



漢坤律師事務所
HAN KUN LAW OFFICES

Design Protection in China

Lili WU, Partner

Nov. 8, 2019



Agenda

HAN KUN

- Design Registration
- Cross Border Issues
- Design Enforcement

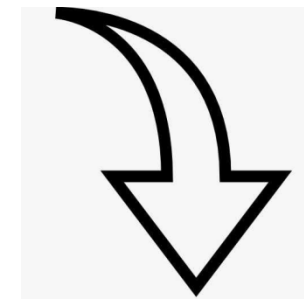
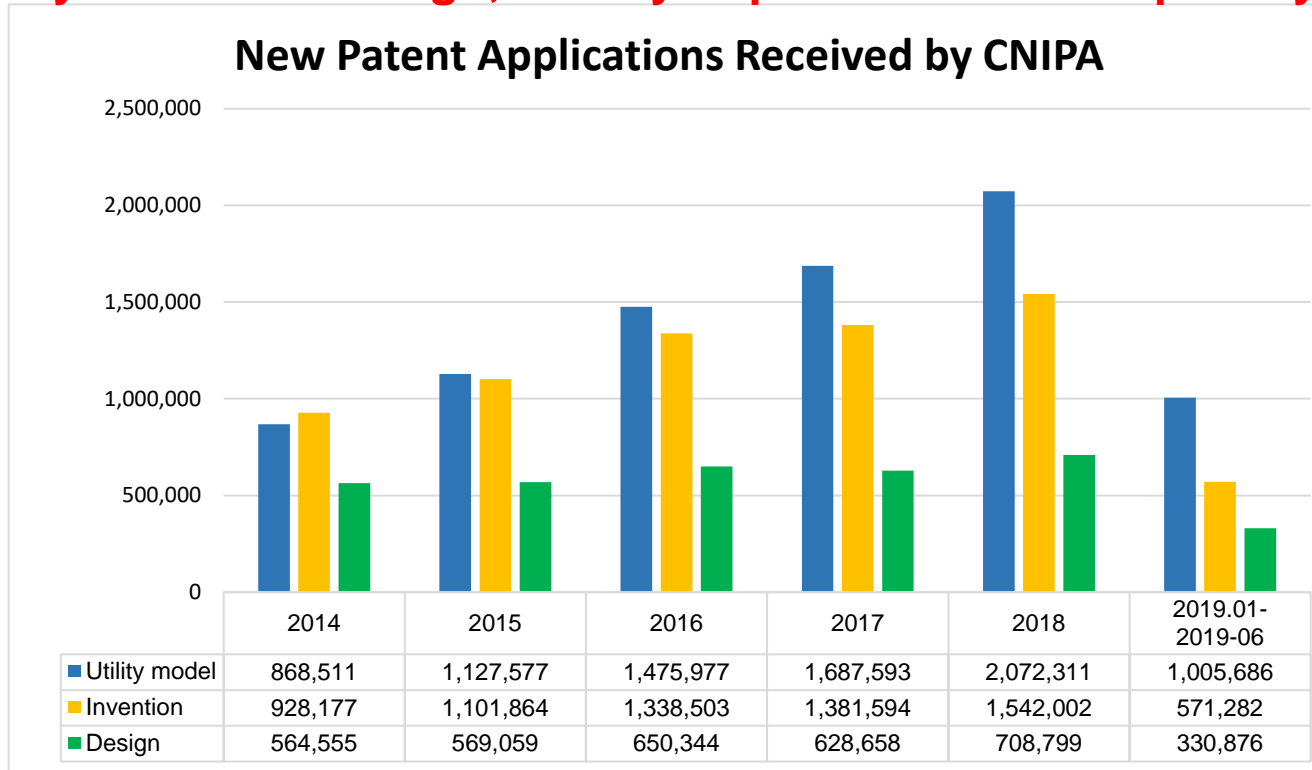


