

July 23, 2020

USPTO CHINA IP WEBINAR

USING OVERLAPPING IP RIGHTS TO PROTECT YOUR PRODUCTS IN CHINA

**During the webinar, send any questions to:
AskChinaIP@uspto.gov**

UNITED STATES
PATENT AND TRADEMARK OFFICE





Exceptional service. Dykema delivers.

OVERLAPPING IP PROTECTION FOR PRODUCTS IN CHINA

USPTO China IP Webinar – July 23, 2020

Presented by Thomas T. Moga

California | Illinois | Michigan | Minnesota | Texas | Washington, D.C.

www.dykema.com

Patent Overview

Invention Patent (very similar to US Utility Patent)

- 20 year life
- Substantive examination – interviewing helps

Utility Model Patent (no US parallel)

- 10 year life
- No substantive examination – but amendments may be required (“Notification of Rectification”)

Design Patent (similar to but not the same as US Design Patent)

- 10-year life (but should soon change to international standard of 15 years)
- No substantive examination but formalities could be a problem – interviewing again helps

Design Patent

Design Patent Features

- Relatively inexpensive
- Relatively easy to obtain
- Relatively valuable
- But narrowly interpreted and applied by courts (though changing)
- In some ways system for granting design patents is closer in practice to the system of copyright registration in the U.S.
- US practitioners may be constrained by their own experiences and, as a result, anticipate not only large prosecution bills but also *limitations on what can be protected*

Design Patent (continued)

Design Patent – Planning

- Drawings are key
- Line drawings may present problems
- Consider 3D CAD images, though photographs are possible
- Beware of “new matter” rejection – include China-bound drawings in US application as appendix

Design Patent (continued)

Design Patent – Timing

- Design patent applications typically are granted quickly in China
- Coordinating product release with filing window
- Adjusting design patent grant timing

Design Patent – Customs Office

- Don't forget to register issued design patents with the Chinese Customs Office

“Trade Dress”

– “Trade Dress” in China

- Trade dress may be registered in the US and other countries under trademark law
- Trade dress is not specifically provided for in China
- Instead, China’s Anti-Unfair Competition Law has been used to protect the overall visual appearance unique to a product:

Chapter II - Acts of Unfair Competition

Article 6. A business operator shall not perform any of the following confusing acts that will enable people to mistake its products for another business's products or believe certain relations exist between its products and any business's products,

1. unauthorized use of a mark that is identical or similar to the name, packaging or decoration of another business's commodity, which has influence to a certain extent...

“Trade Dress” (continued)

– “Trade Dress” in China

- The “influence” (“fame”) requirement
 - Often difficult to prove
 - Chinese courts look to a variety of factors, including the quality, quantity, and cost of advertisement and the duration of product sales
 - Requirements for “influence” almost certainly would exclude new brands

Copyright

– Copyright Law and Practice in China

- In China, a copyright arises when the original work is created “in a fixed medium”
- Registration is optional but recommended
 - Best way to secure a quick takedown of infringing material
- Works of “applied art” (defined as “artistic works with utilitarian functions”) are eligible for copyright protection in China
 - Products such as sneakers and tire treads may be eligible for copyright protection in China as “works of applied art”
- Potentially inconsistent enforcement

Conclusion

- A successful and durable IP portfolio in China can be built but does not happen by accident
- The right mix of protection is critical
- A “China only” plan works best
- Try to see IP from a Chinese point of view
- Monitor IP of others, attend trade shows, on-line research

■

Thank you.

Thomas T. Moga
202-230-1012

●