

## Featured Article

# Navigating the National Phase: Key Insights for PCT Applications in China

### Introduction

Figure 1 illustrates the global trends in PCT applications from 2008 to 2022. As shown, there has been a consistent annual increase in global PCT applications from 2010 to 2022.



Figure 1 Trend of PCT applications and growth and decrease rate from 2008 to 2022  
(Source: PCT yearly review 2023, WIPO)

Table 1 compares the number of global PCT applications and those entering the Chinese national phase between 2020 and 2022. It is evident from Table 1 that from 2020 to 2022, the number of applications entering the Chinese national phase exceeds 100,000 each year, accounting for more than 36% of global PCT applications, demonstrating a growing trend of foreign applicants seeking patent protection in China through the PCT route. These data underscore the increasing importance foreign applicants place on patent protection in China.

**Table 1 Ratio of global PCT applications entering the Chinese national phase in the past three**

	2020	2021	2022
Number of international applications	275,900	277,500	278,100
Number of applications entering CN phase	101,000	107,000	106,000
Ratio	36.6%	38.6%	38.1%

In my daily work, I often receive inquiries from South Korea and Japan on the practical aspects of PCT applications entering the Chinese national phase. Accordingly, I would like to take this opportunity to summarize and sort out several issues that should be paid attention to when applying for patents to the patent administration department under the State Council through the PCT route, for the reference of foreign applicants. Topics covered include timing of entry, entry requirements, amendments to application documents, incorporation by reference, and expedited prosecution pathways.

Given the importance of Chinese translation for PCT applications published in foreign languages at the international phase entering the Chinese national phase, a special section emphasizing the significance of accurate Chinese translation is included, supported by relevant cases.

## I. Procedures

### 1. Timing for entry into the Chinese national phase

According to Rule 120 of the Implementing Regulations of the Patent Law: any applicant for an international application entering the Chinese national phase shall, within 30 months from the priority date as referred to Article 2 of the Patent Cooperation Treaty, go through the formalities at the patent administration department under the State Council; if the applicant fails to go through the said formalities within the prescribed time limit,

he or it may, after paying a surcharge for the late entry, go through the formalities for entering the Chinese national phase within 32 months from the priority date.

According to the above provisions, if the formalities for entering the Chinese national phase are not completed within the said 32 months, the validity of the international application in China shall be terminated.

[Note 1] The above time limit shall run from the earliest priority date recorded by the International Bureau of WIPO, and once the time limit of 32 months has been

missed, the right cannot be restored except for irresistible reasons.

[Note 2] The grace period can only be 2 months, not one month or another period.

## 2. Requirements for entering the Chinese national phase

### 2-1 Designation of protection type

According to Article 9.1 of the Patent Law: for any identical invention-creation, only one patent right shall be granted.

Thus, when an international application designating China is under the process of formalities for entering the Chinese national phase, the applicant can only choose one from "patent for invention" and "patent for utility model", and it is not permitted to request "patent for invention" and "patent for utility model" at the same time.

[Note] The rule of request for two kinds in one case, that is, simultaneous application of patent for invention and patent for utility model, does not apply to applications entering the Chinese national phase based on the PCT route.

### 2-2 Fees

According to Rule 121 of the Implementing Regulations of the Patent Law: the filing fee and the printing fee for the publication of the application must be paid, and where necessary, the surcharge for the late entry should be paid; if necessary, the additional fee for filing application stipulated in the

first paragraph of Rule 110 of these Implementing Regulations should be paid.

[Note 1] The surcharge of the claims and the specification is calculated based on the number of claims and the number of pages of the specification published in the international phase. As a result, when entering the Chinese national phase, the surcharge cannot be saved by deleting the number of claims or deleting part of the content of the specification. The basic number of the claims is 10, and the basic number of pages of the specification is 30 pages, including the drawings.

[Note 2] In China, neither the substantive examination fee nor the annual fee is related to the number of claims.

### 2-3 Requirements for translation

According to Rule 121 of the Implementing Regulations of the Patent Law: when an international application is filed in a foreign language, the foreign language in the abstract, claims, description and drawings **must be translated into Chinese**.

