Application of Double Patenting Prohibition Doctrine From the Perspective of Shu Xuezhang Case

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The double patenting prohibition doctrine, a cornerstone of the patent system, is observed in all national patent laws with out exception.

Article 9 of the Chinese Patent Law and Rule 13, paragraph one, of the Implementing Regulations of the Patent Law have together laid down the basic principle for the prohibition of double patenting in China. In particular, the provision that "for any identical invention-creation, only one patent right shall be granted" as set forth in Rule 13, paragraph one, of the Implementing Regulations of the Patent Law has directly spelt out the meaning of the doctrine of double patenting prohibition. In the Draft of the Third Amendment to the Patent Law, this provision has become paragraph one of Article 9 of the Patent Law, which has highlighted its guiding position.

While the Chinese Patent Law expressly prohibits double patenting, views are divided in the community as to how to understand the function and legal implication of the doctrine of double patenting prohibition and how to apply the relevant law provisions.

I. Heated discussion on double patenting prohibition doctrine as triggered by a specific case

The case to be discussed below is undoubtedly to take an important position in the history of the development of the Patent Law in China. To his unexpectedness, the seventy-eight-year-old Shu Xuezhang has his name closely associated, once more, with the development of the Patent Law in the China since 2002. Shu Xuezhang applied, in 1991, for a patent for the utility model entitled "an efficient energy saving double decked reverse burning furnas", and applied, in 1992, for a patent for the invention of the identical invention. On 1 October 1999, namely, 8 months after the expiry of said utility model patent, Mr. Shu was granted the invention patent. Directed to his invention patent, a furnas plant requested the Patent Reexamination Board (PRB) for invalidation thereof on the grounds that said invention patent was contrary to Rule 12, paragraph one, of the Implementing Regulations of the Patent Law as of 1992 and said utility model patent and the invention patent, identical in subject matter, constituted double patenting. Upon examining the case, the PRB held that the invention patent was granted at the expiry of said utility model patent, so said two patent rights did not co-exist, and the PRB decided to have kept the invention patent valid.[1]

In the follow-up administrative litigation, the first-instance court supported the PRB's view, believing that the provision that "for any identical invention-creation, only one patent right shall be granted" of Rule 12, paragraph one, of the Implementing Regulations of the Patent Law as of 1992 should be construed as meaning that the "identical invention-creation should not exist as two or more valid patents", or they would constitute "double patenting" prohibited under the law[2]. The invention patent and the utility model patent involved in the case did not exist at the same time, with the protection thereof discontinuous, so they did not constitute double patenting. The second-instance court held the opposite view that after the expiry of the utility model patent, re-granting the later invention patent was equivalent to patenting again a technology that had fallen into the public domain. This was a case of double patenting[3].

Rendering of the second-instance ruling was followed by a heated discussion in the society on the function and aim of the doctrine of double patenting prohibition. The court's final ruling did not give a conclusive answer to the question,

and the PRB requested a review. Even after the court's final ruling took effect, the State Intellectual Property Office SIPO explicitly noted in the amended Guidelines for Examination that "the doctrine of double patenting prohibition for identical invention-creation is to prevent conflict between patent rights. Therefore, the doctrine of double patenting prohibition means that the identical invention-creations should not co-exist as two or more valid patent rights"[4].

That the Guidelines for Examination, the regulations of the SIPO, are in direct conflict with the effective court ruling is something rare, which shows that the discussion on the doctrine of double patenting prohibition is of great importance. On 9 August 2007, the Supreme People's Court reviewed the case and decided on 14 July 2008 that "the doctrine of double patenting prohibition under the Patent Law means that the identical invention-creations should not co-exist as two or more valid patent rights, but not that an invention-creation should be granted the patent right once only"[5].

However, the Supreme People's Court's decision only supported the view held by the review requester, the SIPO, without explaining why the view was right from the perspective of the function and theory of the doctrine of double patenting prohibition; hence the Supreme People's Court's decision did not put a full-stop to the heated discussion on the matter of doctrine of double patenting prohibition.

