

Sonderhoff & Einsel News Update: China IP Newsletter (October 2017)

Revision of Administrative Regulations of Prioritized Examination

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Revision of Administrative Regulations of Prioritized Examination

Summary: In China, the Administrative Regulations of Prioritized Examination were revised and the new regulations came into force as of August 1, 2017. Applicants not residing in China can also utilize the new system under certain conditions in order to obtain a quicker grant of a patent.

The average time period for a patent examination is currently 22 months in China, which is not necessarily long. However, considering the serious risk of patent infringement by copied products, there is a stronger need to ensure that patents are granted quickly. In addition to the PPH (Patent Prosecution Highway), the "Administrative Regulations of Prioritized Examination", which was revised in 2017, has been used, mainly by Chinese applicants.

The outline of these regulations are as follows:

1. Applicable applications

Patent, utility model, and design applications would fall under these regulations. Also, applications pending in re-examination proceedings or in invalidation trials can be the subject of this prioritized examination. However, patent applications for which PPH has been requested are excluded.

2. Formal requirements

- (1) Applications must have been filed electronically.
- (2) Regarding patent applications, a request for a substantive examination must have been submitted and an examination fee must have been paid. For utility model and design applications as well as re-examinations and invalidation trials, only payment of the fee is required.

3. Documents to be submitted

- (1) Request for prioritized examination

The request needs to be stamped by the relevant section of the State Council or Intellectual Property Office and accompanied by recommendations by the above authority:

Foreign entities having an office in China: The stamp and the recommendation may be requested at the Intellectual Property Office in the region where the office resides.

Foreign entities having no office in China: The stamp and the recommendation may be requested at the Intellectual Property Office in the region where the office of the Chinese representative resides.

- (2) Documents disclosing prior art

The documents required are those which provide the most relevant prior art such as patent literature, non-patent literature, registered utility models and similar designs. For patent literature, publication numbers and dates are sufficient. For non-patent literature, copies of the pages which disclose the prior art must be provided.

- (3) Proof for relevance

Documents which prove that the subject matter of the request should fall under any of the subject matters for prioritized examination listed in the regulation.

For example:

In case of Rule 3, Item 4

Photographs, catalogues, or pamphlets showing the products and proving that the preparation for their implementation is ready or that said implementation has already been started. Also documents such as contracts or invoices proving that there is a risk of infringement.

In case of Rule 3, Item 5

Explanation that the application to be examined is based on a PCT application or an official filing receipt of other countries in case of an application according to Paris Convention.

In case of Rule 4, Item 1

Documents such as a petition of appeal, notice of a countersuit or written response.

4. Time limits

For the Intellectual Property Office and Re-examination Board:

Subject matter of the examination	Terms
Patent applications	First OA within 45 days, and completion of examination within 1 year
Utility model and design applications	Completion of examination within 2 months
Appeal against Decision of Refusal	Completion of examination within 7 months
Invalidation Trials for patent/utility models	Completion of examination within 5 months
Invalidation Trials for designs	Completion of examination within 4 months

For applicants:

Subject matter of the examination	Terms
Patent applications	Within 2 months from the dispatch date of OA
Utility model and design applications	Within 15 days from the dispatch date of OA

Please note that the above time limits for the applicants are calculated from the date of dispatch of the office action, and not from the date of receipt of the office action as in the case of an ordinary examination.

Also, once a term extension (which is possible like an ordinary examination) is requested, the prioritized examination will be terminated. Regarding prioritized examinations in appeal stages, the time periods for filing a response are the same as those for ordinary examinations. However, when the appellant of the invalidation trial has filed additional reasons for invalidation as well as evidence, or the patent proprietor has corrected the claims in a manner other than deletion of claims, a prioritized examination of the invalidation trial may be terminated.

Overall, the new regulations are more user-friendly with respect to applying a broader scope, relaxed conditions for application, and simplified procedure. Accordingly, it is expected that foreign entities will utilize the prioritized examination system in China more frequently.

Source:

http://www.sipo.gov.cn/zcfg/flfg/zi/bmgz/201707/t20170711_1312507.html

http://www.sipo.gov.cn/zcfg/zcid/201707/t20170712_1312516.html

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