

# Introduction to China's patent Prioritized Examination program

**Dr. Xin Chen, Deputy Director of the Electrical Patent Department at CCPIT Patent and Trademark Law Office, explains the PE program process including important aspects such as requirements, eligibility, and invalidation.**

The patent Prioritized Examination (PE) program in China is the main way to accelerate patent prosecution, besides the well-known Patent Prosecution Highway (PPH) pilot program. The PE program is also a choice to expedite the invalidation proceedings for a patent involved in an infringement dispute. Similarly to the PPH pilot program in China, the PE program has no official fees, and is even quicker than the PPH. For example, an invention patent application can get a final decision within 12 months from the approval of the PE petition. Therefore, the PE program is becoming an attractive option for applicants who desire quick patent protection.

However, the PE program is only applicable to cases that meet certain requirements. The China National Intellectual Property Administration (CNIPA) issued the Administrative Measures for Patent Prioritized Examination ("Measures") on June 28, 2017, which came into effect on August 1, 2017. Below we will introduce the PE program in China based on the Measures and our up-to-date experiences.

## 1. Which types of application or patent are eligible for the PE program?

All three application/patent types, invention, utility model, and design, are eligible for the PE program as long as certain requirements are satisfied (see Items 2-3 for the specific requirements). In particular, the PE program is applicable to:

- Invention, utility model, and design applications during prosecution (hereinafter referred to as "prosecution cases");



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- Invention, utility model, and design applications during re-examination (hereinafter referred to as "re-examination cases"); and
- Invention, utility model, and design patents during invalidation proceedings (hereinafter referred to as "invalidation cases").

Note that the PE program is applicable to both non-divisional applications and divisional applications. Also note that, the applicant

**The applicant cannot request both PE and PPH for the same application.**

## Résumé

**Dr. Xin Chen** is the Deputy Director of the Electrical Patent Department of CCPIT Patent and Trademark Law Office. She has a strong technical background and 14 years' experience in patent prosecution, reexamination, counseling, invalidation, and litigation, especially in the technical fields of software, communication, semiconductor, and optics. She has helped several globally renowned companies obtain patents inside and outside China and has provided them with valuable advice regarding patent prosecution strategies. She has also obtained many favorable results for the clients in patent invalidation proceedings and administrative litigations.

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cannot request both PE and PPH for the same application, i.e., only one of PE and PPH can be used to accelerate the prosecution of an application. Moreover, for a pair of invention and utility model applications filed on the same day with a dual-filing statement, the invention application in the pair is not eligible for the PE program.

## 2. What are the requirements for a prosecution or re-examination case to request PE?

A prosecution or re-examination case can request PE if one of the following requirements is met:

- (i) The application involves national key industries including energy conservation, environmental protection, new generation information technology, biotechnology, high-end equipment manufacturing, new energy sources, new materials, new energy vehicles, intelligent manufacturing, etc.;
- (ii) The application involves industries that are specially encouraged by the people's governments at provincial or municipal levels;
- (iii) The application involves internet, big data, cloud computing or the like, and the technology or product updates fast;
- (iv) The applicant has prepared for or has started implementation, or there is evidence to prove that someone is implementing the invention;
- (v) The application is firstly filed in China and then a counterpart with the same subject matter is filed in another country or region; or
- (vi) Other situations that need prioritized examination due to the great significance to the national interests or public interests.

## 3. What are the requirements for an invalidation case to request PE?

An invalidation case can request PE if one of the following requirements is met:

- (i) There is a dispute of infringement of the patent involved in the invalidation case, and the party concerned has filed a lawsuit with the court, requested the local IP office to handle it, or requested an arbitration or mediation organization for arbitration or mediation; or

- (ii) The patent involved in the invalidation case is of great significance to the national interests or public interests.

## 4. How much can the examination be expedited under the PE program?

For an invention application on the PE track, the CNIPA will issue the first office action within 45 days and issue the patentability decision (Notice of Allowance or Rejection Decision) within one year from the approval of the PE petition. For a utility model or design application on the PE track, the CNIPA will issue the patentability decision within two months from the approval of the PE petition.

For a re-examination case, whether the application is an invention, utility model, or design, the CNIPA will issue the Re-examination Decision within seven months from the approval of the PE petition.

For an invalidation case of invention or utility model patent, the CNIPA will issue the Invalidation Decision within five months from the approval of the PE petition. For an invalidation case of a design patent, the CNIPA will issue the Invalidation Decision within four months from the approval of the PE petition.

## 5. Is there any quota for the PE cases each year?

There is no explicit quota for the PE cases handled by the CNIPA each year. The CNIPA promises that, on the premise that the examination quality and overall pendency are not affected, it will provide as many resources for PE as possible. The quota for the PE cases each year will be determined by the CNIPA according to the statistics such as the examination capabilities in each technical field, the number of patents granted in the previous year and the number of pending cases in the current year. The quota may vary each year and is not disclosed to the public.