II. Confusion about double patenting prohibition doctrine

Regarding the doctrine of double patenting prohibition, namely the provision of the Implementing Regulations of the Patent Law that "for any identical invention-creation, only one patent right shall be granted", it is explained in the Guidelines for Examination as follows:

"Granting several patent rights to the identical invention-creation is prohibited to prevent right conflict; hence the doctrine of double patenting prohibition means that the identical invention-creation should not exist as two or more valid patent rights."

This tells us that the purpose to "prohibit double patenting" is to prevent conflicts between the patent rights. Let's first suppose this view is correct and analyse it with reverse examples:

Supposing that A0 (a prior application) and A1 (a later application) are identical invention-creations, there are two circumstances in connection with identical or different applicants:

(1) In connection with different applicants

If A0 is disclosed before the filing date of A1, then A0 constitutes the prior art of A1, and may be rejected for lack of novelty under Article 22, paragraph two, of the Patent Law or for lack of inventiveness under Article 22, paragraph three, thereof;

If A0 is disclosed after the filing date of A1, then A0 constitutes an application conflicting with A1, and may be rejected on the ground of novelty under Article 22, paragraph two, of the Patent Law.

It is thus shown that there is no need for the application of the doctrine of double patenting prohibition.

(2) In connection with identical applicants

If A0 is disclosed before the filing date of A1, then A0 constitutes the prior art of A1, and may be rejected for lack of novelty under Article 22, paragraph two, of the Patent Law or for lack of inventiveness under Article 22, paragraph three, thereof. It is thus shown that the doctrine of double patenting prohibition has no function to perform.

If A0 is disclosed after the filing date of A1, then A0 does not constitute an application conflicting with A1, and may not be rejected for lack of novelty under Article 22, paragraph two, of the Patent Law; That is to say, there exists no such issue as conflicting applications.

When A0 does not constitute an application conflicting with A1, double patenting is prohibited only under the provision that "for any identical invention-creation, only one patent right shall be granted."

It may be summed up from the preceding analysis that in case of different applicants, Article 22 of the Patent Law would exclude the later application A1 from patentability; it would be impossible for such issue as double patenting to appear; hence it is unnecessary to resort to the "doctrine of double patenting prohibition".

In the case of identical applicants, the conflicting application does not apply. But, we have above supposed that "granting double patent rights to the identical invention-creation is prohibited to prevent right conflict", then due to the identical applicants, that is, the two patentees are the same person, the patents at issue do not conflict with each other; so there is no role for the doctrine of double patenting prohibition to play.

It may thus be concluded that no matter whether the applications are identical or not, the doctrine of double patenting prohibition has no role to play in this regard.

If this conclusion is correct, it shows that the doctrine of double patenting prohibition is not needed within the patent system, which obvious conflicts with the theory of existence of the doctrine of double patenting prohibition as a cornerstone of the patent regime.

Then we are compelled to question the view as shown in the Guidelines for Examination: whether the doctrine of double patenting prohibition functions to prevent right conflict. If the answer is yes, then the issue may be addressed without the need for applying the doctrine of double patenting prohibition. If the answer is no, then the true purpose of the doctrine of double patenting prohibition should be found.

What is its true purpose? Before answering the question, we'd better draw on the provision on "double patenting" in the US patent system for inspiration.

III. How the matter of double patenting is addressed in the U.S.

"Double patenting[6]", a term used for showing the phenomenon in the U.S., is defined in section 804 of the US Manual of Patent Examining Procedure (MPEP)[7] "Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by a different inventive entity having a common inventor, and/or by a common assignee/owner". In other words, when the applicants or inventors are different persons, there would not arise such issue as "double patenting".

