

## **Administrative Measures for Prioritized Examination of Patent Applications**

In order to improve patent examination system and accelerate the examination on particular cases, the State Intellectual Property Office (SIPO) of China released the Administrative Measures for Prioritized Examination of Patent Applications (the Measures) on June 27, 2017; the Measures have come into effect on August 1, 2017.

Foreign companies having research and development institutions in China and foreign companies manufacturing and selling product in China also can be eligible for priority examination through the Measures.

For your convenience, we hereby introduce the points that we think are worth noticing:

### **Patent cases for which Prioritized Examination can be requested**

#### 1) patent cases under the following stages or procedures

- (1) invention patent applications under substantive examination;
- (2) utility model and design patent applications;
- (3) reexaminations of invention, utility model and design patent applications; and
- (4) invalidations of invention, utility model and design patents.

#### 2) patent cases meet any of the following situations

##### (1) for examination or reexamination of patent applications

- where the applicant has got ready for exploiting or has already exploited the technology for which the patent application seeking protection in China, or have evidence which can prove others are exploiting the technology in China; or
- where foreign companies having research and development institution in China file, for the first time, a patent application with SIPO for its research results, and file patent applications for the same in other countries or regions.

(2) for invalidation of patents

- where the patent under invalidation proceeding is involved in infringement disputes, and parties concerned have asked local IP offices for administrative operations, instituted legal proceedings before courts, or asked for arbitration.

**Parties eligible for requesting for Prioritized Examination**

1) for examination or reexamination of patent applications, the request for Prioritized Examination:

- shall be approved by all applicants of patent application or all petitioners of reexamination.

2) for patent invalidation cases, the request for Prioritized Examination:

- shall be approved by all petitioners of the invalidation request or by all patentees of the patent being invalidated; or
- shall be filed by the local IP offices, courts or arbitral organization handling the corresponding infringement disputes of the patent involved.

**Documents that we need for requesting Prioritized Examination**

1) for examination of patent applications

- instruction of requesting for Prioritized Examination;
- information of prior art or prior design and the relevant supporting documents; and
- except for patent applications first filed with SIPO and then filed in other countries or regions, Prioritized Examination request shall be signed or sealed by relevant department of the State Council or the provincial-level intellectual property office with comments of recommendation;

2) for reexamination of patent applications or invalidation of patents

- instruction of requesting for Prioritized Examination;
- relevant supporting documents; and
- except for reexamination of patent applications which have gone through Prioritized Examination during the substantive or preliminary examination procedure, Prioritized Examination request shall be signed or sealed by relevant department of the State Council or the provincial-level intellectual property office with comments of recommendation.

**Duration of prioritized examination**

SIPO determines which Prioritized Examination request can be approved according to factors, such as, examination capacity of each technical field, the number of patent granted in the last year and the number of pending patent application in the current year.

- for invention patent applications to which Prioritized Examination is approved, SIPO shall issue the First Office Action within 45 working days from the date on which the request for Prioritized Examination is approved and finish the examination within one year from the date on which the request Prioritized Examination is approved;

- for utility model and design patent applications to which Prioritized Examination is approved, SIPO shall finish the examination within 2 months from the date on which the request for Prioritized Examination is approved;

- for patent reexamination cases to which Prioritized Examination is approved, the Patent Reexamination Board of SIPO shall finish the reexamination within 7 months from the date on which the request for Prioritized Examination is approved; and

- for invalidation cases against invention and utility model patents to which Prioritized Examination is approved, the Patent Reexamination Board shall finish the invalidation case within 5 months from the date on which the request for Prioritized Examination is approved; and for invalidation cases against design patent, the Patent Reexamination Board shall finish the invalidation case within 4 months.

**Obligation of the parties who request for Prioritized Examination**

- for invention patent applications, the party shall respond to Office Actions within 2 months from the date on which the corresponding Officer Action is issued;

- for utility model and design patent applications, the party shall respond to notifications within 2 months from the date on which the corresponding notification is issued.

**Cease of the priority examination**

SIPO will cease the Prioritized Examination and handle the case under normal procedure once any of the following situations occurs:

1) for examination

- where the applicant makes voluntary amendments to the application documents after the request for Prioritized Examination is approved; or

- where the applicant does not respond to office actions/notification within the prescribed time limit.

