimeter for 14 years in a row. The passing rate for trademark examination, opposition, and review after sample check tapped above **97%**, a great reflection of proven quality.

In 2023, the number of granted utility models decreased by **25.47%** year-on-year, while the number of inventions increased by **15.36%**. Specifically, a total of approximately **921,000** invention patents were granted in 2023 (a year-on-year increase of **122,653**), approximately **2,090,000** utility model patents were granted (a decrease of **714,155** year-on-year), approximately **638,000** design patents were granted (a decrease of **82,907** year-on-year), approximately **4,383,000** trademarks were registered (a year-on-year decrease of **1,794,000**), and approximately **11,300** integrated circuit layout designs were registered.

David Liu/Bing Xiao

| Summary of Data | | | | |
|------------------|--------------------|------------------------|-----------------|-----------------------|
| | Granted Inventions | Granted utility models | Granted Designs | Registered Trademarks |
| 2023 | 921,000 | 2,090,000 | 638,000 | 4,383,000 |
| 2022 | 798,347 | 2,804,155 | 720,907 | 6,177,170 |
| increment | +122,653 | -714,155 | -82,907 | -1,794,170 |



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.



Bing Xiao

Partner
Patent Attorney

As a patent attorney/engineer, Mr. Xiao focuses on patent prosecution. He has successfully handled hundreds of patent filings and prosecuting cases covering various technical fields, ranging from Mechanical Engineering, cars, motorcycles, to children's safety seats and spraying devices. Mr. Xiao has also represented clients in patent re-examination cases.