New Patent Applications Statistic Data

HAN KUN

Huge new patent applications each year! Start to slow down from 2019

Quantity has been enough, Quality of patents becomes priority in CNIPA since 2019



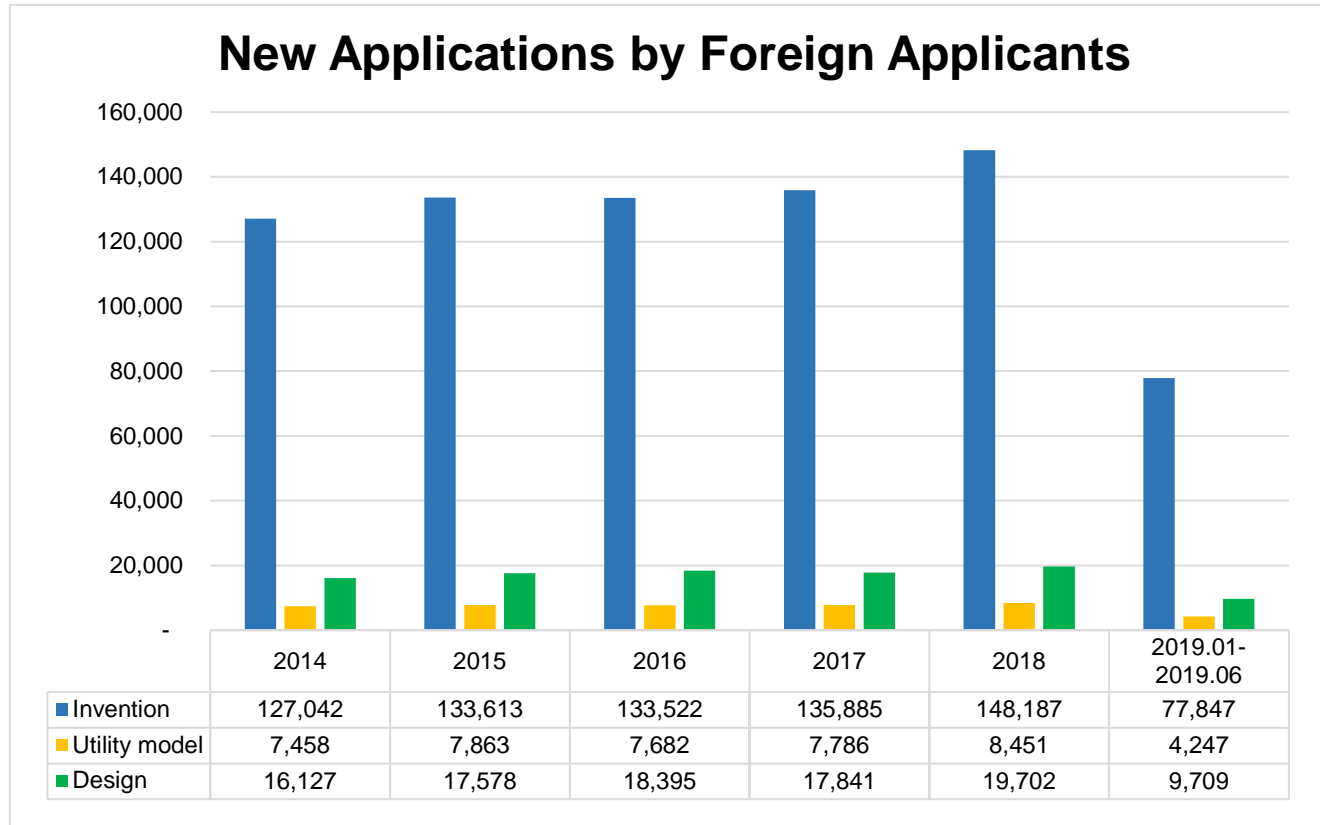
9.4%

first half of 2019

**Source: CNIPA Website*



Many foreign new cases are received by CNIPA



