

Amendments to PRC Patent Examination Guidelines

On 28 February 2017, the State Intellectual Property Office (SIPO) in China announced the amended Patent Examination Guidelines ("the amended Guidelines" hereinafter), which will take effect on 1 April 2017. The amended Guidelines will retroactively apply to patent applications and patent invalidation cases that are pending at the time when the amended Guidelines take effect (i.e., on 1 April 2017), as well as patent applications and patent invalidation cases newly filed on or after 1 April 2017. The major portions of the amendment are summarized as follows:

I. Business Method Related Solutions – Patentable Subject Matter

Section 4.2, Chapter 1, Part II of the current Guidelines stipulates that "if a claim contains not only matter of rules or methods for performing mental activities but also technical features, then the claim, viewed as a whole, is not a rule or method for mental activities, and shall not be excluded from patentability under Article 25 of the Patent Law."

The amended Guidelines (Section 4.2, Chapter 1, Part II) further provide an example that indicates: for a claim involving a business model, if it not only contains content about a business rule or method but also technical features, it shall not be excluded from patentability under Article 25 of the Patent Law. The amended contents further clarify that a claim shall not be rejected for non-statutory subject matter solely because its technical solution involves a business rule or method.

II. Computer Program Related Applications

According to Article 25 of the Patent Law and Chapter 1 of Part II of the Guidelines, "a computer program *per se*" belongs to "rules and methods for performing mental activities" and is not patentable. While Section 1, Chapter 9, Part II of the current Guidelines provides a definition of "computer program *per se*," the current Guidelines do not differentiate it from "computer program." This lack of distinction easily promotes the misconception that an invention related to a computer program is unpatentable.

The amended Guidelines make the following stipulations for patent applications related to a computer program.

1. Stipulating that "computer program *per se*" is different from "invention related to a computer program."

Point (1), Section 2, Chapter 9, Part II of the amended Guidelines makes the distinction that a "computer program *per se*" is non-statutory subject matter, while an "invention related to a computer program" is patentable subject matter, and thus allows drafting a claim in the form of "medium plus computer program flow."

2. Stipulating that an apparatus claim may include programs.
A computer product related apparatus invention is characterized in improvement and

innovation achieved by a combination of software and hardware. According to the provisions in Paragraph 1, Section 5.2, Chapter 9, Part II of the current Guidelines, for a computer product related apparatus invention, a patent applicant shall detail "components for performing functions of the computer program and how these functions are performed." The amended Guidelines no longer include the aforementioned provisions, and further stipulate "the components may include both hardware and programs." In other words, a "program" may serve as a component of an apparatus claim.

In the current practice, only the following two types of claims are allowed for a computer program related patent application: (1) method claim (reciting each step of a program flow) and (2) apparatus claim (reciting each "functional module" that performs a program flow). Some examiners even prohibit the words "program" and "software" in apparatus claims. The amended Guidelines stipulate that a computer program related claim may recite hardware, software, or both, so as to conform to customary practice in this field.

3. Amending "functional module" as "program module."

The expression "functional module" in the current Guidelines fails to reflect the technical essence at issue, and is easily confused with the expression "functional limitation." For this reason, the amended Guidelines amend "functional module" as "program module" (Section 5.2, Chapter 9, Part II).

The current Guidelines stipulate that "if an apparatus claim is drafted solely on the basis of computer program flow and in a way completely identical with and corresponding to each step in the said computer program flow, or in a way completely identical with and corresponding to the method claim reflecting the computer program flow, i.e., each component in the apparatus claim completely corresponds to each step in the computer program flow or each step in the method claim, then each component in the apparatus claim shall be regarded as a functional module required to be built to perform each step in the computer program flow or each step in the method. The apparatus claim defined by such a group of functional modules shall be regarded as functional module architecture to perform said solution mainly through the computer program described in the specification rather than a physical means to realize said solution mainly through hardware." The term "functional module," however, is easily confused with "functional limitation," and causes disputes on the construction of the claims after patent right has been granted. The amended Guidelines validate use of the term "program" in claims, and instruct that the modules in such claims are to be construed as "program modules" for purposes of claim construction.

4. Deleting "Example 9" from the claim drafting examples.

Section 3, Chapter 9, Part II of the current Guidelines lists nine examination examples for invention patent applications that are related to computer programs, wherein Examples 1-3 are related to examination under Item 2 of Paragraph 1 of Article 25 of the Patent Law, and Examples 4-9 are related to examination under Paragraph 2 of Article 2 of the Patent Law. Example 9, which is "a system in which

a foreign-language learner may decide contents of the foreign language by himself/herself," is now deemed as meaningless and thus is deleted.

