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Determining ‘same subject matter’ for Chinese patent priority

The principle of priority is one of the important principles in China’s patent regime. Pursuant to article 29 of the Patent Law, if, within 12 months from the date of first filing a patent application for an invention or utility model in China or a qualified foreign country, an applicant further files a patent application with China’s Patent Office in respect of the same subject matter, the applicant will enjoy domestic or foreign priority.

From the above it can be seen that “same subject matter” is a major condition for priority, whether for domestic or foreign priority. If the subject matter of the subsequent filing is different from that of the previous filing, the applicant is not eligible for priority. Accordingly, determining whether the subject matter of two filings is the same is an important issue.

Judgment principles

The Patent Examination Guidelines provide as follows in respect of determining whether the subject matter of a subsequent filing is the same as that of a previous filing: determine whether the technical solutions described in the claims of the subsequent application are clearly recorded in the documents for the previous filing.

Based on this principle, for the subsequent filing the “subject matter” is neither the entire content of the description nor is it one or more technical features in one claim; rather, it is the technical solution(s) in each of the claims of the subsequent filing. Accordingly, when determining whether priority is established, each claim of the subsequent filing is the minimum unit for judgment. For the previous filing, the subject matter means the technical content disclosed in all of the application documents, including the description, claims and figures (if any), but excluding the abstract.

When determining whether priority is established, it is not required that the technical solution in a certain claim of the subsequent filing be recorded in its entirety in the claims of the previous filing, so long as the documents of the previous filing, as a whole, disclose each of the technical features of the claim in question.



It can be said that the Patent Examination Guidelines have clearly specified the subject of determination, but, as to the manner of determination, i.e. how to understand the so-called “clearly recorded”, the guidelines only vaguely refer to “does not require complete consistency in the manner of description, so long as the technical solution described in the claims of the application is clearly explained”. Accordingly, there are currently a few different views as to how to determine same subject matter.

Views on determination

Determining same subject matter based on novelty. In this view, the previous filing can be treated as a prior art document that is used to determine whether the claims of the subsequent filing are novel. A claim can confer priority only if the outcome of the determination is that the claim in question of the subsequent filing is not novel.

In the majority of circumstances this manner of determination is applicable. However, in certain special circumstances, using this manner of determination will result in an erroneous conclusion. For example, if the previous filing records a specific “feature A” as the invention point, but a claim of the subsequent filing records “feature B” as the invention point, and feature B is a generic feature of feature A, the claim in question of the subsequent filing is not novel when compared to the previous filing. But determining on this basis that the claim in question of the subsequent filing confers priority is apparently inappropriate, the reason being that the claim in question of the subsequent filing goes beyond the disclosure recorded in the documents of the previous filing.

Determining same subject matter from the perspective of going beyond the disclosure. In this view, the description and claims of the previous filing can be treated as a whole and used to determine whether each of the claims of the subsequent filing is recorded in the documents of the previous filing, or can be derived directly and undoubtedly from it. A claim of the subsequent filing can confer priority only if the outcome of the determination is that it does not go beyond the disclosure of the previous filing.

This manner of determination derives from a provision in article 33 of the Patent Law, which states that “amendments may not go beyond the scope of disclosure recorded in the original description and claims”. One of the more salient requirements of this provision is that, when making amendments, generalisation cannot be made as to the technical features in the original



description and claims. However, with respect to the technical solutions that a person skilled in the art can derive from a reasonable generalisation of the documents of the previous filing, it would be apparently unreasonable to exclude such technical solutions from the priority claim.

Determination of same subject matter from the perspective of support. In this view, the description and claims of the previous filing can be treated as one whole and used to determine whether the claims of the subsequent filing are supported by the previous filing. A claim can confer priority only if the outcome of the determination is that the claim of the subsequent filing is supported by the documents of the previous filing.

This manner of determination can effectively circumvent the deficiencies of determining same subject matter based on novelty or the perspective of going beyond the disclosure. But in using this manner of determination, it is necessary to make sure that the claims of the subsequent filing are substantively supported by the content of the previous filing, failing which even if the claims of the subsequent filing are completely identical with the previous filing in terms of the manner of description, it could not confer priority.

The Patent Examination Guidelines do not expressly specify the manner of determining same subject matter, which can have a relatively large impact on patent applicants' preparation and amendment of their application documents, and can also have an impact on the soundness of a patent after its granting. Accordingly, the author would recommend that the guidelines be revised as soon as possible, so as to clarify the manner of determining same subject matter.

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