

Bird & Bird

Legal Update

Deadlines for trade mark, design and patent filings

February 2020

What happens to my deadlines for dealing with office actions (i.e. letters from the registries requiring a response)?

Trade mark

Hong Kong	Mainland China
<p>Hong Kong Government has implemented special work arrangement since the end of the Lunar New Year public holidays and currently civil servants are allowed to work from home until 1 March 2020 subject to further announcements. The operations of the Trade Marks Registry were previously interrupted, causing deadlines to be automatically extended. Nonetheless, its operations have returned to normal since 24 February 2020 and all deadlines have resumed running normally since this date.</p> <p>Generally speaking, for trade mark applications which are under examination, the deadline for responding to the Registrar's First Opinion can be extended for a 3-month period as of right. In cases where a Further Opinion has been issued, it may be possible to apply for a 3-month extension on the basis that additional time is required for preparing evidence of use (if applicable in those cases) and/or exceptional circumstances exist to justify the granting of the extension of time. It is uncertain whether factors relating to the current coronavirus outbreak would be considered an exceptional circumstance. Each time extension request will be considered on a case by case basis, and the Registrar has the ultimate discretion in granting or rejecting the time extension request. It is advised that trade mark owners should contact the particular examiners in charge of their trade mark applications if they have any concerns or queries.</p>	<p>According to CNIPA's Notice No.350 (The Notice for the Time Limits of Patent, Trademark and IC Layout Design Affected by the Epidemic Situation), due to the epidemic situation of the party, the time limit normally can be suspended upon the day for appearance of obstacle and resume after the day for elimination of obstacle.</p> <p>In the further explanation for Notice No.350, CNIPA sets out a non-exhaustive list of the trademark matters available for suspension, including (1) trademark correction matters, (2) response to examination opinions, (3) payment for official fees, (4) filing use evidence and agreement in respect to the application filed on the same day with others, (5) filing use evidence against non-use cancellation, (6) application, response and filing supplemental evidence for opposition, review of rejection, review of refusal, review of invalidation and review of cancellation and (7) response and filing supplemental evidence for invalidation, etc.</p> <p>According to the explanation, the day for appearance of obstacle refers to the day when the party begins to be hospitalized or isolated due to NCP (novel coronavirus pneumonia), or cannot deal with the trademark matters due to the local epidemic controlling measures. The day for elimination of obstacle refers to the day when the party ends the hospitalization or isolation for NCP, or the day for local return to work or the day for local end of personnel controlling.</p>

Design and patent

Hong Kong	Mainland China
<p>The Patents Registry and Designs Registry have resumed normal operations and all deadlines have likewise resumed running normally since 24 February 2020.</p> <p>For HK patent filings, according to Section 100AAC of Patents (General) Rules, response to (further) examination notice and response to (further) review opinion, amongst others, may be granted an extended period not exceeding 2 months by the Registrar if the failure was wholly or mainly attributable to any natural disaster in Hong Kong or Mainland China.</p> <p>According to Section 100AAB of Patents (General) Rules, for response to (further) examination notice and response to (further) review opinion for standard patent (O), amongst others, the periods may be extended for 2 months on request no later than 2 months after expiry of current period, and for response to (further) examination notice and response to (further) review opinion for short-term patent, amongst others, the periods may be extended for 1 month on request no later than 1 month after expiry of current period.</p> <p>In addition, according to Section 29, 37ZD and 123 of Patent Ordinance, for standard patent (R), standard patent (O) and short-term patent, subject to certain exceptions, it may also be able to apply for the restoration of rights if the Registrar is satisfied that the failure to comply with the time limit occurred in spite of the applicant having taken all reasonable care required by circumstances. Such application shall be in writing and shall be made within 1 year after the expiry of the time limit and 2 months after the removal of the cause.</p> <p>For HK design filings, according to Section 73 of Registered Designs Rules, the Registrar may, upon application extend or further extend any period of time for doing any act or taking any proceeding under the Rules on such terms as he may direct, other than the renewal of registration. According to Section 20 of Registered Designs Ordinance, the applicant may file a writing notice requesting reinstatement of application deemed withdrawn following the failure to comply with a time limit under the Ordinance within 1 month after such deemed withdrawal, however, the omission which constituted the failure should have been made good before such notice. The FAQ of Hong Kong IPD has stated that regarding the extension of time due to natural disaster, it will be considered on a case by case basis.</p>	<p>For PRC patent filings, normally for designated periods (except those during the invalidation proceedings) as opposed to the statutory periods, the periods (i.e. letters from the registries requiring a response) could be extended if there are just causes and the extension application is submitted before the deadline. It could only ask for the expansion once, and the expansion cannot be longer than two months. Usually the CNIPA will give two months expansion.</p> <p>In addition, according to CNIPA's Notice No.350 (The Notice for the Time Limits of Patent, Trademark and IC Layout Design Affected by the Epidemic Situation), if the party misses the deadline by the reason of epidemic situation leading to the loss of right, this can be considered as force majeure in Article 6 of the Implementation Rules of Patent Law, so the party can apply for the restoration of the right within 2 months upon the day for elimination of the obstacle but such application should be filed within 2 years after the deadline.</p> <p>In the further explanation for Notice No.350, CNIPA sets out the non-exhaustive list of reasons for restoration, including the party is isolated or infected, and local traffic or place control. According to the explanation, it also includes the circumstance where the right is lost because the return to work day of local government of the party is after the 2020 national Chinese New Year public holiday.</p> <p>The explanation also specifies what kinds of right can be restored by excluding certain rights according to Patent Law. So the rights would be able to restore, except:</p> <ul style="list-style-type: none">• the grace period for novelty in Article 24 of Patent Law;• the priority right periods in Article 29 of Patent Law;• the patent protection terms in Article 42 of Patent Law;• the time limit for filing patent infringement suit in Article 68 of Patent Law.• In the supplemental explanation for Notice No.350, CNIPA confirms that there is no need to file supporting evidence in respect to the restoration of right due to the epidemic situation, in case that it is during the class I response period of major public health emergencies for the province/municipality of the party.