## 2) for reexamination and invalidation

- where the applicant of reexamination fails to reply within the prescribed time limit, i.e. no request for extension of time can be requested;

- where the petitioner of invalidation cases files supplementary evidence and grounds after the request for Prioritized Examination is approved;

- where patentee amends the Claims in ways other than deletion after the request for Prioritized Examination is approved;

- where reexamination or invalidation proceedings are suspended;

- where examination on the present case must rely on the examination results of other cases; or

- where the case is regarded complex or complicated, and obtains approval for cease from the director of Patent Reexamination Board.

## Comments

Comparing with the Measures of 2012, Prioritized Examination is now applicable for more cases in terms of patent application types and procedures. For example, Prioritized Examination used to be applicable only for invention patent application, but the coverage expands to all types of patent applications as well as reexamination and invalidation cases in the 2017 version.

To overseas applicants, if the invention is conceived in China and the first patent application for the invention is filed with SIPO and then filed in other countries or the right of foreign companies is aggrieved and safeguard of their right shall be rely on the grant of a patent or the results of reexamination and invalidation, they may try requesting Prioritized Examination to accelerate the examination process.

The acceleration of the examination process also requires the applicant's full support and cooperation, such as not making voluntary amendments to the examination basis through any methods after the request for Prioritized Examination is approved, responding to official notifications within the prescribed time limit, and etc. If any of the conditions under which the Prioritized Examination shall be ceased is found, the cases will be returned back to general procedure.

Hopefully the above information is helpful to you. Should you have any questions in relation to Prioritized Examination, please feel free to contact us. Thank you!

## CONTACT

Should you have any questions please do not hesitate to contact us.

**Head Office:** Ms. Xia Zheng  
AFD China Intellectual Property Law Office  
Technology Fortune Center Tower B  
16 Fl., Suite 1601A, 8 Xueqing Road,  
Haidian District, Beijing 100192, China  
Tel: +86 (10) 8273-0790, Fax: +86 (10) 8273-0820  
Email: [afdbj@afdip.com](mailto:afdbj@afdip.com)

**US Office:** P. O. Box 60836, Potomac, MD 20859-0836, USA  
Tel: (301) 637 2202, Fax: (301) 251 0237  
Email: [usoffice@afdip.com](mailto:usoffice@afdip.com)

### Who are we

AFD China is one of the few Chinese intellectual property firms that can provide omni-directional and one-stop services for both domestic and overseas clients. Our services include IP strategy planning, filing and prosecution of patents and trademarks, copyright registration and overseas IP filings, searches, free-to-operating analysis, infringement analysis, validity or invalidity analysis, dispute solutions, IP litigation and so on. So far, we are one of the top-tier IP agencies in the aspects of assisting Chinese entities and inventors in filing and prosecuting domestic patent application for invention, PCT international application as well as Hong Kong, Macao, Taiwan and overseas patent applications, and assisting foreign entities and inventors in filing Chinese patent applications for invention.

AFD China adheres to the fundamental value based on “faith”. Through honest and diligent work and satisfactory outcomes, we are trusted by entities and inventors worldwide as a reliable and high quality IP service provider.

AFD China has over 200 practitioners, who combined enable us the rich experience and strong science and technology background to better understand our clients' requirements, and to provide good legal services. We, with comprehensive and forward-thinking approach utilize every possible step to advance clients' cases and to find effective solutions, in order to obtain most possible protection for their IP and create more opportunities for them.

Patent we drafted and represented have won Chinese patent prize (Golden Prizes and Outstanding Prizes) for several years. We were awarded as Being Excellent Patent Agency for two times. We were accredited to be “AAAA-level (top tier) Patent Agency” in 2016, and were presented on the good list of outstanding business service of Beijing. We have been ranked as top PCT patent application filer agency by the reputable magazine - Managing Intellectual Property; awarded to be “IP Starts” for several years; and recommended as a leading IP firm by several famous international IP magazines, such as IAM Patent 1000, Asia IP, and Legal 500.

