

Explanation of the State Intellectual Property Office on the 'Draft Amendments to the Guidelines for Patent Examination (Exposure Draft)'

I. Necessity for and Main Processes of Amendments to the Guidelines for Patent Examination

It is pointed out in the Several Opinions of the CPC Central Committee and the State Council on Deepening the Reform of Systems and Mechanisms and Speeding up Innovation-Driven Development Strategy (Zhong Fa [2015] No. 8) that it should explore the measures for protecting intellectual property rights of new forms of innovation achievements such as business modes. In addition, it is provided for in the Several Opinions of the State Council on Speeding up Building of Intellectual Property Rights in the New Situation (Guo Fa [2015] No. 71) that it should strengthen the protection on intellectual property rights of innovation achievements of new industries and new forms and explore to improve the intellectual property right protection system of business mode; strengthen research on the protection rules for intellectual property rights in the fields of the Internet, electronic commerce, and big data and boost the improvement on relevant laws and regulations; improve the system of revising patent documents after authorization; and promptly publicize the process information of patent examination in accordance with law.

In recent years, the Internet technology has flourished and deeply integrated with all sectors of the economy and society, which effectively boosts the innovation in the business modes of all industries. It has been found out after investigation that innovation subjects wish the patent system will be able to protect technical plans in the innovation in such business modes. In addition, in the practice of patent examination, innovation subjects have the reasonable concerns and needs of specifying the examination principle of supplementary experimental data, methods of revising patent documents after authorization, and further disclosure of process information of patent examination. It is necessary to actively respond to their concerns and needs at the rule level, specify examination standard, and strengthen law-based administration, so as to improve the public service rendered by the government. The patent examination procedures should also be accordingly adjusted as relevant laws are amended.

By the end of 2015, the SIPO initiated the amendments to the Guidelines for Patent Examination (hereinafter referred to as the "Guidelines") with a view to better implementing documents of the CPC Central Committee and the State Council, promptly resolving issues that are highly concerned and imminently needed by the society, and boosting the continuous improvement of the patent examination system. The Draft Amendments to the Guidelines for Patent Examination (Exposure Draft) are formed after survey and symposium in the past years, through prudently study, and based on opinions of some enterprises and agencies.

II. Major Amendments

(I) Amendment to Chapter 1 of Part II (Inventions-Creations for Which No Patent Right Shall Be Granted)



According to the existing Guidelines, the managerial methods and systems in business implementation as rules and methods for mental activities are not subject matters to which patent rights can be granted. With the development of the Internet technology, the innovations in business modes of such sectors as finance, insurance, securities, lease, auction, investment, marketing, advertising, and operation management have emerged one after another. These new business modes operate well in the market with best user experience, improve the resources allocation and circulation efficiency, save social costs, and enhanced social welfare. Therefore, it should actively encourage and properly protect the technical plans in the innovation in such business modes and should not refuse to grant of patent rights just by reason that such technical plans contain business rules and methods. It is suggested that the Guidelines should specify that **if a claim involving business mode in its whole contents contains not only rules and methods for mental activities but also technical features, then the claim shall not be excluded from patentability under Article 25 of the Patent Law.** (Section 4.2)

(II) Amendment to Chapter 9 of Part II (Some Provisions on Examination of Invention Applications Concerning Computer Programs)

1. Further specifying that "a computer program per se" is not "an invention involving computer programs" and allowing to draft claims by means of "medium + computer program flow"

Subject to Article 25 of the Patent Law and enumerative provisions set out in Chapter 1 of Part II of the Guidelines, "a computer program per se" falls into the scope of the rules and methods for mental activities and does not constitute the subject matter for which patent protection may be sought. The term "computer program per se" is specifically defined in Section 1 of Chapter 9 of Part II of the existing Guidelines; in Section 2 "Examination Criteria of Patent Applications for Invention Involving Relating to Computer Programs", however, it fails to differentiate the expression of "computer program" from that of "computer program per se", which would possibly lead to the misunderstanding that "an invention involving computer programs" is not the subject matter for which patent protection may be sought. To this end, it suggested to differentiate one from the another by adding "**per se**" after "computer program" or "program" referred to in Section 2(1) to clarify that only the "computer program per se" is not the subject matter for which the patent protection may be sought but "an invention involving computer program" is the subject matter for which the patent protection may be sought. It is further suggested that it is allowed to draft claims by means of "medium + computer program flow". (Section 2)

2. Specifying that a detailed account shall also be given on the component parts which may include program

A computer product features that both software and hardware are two synergized component parts both of which can be improved and innovated. The claims of an invention application involving computer programs may be drafted as process claim or product claim, with the most common expression being "the apparatus for executing the process". Under the existing Guidelines, the current method of drafting an apparatus claim would possibly be understood as a method or function of limiting hardware. In order to guide applicants to directly and explicitly describe improvement on the program flow involved in their inventions, it is suggested

to delete the express of "**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**" referred to in the first paragraph of Section 5.2, add the expression of "**a detailed account shall also be given on the component parts which may include not only hardware but also program**" at the end of the last paragraph to specify that a "program" can be a component part of an apparatus claim. In addition, it is suggested to accordingly amend the expression, "i.e., the apparatus for executing the process" referred to in the first paragraph as "**e.g., the apparatus for executing the process**". (Section 5.2)

3. Amending "function modules" as "program module"

The expression relating to "function module" referred to in the existing Guideline fails to clearly reflect the technical nature and is prone to be confused with the expression of "functional limitation". It is suggested to amend "function modules" referred to in Section 5.2 as "**program modules**". (Section 5.2).

