

REVISION OF THE PATENT EXAMINATION GUIDELINES IN CHINA

By Dan SHI
Chinese Patent Attorney

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The State Intellectual Property Office (SIPO) of China recently issued Decision of the Revision to “Guidelines of Patent Examination” (“the Guidelines”). The Revision to the Guidelines (“the Revision”) will take effect from 1 April 2017.

The Revision clarifies the practice in some technology areas that have witnessed a fast growth brought on by the development of the Internet and computer technology and services, such as business method, and computer-implemented method.

The Revision also confirms changes on some extensively concerned subjects, such as supplemental data in chemical cases, amendments during invalidation proceedings, the public’s access to patent application files.

Further, the Revision seeks to harmonize the time limits for the suspension of procedure with the Civil Procedure Law (2013).

Here is a brief summary of the Revision:

- Potentially good news for applicants of **Business method-related inventions** is that their inventions containing business models and methods will no longer be subjected to immediate rejections for non-statutory subject matters.

The Revision adds: *“if a claim involving a business model contains not only matter of business rule or methods but also technical features, the claim shall not be excluded from patentability”* (Part II, Chapter 1, Section 4.2).

- Also positive news for applicants seeking protection for their **computer-implemented methods**, as the definition of a computer-implemented methods is clarified as

different from the computer program *per se* which has always been excluded from patent law protection.

Drafting computer-implemented methods into apparatus claims is confirmed as the Revision replaces “*a detailed account shall also be given on the component parts by which the various functions of the computer program are performed, and on how these functions are performed*” by “*the component parts may not only contain hardware but also program*” (Part II, Chapter 9, Section 5.2).

To emphasize the difference between an apparatus claim realizing a solution mainly through a computer program and that through hardware with “means-plus-function” claims, the Revision replaces “*the apparatus claim defined by such a group of function modules*” by “*the apparatus claim defined by such a group of computer program modules*” (Part II, Chapter 9, Section 5.2).

- **Experimental data submitted after the date of filing** will now be taken into consideration by the Examiner

The Revision adds the condition to consider such data for estimating sufficient disclosure, i.e. “*the technical effects proven by the supplementary experimental data shall be those that can be obtained from the disclosure of the application by one skilled in the art*” (Part II, Chapter 10, Section 3.4).

This again brings positive changes as it provides applicants with a chance to argue against a potential rejection for lack of sufficient disclosure by submitting further experimental data.

- **About the invalidation proceedings**

The invalidation proceeding in China is a post-grant procedure meaning once a patent is granted, any person (individual or entity) who believes that the patent should not have been granted pursuant to the Chinese patent law, can request that the Patent Reexamination Board (“the Board”) of SIPO declare the patent invalid.

During the invalidation proceedings

- the **patentee** is now provided with **more flexibilities to amend the claims** such as by adding further limitations from other claim(s) (instead of merely being able to combine existing claims as was the case before) and by correcting obvious errors, in addition to the patentee’s current ability of amending by deletion of claims and deletion of a technical solution from a claim (Part IV, Chapter 3, Section 4.6.2).

Meanwhile, for the amendment to be valid it shall not go beyond the original disclosure as required by Article 33 of the Chinese Patent Law.

- o the **petitioner** may face more constraints
 - when the petitioner **raises additional causes** for invalidation more than one month from the date of submitting the request, for the additional causes to be taken into account by the Board concerning claims amended by adding further limitations by the patentee, the additional causes for invalidation **can be made only with respect to the amendments** within the time limit (Part IV, Chapter 3, Section 4.2).
 - when the petitioner **presents additional evidence** more than one month from the date of filing the request for invalidation, for the additional evidence to be taken into account by the Board, the additional evidence **has to be made only concerning counterevidence presented by the patentee** within the time limit. (Part IV, Chapter 3, Section 4.3.1). For example, the petitioner cannot present additional evidence concerning claims amended by the patentee.

The Revision on the one hand provides more options to the patentees to amend the claims; on the other hand, it will be more difficult for the petitioners to estimate their strategies for invalidation.

- **File inspection** of Chinese patent applications which have been **published but not yet granted** is no longer limited to documents during the preliminary examination, and is **extended to “notifications, search reports and decision issued to the applicant during the substantive examination”** (Part V, Chapter 4, Subsection 5.2(2)).
- **File inspection** of Chinese patent applications which have been **granted now includes access to “priority documents” and “search reports”** (Part V, Chapter 4, Subsection 5.2 (3)).

The broadened access to Chinese patent applications seems positive to all the interested parties, and to the public in general.

- The duration of the suspension periods in the suspension procedures will be adapted to the orders of the civil court (Part VII, Chapter 7, Sections 7.4.2 and 7.4.3).

Related legal procedures may be streamlined.

Our teams are at your disposal to help you if you have any questions regarding the Revision



Dan SHI (shi@regimbeau.eu),
Chinese Patent Attorney,

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Fifteen partners head a team of more than 200 people whose skills are put into practice in every strategic aspect of Intellectual Property - business intelligence and information search, license agreements, IP portfolio audits, partnership negotiations, acquisition of industrial property rights, litigation.

Already well implanted in France with headquarters located in Paris along with several local branches (Lyon, Rennes, Grenoble, Montpellier, Toulouse and Caen), REGIMBEAU strengthened its presence in Europe in September 2012, with the opening, of a Munich branch situated close to the European Patent Office (EPO). REGIMBEAU has put a specialized organization into place, with a core team dedicated to handling EPO proceedings for foreign applicants.

