

8 years
2011-2019

Cross-Border Strategies in China for Patent Enforcement

Presented by Frank Gao
ABC Patent Service, LLC
www.abc-patent.com
June, 2019

This presentation and any accompanying materials should not be considered to constitute legal advice or legal opinions of Frank Gao and/or ABC Patent Service LLC, and is meant merely to promote discussion about valuation. This presentation does not create an attorney-client relationship with ABC Patent Service LLC. Please consult legal counsel or valuation professionals familiar with your particular circumstances before taking any action.

Myth

8 years
2011-2019

- Global Patents?
- any geography limits for patents?
- Filing US patents help enforcing IP in China?

Strategies

8 years
2011-2019

- Preventive measure
- Reactive measure



Preventive measure

8 years
2011-2019

- I. File Multiple Chinese Patents
- II. Choose partners carefully
- III. Bi-lingual engagement letter
- IV. Online and offline counterfeit



File Chinese Patents

8 years
2011-2019

- Via PCT
- Via Paris Convention
 - Need translation
 - Prosecution: 3-6 years
 - Grant/search system, not registration system

Allowance/Issuance

8 years
2011-2019



- Last chance to fix a number of issues
 - Notice provides a checklist
 - Attorney's checklist if accessible
- Hint that patent attorney was being diligent

Reactive measure

8 years
2011-2019

- I. Cease and Desist Letter
- II. file patent infringement law suit
- III. Work with local gov't
- IV. Work with customs

Where

8 years
2011-2019

- Intellectual Property Office of the People's Republic of China
 - <http://english.sipo.gov.cn/>
 - SIPO----CNIPA (Chinese National Intellectual Property Admin)
 - Free patent and publication searching
 - All the laws, rules, and regulations
 - Statistics, papers, presentations, etc.

Where?

8 years
2011-2019



- www.uspto.gov
 - Free patent and publication searching
 - All the laws, rules, and regulations
 - Statistics, papers, presentations, etc.
 - The Examiner's bible is the **MPEP** (Manual of Patent Examination Procedure)
 - File histories from PAIR (Patent Application Information Retrieval) system
 - Free public database
 - <http://portal.uspto.gov/external/portal/pair>
 - Generally from patents 6,700,000 (filed 2004) to the present
 - Otherwise, order older file histories from an IP support co.
- Other private databases (Lexis)

8 years
2011-2019

Questions?

Thank you for your time.

Frank Gao

ABC Patent Service, LLC

614-806-0302

frank@abc-patent.com

or visit us at www.abc-patent.com