

The Docketing Excellence Webinar Series



Tricky Chinese Patent Docketing



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Tricky Chinese Patent Docketing

- Presenters and panelists:
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 - Kristi Wheeler, Foreign Filing Paralegal, Schwegman, Lundberg & Woessner, P.A.
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Topics

- How to Calculate Deadlines in China
- Important items to Docket before the Substantive Exam Process
- Overview of the Substantive Exam Process
- Items to Docket during Substantive Exam
 - Office Actions
 - Decisions of Rejection
 - Reexamination Decision – Revoking of Decision of Rejection
 - Notification of Reexamination
 - Decision of Reexamination – Upholding Decision of Rejection
- Why are China deadlines so tricky and what can you do?

Calculating Deadlines in China

- Where any document is sent by mail by the Patent Office, the 16th day from the date of mailing shall be presumed to be the date on which the document is received.
- How to Calculate
 - The first day of any time limit is not counted in the calculation.
 - For example, where a notification is issued on July 4, 2017 by the Patent Office, the date on which the notification is presumably received is July 19, 2017.
 - The due date is calculated from the date on which a notification or decision is presumably received.

Calculating Deadlines in China (cont.)

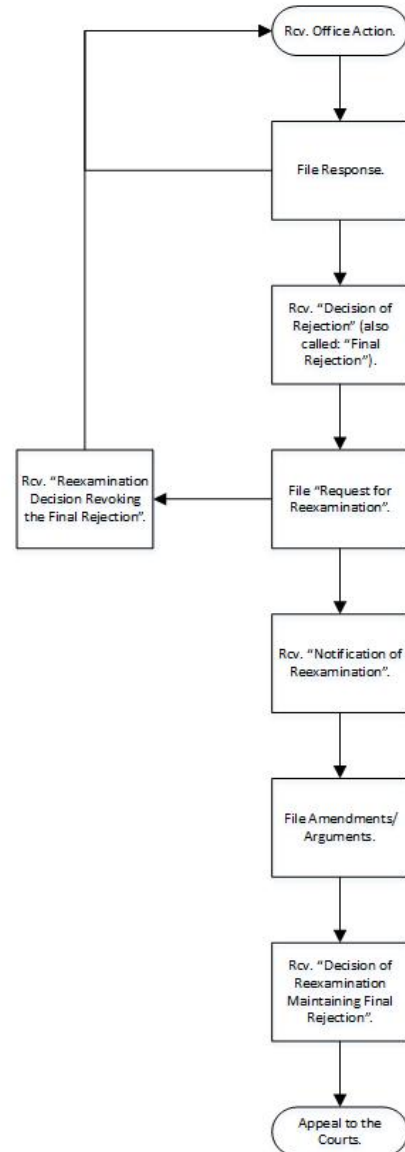
- If an Office Action with a two month period for responding is mailed by the Patent Office on June 6, 2017, the date on which it is presumably received is **June 21, 2017**.
- The two month due date for responding date is **August 21, 2017**.
- August 21 is the actual deadline for the response.

Before Substantive Exam

- Items to Docket before the Substantive Exam Process
 - Formalities
 - “Request for Examination”
 - 3 years from earliest priority
 - For Divisional Filings, the due date is 2 months from filing of the divisional
 - “Deadline to Record in Hong Kong”
 - 6 months after the publication date
 - Publication date is in the “Notice of Publication” that you will receive
 - “Voluntary Amendments Due”
 - 3 months after Receipt Date of “Notice of Entry into Substantive Examination”

Chinese Prosecution Flow Chart

Chinese Substantive Examination Process



Docketing Chinese “Office Actions”

- Chinese “Office Action” is equivalent to U.S. Non-Final Office Action
 - Follows the Notification of Substantive Examination and the corresponding Voluntary Amendment deadline
- How to docket?
 - May receive more than one Office Action
 - Response period for the first office action is 4 months
 - Second and subsequent Office Actions have a 2 month response period
 - 15 day mailing period applies
- Extensions available?
 - One-time request for extension of 1 or 2 months

Docketing Chinese “Office Actions”

Example A: Language from an agent letter regarding a first Office Action mailed Jan. 5, 2012

- “Please be informed that we received the first Office Action for the above referenced application issued on January 5, 2012. . . Please be noted that the extendible deadline for responding to the Office Action is May 20, 2012. We would like to have your instructions by May 5, 2012 so as to prepare and submit necessary documents with the SIPO.”
- Actual Mailing Date (1/5/2012) + 15 days + 4 months = Actual Deadline (5/20/2012)

Docketing Chinese “Office Actions”

Example B: Language from an agent letter regarding a first Office Action mailed Nov. 4, 2014

- “Please be advised that the State Intellectual Property Office (SIPO) issued a first office action raising objections against the subject application. . . The deadline for filing a response to the office action is 17 March 2015. If possible, please let us have your instructions and comments on the response before 6 March 2015, so that we will have sufficient time to prepare the response and file it with the SIPO.”
- Actual Mailing Date according to the Translated Office Action (11/04/2014) + 15 days + 4 months = Actual Deadline (March 19, 2015)

Docketing Chinese “Decision of Rejection”