8.6%

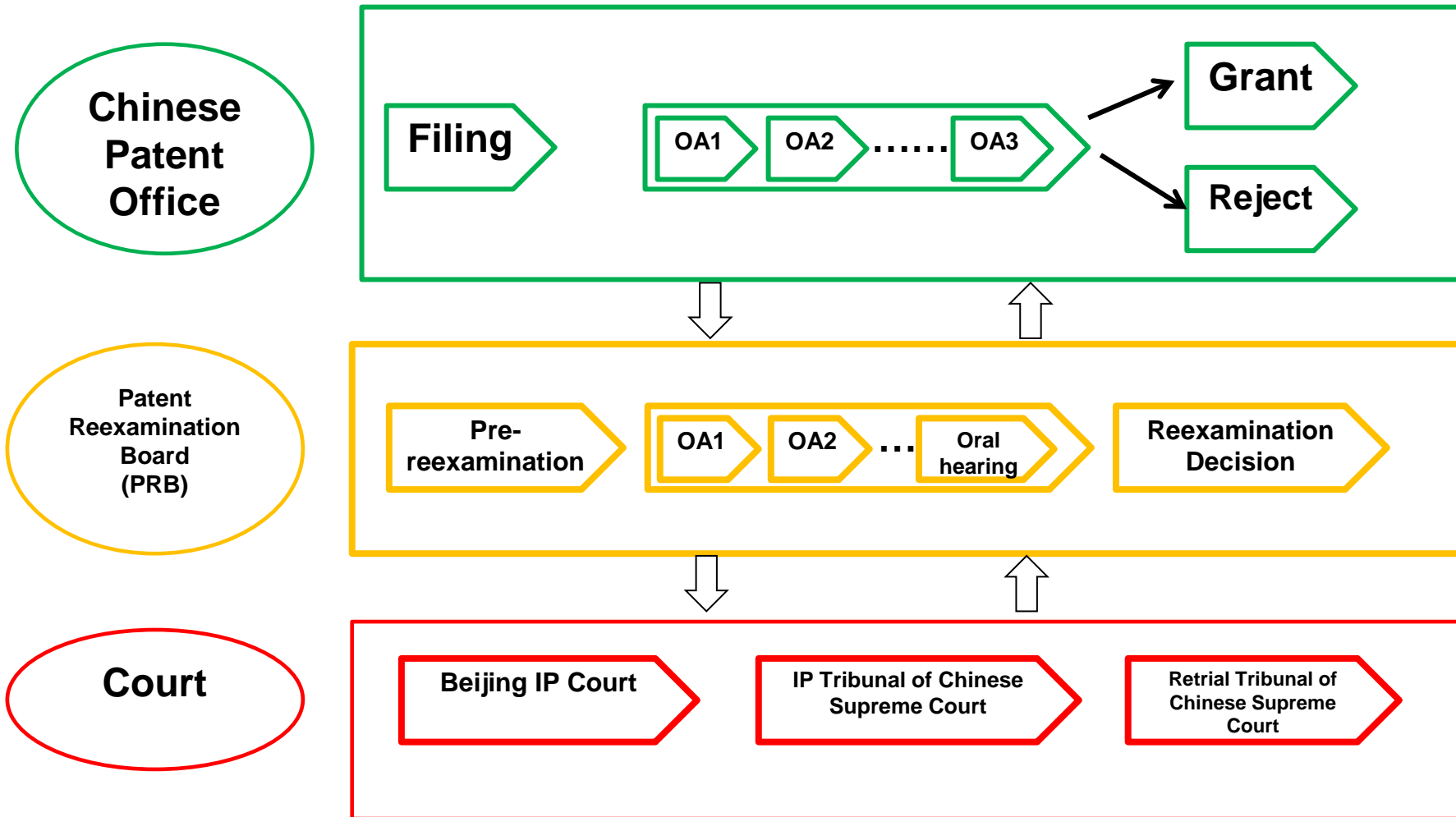
first half of 2019

*Source: CNIPA Website



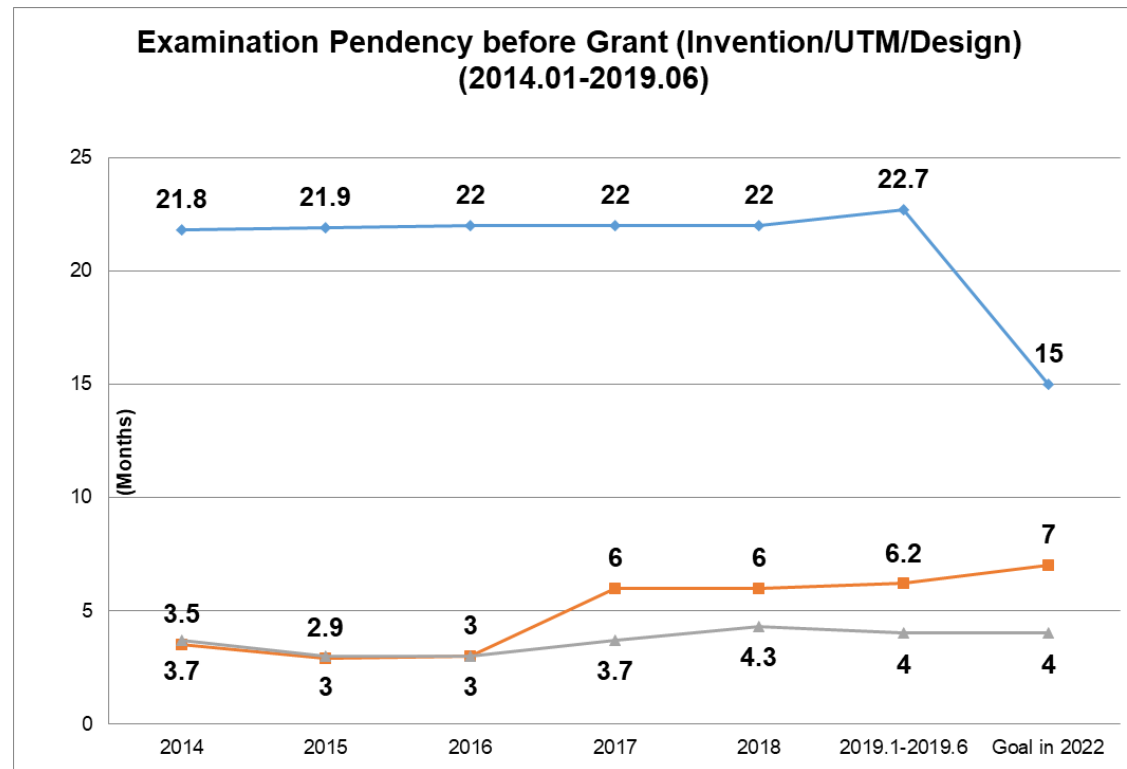
Design Prosecution Timeline

HAN KUN





Pendency of design applications in CNIPA is around 4 months!



Cost: 500 USD

Annuity for 10 years: 2,500 USD

**Source: CNIPA Website*



Design Practice Comparison

HAN KUN



Photographs

Solid lines

Broken lines

Shading lines

Partial design



Photographs

Solid lines

Broken lines

Shading lines

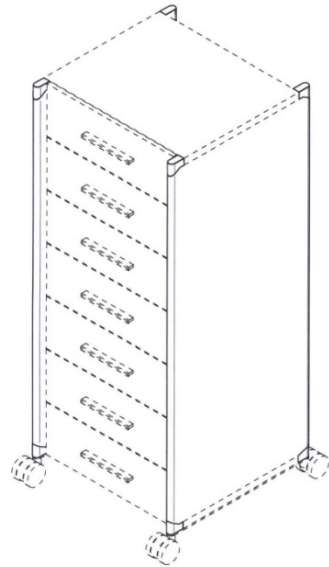
Partial design



- Partial design (Broken line not allowed in China)



