

Monthly Newsletter

Issued by Chang Tsi & Partners | www.changtsi.com | Sep 2023

Partner Michael Wu Delivered Highly Praised Speech on Chinese Design Patents

We are thrilled to announce that Chang Tsi & Partners has once again achieved recognition as a Highly Recommended Firm for 2023-24 by AsiaLaw. This accolade reaffirms our commitment to delivering exceptional legal services to our clients.

AsiaLaw is a renowned international legal rating agency that covers five jurisdictions in the Asia-Pacific region and provides the latest information and rating analyses for 28 sectors and fields of law firms and individual lawyers.

Each year, AsiaLaw conducts a comprehensive evaluation of law firms and lawyers in the Asia-Pacific region, gathering information from various sources, including internal surveys, feedback from partners, and client feedbacks.

We are also proud to share that two of our esteemed partners have been listed individually:

Spring Cang, Founding Partner, has been recognized as an Elite Practitioner.

Simon Tsi, Managing Partner, has been honored as a Notable Practitioner.

These distinctions reflect their outstanding contributions to our firm and the legal community as a whole.





















With over two decades of dedicated industry experience, Chang Tsi & Partners remains committed to our core values of maximizing our clients' legal rights and delivering customized, comprehensive, and competent legal services in the field of intellectual property.

We look forward to continuing to create value for our clients and contributing to the growth and development of the legal industry.

Spring Cang Earns Recognition in Who's Who Legal's 2023 Global Elite Thought Leaders – Trademark

Global Elite Thought Leaders - Trademarks

Name	Firm	Region
 Ai-Leen Lim	Awapatent	Asia-Pacific
 Annie Tsoi	Deacons	Asia-Pacific
 Jo-Ann See	Amica Law LLC	Asia-Pacific
 Karen Abraham	Shearn Delamore & Co	Asia-Pacific
 Lisa Ritson	Ashurst	Asia-Pacific
 Marion Heathcote	Davies Collison Cave	Asia-Pacific
 Nick Holmes	Davies Collison Cave	Asia-Pacific
 Samta Mehra	Remfry & Sagar	Asia-Pacific
 Spring Chang	Chang Tsi & Partners	Asia-Pacific
 Stephen Stern	Corrs Chambers Westgarth	Asia-Pacific
 Winnie Tham	Amica Law LLC	Asia-Pacific
 Alexander von Mühlendahl	BARDEHLE PAGENBERG Partnerschaft mbB	EMEA
 Åsa Krook	Waselius & Wist	EMEA
 Charlotte May KC	8 New Square	EMEA
 David Stone	Allen & Overy LLP	EMEA
 Gregor Vos	Brinkhof NV	EMEA
 Laura Alonso	HOYNG ROKH MONEGIER VÉRON	EMEA
 Maximilian Kinkeldey	Grünecker Patent - und Rechtsanwälte	EMEA

We are thrilled to announce that Chang Tsi & Partners' Founding Partner, Spring Cang, has been recognized in the 2023 Global Elite Thought Leaders-Trademarks list by Who's Who Legal.

Who's Who Legal, a renowned legal media outlet under Law Business Research Limited based in London, conducts comprehensive research into legal markets worldwide. Spring Cang's inclusion in this prestigious list is a testament to her exceptional legal expertise and contributions to our firm's success.

We would like to extend our sincere appreciation to our outstanding team and valued clients for their continued support. This recognition underscores our commitment to providing top-tier legal services and maximizing our clients' legal rights.

Chang Tsi & Partners Recognized for Excellence in WIPR China Trademark Rankings

We are thrilled to announce that Chang Tsi & Partners has once again secured top honors in the prestigious World Intellectual Property Review (WIPR) China Trademark Rankings. This recognition reaffirms our unwavering commitment to delivering exceptional legal services in the field of intellectual property.

In this year's rankings, our remarkable achievements are underscored by several noteworthy distinctions:

Spring Chang Named One of China's 'Senior Statesperson' for Trademark

Spring Chang, the esteemed founding partner of Chang Tsi & Partners, has been honored as one of only three **'Senior Statespeople for Trademarks in China'**. This recognition not only underscores her profound influence in the industry but also her pivotal role in shaping trademark law and practice in the region.

Moreover, Spring Chang has received individual recognition as **'Outstanding'** in the contentious listings, a testament to her outstanding legal expertise and unwavering dedication to protecting our clients' intellectual property rights.

