

## Deacons Bitesize IP

# China Intellectual Property

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## China has designs on Hague but local requirements still important

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### Did you know?

On 5 February 2022, China joined the Hague System for the International Registration of Industrial Designs. The Hague System is an international treaty that establishes a mechanism for obtaining design protection in multiple jurisdictions through filing a single application. The provisions will become effective in China on 5 May 2022 and means that international applicants will be able to designate China as one of the jurisdictions covered by an international design application. It also means that Chinese applicants will be able to seek international protection for their designs in up to 94 countries currently covered by the Hague System including the EU, Japan, the US and the UK. Given that, according to WIPO statistics, Chinese residents filed some 55% of the worldwide design application total in 2020, the system is expected to be popular with Chinese applicants.

### Why does this matter to you?

The advantage of filing under the Hague System is that the process is simple and very cost-effective. A single application will also make maintenance and renewal much easier in different jurisdictions. However, it is important to note that the domestic examination process and legal standards in the designated countries remain unchanged. For China, important issues such as novelty, the novelty grace period, and other substantive aspects of the Chinese Patent Law, will not be changed by joining the Hague System.

Although Chinese Law does not require substantive examination of design applications, in practice, we are expecting the Chinese Patent Office to conduct a supplementary “formality” examination which is likely to include substantive issues such as novelty and distinctiveness. This is suggested by the Draft Amendments to the Chinese Examination Guidelines, which introduce a discretion for examiners to conduct limited prior design search, and novelty and distinctiveness examination, if they find it necessary.

In addition, the Chinese Patent Office will check other “formality” issues relating to clarity, such as vague representations, inconsistency between design views, overexposure/reflection in the picture, and shading, or insufficient design projection views, which will be considered substantial defects. These issues are frequently encountered in design applications filed in China under the Paris Convention, and can be addressed easily during the pre-filing stage for Paris Convention applications, but may be hard to remedy under the Hague System. This is because late submission of projection views, or amendments to the representations, are likely to be considered added matter and beyond the original scope of the application under certain circumstances.

China also has very strict criteria for multiple designs in contrast to other IP Offices, such as the EUIPO. Therefore, applications filed from Europe will need to check that their designs meet the Chinese standard. Otherwise, the Chinese Patent Office may raise a lack of unity objection and require applications to be divided into separate applications, when a divisional application could have been filed at the outset.

Although the Hague System establishes general provisions for all Contracting Parties, it allows individual countries to declare certain amendments within the agreed ranges to accommodate their domestic requirements. China will be making some Declarations including the requirement for unity of design and specific views of designs but full details have not been formally announced.

Therefore, it is advisable to discuss with local counsel when deciding whether to file an international design application or a direct national application, and to make sure that the design will not meet with objections or rejection when it is examined locally. This is especially important as China's absolute novelty rule could mean that applicants will not be able to remedy any substantive deficiencies.

Please also be aware, China has specified that the Hague System will not apply in the Hong Kong or Macao Special Administrative Regions as the IP systems in these two regions are governed by local legislation under the "one country, two systems" constitutional principle.

For Chinese applicants, the Hague System could allow them to seek quick and easy design protection in multiple countries and help their expansion into international markets.

## Want to know more?

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