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## Confidentiality review system under Patent Law in China

Most countries have established confidentiality review measures to first conduct a confidentiality review where a foreign patent application needs to be made for an invention/creation so as to determine whether it has a bearing on national security or material interests.

Pursuant to the first paragraph of article 20 of the Patent Law, so long as an invention or utility model is completed in China, the inventor – whether a citizen or a resident of China – is required to first submit a request for confidentiality review to the State Intellectual Property Office (SIPO), and may only apply for a foreign patent after receiving permission to do so. As for designs, since they do not involve technical improvements, the Patent Law does not set any requirements.

### **Application denied**

Article 20 of the Patent Law additionally specifies that if an applicant applies for a foreign patent in violation of the first paragraph and further applies for a patent for the same invention or utility model in China, the grant of a patent under the China patent application will be denied.

The question is then how to determine whether an invention was completed in China. The first paragraph of article 8 of the Implementing Rules for the Patent Law specifies that an invention or utility model that is completed in China means an invention or utility model the substantive content of the technical solution of which was completed in China. The “in China” here refers to mainland China only, excluding Hong Kong, Macau and Taiwan. “Substantive content” means the content created by the inventor that is not disclosed or taught by the closest prior art.

In practice, even if only a portion of the creative content of an invention is completed in China – e.g. a situation where an inventor in China and an inventor in a foreign country co-operated in completing the invention, or a situation where an inventor, during the period of developing the invention, resided both in and outside of China – in order to avoid the consequence that a patent cannot be granted for a patent application filed in China, the applicant should first submit a request for confidentiality review in China and secure permission to apply for a foreign patent.

Pursuant to article 8 of the Implementing Rules for the Patent Law, there are three ways to



submit a request for confidentiality review: (a) submitting a request for confidentiality review to SIPO upon or after filing a Chinese patent application; (b) submitting a standalone request to SIPO for confidentiality review; or (c) filing a Patent Co-operation Treaty (PCT) international application with SIPO as the receiving office (the same is deemed as submitting a request to SIPO for confidentiality review).

Although article 9 of the implementing rules specifies that a review in respect of a request for confidentiality review may take as long as six months from the request date, in practice, if it is apparent that the technical solution does not require confidentiality, SIPO will normally issue a permission notice within about 15 to 30 days from the request date. With respect to certain technical solutions that may need to be kept confidential, SIPO will notify the applicant that a further review is required.

### **Early filing date**

Accordingly, if the applicant wishes to secure the earliest possible filing date, he or she should opt for option (a) or (c). With respect to option (a), if the applicant does not submit the request for confidentiality review upon the filing of a Chinese patent application, it would be best if he or she does so within six months from the filing date to avoid a possible failure to secure the permission to apply for a foreign patent within the 12-month priority period.

As for option (b), the description of the technical solution submitted by the petitioner must be in Chinese, and where an agency has been appointed, an original copy of a power of attorney (POA) must be submitted when filing the request.

If the petitioner only has an English version of the technical solution, he or she must consider the time required for having it translated into Chinese, and the service of the original POA. In such a situation, in order to secure the earliest possible filing date, option (c) may be considered. This is because SIPO, as a receiving office, accepts PCT international applications filed in English, and in a PCT international application, the POA may be submitted at a later date.

Where option (b) is opted for, the description of the technical solution submitted in the request for confidentiality review must be consistent with the technical solution recorded in the description in the foreign application filed for the same invention. If the description in the application submitted in a foreign country includes content that was not disclosed in the request for confidentiality review submitted to SIPO, the technical solution on which the undisclosed



content has a bearing will be deemed not to have undergone a confidentiality review by SIPO, and it will not be eligible for the granting of a patent in China. Accordingly, it is best if the description of the technical solution submitted by the petitioner is the entire description for the foreign patent application. Of course, the description need not include the content of the claims or abstract.

### **Confidential content**

Regarding option (c), generally speaking, permission to apply for a foreign patent is deemed to have been secured upon receipt of the PCT/RO/105 form, which formally grants the filing date and filing number issued by SIPO. However, if it is specially noted on the form that the application requires further confidentiality review, since it contains potentially confidential content, the applicant is not allowed to apply for a foreign patent for the invention in question until having received further notice informing him or her that the application has passed the confidentiality review.

Regardless of whether option (a), (b) or (c) is opted for, the applicant should not directly apply for a foreign patent after having submitted the request for confidential review, but before having secured permission to apply for such a patent. If the applicant does, even if he or she later secures permission, it is possible that the applicant may be denied a patent in China for the same invention as a result of having violated the first paragraph of article 20 of the Patent Law.

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