- Chinese "Decision of Rejection" is equivalent to U.S. Final Office Action
- Typically follows a response to an Office Action
- How to docket?
 - Docket a deadline to file “Request for Reexamination”
 - Due 3 months from Decision of Rejection
 - 15 day mailing period applies
- Extensions available?
 - Deadline to file Request for Reexamination is **NOT** extendable

Docketing Chinese “Decision of Rejection”

Example C: Language from an agent letter regarding a Decision of Rejection mailed March 11, 2014

- “Please note that we have received the rejection decision issued on March 11, 2014 for the application. The official deadline for responding to this rejection decision is June 26, 2014, no extension is available.”
- Actual Mailing Date (3/11/2014) + 15 days + 3 months = Actual Deadline (June 26, 2014)

Docketing Chinese “Decision of Rejection”

Example D: Language from an agent letter regarding a Decision of Rejection mailed April 23, 2015

- “Please be advised that the State Intellectual Property Office (SIPO) issued a rejection decision raising objections against the subject application. The deadline for filing a petition for reexamination is 6 August 2015. If possible, please send us your instructions before 27 July 2015, so that we will have sufficient time to prepare the reexamination brief and file it with the SIPO in due course. **Please note that NO extension of time is available at the present stage.**”
- Actual Mailing Date (4/23/2015) + 15 days + 3 months = Actual Deadline (August 8, 2015)

Docketing “Reexamination Decision” – Revoking of Decision of Rejection

- Chinese “Reexamination Decision Revoking the Final Rejection”
- Application is forwarded back to the original examiner by the PRB (Patent Review Board)
 - The examiner may do the following
 - Issue an Office Action (continue prosecution)
 - Issue a Notice of Allowance
- How to docket?
 - No deadlines for the Applicant at this point

Docketing “Notification of Reexamination”

- PRB (Patent Review Board) maintains the rejection and issues a Notification of Reexamination
 - The “Reexamination” process in China is equivalent to the Appeal process in the US
- How to docket?
 - Period for filing a response is 1 month
 - 15 day mailing period applies
- Extensions available?
 - One-time request for extension of 1 or 2 months

Docketing “Notification of Reexamination”

Example E: Language from an agent letter regarding a Notification of Reexamination mailed December 28, 2015

- “This is to report to you that we have received a Notification of Reexamination issued by the Patent Reexamination Board in connection with the above-identified application on December 28, 2015. A response to the Notification of Reexamination is due on February 12, 2016 (including the 15 days grace period for post).”
- Actual Mailing Date (12/28/2015) + 15 days + 1 month = Actual Deadline (2/12/2016)

Docketing “Notification of Reexamination”

Example F: Language from an agent letter regarding a Notification of Reexamination mailed February 3, 2016

- “With respect to the subject application under reexamination, we received a notification from the Patent Reexamination Board (PRB) of the State Intellectual Property Office (SIPO)... The deadline for responding to the notification is 16 March 2016 **(including a 15-day grace period for postal delivery)**...”
- Actual Mailing Date (2/3/2016) + 15 days + 1 month = Actual Deadline (3/18/2016)

■ Docketing “Decision of Reexamination” – Maintaining Decision of Rejection

- Chinese “Decision of Reexamination – Maintaining Decision of Rejection”
- Typically follows amendments and arguments filed after the Notification of Reexamination communication
- How to docket?
 - Deadline to “File Divisional a Application”
 - Due 3 months from date of receipt of notification (15 day mailing period applies)
 - Deadline to “File Appeal in the Intellectual Property Court of Beijing Municipality of the PRC” (this is a law suit)
 - Due 3 months from date of receipt of notification (NO 15 day mailing period available)
- Extensions available?
 - Deadline is NOT extendable

Why are China Deadlines Tricky to Docket?

- Agents are inconsistent regarding the due date they put in their report out letters
 - Does due date include 15 day period or not?
 - Did agent shorten the deadline?
 - Agents may call a deadline an "Official Deadline" even when it is not.
 - Agents often do not indicate whether the 15 day mailing period has already been included in their deadline.
- Agents may not provide the "actual" mailing date
 - May not provide mailing date at all
 - May give their "actual" date of receipt rather than the 15-day mailing period as the date of receipt

Why are China Deadlines Tricky to Docket? (cont.)

- Not in English
 - Difficult to tell what is the correct date in the Chinese language document
- Attorneys may assume that they have 15 additional days when they do not
- Document titles can be confusing
 - “reexamination” has a different meaning in the US than in China

What should you do?

- Make sure docketers understand how deadlines are calculated in China
- If you can, have a consistent policy for what goes into your docketing system
 - Use country law in system – don't override (usually that does not include the 15 day period)
 - Docket off agent letter
 - Calculate deadline yourself
- Ask agents to provide what you want
 - Actual mailing date from SIPO
 - Actual deadline with 15 day mailing period (specify clearly in the agent letter that the 15 day period is included)
 - Extensions available

Questions

- Questions on Today's Program
 - Please submitted your questions using the Q&A button on the control bar on your screen.
- If you have questions regarding Black Hills IP's services or processes, please contact:
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The Docketing Excellence Webinar Series

Please join us for our next presentation:

Understanding Docketing for the Appeal Process in China,
Korea and Japan

March 29, 2017 at 1:00 PM Central