

Foreign filing license practice –
US vs China

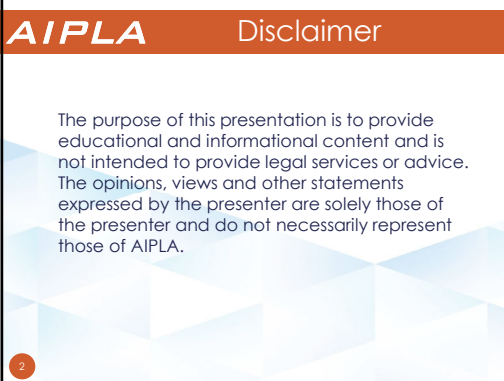


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AIPLA FFL practice – US vs China



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Cross border research

- 29 countries having local law requirements similar to the US foreign filing license – China, India, France, Germany, Spain, Malaysia, Vietnam, etc.
(https://www.wipo.int/pct/en/texts/nat_sec.htm)
- Research teams in the US and China (good luck if you have more)

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What could happen if not complied with?



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China – secrecy examination

- Introduced in the 2008 revision of the CN Patent Law
- Modelled from the US foreign filing license system
- ONLY invention patent and utility model. Design not included
- Must be complied with **BEFORE** filing a patent application not in China

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China – secrecy examination

- Invention substantially "completed" in China
- **NO** relevance to the nationality of the inventor



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China – secrecy examination

- How to do it?
 1. File a separate request for secrecy examination
 2. File this request together with a patent application (in Chinese) with the CNIPA
 3. File a PCT application with the CNIPA as the Receiving Office (RO)
- Prefer to choose 2. or 3.
- Need a detailed description of the invention → patent specification
- Modification?

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China – secrecy examination

- What would happen?
 - If no notice from the CNIPA in 4 months that further examination is required; OR
 - If a notice is issued that further examination is required but not result notification is issued to the applicant in 6 months
→ Foreign filing license granted
- CNIPA could issue a notice of "free to go" (typically in 2-4 weeks)

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China – secrecy examination

- PCT application with CNIPA as the RO
 1. English
 2. Automatic allowance (need 4 months)
 3. Need one CN entity (CN inventor, or CN branch) as applicant

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US + CN research team suggestion

- Obtain a foreign filing license from the USPTO **without** filing a patent application
- File a PCT application with the CNIPA as the RO

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US – Filing in a Foreign Country

- "Except when authorized by a license ... a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country." 35 U.S.C. § 184(a).

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US – Foreign Filing License (FFL)

- FFL required for “any application for patent including any modifications, amendments, or supplements thereto or divisions thereof” or “for a utility model, industrial design, or model, in a foreign country, foreign patent office, foreign patent agency, or any international agency,” if
 - Application filed in the USPTO less than 6 months prior; or
 - No application has been filed in the U.S.

See 37 CFR 5.11(a).

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US – FFL granted

- Filing receipt usually indicates that FFL is granted.
- If no FFL and no secrecy order, Applicant may foreign-file the application.

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US – FFL authorizes:

- filing the application in a foreign country; and
- the export of technical data abroad for purposes relating to the preparation, filing or possible filing and prosecution of a foreign application.

See 37 CFR 5.11(b).

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US – Penalty for FFL Failure

- Willful violation subject to “be[ing] fined not more than \$10,000 or imprisoned for not more than two years, or both.” See 35 U.S.C. 186.
- Invalidation of the U.S. patent unless violation “through error” and disclosure not subject to a secrecy order. See 35 U.S.C. 185.
- Abandonment of invention, i.e., forfeiture, for violating a secrecy order. See 35 U.S.C. 182.

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US – How to obtain FFL?

- Wait for the filing receipt or six months after filing the U.S. application.
- Petition for expedited FFL.
- Petition for retroactive FFL.

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US – Expedited FFL

- Petition under 37 CFR 5.13.
- A legible copy of material upon which a license is desired.
- Required fee.
- Submitted via e-filing, facsimile, or hand-delivered.
- FFL may be granted in 2-3 days.

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US – Retroactive FFL

- Petition under 35 U.S.C. 184.
 - With a declaration that: no secrecy order, showing of diligence, explanation how the error occurred.
- Required fee.
- Submitted via e-filing, facsimile, email, or hand-delivered.

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