

SLW Institute International IP Webinar Series | Episode 06

# Expediting Examination in China

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Aaron Winger is a Senior Attorney and SLW's Director of China Intellectual Property. Aaron counsels both U.S. and Chinese companies on portfolio development and preparation of their patent applications and office action responses. He has worked with clients in the areas of software, networks (wired and wireless), lasers, medical devices, semiconductors and physics. Aaron also counsels clients on cross-border enforcement issues.

Most recently, Aaron has counseled Chinese companies on freedom to operate analyses for their entry into the U.S., represented a U.S. gaming company with operations in China, handling Series A and IP issues in China through to IPO; a U.S. scanning electron microscope company, handling their patent portfolio from incorporation through exit via acquisition, and a U.S. wireless company through acquisition. His knowledge of both the Chinese and American markets allows him to advise his clients as they expand their patent portfolios and look for investors to help the company grow.

Aaron has been in China for more than a decade and is conversational in Mandarin. He is a frequent contributor to ZhiChanLi.

# Patent Prosecution Highway





## Patent Prosecution Highway

- *Allows for expedited examination of a Chinese application when a corresponding application in a participating patent office has at least one allowable/patentable claim.*
- *IP5 PPH Program extended to January 5, 2023*
  - *EPO*
  - *JPO*
  - *KIPO*
  - *CNIPA*
  - *USPTO*
- *Other countries include: Norway, Iceland, etc.*

## Patent Prosecution Highway

### *Requirements:*

1. Chinese application must share a priority date or filing date with an application in another participating patent office and must claim priority to the application or share a common priority.
2. At least one claim in the corresponding application indicated to be patentable/allowable.

## Patent Prosecution Highway

### *Requirements (cont.):*

3. All claims in the Chinese application must sufficiently correspond to an allowed claim in the corresponding application.
  - Same or similar scope.
  - Chinese claims can be narrower.
  - Adding new category of claim does not sufficiently correspond.
  - Make sure to amend Chinese claims during voluntary amendment periods to ensure can participate.
    - Filing request for substantive examination
    - Within 3 months of receiving a Notice of Entering Substantive Examination

## Patent Prosecution Highway

### *Requirements (cont.):*

#### 4. Timing:

- The Chinese application must be published.
- The Chinese application must have entered substantive examination.
  - Exception: can request PPH when file Request for Substantive Examination
- CNIPA has not begun examination of the Chinese Application

#### 5. The application must be an electronic patent application.

## Patent Prosecution Highway

### *Documents Required to Participate*

1. Copies of all Office Actions with translations to English or Chinese.
2. Copies all claims found to be allowable with translations to English or Chinese.
3. Copies of all non-patent literature cited in the corresponding application used in any rejection.
  - Translation of references not required.



## Patent Prosecution Highway

### *Documents Required to Participate (cont.)*

#### 4. Claims Correspondence Table

- Table showing how Chinese claim correspond with patentable/allowable claims.
  - Both claims are the same.
  - Chinese claim is narrower than allowable claim by including an additional limitation.

# Patent Prosecution Highway

## *Strategy*

1. File a US application with a Track One Request
2. Upon receiving a Notice of Allowance or an Office Action indicating an allowable/object to claim:
  1. Make allowable/objected claim the base claim.
  2. File application in China accordingly.
  3. Request examination/PPH simultaneously with filing.

# Administrative Measures for Patent Priority Examination



# Administrative Measures for Patent Priority Examination

- Allows for expedited examination of patent applications under specific conditions
  - Technology
  - Infringement
  - Implementation
  - Foreign Filing
  - National/Public Interest
- Geared towards Chinese applicants.
  - “In order to promote... the construction of a strong intellectual property country.”

# Administrative Measures for Patent Priority Examination

## *Requirements:*

1. Involve national key development industries such as energy conservation and environmental protection, new generation information technology, biology, high-end equipment manufacturing, new energy, new materials, new energy vehicles, and smart manufacturing;
2. Involve industries encouraged by the provincial and district-level municipal governments;
3. Involve the Internet, big data, cloud computing and other fields and the technology or product obsolescence is fast;
4. The patent applicant has made preparations for implementation or has begun implementation, or there is evidence that others are implementing their inventions;
5. The patent application was first filed in China and then filed in a foreign country; or
6. Of great significance to national interests or public interests need to be reviewed first.

# Administrative Measures for Patent Priority Examination

- Submissions:
  - Priority Exam Request;
  - Prior Art (except if based on foreign filing);
  - Proof of meeting the requirements; and
  - Approval by State Council or Provincial IP Office
    - US does not have provincial Chinese IP offices
- If approved:
  - 45 days to first office action
  - 1 year to conclude examination



Other



## Intellectual Property Rapid Protection Centers:

- Built around industrial clusters
- Must be registered in the district and IP related to the industrial cluster.
  - Zhongshan – Lighting
  - Nantong – Home Textiles
  - Hangzhou – Pens
  - Jingdezhen – Ceramics
  - Dongguan – Furniture

- Request Substantive Examination Early
  - Unlike US, must request exam.
  - Due at 36 months from priority date.
  
- Voluntarily Amend Claims to Match Parent Application to Avoid Duplicate Rejection
  
- Attend to claim formalities early
  - Compact prosecution not always practiced.
  - After all rejections overcome, may receive new office action for formalities.
    - Antecedent basis.
    - Preamble.

# Conclusion



## Closing Tips

- Be cognizant of time limitations to voluntarily amend claims.
- Be assertive with Chinese counsel re Administrative Measures for Patent Priority Examination
  - Some counsel not familiar with program.
  - Some counsel may assert only for Chinese applicants.





Any questions?

<https://www.chinaiplawupdate.com>



# Thank you

An aerial view of the Shanghai skyline at dusk. The Oriental Pearl Tower is prominent on the right side, with its distinctive spheres. Other skyscrapers are visible, including one with 'ALROSA' and '花旗集团' (Flower Group) signage. The Bund is visible in the foreground, with the Huangpu River and a few boats. The sky is a mix of orange and blue.

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