In the U.S., in addressing the issue of "double patenting", "identical inventions" are divided into two types: one that can be rejected on the "statutory" double patenting grounds and the other on the non-statutory grounds of "judicially created obviousness"[8].

(1) The "statutory" double patenting grounds

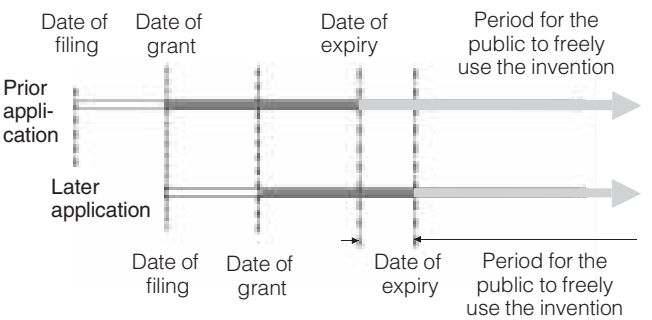
When a later patent application and a prior patent are identical inventions, the application may be rejected under the provision "whoever invents or discovers any new and useful process ..... may obtain a patent therefor" as set forth for in 35 U.S.C. 101. When determining the presence of the statutory double patenting ground, the question to be asked is whether the same invention being claimed twice, for 35 U.S.C. 101 prevents two patents from being issued for the same invention. "Same invention" means "identical subject matter."[9]

(2) The non-statutory grounds of "judicially created obviousness"

Where a later patent application is not identical with a prior patent, but it may be "anticipated" from the latter or it is obvious modification of the latter, then there exists the matter of "rejection on the basis of double patenting arising from the judicial obviousness".

The non-statutory grounds of "judicially created obviousness", a rejection based on non-statutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Goodman.[10]

The rejection based on non-statutory "obviousness type" can be illustrated with the following diagram:



As is shown above, the US view is that after a patent expires, the invention or its obvious modification is freely available to the public. In case of the non-statutory grounds of "judicially created obviousness", two patents granted at different times co-exist simultaneously, but it seems that the Americans do not mind too much the "time of co-existence". We may thus assume that "the time of co-existence is not an issue, what is not tolerant under the US patent system is the extension of the time upon expiry. Now that the Americans do not tolerate this, so they act directly, not by preventing the "co-existence" through disclaimer of a patent, but by letting the patentee makes a "terminal disclaimer" to "advance" the date of expiry of the later patent to that of the prior patent. That is, the later patent expires earlier on the date of expiry of the prior patent. It is thus shown that US practice is to cut off the later "extension time", without caring too much about the earlier "time of co-existence".

There are two circumstances where double patenting is treated in the U. S.: 1) you have obtained a patent for an identical patent; and 2) the patent you now claim is an obvious modification of the patent you have earlier obtained.

The solution to the first circumstance is to present rea-

sons that the two applications are dissimilar, or to amend or delete the claims of the later application, rather than disclaim the time of extension by making a terminal disclaimer; and the second circumstance is addressed by seeking the grant of the later patent by way of disclaiming the time of extension.

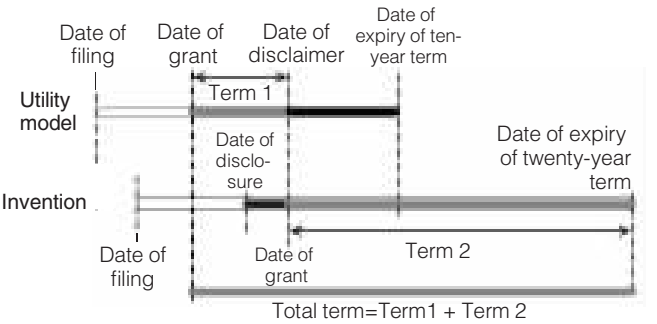
To sum up, in the U.S., the concept similar to "identical invention" in China is divided into the same invention and obviousness-type invention, and they are treated differently. As regards the former, 35 U.S.C. 101 clearly provides for the prohibition of claiming one patent twice; as for inventions that are not literally the same, an applicant is not allowed to seek the extended term of protection by a disclaimer of the time of extension. The US Constitution expressly confines the exclusive rights, including patent, to "limited time"[11], and the essential purpose to prohibit double patenting is to prevent improper extension of the term of a patent protection. For an inventor to enjoy the exclusive right within a limited time is virtually a pay-off for his disclosure of his invention, and beneficial for the public at large availability. Therefore, the purpose of the doctrine of double patenting prohibition in the U.S. is twofold: to prevent unfair extension of the exclusive right and to ensure the free availability of a patented technology, including its obvious modification to the public upon the expiry of the patent right.

