Featured Article

Recent Trends in the Modification of "Dual Application for One Invention" System

The China National Intellectual Property Administration (CNIPA) initiated the revision of the "Patent Examination Guidelines" (hereinafter referred to as the "Guidelines") in January 2025, and recently issued the "Draft Revision of the Patent Examination Guidelines (Exposure Draft)" (hereinafter referred to as the "Exposure Draft") for some of the revisions to the public, which involves the proposed revisions of the "Dual Application for One Invention" system (also called as "One Invention, Two applications" system).

The "Dual Application for One Invention" system is a characteristic application mode in the Chinese patent system. Although the "Dual Application for One Invention" system is a product during the development of the Chinese patent system, and the legality and legitimacy of its existence have always been controversial in the academic community, most innovative subjects perhaps pay more attention to the reasonable and effective use of the "Dual Application for One Invention" system in the practical operation.

In this regard, the following is an explanation of the changes to the "Dual Application for One Invention" system in the Exposure Draft, for providing corresponding references in terms of application strategies.

I. Legal Basis for the "Dual Application for One Invention" System

The "Dual Application for One Invention" system is mainly derived from the provisions of Article 9.2 of the Patent Law. In short, if the same applicant files both a utility model patent application and an invention patent application for the same invention-creation on the same day, and the previously granted utility model patent right has not yet been terminated, and the applicant declares to abandon the utility model patent right, an invention patent right may be granted.

Rule 47.2 of the Implementing Regulations of the Patent Law puts forward the procedural provisions of "Dual Application for One Invention", i.e., if the same applicant files both a utility model patent application and an invention patent application for the same invention-creation on the same day (referring to the filing date), the applicant shall state separately at the time of filing that another patent application for the same invention-creation has been filed; if no such statement is made, the application shall be handled in accordance with the principle that only one patent right may be granted for the same invention-creation.

Rule 78.4 of the Implementing Regulations of the Patent Law additionally provides that the same applicant files both a utility model patent application and an invention patent application for the same invention-creation on the same day, and obtains an invention patent right in accordance with the provisions of Rule 47.4 of the Implementing Regulations, the provision of Article 42.2 of the Patent Law does not apply to the term of patent right as obtained. That is to say, for the invention patent in the "Dual Application for One Invention", the patent term compensation is not applicable[1].

Based on the above laws and regulations, "Dual Application for One Invention" should meet at least the following basic conditions:

1. filing both a utility model patent application and an invention patent application;
2. filing the both applications on the same filing date;
3. the both applications relate to the same invention-creation, generally speaking, "the same invention-creation" requires that the invention patent application and the utility model patent application are essentially identical in technology, including the technical field, technical problem, technical solution and expected effect;

1. Article 42.2 of the Patent Law: Where a patent right for an invention is granted after the expiration of four years from the filing date and after the expiration of three years from the date of the request for substantive examination of the application, the patent administration department under the State Council shall, at the request of the patentee, extend the term of the patent to compensate for the unreasonable delay in the granting process of the invention, except for the unreasonable delay caused by the applicant.

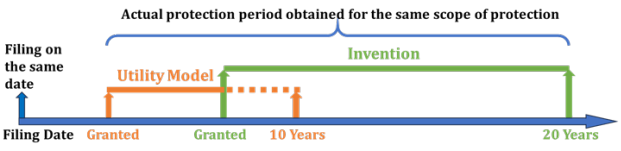
4. mandatory statement of "Dual Application for One Invention" when filing the application; and
5. the utility model was patented first and has not been terminated.

II. Reasons for the Use of the "Dual Application for One Invention" System

It seems there is a contradiction between the "Dual Application for One Invention" system and the principle of prohibiting double patenting as provided by Article 9.1 of the Patent Law (i.e., "for any identical invention-creation, only one patent right shall be granted."). However, in order to encourage small and medium-sized enterprises to carry out invention-creations, balance the public interest, avoid abuse of the patent system and so forth, as an exception to the principle of prohibiting double patenting, the "Dual Application for One Invention" system allows that when one of the two applications is granted and remains valid, the other one thereof can be re-granted with the same protection scope (also called as "secondary granting") under the conditions of allowance, as long as the applicant is willing to voluntarily give up one of the two applications which have already been granted before the granting of the other one of the two applications.