Simon Tsi: Highly Recommended in Contentious Trademark Work

Simon Tsi, a prominent figure in the field, has been ranked as **'Highly Recommended'** for his exceptional contributions to contentious trademark work. His commitment to upholding the highest standards of legal practice has made him a trusted authority in trademark disputes.

Chang Tsi & Partners Clinches Top Ranks in Non-Contentious and Contentious Trademarks

Chang Tsi & Partners is proud to be listed as 'Outstanding' in the non-contentious category, securing the position in the top tier. This recognition places us among an elite group of just five firms distinguished for their excellence in non-contentious trademark matters.

In the contentious category, our firm has earned a 'Highly Recommended' status among the top 10 firms. This accolade reflects our dedication to providing effective solutions in complex trademark disputes.

We extend our heartfelt thanks to our valued clients and colleagues for their trust and support, which has played a critical role in our continued success. Our commitment to delivering exceptional legal services and protecting your intellectual property remains steadfast.

At Chang Tsi & Partners, we are honored to be recognized as leaders in the field of intellectual property law. We look forward to continuing our mission of safeguarding your innovations, brands, and ideas with the highest level of expertise and dedication.

Leslie Xu Published a Comment on Proposed Fifth Amendment to China's Trade Mark Law in GRUR International

Leslie Xu, one of our esteemed lawyers, has made a significant contribution to the legal community. His insightful article, 'New Trends, New Possibilities: A Comment on the Proposed Fifth Amendment to China's Trade Mark Law' has been published in GRUR International.

GRUR International is a renowned legal journal that provides invaluable insights into global intellectual property law. It serves as a platform for legal experts and scholars to share their expertise, shaping the future of intellectual property rights worldwide.

Leslie Xu's article delves into the proposed Fifth Amendment to China's Trade Mark Law, giving an overview of the background of the fifth amendment and highlights and commenting on the fundamental changes in the Draft Amendment. This is a testament to the exceptional legal minds at Chang Tsi & Partners, continually contributing to the legal discourse on an international stage.

The screenshot shows the top navigation bar of the GRUR International website. On the left is the Oxford Academic logo. In the center are links for 'Journals' and 'Books'. Below this is a green banner with the journal's title 'GRUR International' and subtitle 'Journal of European and International IP Law'. At the bottom of the banner is a dark green navigation bar with links for 'Issues', 'Advance articles', 'Submit', 'Purchase', 'Alerts', and 'About'. On the far right of this bar is a 'GRUR International' button.

Article Contents

- Abstract
- I. Introduction
- II. Background of the fifth amendment to the Trade Mark Law
- III. Highlights of the Draft and comments
- IV. Conclusion
- Acknowledgements
- Footnotes

JOURNAL ARTICLE

New Trends, New Possibilities: A Comment on the Proposed Fifth Amendment to China's Trade Mark Law

[Get access >](#)

Liang Xu ✉

GRUR International, ikad074, <https://doi.org/10.1093/grurint/ikad074>

Published: 09 August 2023

“ Cite ✎ Permissions ↻ Share ▼

Abstract

In January 2023, the China National Intellectual Property Administration (CNIPA) released the Draft Amendment to the Trade Mark Law of the PRC (Draft for Public Comment), launching the proposed fifth revision of the Trade Mark Law. This revision comes 40 years after the first version of the Trade Mark Law was implemented. Compared with previous amendments, the Draft makes significant changes, representing a new legislative trend in China's trade mark law. This comment gives an overview of the background of the fifth amendment and highlights and comments on the fundamental changes in the Draft Amendment.

Issue Section: [Opinion](#)

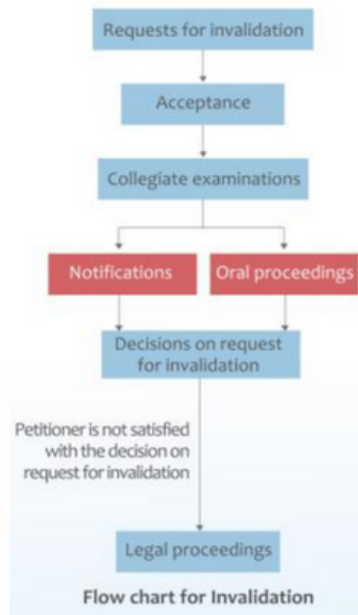
Chinese Patent Invalidation Data Quick Reference Manual (2023 Edition)

Michael Wu

On September 4, 2023, China's third-party media released the China Patent Invalidation Data Quick Check Manual (2023 Edition). In this manual, the overall situation of China patent invalidation is introduced, including statistical analysis of the parties, trial cycle, and legal basis. Based on the manual, this report has compiled some key data for your reference.