According to Chapter 1 of Part III of the Guidelines for Patent Examination, "3.2.1 Translation of Description and Claims", it is stipulated that the translation of the description and claims shall be consistent with the content of the description and claims in the international publication document transferred by the International Bureau. The translation should be complete and **authentic to the original**. **The applicant shall not add any content of**

the amendment in the translation of the original.

[Note] When entering the Chinese national phase, it is not possible to submit the application documents in a foreign language (such as English) first and then submit the Chinese translation. According to Rule 123 of the Implementing Regulations of the Patent Law: where an international application was amended in the international phase and the applicant requests that the examination be based on the amended application documents, the Chinese translation of the amendments shall be finished within two months from the date of entry.

### **3. Amendments to application documents**

According to the provisions of Article 28 or 41 of the PCT Treaty, when an international application enters the Chinese national phase, the applicant may make voluntary amendments.

After the above amendments are made, in accordance with the provisions of Rule 57 of the Implementing Regulations of the Patent Law, within the time limit of three months after the receipt of the notification of the patent administration department under the State Council on the entry into the examination as to the substance of the application, the applicant may also make further voluntary amendments to the application documents that have entered the Chinese national phase.

If the kind of protection is indicated as a patent for utility model when the international application enters the Chinese national phase, according to Rule 130 of the Implementing Regulations of the Patent Law, the applicant may make voluntary amendments to the patent application documents within 2 months from the date of entry.

[Note] There is no official fee for voluntary amendments. In addition, the patent administration department under the State Council does not charge any fees for claims that are added through voluntary amendments.

[Recommendation] When filing for a patent application through the Paris Convention or direct filing, in order to save surcharges, it may be considered to limit the number of the claims to 10 at the initial filing stage, and additional claims may be submitted at the same time when requesting substantive examination, or within the time limit of three months after the receipt of the notification of the patent administration department under the State Council on the entry into examination as to substance of the application.

In addition, according to Rule 131 of the Implementing Regulations of the Patent Law, where the applicant finds that there are mistakes in the Chinese translation of the description, the claims or the text matter in the drawings as filed before the completion of preparations for publication of an application for a patent for invention or announcement of patent right for utility

model by the patent administration department under the State Council, or within three months from the date of receipt of the notification sent by the patent administration department under the State Council, stating that the application for a patent for invention has entered into the substantive examination phase, he or it may correct mistakes after filing a written request and paying the prescribed fee for the correction of the translation.

The above translation correction procedure is also applicable to divisional applications for PCT applications entering the Chinese national phase.

#### **4. Incorporation by reference**

What is incorporation by reference?

According to the provisions of the Regulations under the Patent Cooperation Treaty, if an applicant omits certain items or parts when filing an international application, the original international application date can be retained through incorporating the omitted items or parts by referring to the corresponding parts in prior applications. Herein "item" refers to all specifications or all claims, and "part" refers to part of the specifications, part of the claims or all or part of the drawings.

Before January 20, 2024, China has made reservations to the above provisions of the Regulations under the Patent Cooperation Treaty. The patent administration department under the State Council does

not approve the retention of the original international application date through incorporating the omitted items or parts by referring to the prior applications.

However, both the new "Guidelines for Patent Examination" and "Implementing Regulations of the Patent Law", which have come into effect on January 20, 2024, have clarified the above provisions of the Regulations under the Patent Cooperation Treaty.

As a result, for international applications, the original description and claims mentioned in Article 33 of the Patent Law refer to the description, claims and drawings of the international application as originally filed, including the items or parts added through incorporation by reference.

#### **5. Expedited prosecution pathways**

For foreign applicants, priority examination and PCT-PPH are available for fast access to patents in China (PPH is available for applications based on the Paris Convention route).

As for the priority examination, the "Administrative Measures for Priority Examination of Patent" implemented since August 1, 2017 shall apply. The Measures stipulate that: if the applicant submits a priority examination request for an application for a patent for invention, utility model or design, he/she shall submit a priority examination request, prior art or existing design information materials and

relevant supporting documents; the priority examination request shall be signed by the relevant department in the State Council or the provincial intellectual property office for recommendation, and the above materials shall be submitted to the patent administration department under the State Council; after accepting and examining the priority examination request, the patent administration department under the State Council shall timely notify the priority examination requester of the examination opinion.