IV. Essential purposes of establishing double patenting prohibition doctrine in China

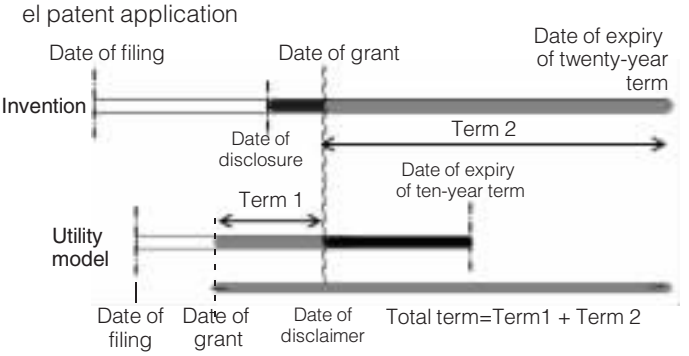
It is shown in the foregoing analysis that the doctrine of double patenting prohibition as embodied in Rule 13, paragraph one, of the Implementing Regulations of the Patent Law is applicable only to the same applicant's repeated application for patent for the identical invention, but not to a different applicant's repeated application for patent for the identical invention. Based on this, the analysis is presented here below.

First of all, we would like to analyse the circumstance where the same applicant applies, at different times, for an invention patent and utility model patent for the identical invention in the following diagram.[12] To be specific, there are three ways:

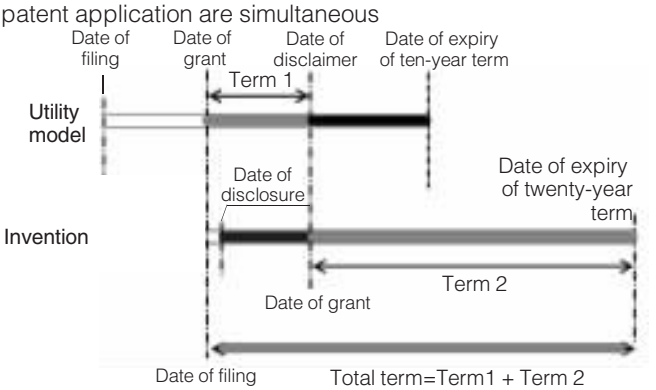
(1) The utility model patent application is prior to the invention patent application



(2) The invention patent application is prior to the utility model patent application



(3) The invention patent application and the utility model patent application are simultaneous



What is common to (1), (2) and (3) is that the applicant adopts the strategy of applying two types of patents for the same technical solution, thus virtually extending the term of said technical solution. As a result, the applicant secures a term for his invention longer than what he would otherwise obtains for a invention patent or utility model patent alone.

As is clearly shown in the above diagrams, the invention patent becomes valid from the date of disclaimer of the utility model patent, and after the applicant secures a term longer than that of any one of the patent types, he abandons his utility model patent assured. The State Intellectual Property Office (SIPO) admits that the problem arising from this practice is that "the term a patentee secures for the identical invention is likely to be longer than the term of twenty years for

an invention patent".[13] The drafters of the Guidelines for Examination were aware of the problem, and has come up with a solution in the amended Guidelines for Examination: when challenged for double patenting, the patentee should present, "in writing, the terminal disclaimer of its patent right from the date of application" to the PRB, and in this manner, seeks to keep the patent right for the identical invention-creation valid. "In case of such a disclaimer, the patent right is deemed to have not existed from the beginning"[14]. For them, "the great advantages of the terminal disclaimer of the patent right from the date of filing is to ensure that the term of a patent for the invention will not be extended, and the disclaimer and the invalidation thereof are of the same effect."