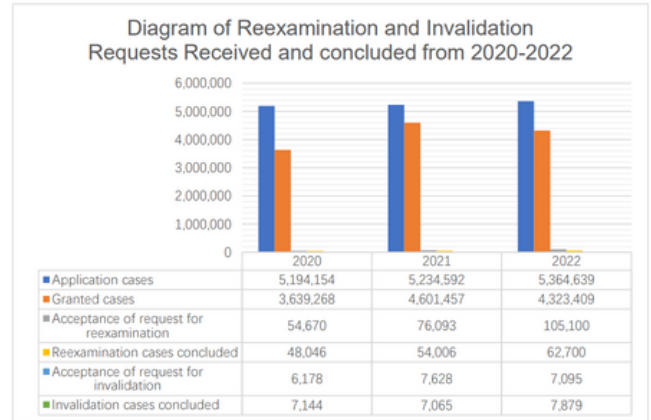
I. The process of Chinese patents invalidation

According to data released by the Patent Reexamination and Invalidation Department (Hereinafter referred to as "PRID") of the China National Intellectual Property Administration (Hereinafter referred to as "CNIPA"), the completion period for invalidation cases in 2021 is 5.8 months. This is the time from the first invalidity review, excluding cases that have been retried after the judicial review decision was withdrawn.



II. Basic situation of Chinese patents invalidation

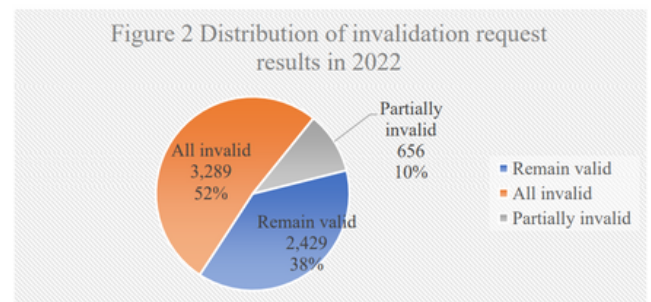
1. According to data released by the PRID, 7,065 invalidation cases were concluded in 2021. Comparing China's annual application cases, granted cases, acceptance of request for reexamination, reexamination cases concluded, and acceptance of request for invalidation, invalidation cases concluded, it can be seen that there will be one reexamination for every 50 patent application cases and one invalidation request for every 600 patents granted.



2. Remain valid: Partially invalid: Fully invalid ≈ 4:1:5
 In 2022, 51.6% of patents fully invalidated, 10.3% will be partially invalidated, and 38.1% will remain valid. Compared with 2021, the proportion of all invalid cases increased by 2.3%.

Table 1 Patent invalidation decision cases

	2021		2022		Total		2022 incremental percentage
	Decision cases	Proportion	Decision cases	Proportion	Decision cases	Proportion	
Remain valid	2,286	40.3%	2,429	38.1%	4,715	39.2%	-2.2%
All invalid	2,794	49.3%	3,289	51.6%	6,083	50.5%	2.3%
Partially invalid	586	10.3%	656	10.3%	1,242	10.3%	-0.1%
Total	5,666	100%	6,374	100%	12,040	100%	/



3. Invention patents are the most stable and the most difficult to be invalidated
 Taking all the data in 2022 as a reference, the difficulty coefficient of invalidating all invention patents is the largest, 1.5 (51.6%/34.8%); the difficulty coefficient of invalidating all utility models is 1.0; and the difficulty coefficient of invalidating all designs is 0.8.

Table 2 Proportion of invalidation results for three types of patents

	Remain valid		Partial invalid		All invalid		Difficulty coefficient for all invalid
	Decision cases	Proportion	Decision cases	Proportion	Decision cases	Proportion	
Invention	625	51.4%	169	13.9%	423	34.8%	1.5
Utility model	948	33.5%	475	16.8%	1,408	49.7%	1.0
Design	856	36.8%	12	0.5%	1,458	62.7%	0.8
Total	2,429	38.1%	656	10.3%	3,289	51.6%	1.0

III. Legal basis

1. Inventive step, the soldiers must fight

Inventive step is the hot spot of patent invalidation. Even if the patent is invalidated, it is not an exaggeration to say that the dispute is about inventive step.