It should be noted that the Measures do not exclude foreign applicants from the eligible subject of the application, but in fact, whether foreign applicants can apply for priority examination based on the Measures is suggested to consult the patent administration department under the State Council or the provincial intellectual property office in advance.

With regard to PCT-PPH, here we focus on how to apply for PCT-PPH before the international application is published.

In China, there are two opportunities to apply for PCT-PPH or PPH: the first is to submit a request at the same time as the request for substantive examination; and the second is to submit a request after the application has entered the substantive examination stage and before the issuance of the notification of first office action.

Generally, when an international application enters the Chinese national phase before it is published, the

preliminary examination is not conducted. However, in accordance with Rule 129 of the Implementation Regulations of the Patent Law, the preliminary examination may be conducted when the applicant has submitted a confirmed copy of the international application (or a certified copy of the international application).

As a result, if a foreign applicant wants to obtain rights quickly in China soon after submitting an international application, he/she may consider providing a copy of the international application at the application stage and request for early publication. Once published, he/she may submit requests for substantive examination and PCT-PPH at the same time.

[Note] When there are comments in column VIII of WO/ISA, WO/IPEA or IPER, the applicant may submit a PCT-PPH request to the Patent Administration Department under the State Council if the written comments therein fall under the following circumstances:

- (1) the comments in column VIII do not relate to the claims corresponding to the PPH request to the Patent Administration Department under the State Council; or
- (2) the comments in column VIII only refer to the defects in the specification or drawings.

For the above two cases, the applicant may submit a PCT-PPH request under the premise that other conditions are met, and



briefly describe the reasons for meeting the submission conditions in column VIII in "Explanation of Special Items" on page 3 of "Description of Items" in column E of the request form. If no explanation is given or the above-mentioned circumstances are not met after examination, the request shall be rejected.

## II. Chinese Translation of PCT Application

As described above, the Chinese translation of the PCT application must be authentic to the original.

According to Rule 135 of the Implementing Regulations of the Patent Law: where, for the patent right granted upon the international application, the protection scope determined in accordance with Article 64 of the Patent Law has exceeded the scope expressed in the original text of the international application due to errors in the translation, the protection scope which is limited on the basis of the original text shall prevail; while if the protection scope is narrower than the scope expressed in the original text of the international application due to the same reason, the protection scope at the time of authorization shall prevail.

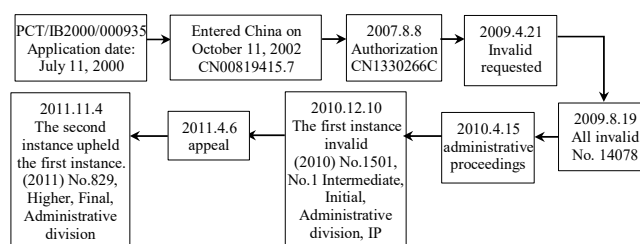
In addition, according to Chapter 2 of Part III of the Guidelines for Patent Examination, "3.3 Legal Effect of International Application Documents as Original Filed", the international application documents as originally filed

shall have legal effect and form the basis for any amendment to the application documents.

Because the international application documents as originally filed have legal effect and can be used as the basis for any amendment to the application documents, any mistranslation or omission in entering the Chinese national phase may be regarded as an intentional and voluntary amendment by the applicant.

Below, the serious consequences caused by mistranslation are shown in two cases.

[Case 1] The following is the timeline from the entry of the international application for PCT/IB2000/000935 into the national phase in China to the final ruling of the Beijing Higher People's Court that the authorized patent was declared invalid for violating Article 33 of the Patent Law.



This article does not specifically introduce the details of the mistranslation, but focuses on the viewpoints of administrative departments at all levels.