III. Submission of Supplementary Experimental Data

Point (2) of Section 3.4, Chapter 10, Part II of the current Guidelines stipulates that: experimental data submitted after the date of filing shall not be taken into consideration.

In the amended Guidelines, original Point (2) of Section 3.4 is moved to Section 3.5, entitled "Regarding Supplementary Experimental Data," which changes "the examiner shall not consider experimental data submitted after the date of filing" to "the examiner shall examine experimental data submitted after the date of filing. The technical effects proved by the supplementary experimental data shall be determinable by a person skilled in the art according to the disclosure of the application documents originally filed." Accordingly, in response to the "insufficient-disclosure objection" raised during the prosecution of a patent application, an applicant, besides making a defense or further defining claims, may submit relevant supplementary experimental data after the date of filing according to the provision in the amended Guidelines.

IV. Regarding an Invalidation Request

1. Relaxed requirements for concrete manners of amending patent claims

Paragraph 1 of Section 4.6.2 of Chapter 3 of Part IV of the current Guidelines stipulates that: subject to the above principles of amendments, the concrete manners of amending claims are generally limited to (1) deletion of a claim, (2) combination of claims, and (3) deletion of a technical solution.

The amended Guidelines stipulate that: subject to the above principles of amendments, the specific manners of amending claims are generally limited to (1) deletion of claims, (2) deletion of a technical solution, (3) further limitation of claims, and (4) correction of obvious errors. The amended Guidelines properly relax the restrictions to the manners in which the claims of a patent may be amended. In line with the aforementioned amendments to the Guidelines, the amended Guidelines further explicitly stipulate that: "further limitation of a claim means incorporating one or more technical features disclosed in other claims into this claim, so as to narrow the protection scope."

2. Manner of patent amendment

Paragraph 2 of Section 4.6.3 of Chapter 3 of Part IV of the current Guidelines stipulates that: the patentee may amend the claims by way of combination only within the time limit and under one of the following circumstances: (1) in response to the petition for invalidation; (2) in response to causes for invalidation or evidence added by the petitioner; and (3) in response to causes for invalidation or evidence not mentioned by the petitioner but introduced by the Patent Reexamination Board.

In view of the relaxation on existing restrictions on manners of amending patent claims, the amended Guidelines change "amending claims by the way of combination" to "amending claims in ways except deletion."

3. Supplementation of invalidation causes by an invalidation petitioner

Point (2) of Section 4.2 of Chapter 3 of Part IV of the current Guidelines stipulates that: where the petitioner raises additional causes for invalidation after one month from the date of submitting the request, generally the Patent Reexamination Board will not take them into account, except for any one of the following circumstances: (1) in response to the claims amended by way of "combination" by the patentee, the addition of causes for invalidation is made within the time limit specified by the Patent Reexamination Board, and the added causes are explained concretely within the time limit, or (2) the purpose of the addition is to obviously change the causes for invalidation which do not correspond to the evidence submitted.

The amended Guidelines change the exception in Point (1) to read "in response to the claims amended by ways 'except deletion,' addition of causes for invalidation is made within the time limit specified by the Patent Reexamination Board, and the added causes are explained concretely within the time limit." In other words, in the aforementioned circumstance, the invalidation petitioner may raise additional causes for invalidation within one month from the date of submitting the request.

In view of the new manners of amending patent claims, the amended Guidelines further stipulate that the invalidation petitioner may add invalidation reasons in response to the claims amended by the patentee by ways "except deletion," but the reasons should be relevant to "the amended content."

4. Supplementation of evidence by an invalidation petitioner

Point (2)(i) of Section 4.3.1 of Chapter 3 of Part IV of the current Guidelines stipulates that the invalidation petitioner may add supplementary evidence after one month from the date of submitting the invalidation request only when responding to the claim amendment made by the patentee by way of combination.

As stated above, "claims amended by way of combination by the patentee" is changed in the amended Guidelines to "further limitation of a claim (that is, the claim is amended by incorporation of one or more technical features that are disclosed in other claims)." When a patentee amends a claim by incorporating the technical features disclosed in other claims into the claim, the patentee introduces no technical features that are not disclosed in the original claims. Therefore, the invalidation petitioner only needs to adjust the combination manner of the submitted evidence, and does not need to add evidence. Accordingly, the amended Guidelines delete the provision that when responding to claim amendment made by way of combination by the patentee, the addition of causes for invalidation is allowed within the specified time limit, so as not to prolong the procedures unreasonably.