Evidently, the drafters of the Guidelines for Examination have also realised that the doctrine of double patenting prohibition should have the purpose and function to prevent extension of patent term. But, the solution made available in of the Guidelines for Examination as of 2006 has not solved the problem of extended term once and for all.

In legal sense, the disclaimer is to abandon the existing patent right for a utility model, and the patent should not be taken as "not existing from the beginning". It has nothing in common with the "invalidation" in legal sense. By law, "invalidation" results in "a patent not existing from the beginning". That is, the patent is not legitimate from the very beginning, while making the terminal disclaimer is a voluntary act of free disposal of one's own right. In practice, even if a patent right is disclaimed from the date of filing, the patent right is valid in reality from the date of filing to the date of presenting the disclaimer. For example, the patentee may bring an action against infringement in the meanwhile, and secure benefits from the right that is to be deemed non-existent later, and need not return the benefits secured from a right that does not exist from the beginning after disclaimer of the patent right. Obviously, this solution cannot prevent the extension of the term of the patent at issue.

While the drafters of the Guidelines for Examination as of 2006 fail to address the issue of patent term extension,[15] their realisation of the purpose of the doctrine of double patenting prohibition to prevent extension of the term of a patent represents progress.

After the foregoing analysis, it may be found out from the Supreme People's Court's view that the Supreme People's Court confines the doctrine of double patenting prohibition merely to disallowance of co-existence of two or more valid patent rights for the identical invention-creation. It does not restrict the view and practice that only one patent right is granted to the identical invention-creation, nor does it rectify the defect of extended term of a patent, nor is it possible to embody the fundamental purpose of the doctrine of double patenting prohibition.

V. Doubts about some remarks in the Supreme People's Court's Ruling

(1) About the practice that "one applicant applies for both a utility model patent and an invention patent for identical invention"

In the Ruling, the Supreme People's Court noted: "the Guidelines for Examination allows one applicant applies for a utility model patent and an invention patent for identical invention at the same or different times. This practice has been there for historical reasons. While not perfect, this practice is good for applicants to choose the best way to seek patent protection for their invention-creations."

It should be pointed out that it is not literally provided in the Guidelines for Examination that "one applicant is allowed to apply for a utility model patent and an invention patent for identical invention at the same or different times". Whether and how to apply is an applicant's own choice. In practice, it is common for one applicant to apply for a utility model patent and an invention patent for the identical invention at the same or different times. The applicant takes advantage of the expedite utility model examination to seek early grant of a patent, and makes use of the long term of patent for invention patent to secure longer legitimate monopoly of his technology. How this practice is dealt with under law has a bearing on the balance of interests between the patentees and the public at large, and on how to construe and implement the doctrine of double patenting prohibition. Account should not be taken merely of whether it is good for the applicants, but, more importantly, of whether the practice is legally well based, and whether the balance of interests between the patentees and the public would be ruined. Then, as the Shu case shows, the practice has exactly exposed him and the public to repeated lawsuit. Perhaps, we may draw on the experience gained in the Taiwan region, where the circumstance for one applicant applies for an utility model patent and an invention patent for identical invention at the same or different times is known as "two applications in respect of one invention"[16]. A scholar in Taiwan believes that "repeated applications should not be filed for an inven-