What happens if I am not able to get the required information and evidence because personnel are not able to work?

Trade mark

Hong Kong	Mainland China
<p>As mentioned, in cases where a Further Opinion has been issued, it may be possible to apply for a 3-month extension on the basis that additional time is required for preparing evidence of use (if applicable in those cases) and/or exceptional circumstances exist to justify the granting of the extension of time. A party may try to submit that personnel are not able to work during the coronavirus outbreak which is an exceptional circumstance justifying an extension of time. Nonetheless, it is difficult to predict whether this reason would be accepted because the Registrar has the ultimate discretion in granting or refusing time extension. Each time extension request will be considered on a case by case basis.</p> <p>As for deadlines for filing evidence for other trade mark proceedings (e.g. oppositions), a party may request a time extension but it must be supported by full reasons. The grant of time extension request is subject to whether the other party objects to the request as well as the Registrar's discretion. Again, it is difficult to predict whether difficulty in obtaining information/evidence due to special work arrangements during this period may suffice. It is advised that trade mark owners/parties should contact the particular examiners in charge if they have any concerns or queries.</p>	<p>The answer to this question depends on whether the fact that personnel are not able to work amounts to the reason of epidemic situation for the party. The current official regulations or explanations do not provide a clear response to this point. If it does amount to such reason, the time limit for filing the evidence may be suspended in accordance with the explanation for Notice No.350. In addition, the Implementation Regulations of Trademark Law provides that CTMO may accept the evidence which cannot be filed within the time limit for good reason but filed afterwards during the opposition (Article 27) and review (Article 59) proceedings.</p>

Design and patent

Hong Kong	Mainland China
<p>For the HK patent filings, it depends on whether this circumstance can make the Registrar be satisfied that the applicant has taken all reasonable care required.</p> <p>For the HK design filings, since the criterion in the legislation is not very clear, so it may be considered according to the specific circumstance on a case by case basis.</p>	<p>For the PRC patent filings, due to the COVID-19, the reason mentioned in this question might be regarded as just cause. It could apply for the two months expansion of the periods, if applicable.</p> <p>In addition, it may also depend on whether personnel are not able to work amounts to the reason of epidemic situation for the party. The current official regulations or explanations do not provide the clear response on this point. However, if it does amount to such reason, and it leads to the party loses the right, the party may apply for the restoration of the right, subject to the above-mentioned four exceptions.</p>

What happens to my renewal deadlines?

Trade mark

Hong Kong	Mainland China
<p>In Hong Kong, if a trade mark owner fails to renew a trade mark registration by the expiry date, it is possible to apply for late renewal within 6 month after expiry on the payment of a late renewal fee.</p> <p>Beyond this 6-month grace period, the registration will be removed but an owner may apply to restore the registration within 6 months after the date of removal. Nevertheless, a request for restoration must be supported with adequate reasons for the failure to renew. The Registrar will consider all the circumstances of the failure to renew. Generally, it would be just to restore the registration where the owner had in place a proper system for renewing the registration and a request for restoration was filed as soon as practicable after the omission became apparent. It is uncertain whether any factors relating to the current outbreak would be considered sufficient reasons to justify restoration. An owner is advised to take necessary action as soon as possible once it is discovered that the 6-month grace period has expired.</p>	<p>According to Notice No.350 and the explanation, if the party does not renew the trademark right before the expiration of gracing period provided by Trademark Law due to the epidemic situation, the party can file the renewal application within 2 months upon the day for elimination of obstacle.</p>

Design and patent

Hong Kong	Mainland China
<p>For patent renewal deadlines, according to Section 40 and 127 of Patent Ordinance, lapsed standard patents and short-term patent are able to apply for restoration within 18 months after the lapsed date, if the Registrar is satisfied that the failure to pay renewal fee occurred in spite of the applicant having taken all reasonable care required by circumstances. Section 39 of Patent Ordinance provides 6 months grace period for the payment of annuity, subject to additional fees.</p> <p>For design renewal deadlines, according to the wording of Section 73 of Registered Designs Rules, the renewal deadline appears to be beyond the Registrar's power of extension. Section 28 of Registered Design Ordinance provides 6 months grace period for renewal, subject to additional fees.</p>	<p>For the PRC patent, even though the deadline has lapsed, it may still have ways to renew the rights. Based on Article 6 of the Implementation Rules of Patent Law, there are two options:</p> <ul style="list-style-type: none"> • If the reasons are irresistible, it could apply for the restoration in two months upon the obstacles disappear but in two years from the deadline; (this option would be the better one because it could have longer period) • If the reasons are reasonable, it could apply for the restoration in two months upon the receipt for the notice of loss. <p>The right of renewal does not fall in the excluded scope for restoration, so if the party misses the renewal deadline due to epidemic situation, the party can apply for restoration of right. Article 98 of Implementation Rules of Patent Law also provides 6 months grace period for the payment of annuity, subject to late fees.</p>

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