

Two Paths for Accelerating Patent Prosecution in China

In recent years, with the increase in patent applications filed in China, the China National Intellectual Property Administration (CNIPA) has focused on expediting patent examinations to decrease the duration of the normal patent prosecution process. There are two main paths for expediting patent prosecution in China: one is Prioritized Examination and the other is the Patent Prosecution Highway (PPH), both of which are free of official fees. These paths can provide applicants with relatively effective ways to pursue a fast patent allowance in China without incurring extra official costs.

Prioritized Examination

More specifically, a request for Prioritized Examination should be submitted with authorization from all applicants and is applicable to: (1) substantive examination of an invention patent application; (2) utility model and design patent applications; (3) reexamination of invention, utility model and design patent application; and (4) invalidation of invention, utility model and design patents. Where a patent application or a patent reexamination case involves any of the following circumstances, the applicant or petitioner can request Prioritized Examination:

- Industries considered priorities for national development, such as energy conservation and environmental protection, new-generation information technology, biology, high-end equipment manufacturing, new energy, new materials, new energy vehicles and intelligent manufacturing
- Industries encouraged by governments at provincial and municipal levels
- Internet, big data, cloud computing and related fields where the technology is changing rapidly
- A patent applicant or reexamination petitioner has prepared for implementation, has begun to implement or has evidence to prove that a third party is implementing its invention and creation
- A patent has been filed in China for the first time and further filed in other countries or regions for the same subject matter
- Other circumstances with great significance to national or public interest

For an invalidation case that involves any of the following circumstances, the patent applicant or invalidation petitioner can apply for Prioritized Examination:

- Where a patent involved in the invalidation case is the subject of an infringement dispute, and the parties involved have requested that the local intellectual property office handle the dispute, brought a lawsuit to a people's court or requested arbitration or mediation
- Where a patent involved in the invalidation case is considered of great significance to national or public interest

In practice, the CNIPA will issue a decision on whether a patent application is approved for Prioritized Examination within three to five working days after receiving the request. Further, the CNIPA should conclude the case within the following period from the date of approval for Prioritized Examination:

- Issuing the First Office Action within 45 days and concluding the case within one year for an invention application

- Concluding the case within two months for a utility model and design application
- Concluding the case within seven months for a reexamination
- Concluding the case within five months for an invalidation of invention and utility model
- Concluding the case within four months for an invalidation of design

In addition, during a Prioritized Examination, the applicant should respond to the Office Action within the following time limits from the issuing date (not including the 15-mailing day grace period): two months for invention applications and 15 days for utility model and design applications. The above time limits and deadline for replying to notifications in a patent reexamination or invalidation cannot be extended. Also, the applicant cannot make voluntary amendments to documents filed for a patent application. As for a patent reexamination or invalidation, the petitioner cannot add supplementary evidence or grounds, and the patentee cannot revise the claims in any way other than deletion.

Patent Prosecution Highway

Unlike Prioritized Examination, a request for PPH can be submitted with authorization from at least one applicant and applies to only invention applications under substantive examination. A request to participate in PPH can be made after the Chinese application is published and before the CNIPA issues the First Office Action. Additionally, a First Office Action is usually issued within two to three months from the issuance of the Notice on Approval of PPH request. The Chinese claims should be the same as or have a narrower scope than the corresponding allowable claims.

Foreign and Domestic Application Process

Prioritized Examination and PPH are both available for foreign applicants. Prioritized Examination can expedite the prosecution, reexamination and invalidation of invention, utility model and design patents. However, PPH only accelerates the issuance of the First Office Action in the prosecution of an invention patent application.

Domestic applicants may also go through local Intellectual Property Right Center for Rapid Right-Defense (?????????, the Rapid Right-Defense Centers) and/or local Intellectual Property Rights Centers for Right-Protection (?????????, the Right-Protection Centers) to expedite the prosecution of their Chinese applications. The Rapid Right-Defense Centers handle mainly design patent applications, and the Right-Protection Centers accept all types of patent applications related to technologies specified for each local center. Twenty-one Rapid Right-Defense Centers and 23 Right-Protection Centers have been established in China. Please see <http://www.cnipa.gov.cn/mtsd/1097483.htm> for more information.

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