For patent ZL00819415.7, one of the reasons for the invalid request is that "thermoplastic material" in the claims of this patent cannot be derived directly and unambiguously from "thermoplastic elastomeric material" and "thermoplastic elastomer" in the international publication;

and "chemical adhesive bonding" in the specification of this patent cannot be derived directly and unambiguously from "chemical bonding" and "welded chemically" in the international publication. Therefore, it is beyond the scope of the original claims and the description and does not conform to the provisions of Article 33 of the Patent Law.

In response, the patentee argued that the "chemical adhesive" was a translation error, and the amendment was an error in the process of translating the original application text from a foreign language into Chinese.

**The Patent Reexamination and Invalidation Department** considers that for international applications, the original specifications and claims mentioned in Article 33 of the Patent Law refer to the description, claims, and drawings of the international application as originally filed. The amendment to the claims and specification of the patent cannot be determined directly and unambiguously from the international application documents as originally filed, and thus, such amendment does not conform to the provisions of Article 33 of the Patent Law, even if such amendment is caused by translation error (No. 14078).

While upholding the invalid decision, **the court of first instance** pointed out that there may be corresponding translation errors during the translation process, but if the above translation errors constitute amendments, and the amendments go

beyond the scope of the international public text, thereby violating the provisions of Article 33 of the Patent Law of 2001, **the risk shall be borne by the applicant** ((2010) No.1501, No.1 Intermediate, Initial, Administrative division, IP).

While upholding the judgment of the first instance court, **the court of the second instance** pointed out that if an error occurs in the translation process and the translation error constitutes amendments, and the amendments go beyond the scope of the international public text, it shall be deemed as a violation of the provisions of Article 33 of the Patent Law ((2011) No.829, Higher, Final, Administrative division).

[Case 2] Another case is shown below. When the international application of PCT/EP2002/002042 entered the national phase in China, the German word "stische Arme" was translated into "elastic arm" (editor's note: the correct translation is "a plurality of elastic arms, i.e., more than two elastic arms"). Based on this, the applicant added "having elastic arms" to claim 1 when responding to the notification of an office action. Regarding the "one elastic arm" in the prior art, the patentee claimed that the "elastic arm" of claim 1 was plural based on the international application documents in the invalidation stage. In response, the Beijing No.1 Intermediate People's Court gave its support ((2009) No.120, No.1 Intermediate, Initial, Administrative division). However, in the second instance, the Beijing Higher People's Court pointed out that the



applicable law in the first instance was wrong and pointed out that the "elastic arm" in claim 1 was not limited to the plural ((2011) No.100, Higher, Final, Administrative division).

Through the above two cases, the translation of the PCT applications entering the Chinese national phase can be summarized as follows:

- (1) The translation must be authentic to the original. Translation is required except for those that are permitted not to be translated in the drawings (for example, computer program languages appearing in the drawings and certain textual contents as screen display images).
- (2) If any errors are found in the translation, the translation shall be revised in a timely manner.
- (3) For example, in case 1, corresponding translation errors may occur in the translation process, but if the translation errors constitute amendments, and the amendments go beyond the scope of the international public text, thereby violating the provisions of Article 33 of the Patent Law, the risk shall be borne by the applicant.
- (4) In case 2, a seemingly simple translation of the singular or plural may also result in the patent being declared invalid. It can be seen that when translating a non-technical term, one must fully understand the exact meaning of the non-technical term in the country.

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*Email address : [ltbj@lungtin.com](mailto:ltbj@lungtin.com) Website [www.lungtin.com](http://www.lungtin.com)*

*For more information, please contact the author of this article.*



**CUI, Bingzhe**

Partner, Korean  
Account Director,  
Senior Patent Attorney

Mr. Bingzhe Cui has expertise in patent drafting and prosecution, Office Action responses and patent reexamination and invalidation, patent analysis etc., and he is very experienced in patent cases in mechanical related field such as automobiles, work vehicles, semiconductors, air conditioners, display devices, image forming devices, home appliances etc. Mr. Cui is familiar with Japanese patent practice and good at handling translations, Office Action responses and patent reexamination for domestic and foreign applications from China to Korea and Japan. Since November 2007, Mr. Cui has handled more than 1,000 patent applications for many Fortune 500 companies.