According to the 2021 annual report of the CNIPA, 77,000 PE cases were handled by the CNIPA in 2021, which increased by 31.5% compared to 2020.

## 6. Are the examination standards for PE cases different from normal cases?

The examination standards for PE cases are the same as normal cases. Unlike the Accelerated Examination (AE) program in the USPTO, there is no limitation on the number of claims or independent claims for the PE cases. Also, it is not required that the claims be directed to a single invention. If the claims of an application on the PE track are directed to more than one invention,

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the applicant may receive a lack-of-unity rejection and pursue divisional applications later.

#### 7. Is the period for replying to office actions for PE cases the same as normal cases?

For a prosecution case, the office actions for PE cases will have a shorter period for reply than normal cases. Specifically, the period for reply is two months for invention applications and 15 days for utility model or design applications, regardless of whether the office action is the first one or a subsequent one.

For a re-examination or invalidation case, the period for replying to office actions for PE cases is the same as normal cases.

Failure to timely file a reply will result in the PE case going back to the normal track.

#### 8. What is the timing for filing the petition for PE?

For an invention application, the petition for PE can be filed after the CNIPA issues a notification informing that the application has entered substantive examination. For a utility model or design application, the petition for PE can be filed after the applicant has paid the filing fee. For a re-examination case, the petition for PE can be filed after the re-examination fee has

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**For a prosecution case, the applicant needs to file a PE petition form, prior art references, and supporting materials.**

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been paid. For an invalidation case, the petition for PE can be filed after the fee for requesting invalidation has been paid.

After receiving the petition for PE, the CNIPA will issue a notification to inform whether the petition is approved or not, which typically takes two weeks. If the petition for PE is rejected by the CNIPA, the petition cannot be filed again.

#### 9. Who is eligible to request PE?

For a prosecution or re-examination case, it is the applicant who can file a petition for PE with the CNIPA. For an invalidation case, both the invalidation petitioner and the patentee can file the petition for PE. If there are multiple applicants or patentees, the consent of all the applicants or patentees is required.

In addition, the court, the local IP office, or the arbitration/mediation organization that is handling the relevant patent infringement dispute can request PE for the invalidation case.

#### 10. What are the documents required for filing the petition for PE?

For a prosecution case, the applicant needs to file a PE petition form, prior art references, and supporting materials. In the case of above Item 2(v) (i.e., outbound application), these documents shall be directly filed with the CNIPA. In the



other cases, these documents shall be first submitted to the provincial IP office in the province where the applicant or its agency is located to have the PE petition form signed by the provincial IP office, and then filed with the CNIPA. The provincial IP office usually signs the form quickly (e.g., in several days) if the requirements are satisfied.

For a re-examination case, the applicant needs to file a PE petition form and supporting materials. Except for the case where the application was already on the PE track during the prosecution, the sign by the provincial IP office on the PE petition form is also required before filing the documents with the CNIPA.

For an invalidation case, the party requesting PE needs to file a PE petition form and supporting materials. Similarly, a signature from the provincial IP office on the PE petition form is required before filing the documents with the CNIPA.

For all the cases, if an agency is entrusted to handle the PE matters, a power of attorney is also required.

The supporting materials include the necessary documentation to prove that the case complies with the requirements listed in above Items 2-3. Usually, a brief introduction of the invention and the identification of all applicants (e.g., a copy of ID card for an individual, or a copy of business registration for a company) are required for all the cases.

The other documents included in the supporting materials may vary depending on the cases. For an application meeting Item 2(i)-(iii), a statement explaining why the application involves a specified industry is required. For an application meeting Item 2(iv), proofs showing the implementation or preparation for implementation are required, such as a claim chart between a product and the claims, an invoice or agreement showing the sale of the product, a picture or manual of the product, etc. For an application meeting Item 2(v), the filing receipt by the patent office in the other country or region is required. For an invalidation case meeting Item 3(i), documents such as the notifications issued by the court or the compliant as filed are required.

### **11. Under what circumstances will the PE case be moved back to normal track?**

For a prosecution or re-examination case, the case may be moved from the PE track to the normal track if the applicant makes voluntary amendments after the approval of the PE petition, fails to timely reply to the office action, submits false materials, or is found to be an abnormal application.

For an invalidation case, after the approval of

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the PE petition, if the invalidation petitioner supplements causes and evidence for invalidation or the patentee amends the claims in a way other than deletion, the case will be moved back to the normal track. In addition, if the invalidation case is suspended for some legitimate reasons, the case may also be moved back to the normal track.



## **Contact**

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