In addition [Example 9] "A system for learning foreign language with active selection of learning contents" that has not guiding significance is to be deleted. (Section 3)

(III) Amendment to Chapter 10 of Part II (Some Provisions on Examination of Patent Applications for Invention in the Field of Chemistry)

Whether or not the description is sufficiently disclosed is judged on the basis of the disclosure contained in the initial description and claims. Therefore, the experimental data submitted after the application date will not be taken into account under the existing Guidelines. If, however, the technical effects to be evidenced by the supplementary experimental data are those that a person skilled in the art can get from the disclosed content of the patent application, it should be examined by the examiner. In order to avoid any possible misunderstanding that might be brought about by the existing provisions and specify how should examiner examine the supplementary experimental data, it is suggested to add Section 3.5 "Supplementary Experimental Data", move

the content relating to supplementary experimental data in Section 3.4(2) to Section 3.5, and amend the expression of "any embodiment and experimental data submitted after the date of filing shall not be taken into consideration" as "The experimental data submitted after the application date shall be examined by the examiners. **The technical effects to be evidenced by the supplementary experimental data shall be those that a person skilled in the art can get from the disclosed content of the patent application**". (Section 3.5)

(IV) Amendment to Chapter 3 of Part IV (Examination of Requests for Invalidation)

1. Appropriately lifting the control over the methods for revising patent documents

Subject to the provisions set out in the existing Guidelines, the methods of revising a patent document after authorization are limited to deletion and combination of the claims in the invalidation procedure and deletion of technical plans. In practice, patentees wish that the revision of patent documents will be more flexible and

allow addition of technical features recorded in the claim or description and allow revision of any obvious error. However, the revision of a patent document should not impair the reliance interests of the public as the protection on a patent right is limited to its claim and the claim of an authorization announcement should be of publicity. After comprehensive consideration, it is suggested to appropriately lift the control over the methods of revising patent documents and allow to **record one or more technical features recorded in other claims in a claim so as to narrow the protection scope.** (Sections 4.2, 4.6.2, and 4.6.3)

2. Adjusting the provisions on the addition of causes for invalidation or supplementary information by the petitioner.

Subject to Article 67 of the Implementing Rules for the Patent Law, the petitioner may, after the Patent Reexamination Board accepts any request for invalidation, raise additional causes for invalidation or produce new evidence within one month from the date of submitting the request; otherwise the Patent Reexamination Board will not take them into account. In practice, it should give an opportunity to the petitioner to add his causes for invalidation after the patentee revised the patent documents; provided that such addition should be pertinent to such revision. In the consideration of foregoing provision of lifting up the control over the methods of revising patent documents, it is suggested to specify that if the petitioner adds causes for invalidation "**for claims amended by other ways than deletion by the patentee**", the addition should be "**for the revised contents**" only. (Section 4.2)

If a patentee revises claim by adding the technical features recorded in other claims other than those not existed in the previous claims, the petitioner is only required to adjust the combination of the submitted evidence other than submit supplementary evidence. Therefore, it is suggested to delete the provision of allowing petitioner to submit supplementary evidence within specified term "for claims amended by way of combination by the patentee" in the existing Guidelines so as to avoid unreasonable extension of procedure. (Section 4.3.1)

(V) Amendment to Chapter 4 of Part V (Patent Application Files)

Subject to the existing Guidelines, for the file of a patent application for invention which has been published and whose grant of patent right has not been announced, the contents in the file which may be consulted and copied relate to those before the date of the publication. This provision is against technology dissemination while affecting the public to promptly access to the process information of patent examination and their supervision on the patent examination. Therefore, it is suggested to add content of allowing the public to consult and copy, delete the provision of "**before the date of the publication**" referred to in Section 5.2(2), and expand the scope that the public can consult and copy to the substantive examination procedure, including **the notifications, and notifications, search reports, and decisions sent to the applicant in the substantive examination procedure**; in Section 5.2(3), the "**search reports**" should be included into the content that the public may consult and copy, as for the patent application for which the patent right is granted as announced. Moreover, Section 5.1 "Principles of Consultation and Photocopying" specifies the principle of judging whether or not is allowed to consult and photocopy". Therefore, it is suggested to delete the

provision set out in Section 5.2(5): **"except for the above-mentioned contents mentioned above, consultation or photocopying of other documents shall not be allowed."** (Section 5.2)

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

In order to effectively resolve the difficulty in enforcing valid judgments and written orders of the people's courts, the Civil Procedure Law, as amended, that has been effective as from January 1, 2013 strengthened the requirements for assisting enforcement obligations of relevant authorities such as seizing and freezing properties. Therefore, it is suggested to make adaptive revision of the provisions set out in the existing Guidelines on suspension of procedure, specifying that, for the suspension due to execution assistance of property preservation asked by the people's court, relevant procedures shall be suspended by the patent office in accordance with the property preservation term specified in the civil judgment and notification of assistance of enforcement. If the people's court orders to continue to take the property preservation measure upon the expiry of such suspension, it shall deliver a notification of assistance of enforcement to the patent office prior to such expiry. If it complies with relevant provisions as examined, the suspension may be extended. Subject to the provisions of Article 86 and Article 88 of the Implementing Rules for the Patent Law, the requirements for suspension involving invalidation procedure shall be regulated. (Sections 7.4.2 and 7.4.3)

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