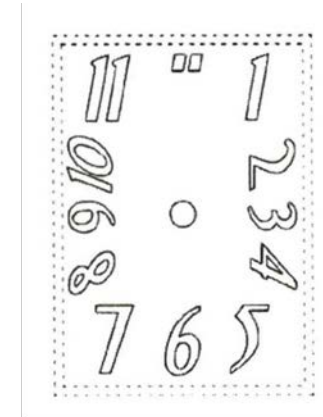
DM/095424
Seat



RCD000161971
Furniture



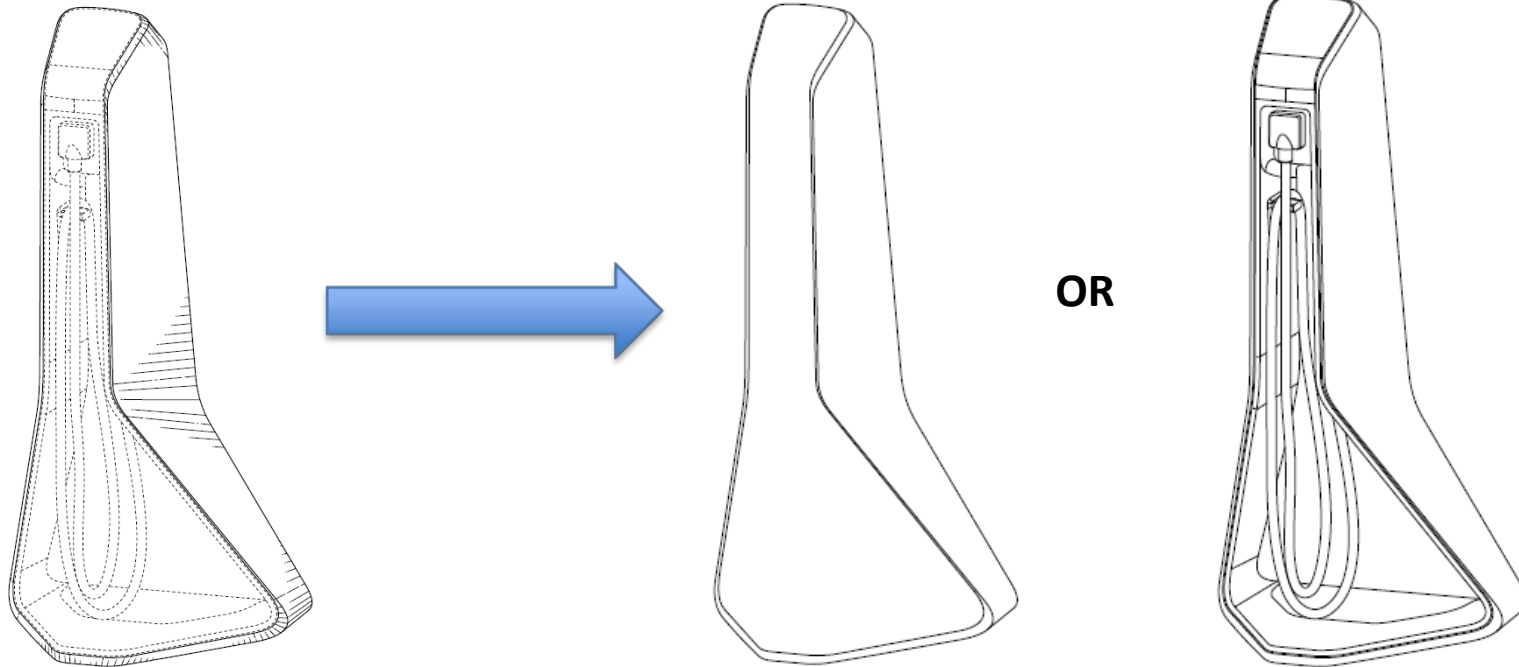
RCD002235994
Watch



RCD000675830
Watch dial



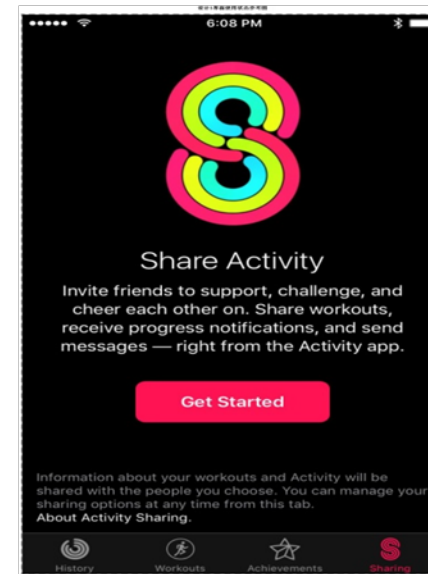
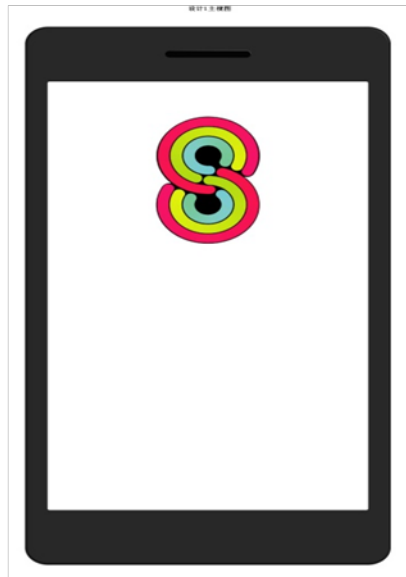
- Design (**adaptive amendment before CN filing**)





- GUI design

CN201630604582.4



GUI for Mobile Communication Device



Agenda

HAN KUN

- Design Registration
- Cross Border Issues
- Design Enforcement



Hague Agreement concerning the International Registration of Industrial Designs

- China has **not yet subscribed the Hague Agreement** concerning the International Registration of Industrial Designs. Therefore, the only way to seek protection of a design in the country is through the national filing of the registration.

■ *International Exhaustion*

- According to Article 69 of the CPL, “*None of the following circumstances shall be deemed an infringement upon a patent right: using, promising to sell, selling or importing any patented product or product directly obtained under the patented process after the said product is sold by the patentee or by its (his) licensed entity or individual*”. Therefore, **China adopts the international exhaustion principle**, and the products that are imported into China lose the protection by the CPL if they have been legally obtained by the importer.



■ *Transfer of design patent right*

- Both the design patent and the design application can be transferred. **All transfers must be confirmed in writing and registered before the CNIPA.** The transfer will only be valid and effective after its recordation.

■ License

- As to the license of the design patent, it is **not required to be recorded before the CNIPA.**



Agenda

HAN KUN

- Design Registration
- Cross Border Issues
- Design Enforcement



Design Patent Enforcement

HAN KUN

■ Generally four ways

- On Line Complaint
 - Send the complaint to e-commerce platform
 - Foreign court decision is very helpful



– Customs Seize



– Administrative Enforcement (SAMR)