One of the main reasons why "Dual Application for One Invention" system is favored by some innovation subjects lies in the fact that: in the reality of the relatively weaker legal effect of the temporary protection after the publication of an invention patent application, the "Dual Application for One Invention" system, to some extent, may solve the problem of the innovation subject's uncertainty about the inventive step of the technical solution and give a longer period of protection with stronger legal effect.

In other words, the innovation subjects can make use of the procedural advantage that the utility model may be granted quickly by only conducting preliminary examination, obtain the utility model patent right of a certain scope of protection first, and then declare that the utility model patent right will be terminated as of the date of the announcement of granting the invention patent right, so that the utility model patent right and the invention patent right can realize the "seamless connection" of the same scope of protection in the "baton" mode in terms of the patent protection period, which extends the effective patent protection period of the same protection scope compared with only filing one of the utility model and the invention applications (see the following figure).



III. Changes to the "Dual Application for One Invention" System in the Exposure Draft

The contents of Part II, Chapter 3, Section 6.1 "Principles of Judgment" of the Patent Examination Guidelines currently in force is amended in the Exposure Draft (indicated by amendment marks):

"6.1 Principles of Judgment

……

When making a judgment, if one claim of a patent application or patent has the same scope of protection as a claim of another patent application or patent, they shall be deemed to be the same invention-creation. According to Rule 47.2 of the Implementing Regulations of the Patent Law, if the same applicant files both a utility model patent application and an invention patent application on the same day (referring to the filing date) and makes a statement at the time of filing respectively, whether both applications belong to the same invention-creation or not shall be based on the statement made by the applicant in the request.

At the same time, Section 6.2.2 "Treatment of a Patent Application and a Patent Right" in the same Chapter 3 is also amended in the Exposure Draft (indicated by amendment marks):

"6.2.2 Treatment of a Patent Application and a Patent Right

……

However, where the same applicant files both a utility model patent application and an invention patent application for the same invention-creation on the same day (only referring to the filing date), the utility model patent right granted earlier has not yet been terminated, and the applicant has made a statement at the time of filing of the applications respectively, ~~in addition to amending the invention application,~~ the applicant may ~~also~~ avoid double patenting issue by abandoning the utility model patent right. Therefore, during the examination process of the said invention patent application, if the invention patent application meets other conditions for granting a patent right, the applicant shall be notified to make a choice ~~or make an amendment~~, and if the applicant chooses to give up the utility model patent right which has already been granted, the applicant shall attach a written statement of abandoning the utility model patent right to the reply for responding to an relevant Office Action. At this time, for the invention patent application which meets the conditions for granting and has not yet been granted, a notification of grant shall be issued, and the written statement of abandoning the aforesaid utility model patent right shall be forwarded to the relevant examination department, and the Patent Office shall register it and make an announcement, which states that the aforesaid utility model patent right shall be terminated as of the date of the announcement of the grant of the invention patent right. If the applicant does not abandon the utility model patent right,

the invention patent application will be rejected."

IV. Differences in the "Dual Application for One Invention" System before and after Amendment

1. Regarding Amendments to Part II, Chapter 3, Section 6.1 "Principle of Judgment"

The amendment related to Part II, Chapter 3, Section 6.1 "Principles of Judgment" clarifies that the nature of the case of "Dual Application for One Invention" is based on the applicant's written statement at the time of filing of the patent applications to determine whether the applications filed on the same day is for the same invention-creation or not, which is in fact in line with the current operation practice. This processing mode provides a simple and operable way to judge "Dual Application for One Invention", regardless of whether the protection scopes of the invention and the utility model applications are same or not.

2. Regarding Amendments to Part II, Chapter 3, Section 6.2.2 "Treatment of a Patent Application and a Patent Right"

The amendment related to Section 6.2.2 "Treatment of a Patent Application and a Patent Right" will somehow have a substantial impact on the current practice.