tion patent and a utility model patent for the identical invention, nor is there a relay of rights one following another. Therefore, under the circumstance where an applicant, intending to take advantage of the shorter time required for examination of an application for utility model patent, files applications for both the invention patent and utility model patent for the identical invention, even if he can secure the patent right for utility model first, the resultant risk is possibly unfavorable evaluation of the technical report or even the concern that the patent would become non-existent from the very beginning. If he exercises the right, he would be held liable for damages under Article 105 of the Patent Law,[17] and be exposed to unnecessary trouble for nothing."[18] The scholar finally cautions applicants that "never file two applications for a utility model patent and an invention patent for identical invention; otherwise, you would not only have to pay for the application fees and annual fees for both patents, but also make the legal relations between the two applications complicated, and invite endless involvement in complaint and litigation. The applicants must act with caution."

Therefore, a ruling that presents a legal analysis is convincing.

(2) About the assertion that "double patenting is construed as meaning grant of patents twice for identical invention"

In the Ruling, the Supreme People's Court noted: "if double patenting is construed as meaning grant of patents twice for identical invention, it would make the patent examination and grant operationally difficult in practice. If within the time after an application is filed for an invention patent and before its publication, another person files an application for a utility model patent for the identical invention-creation and is granted the patent right, the invention patent should not be granted if it is simplistically believed that only one patent right should be granted to the identical invention-creation this obviously goes against the first-to-file doctrine. If the grant of an invention patent must follow the invalidation of a utility model patent, it would also make the practical operation difficult."

Evidently, here is a contradiction in the Ruling. Before this, the provision that "for any identical invention-creation, only one patent right shall be granted" of the Implementing Regulations of the Patent Law is interpreted in the Ruling as meaning that where one applicant applies for a utility model patent and an invention patent for identical invention-creation, so long as the two patent rights do not co-exist at the same time, they are not contrary to the doctrine of double patenting prohibition." It is thus shown that the premise for the discussion of the issue of double patenting is that "one applicant applies for a utility model patent and an invention patent for identical invention at different times", rather than the "issue of conflict" arising from another party's "separately filing an application for a patent for the identical invention-creation". But the circumstance where within the time after an application is filed for an invention patent and before its publication, another person files an application for a utility model patent for the identical invention-creation and is granted the patent right" obviously has nothing to do with double patenting, and based on this it is impossible to explain why the patent right can be granted twice for which one applicant files for "identical invention".

(3) About the issue of a patent falling into the public domain upon expiry.

The Supreme People's Court admits: "under most circumstances, expiry of a patent right would result in a technology falling into the public domain". To prove the exceptional cases in a few circumstances, where "it cannot be concluded that once a patent right expires, the relevant technology falls into the public domain", the Supreme People's Court recites the examples of parent and daughter patents to support its view.

However, an essential point is missing in the Supreme People's Court's assumption as is shown in this article: the doctrine of double patenting prohibition is applicable only to the issue that one applicant applies for patent twice for the identical invention. The parent and daughter patents are not "identical invention".

The Supreme People's Court defines the parent and daughter patents as follows:

The daughter patent, also known as improvement patent, means that the later invention patent or utility model patent is an improvement of a prior patent by addition of new technical contents while using the technical solution of the prior patent, including addition of a new technical features or discovery of new use on the basis of the prior patent. This is patentable, and its prior patent is known as the parent patent."[19]

As this definition shows, in terms of time, the parent patent application is prior to the daughter patent application, and the daughter has novelty and inventiveness relative to the prior patent. That is, the two would by no means constitute "identical inventions".

Accordingly, any discussion and analysis along the line become meaningless.

(4) About the relations between domestic priority system and doctrine of double patenting prohibition.

It is known that there are three types of patents in the patent regime in China: invention, utility model, and design. Examination of the utility model patent application is on a fast track, with quick grant for earlier patent, while that of the invention patent application is slow, and grant thereof takes longer time, with longer term than that of the utility model patent. Patents of the two types are mutually complementary. With the two types of patents, being invention-creations relating to technical solution and in the absence of a new application type that has the advantages of the said two types of patent in the patent system in China available to the applicants, the applicants have to choose between the two. That is why applicants are often hesitant as to whether to apply for the invention patent or the utility model patent.