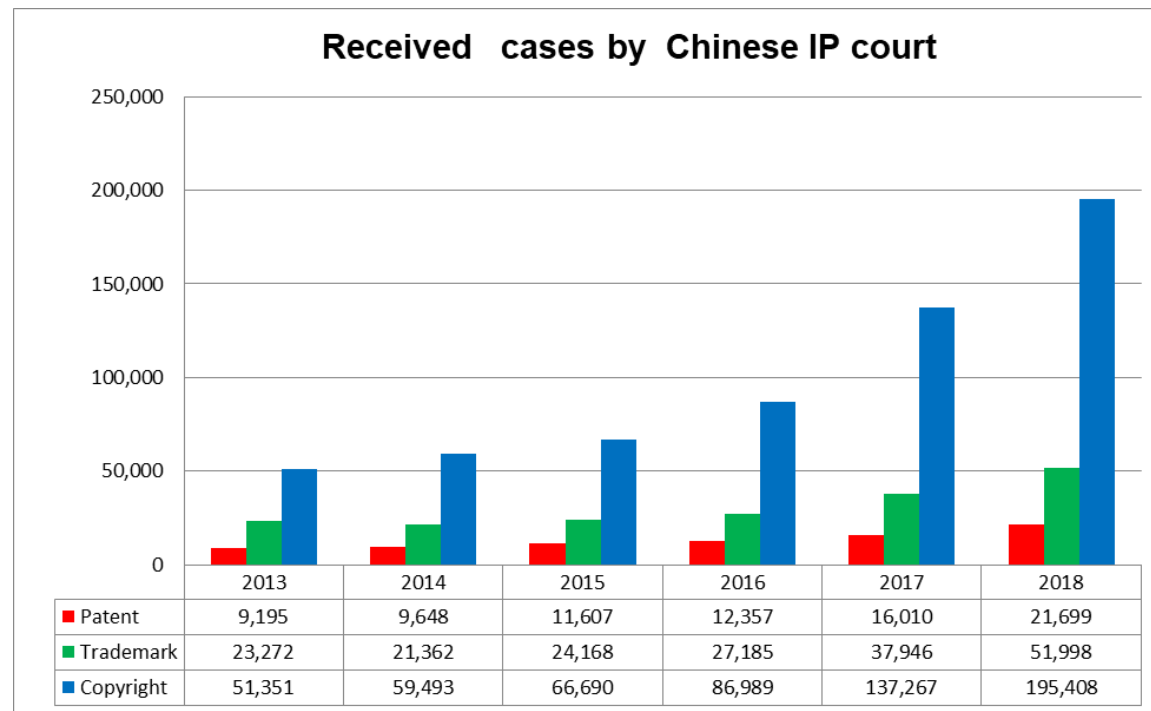


– Patent Litigation





Many new IP cases were received by Chinese courts



*Source: White paper regarding IP protection in China (SPC, 2013-2018)



- Injunction
- Damage



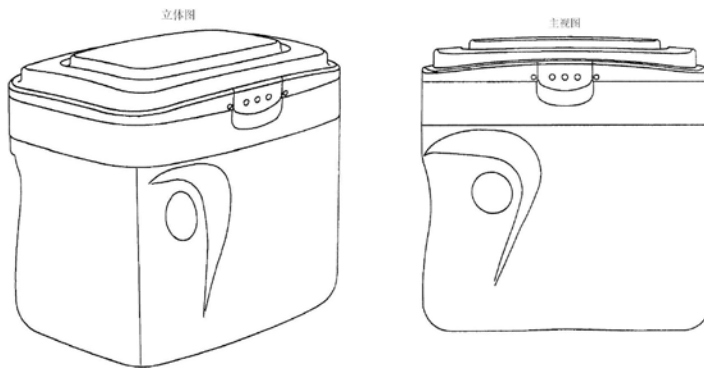
■ Injunction

- Permanent injunction

- Almost automatic once there is infringement

- Preliminary injunction

- Very likely if the infringing product is the same or very similar as the design patent





■ Damage

- (1).Lost profit of the plaintiff
- (2).Illegal gaining of the infringer
- (3).Reasonable royalty
- (4).Statutory damage of up to 1 million RMB (about 140K USD) if the above (1) to (3) cannot be decided.
- (5) Punitive damage of up to 5 times of damage for bad faith infringement according to the draft of amendment of Patent Law

THANKS



Lili WU

Partner

Lili.wu@hankunlaw.com

Mobile: (86) 13511006372

Telephone: (86 10) 8516 4266

Facsimile: (86 10) 8525 5511 / 5522

9/F, Office Tower C1, Oriental Plaza,
1 East Chang An Ave., Beijing
100738, P. R. China

www.hankunlaw.com