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SIPO Announced *Administrative Measures for Prioritized Patent Examination 2017*

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SIPO has recently announced the officially approved *Administrative Measures for Prioritized Patent Examination 2017* (hereinafter refers to the “*Measures 2017*”), which comes into force from August 1st, 2017.

Key Points

The *Measures 2017* broadens the types of patent applications for prioritized examination by extending to utility models and design applications. Meanwhile, more technical fields to which patent applications are related are incorporated as eligible for prioritized examination in the *Measures 2017* on the basis of *Measures 2012*. The procedures of the prioritized examination are simplified for the applicants, as well as the examination will be more efficient as the corresponding time limits for filing observations and bringing a case to conclusion are stipulated, and the circumstances for suspending the prioritized examination are provided in the *Measures 2017*. Followings are our brief comments and practical details for the *Measures 2017*.

Brief Comments

The *Measures 2017* brought a hot discussion once released and has been hailed as an advance step for improving examination efficiency. The benefits such as broadening scope for prioritized examination, stipulating the time limits for case conclusion, electronically submission and etc. appears to be a very exciting guideline that the examination of patent applications will be accelerated as well as this great move will be well aligned with increasing market demand on patent filings and IP disputes. However, two considerations from practicing Chinese patent law worth to be stressed.

First, as the “recommendation from the relevant departments of the State Council or the provincial IP offices” is one of the formality requirements, whether a foreign patentee would obtain such recommendation under the authorities’ same discretion is not clear. It shall be noted that, pursuant to the Rule 1 of the *Measures 2017*, the aim is to improve the optimization and update of the industrial structure and propel the implementation of National Intellectual Property Strategies and the construction of a strong IP State.

Second, according to statistic from SIPO, the average pending period for invalidation requests

related to three types of patents was 5.4 months, though the period related to invention patent is longer. In comparison, as set forth in the Rule 10 of the *Measures 2017*, the invalidation cases of invention and utility model patent shall be concluded within 5 months. By examining our practical experience, apart from the prioritized examination, a key to speed up the procedures at the Patent Re-examination Board is to keep effective communicating with the patent authorities.

In general, we believe the prioritized patent examination is definitely helpful, but it will take time to see if the measures has an effect on behavior of applicants or petitioners. We will see if it could change the basic landscape of patent dispute resolution in China, especially in a way in same favor of both foreign and domestic patentees.

Main Contents

1. The scope of case

(1) What types of cases are allowable for prioritized examination?

Compared with the *Measures 2012*, in which only invention patent applications are eligible for the prioritized examination, the *Measures 2017* extends to patent applications of utility models and design patent applications, and cases of re-examination and invalidation. The current allowable types of cases for prioritized examination are:

- a) Invention patent applications at the stage of substantive examination;
- b) Utility models and design patent applications,
- c) Invention patent applications, utility models and design patent applications at the stage of re-examination;
- d) Declaration of invalidation of invention patent, utility model and design patent applications.

(2) What patent applications or patent re-examination cases are eligible for prioritized examination?

- a) Involving the technology fields which are considered to be the nationally prioritized developing industries, such as energy saving and environmental protection, new generation of information technology, biotechnology, high-end equipment manufacturing, new energy, new materials, new energy vehicles and intelligent manufacturing, etc.;
- b) Involving the key industries encouraged by provincial and municipal people's governments;
- c) Involving the technology fields of internet, big data, and cloud computing and the technology or the product is updated with high speed.
- d) Patent applicant or patent re-examination petitioner is about to implement or has already implemented, or there are evidences that others are implementing their inventions and creations;

- e) The Chinese first patent applications wherein the patent application is first filed in China and then filed in other countries or areas with the same subject matter.
- f) Others are of great significance to national interests or the public interest.

(3) What invalidation cases are eligible for prioritized examination?

If any of the situations happens for invalidation cases, the cases are eligible for prioritized examination under the *Measures 2017*:

- a) The target patent of Invalidation cases is in infringement disputes, and the parties have filed requests to the local Intellectual Property Offices, or filed lawsuits in the People's Court, or requested arbitration mediations;
- b) Patents involved in the invalidation cases are of great importance to national interests or the public interest.

2. The Procedures of the Prioritized Examination

(1) Who can file the request of prioritized examination?

Patent applicants could file a request for prioritized examination for the patent applications and the patent re-examinations. When the applicant is multiple, it shall be approved by all applicants or all petitioners for re-examination;

Petitioners or patentees could file requests for prioritized examination for the invalidation case. When the petitioner or patentee is multiple, it shall be approved by all of them.