Some countries or regions have made useful exploration of the issue people are hesitant about.

In Japan, for the convenience of applicants, Article 46 of the Japanese Patent Law provides: An applicant for a utility model registration may convert his application into a patent application. However, this provision shall not apply after three years from the filing date of the application for a utility model registration.[20]

It is provided in the Taiwan Region that an application originally filed for an invention or a design patent protection may be converted into a utility model patent application or where an application originally filed for a utility model into an invention patent application.[21]

Article 29, paragraph two, of the Chinese Patent Law provides: "where, within twelve months from the date on which any applicant first filed in China an application for a patent for invention or utility model, he or it files with the Patent Administration Department under the State Council an application for a patent for the same subject matter, he or it may enjoy a right of priority."

While the "conversion system" is absent in China, with the help of the domestic priority system, an applicant has a chance, within the time of priority, to switch between an invention patent application and a utility model patent application. Therefore, it may be said that the important function of the domestic priority system is the convertibility between the two types of patent applications. Since the applicant is the same person, this function is similar to that of the provision that "one applicant applies for a utility model patent and an invention patent for identical invention".

In converting the invention patent and utility model patent applications by making use of the domestic priority system, the important matter is not to break the bottom line of the doctrine of double patenting prohibition. To this end, the law provides that once a later application is filed by making use of domestic priority system, it is necessary to deem the prior application to have been withdrawn, and a granted prior application should not be converted any more. Therefore, the conversion is made between two patent applications. There is an important time restriction on utilising the domestic priority system, that is within twelve months from the date of first filing the patent application, and the priority should not be restored upon the expiry of the twelve months.

This is also the case of one applicant and that of two applications. If the applicant does not utilise the domestic priority system to converse one application into another, but applies for both the utility model patent and the invention patent for the same invention, he is not restricted in time by the domestic priority system. If this practice is acceptable, it is unnecessary for the domestic priority system to exist.

The Supreme People's Court's belief that "one applicant is allowed to apply for utility model patent and invention patent for the identical invention mainly out of the consideration of providing timely patent protection of his invention-creation" does not hold water. If "an invention-creation is provided timely patent protection, it is quite OK to take advantage of the expedite grant of a patent and to directly apply for a utility model patent. Why should we spend more money applying for an invention patent that often requires a longer time for examination? The purpose behind it is obviously to seek a longer term of patent than it is otherwise secured by filing an application for an invention patent.

Allowing "one applicant applies for a utility model patent and an invention patent for the identical invention" is not equal to double patenting of the applications for a utility model patent and an invention patent for identical invention. If the legislative aim of the provision that "for any identical invention-creation, only one patent right shall be granted" is correctly construed, it is naturally concluded that there has not been made "available any choice in China for one applicant to conveniently apply for patent."

Conclusion

The article examines the function of the doctrine of dou-

ble patenting prohibition, arguing that the purposes of the doctrine should include prevention of filing applications for patents for identical invention-creation twice to seek extended term thereof. In the case discussed here, the Beijing Higher People's Court's view is in line with the current mainstream international practice of double patenting prevention. In the third amendment of the Patent Law, the lawmakers are quite aware of the problem of improper patent term extension, so they confine, in the draft amendment to the Patent Law, two-time applications for patents for the identical invention to one applicant filing the same application on the same day. Against this backdrop, the Supreme People's Court's view in the case has evidently taken a step back in the development of the doctrine of double patenting prevention. ■

[1] See Invalidation Request Examination Decision No.3209 made by the PRB on 26 March 2001, accessible at http://www.sipo-reexam.gov.cn/fushen/search/searchfs.asp.

[2] See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongzhichuzi 195/2001 made on 17 September 2001.