V. Public Inspection and Copying of Prosecution History Files

1. Invention patent application

Point (2) of Section 5.2 of Chapter 4 of Part V of the current Guidelines stipulates that: for a patent application for invention which has been published but has not been granted, the contents in the file which may be inspected and copied may be limited to those published **by the date of publication**, including application documents, procedural documents directly related to the application, publication documents, notifications and decisions sent to the applicant in the preliminary examination procedure and the text of the response briefs submitted by the applicant in response to the notifications.

The amended Guidelines stipulate that, for a patent application for invention which has been published and granted, the contents in the file which may be inspected and copied include application documents, procedural documents directly related to the application, publication documents, notifications and decisions sent to the applicant in the preliminary examination procedure and the text of the response briefs submitted by the applicant in response to the notifications, **and notifications, search reports, and decisions sent to the applicant during a substantive examination procedure.**

The stipulation in the current Guidelines is not conducive to dissemination of technology and prevents the public from obtaining information during the prosecution in time and monitoring the patent examination. Therefore, the amended Guidelines expand the content that can be inspected and copied by the public by deleting the provision "by the date of publication" in Point (2) of Section 5.2, to thus include documents that are issued to the patent applicant during the substantive examination procedure, including notifications, search reports, and decisions that are issued to the applicant.

It should be noted that regarding the files of the application that enter the reexamination procedure, according to the stipulation of Point (4) of Section 5.2 of Chapter 4 of Part V of the current Guidelines, the contents in the patent application files before entering the current examination procedure may be inspected and copied according to the provisions in the same section. In other words, regarding the application entering the reexamination procedure, the scope of files available for inspection and copying may also be extended to documents under the substantive examination procedure. However, after the amended Guidelines come into force, regarding an application for which the reexamination procedure is not concluded, the inspection and copying is still limited only to parties concerned in said case according to the stipulation in Section 5.1 of Chapter 4 of Part V of the current Guidelines.

2. Files of a patent application for which grant of patent right has been announced

According to the provisions of the amended Guidelines, Point (3) of Section 5.2 of Chapter 4 of Part V is amended as follows.

"(3) For a patent application that has been published and for which grant of

patent right has been announced, the contents in the files which may be inspected and copied include: application documents, priority documents, procedural documents directly relating to the application, an offprint of invention patent application filed, an offprint of invention patent specification allowed, an offprint of utility model specification allowed, and an offprint of design patent specification allowed, patent registration books, patent right assessment report, and notifications, search reports and decisions issued by the Patent Office or the Patent Reexamination Board to the applicant or parties concerned and the response brief submitted by the applicant or the parties concerned in response to the notifications in the examination proceedings which have been closed (including procedures of preliminary examination, substantive examination, reexamination, invalidation, etc.)."

In other words, for a patent application for which grant of patent right has been announced, "**priority documents**" issued by the Patent Office are to be among the files for which inspection and copying are allowed.

VI. Amendment to Chapter 7 of Part V (Time Limit, Restoration of Right, and Suspension of Procedure)

In order to relieve difficulties experienced in execution of judgments or orders of the People's Court, the Civil Procedure Law enforced from 1 January 2013 strengthens the requirements for the relevant organizations in fulfilling execution assistance duties such as seizure and freezing of property. Therefore, the amended Guidelines make corresponding amendments to the provisions concerning the suspension procedure in the current Guidelines, stipulating that: if the People's Court orders the Patent Office to execute the suspension procedure so as to assist to execute property preservation, the Patent Office shall suspend relevant procedures according to the time limit of property preservation specified in the civil order and the notification on assistance in execution issued by the court; if the People's Court orders the Patent Office to continue execution of property preservation, the People's Court shall serve the Patent Office with a notification on assistance in execution of the preservation before the expiration of the time limit, and the time limit of suspension may be extended if said notification complies with the regulations.

Regarding registration of preservation, a preservation request at the top of the waiting list shall be executed from the date on which the previous preservation comes to an end, and the time limit of suspension is also changed from "six months" to "the time limit of property preservation specified in the civil order and notification on assistance in execution." Meanwhile, regarding Section 7.4.3 entitled "Time Limit of Suspension Concerning Invalidation Procedure," because the amended Section 7.4.2 includes a general provision on the situation of suspension due to execution assistance of property preservation requested by the People's Court, the time limit of property preservation specified in the civil order and notification on assistance in execution is also applicable to the situation that the suspension appears in the invalidation procedure due to execution assistance of property preservation requested by the People's Court.