In addition, in order to accelerate the settlement of disputes, the local Intellectual Property Office, the People's Court or the arbitration mediation organization handling the infringement disputes is also capable of filing the prioritized examination request.

(2) In what way shall the prioritized examination request be filed?

In order to improve the efficiency of prioritized examination, e-filing should be used for patent applications and the patent re-examinations according to the Rule 7 in the *Measures 2017*. Also, e-filing request manner is recommended for invalidation case.

(3) What is the timing for filing prioritized examination request?

For invention patents, applicants shall file for prioritized examination after filing the request of substantive examination and the payment of the corresponding fees.

For utility models or design patents, applicants shall file for prioritized examination after the payment of the application fee.

For patent re-examination and invalidation cases, petitioners shall file for prioritized examination after the payment of filing fee and before the conclusion.

(4) What are the formality requirements for prioritized examination?

- a) Patent applicants shall submit Request for Prioritized Examination, available information or materials regarding the prior arts or prior design as well as relevant credentials. If there

is a same-day application, the application number shall be mentioned in the request form. Besides, the recommendation opinion shall be signed regarding the Request by the relevant departments of the State Council or the provincial IP offices, except for “the Chinese first patent applications wherein the patent application is first filed in China and then filed in other countries or areas with the same subject matter”. The relevant departments of the State Council refer to the competent departments for national science and technology, economics and industries, and Interministerial Coordination Members for National Intellectual Property Strategies.

- b) Petitioners who requested the re-examination or invalidation shall submit Request for Prioritized Examination and the relevant credentials, and the recommendation opinion shall be signed regarding the Request by the relevant departments of the State Council or the provincial IP offices. However, two situations are exceptional: the patent under re-examination has been prior examined during the substantive examination stage; the prioritized examination for the invalidation case is requested by the local Intellectual Property Office, the People’s Court or the arbitration mediation organization which handles the infringement dispute, it is required to submit the Re-examination/Invalidation Prioritized Examination Request and the relevant supporting documents, and explain the reasons.
- c) The prioritized examination request and the relevant supporting documents are required to submit in original paper copy.

3. The time limits for the examination and the conditions for ceasing the examination

- 1) What are the respective time limits for issuing the opinions for whether accepting the request for prioritized examination and bringing a case to conclusion?

For pending patent applications, applicants will receive the opinions whether the prioritized examination is accepted within 3 to 5 working days from the date of filing the prioritized examination request. There is no definite time limit for the issuance of such opinions for patent re-examination and invalidation case.

Upon acceptance of prioritized examination, for invention patent applications, the first office action will be sent out within 45 days from the date of acceptance of prioritized examination, and the cases will be concluded within 1 year; for utility models and design patent applications, the case will be concluded within 2 months; for patent re-examination cases, they will be concluded within 7 months; for invention patent and utility model invalidation cases, they will be concluded within 5 months, and for design patent invalidation cases, will be concluded within 4 months.

- 2) What are the time limits for response?

For invention patent applications, the time limit for responding the office action of patent examination is 2 months from the date of the notice issuance, and it is 15 days from the date of the notice issuance for utility models and design applications.

The time limits for responding the notice issued by re-examination board are as same as

regular cases.

3) Under what conditions the prioritized examination for patent applications should be ceased?

It is stipulated in Rule 12 of the *Measures 2017* that under following conditions, the prioritized examination for patent applications should be ceased and proceeded with regular procedure:

- a) The application document is amended under Paragraph 1 and 2 of Rule 51 of the Implementation Regulations of Patent Law after the prioritized examination is accepted.
- b) The response is failed to be filed within the time limit set forth under the Rule 11 of the Measure 2017.
- c) False documents were submitted.
- d) Abnormal patent application discovered during the examination.

4) Under what conditions the prioritized examination for patent re-examinations or invalidation cases should be ceased?

It is stipulated in the Rule 13 of the *Measures 2017* that under following conditions, the prioritized examination for patent re-examinations or invalidation cases should be ceased and proceeded with regular procedure:

- a) The petitioner for re-examination requested to extend the time limit for filing an observation.
- b) The petitioner for invalidation case requested to submit supplementary evidences and grounds after the acceptance of the prioritized examination.
- c) The patentee amended the claims after the acceptance of the prioritized examination in ways other than deletion.
- d) The re-examination or invalidation proceeding is suspended.
- e) The hearing of current case must rely on the examination decision of other cases.
- f) The current case is regarded as a difficult case and has been approved by the director of the Patent Re-examination Board.