[3] See the Beijing Higher People's Court's Administrative Judgment No. Gaominzhongzi 33/2002 made on 22 April 2002.

[4] See Section 6, Chapter 3 of Part 2 of the Guidelines for Examination as of 2006, P.158.

[5] See the Supreme People's Court's Administrative Judgment No. Xingtizi 4/2007 at http://www.chinaiprlaw.cn/file/2008072213323.html.

[6] The "patenting" in "double patenting" is a gerund, which is more suggestive of the repeated action in patent grant.

[7] Similar to the Guidelines for Examination in China, it is abbreviated as MPEP for the sake of convenience.

[8] See In re Vogel (CCPA 1970).

[9] See Miller v. Eagle Mfg. Co., 151 U.S. 186 (1984); In re Vogel, 422 F. 2d 438, 164USPQ 619 (CCPA 1970); and In re Ockert, 245 F.2d 467, 114USPQ 330 (CCPA 1957).

[10] In re Goodman, 11 F.3d 1046, 29USPQ2d 2010 (Fed. Cir. 1993).

[11] Article I, Section 8, Clause 8 of the U.S. Constitution: To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

[12] For the sake of convenience, the diagram is drawn based on the provision relating to treatment of identical invention under the Guidelines for Examination as of 2001. It is later pointed out that even if the date of disclaimer is put on the date of filing in the Guidelines for Examination as of 2006, the principle shown in the diagram remains applicable.

[13] A Detailed Explanation of the Newly-Amended Patent Law, the Legal Affairs Department of the SIPO, the Intellectual Property Publishing House, 2001, P.54.

[14] A Guide to the Amendment to the Guidelines for Examination as of 2006, the Examination Management Department of the Patent Office of the SIPO, the Intellectual Property Publishing House, 2006, P.303.

[15] The drafters of the Guidelines for Examination as of 2006 proposed other solutions: "(1) keeping the current Guidelines for Examination unchanged with a view to keeping the uniformity of the policy. But the drawback is that different dates of application would results in extended term; (2) the term is counted from the earliest date of application to address the matter of term extension, but its drawbacks also obviously lie in that the changed date of filing of the other patent application is contrary to the basic provisions of the Patent Law and that it makes the practical operation difficult, for example, how to publish it, whether the change in the date of filing should also be published, or whether the patent certificate obtained by the patentee should be changed." Ibid.

[16] In the amended Patent Law of the Taiwan Region, the substantive examination of utility model patent application has changed into examination as to form, which highlighted the problem of filing two applications for patents for the identical invention.

[17] Article 105 of the Patent Law of the Taiwan Region: "In case the patent right of a utility model is revoked, the patentee shall be liable for the damages sustained by any other persons from the exercising of such utility model right by said patentee prior to the revocation thereof."

[18] Li Mei, Study on the Doctrine of Double Patenting Prohibition within the Framework of the Amended Patent Law: the principle for dealing with one applicant filing invention patent and utility model patent for the identical invention, as accessible at pcm.tipo.gov.tw/pcm/pro_show.asp?sn=144.

[19] See Article 32 of the Provisions on Several Issues Relating to Trial of Cases of Dispute Arising from Patent Infringement (Draft for comments between 27-29, October 2003.

[20] In Article 46bis of the Japanese Patent Law as of 2005, the time limit for application for an invention patent after the patent disclaims changed into three years from the date of filing of the original application, or thirty days from notifying the patentee of the facts after a non-patentee applies for the technical evaluation.

[21] Article 102 of the Patent Law of the Taiwan region

"Where an application originally filed for an invention or a new design patent protection is converted into a new utility model patent application or where an application originally filed for a new utility model is converted into an invention patent application, the filing date of the original patent application shall be taken as the filing date of the converted patent application, provided that no application for patent conversion may be filed after the service of an allowance decision on the original application or after the expiry of sixty (60) days from the date of service of a rejection decision on the original application."