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IP UPDATE



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Points to Note in Riding on the Patent Prosecution Highway in China

The Patent Prosecution Highway (PPH) is a set of programs which enable applicants who has obtained allowable or granted patent claims from one participating patent office to request accelerated prosecution of corresponding claims in another participating patent office.

If a patent application can undergo the PPH, the examination time may be greatly reduced as the examiner in the office handling the subsequent examination can rely on the search and examination results from the office of the earlier examination (OEE). The costs for the prosecution of the patent application may therefore be reduced due to the reduction of the number of office actions.

Commencing from 1st November 2011, the State Intellectual Property Office (SIPO) of China first launched the PPH pilot project with the Japanese Patent Office and since then has entered into 20 PPH programs with most major patent offices in the world including the popular "IP5 PPH program" with China, the United States, Europe, Japan and Korea being the five participating countries.

TIMING FOR FILING PPH REQUEST

Under the regulations of SIPO, a request to participate in the PPH may be made after the application is published but before the SIPO issues the first Office Action. All pending claims in the Chinese application must sufficiently correspond to (i.e. be similar in the scope or narrower than) the allowed claims in the application of OEE.

LIMITATION OF THE TIMING FOR FILING PPH REQUEST

The limitation on the timing for filing the PPH request occurs if the originally filed claims of the Chinese application are broader in scope than the allowed claims of the OEE application.

For normal Chinese invention patent applications, applicants are entitled to two chances to file voluntary amendments to the application during the prosecution, namely (1) when filing the request for substantive examination; and (2) within three months since receiving the notice of entry into the substantive examination procedure. For Chinese national phase entry of a PCT application, there will be one more opportunity, which is when the PCT application enters China upon which an amendment can be made under PCT Article 28 or 41.

In case the issuance of the notice of allowance or granting of the OEE application is subsequent to the deadline to file a voluntary amendment, the applicant is not able to amend claims of the Chinese application to match the allowed claims of the OEE application. Under such circumstance, the Chinese application may not be eligible to participate in the PPH program.

Accordingly, applicants may consider delaying examination of their Chinese patent applications by postponing the filing of a request for examination until the final deadline of three years from the filing date or the earliest priority date. On the other hand, applicants may request expedited examination of their application of the OEE if such option is available.

CONFORMITY OF CLAIMS

Under the regulations of SIPO, a PPH request will be accepted if the scope of the Chinese claims are the same or narrower than the scope of claims of the foreign or PCT application. But in practice, the formality examination of SIPO on PPH request is usually very strict and rigid. Besides, SIPO provides applicants only one chance to revise a rejected PPH request. Therefore, it is recommended that the Chinese claims be conformed fully (ideally verbatim) to the claims of the OEE application.

RELATIONSHIP WITH CORRESPONDING APPLICATIONS

PPH requests may be categorized into two circumstances: normal PPH and PCT PPH, depending on whether the OEE is a foreign national application or an application under the Patent Cooperation Treaty (PCT).

Under normal PPH, the indication of allowance of claims in a notification of a corresponding foreign application is used to expedite examination of the Chinese application, whereas under PCT-PPH, the positive written opinion or International Preliminary Examination Report of the International Searching Authority is used to expedite examination of the Chinese application.

To participate in the normal PPH, the relationship between the Chinese application and the corresponding foreign application should fulfill one of the following requirements:

- 1) The Chinese application claims priority to the corresponding foreign application directly under the Paris Convention;
- 2) Both the Chinese application and the corresponding foreign application claim priority to the same firstly filed foreign application and the firstly filed application comes from the same country of the corresponding foreign application;

- 3) The Chinese application is a national phase entry of the same PCT application claiming priority to the corresponding foreign application.
- 4) Both the Chinese application and the corresponding foreign application are national phase entries of the same PCT application;
- 5) Both the Chinese application and the corresponding foreign application are national phase entries of a PCT application claiming priority to a firstly filed foreign application which comes from the same country of the corresponding foreign application;
- 6) The Chinese application is a national phase entry of a PCT application, and both the PCT application and the corresponding foreign application claim priority to a firstly filed foreign application which comes from the same country of the corresponding foreign application;
- 7) The Chinese application is a divisional application of the application which satisfies the above requirement (1).

As for PCT-PPH, the relationship between the Chinese application and the corresponding international application should fulfill one of the following requirements:

- 1) The Chinese application is a national entry of the corresponding PCT application;
- 2) The Chinese application is a national entry of a PCT application claiming priority from the corresponding PCT application;
- 3) The Chinese application claims priority from the corresponding PCT application;
- 4) The Chinese application is based on the priority claim of the corresponding PCT application;
- 5) The Chinese application is a divisional application of the application which satisfies the above requirement (1); or
- 6) The Chinese application claiming domestic priority to the application which satisfied the above requirement (5)

With a comprehensive understanding the above requirements, applicants may wish to implement timely check points for all related prior applications or international applications and determine whether their Chinese applications are eligible to a PPH request.

CHANGE OF OFFICIAL FEES FOR PATENT APPLICATION IN CHINA

With effect from 1 July 2017, the Chinese Government will reduce the official fees on patent applications as follows:-

Item	Old Official Fee (RMB)	New Official Fee (RMB)
Filing an application for an invention patent (including publication fee)	950	900
Filing an application for national entry of a PCT application	950	900
Filing a divisional application (including publication fee)	950	900
Providing a certified copy of Chinese patent application	100	30

On the other hand, the official fee for filing a request for restoration of priority in the national phase of PCT application will be increased from RMB300 to RMB1,000.