As shown in the table below, among the many available grounds for invalidation listed, A22.3 are the most frequently used (Inventive step of invention and utility model, 3,755 times), followed by A23.2 (Inventive step of design, 1,800 times).

Inventive step-related provisions were used by invalidation claimants in a cumulative total of 5,555 cases, involving 87.2% of the total cases (5,555/6,374).

Table 3 Frequency of reasons for invalidation(based on invalidation decisions in 2022)

	Reasons for invalidation	Abbreviation	Content	Frequency of use	Proportion
1	Article 2 of the Patent Law	A2	Objects of Patent Rights	52	0.6
2	Article 22 of the Patent Law	A22.2	Novelty	700	7.9
		A22.3	Inventive step	3,755	42.1
		A22.4	Practicality	84	0.9
		A22.5	Prior art	2	0.0
3	Article 23 of the Patent Law	A23.1	Novelty for design patent	646	7.2
		A23.2	Inventive step	1,800	20.2
		A23.3	No conflict with prior rights of others	87	1.0
		A23.4	Existing design	0	0
4	Article 26 of the Patent Law	A26.3	Adequate disclosure of specification	552	6.2
		A26.4	Claim based on the specification	785	8.8

2. A26.3/A26.4: High suspicion rate, high successful invalidation rate

Inventive step in patent invalidation means high suspicion rate and high successful invalidation rate; while A26.3/A26.4 means high suspicion rate and low successful invalidation rate.

In 2022, 3,289 invalidation decisions were invalidated, with 6,457 Legal basis used. Combined with the usage of Legal basis and the content shown in the table below, Inventive step-related clauses (A22.3, A23.2) are used more frequently as Legal basis and are also prominent in the basis for successful invalidation. In comparison, A26.3/A26.4 has a high usage rate and low success rate.

Table 4 Legal basis for successful invalidation used in invalidation decisions

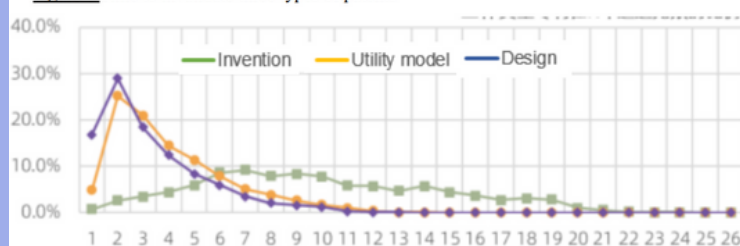
	Abbreviations and content	Invention	Utility model	Design	Total
Article 22 of the Patent Law	A22.2- Novelty	29	175	0	204
	A22.3- Inventive step	373	1,360	0	1733
	A22.4- Practicality	1	0	0	1
Article 26 of the Patent Law	A26.3- Adequate disclosure of specification	12	13	0	25
	A26.4-Claim based on the specification	22	11	0	33

IV. The Parties

1. Time to invalidate three types of patents

The three types of patents that have become the focus of controversy also have their own cycles: 10 years for inventions, 4 years for utility models, and 3 years for designs.

Figure 1 Time to invalidate three types of patents



This data can be used as one of the reference indicators for patent management by patentees. In the 14th year of invention patent application, the 6th year of utility model application, and the 5th year of design application, 80% of patent invalidations have already occurred if they would occur. For some important patents, even if the protection period has expired, disputes continue.

2. To be focus, choose the right type

When companies carry out patent arrangements, it is important to choose the appropriate type of patent, such as invention, utility model and design, combined with the shape of their products.

In terms of patent invalidation, there is a big difference in the types of patents invalidated by invalidation applicants.

V. Conclusion

The establishment of the patent invalidation system is to correct the CNIPA decision to grant patent rights to inventions that do not meet the conditions stipulated in the patent law, maintain the fairness of patent rights, and protect public interests. In Chinese judicial practice, the alleged infringer's request to invalidate the patent involved has almost become an "inevitable step" in patent infringement litigation. Therefore, the patent invalidation procedure is of great significance to both the patentee and the public.