- **Current Practice (Before Amendment)**

At present, the "Dual Application for One Invention" system allows for "peaceful coexistence" of the invention patent and the utility model patent. In other words, on the one hand, "Dual Application for One Invention" can achieve "secondary granting" by abandoning the utility model patent right for the same scope of protection, and on the other hand, "secondary granting" can be circumvented by amending the protection scope of the invention patent application, such that both the invention patent and the utility model patent can coexist. For example, during the examination of the invention patent application, if the application meets the other conditions for granting a patent right except for the problem of doubling patenting, the CNIPA will notify the applicant to make a choice or make an amendment, which is a key point during the examination process and gives the applicant a certain degree of decision-making power.

This model gives the applicant a greater freedom to weigh the retention of the invention and utility model rights during the examination process, and even to protect the protection scope other than that of the utility model right through the invention patent right while retaining the utility model right. Therefore, under the present (un-amended) "Dual Application for One Invention" system, in fact, there is no limitation on whether the protection scopes of the invention and the utility model are the same or not at the time of filing, and it is generally believed that

advocating "Dual Application for One Invention" provides more room for the applicant to operate and is "beneficial and harmless".

- **Revised according to Exposure Draft (After Amendment)**

Based on the amendments made in the Exposure Draft, the amended "Dual Application for One Invention" system will result in the "incompatibility" of the invention patent right and the utility model patent right. In other words, after amendment, only one of the invention and utility model patent rights can be retained in the "Dual Application for One Invention", regardless of whether the invention patent application has been amended or not, and whether there is a double patenting issue between the invention and the utility model. This means that the applicant can only obtain one patent right from the "Dual Application for One Invention", regardless of the situations of the subsequent examination. Moreover, if the applicant does not voluntarily abandon the earlier granted patent right, the later examined application will be rejected.

It can be seen that the treatment of "Dual Application for One Invention" has been clearly defined as that the invention patent right may be granted only if the obtained utility model patent right is abandoned, and otherwise the invention patent application will be rejected. Therefore, under the amended "Dual Application for One Invention" system, whether or not to adopt the "Dual Application for One Invention" system looks mainly related to whether or not the protection scopes are same or not in the invention and utility model. It is no longer a "beneficial and harmless" model for the applicant to adopt the "Dual Application for One Invention" system without considering the protection scopes. On the contrary, it is necessary to carefully consider whether to state "Dual Application for One Invention", since "Dual Application for One Invention" may only retain one patent right.

Specifically, if the applicant expects the protection scopes claimed by the invention and the utility model are the same, which may be understood as that at least one claim of the invention is as same as at least one claim of the utility model, and wishes to benefit from the utility model compared with the invention in aspects of faster examination procedure, relatively lower inventive step and so forth, the applicant may choose to claim "Dual Application for One Invention". However, if the applicant expects at the time of filing that the protection scopes claimed by the invention and the utility model are different, which may be understood as that none of the protection scopes of the invention and the utility model are same, and wishes to have opportunities to obtain two types of patent rights, please bear in mind not to choose to claim "Dual Application for One Invention".

V. Conclusion

The above preliminary analyses of the potential revision trend of the "Dual Application for One Invention" system are made in conjunction with the Exposure Draft. The amendments to this part of the Guidelines aim to further regulate the situation where the same applicant files both a utility model patent application and an invention patent application for the same invention-creation on the same day, reduce the problems caused by the granting of the invention and the utility model filed at the same day in terms of the maintenance and enforcement of the patent rights or others, save examination resources, reduce the burden on the applicants, and further improve the public expectation of the examination results of the applications filed on the same day. The revision is likely to be implemented soon, so the innovation subjects need to plan ahead.

In short, if the Guidelines are finally revised as above, for the invention and the utility model to be filed on the same day, it is recommended to determine in advance whether they are intended to protect the same scope of protection, and then at least based on this, determine whether or not to state "Dual Application for One Invention". While, for the invention and the utility model to be filed on the same day and intended to cover different scopes of protection, it is recommended not to state "Dual Application for One Invention".

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