SIPO Revises the Guidelines for Patent Examination

The State Intellectual Property Office of China (SIPO) has issued on 28 February 2017 the Decision on Revision of the Guidelines for Patent Examination, which will take effect on 1 April 2017. This revision covers such aspects as protection of business models and computer programs, supplementary experimental data, amendment to claims in invalidation procedure, patent examination information disclosure, and suspension procedure. In the following we will provide an English translation of the amendments along with comments on the background and implications of the changes brought by this revision.

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<th>The Amendments</th>
<th>CPA Comments</th>
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| **Part II, Chapter 1**  
**4.2 Rules and Methods for Mental Activities**  
"Mental activities" refer to human's thinking movements. They originate from human's thinking, and produce abstract results through inference, analysis and judgment, or, via human's thinking movement, produce results by indirectly acting on the nature.  
......  
(2) Except the cases described above in point (1), if a claim in its whole contents contains not only matter of rule or method for 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.  
[Example]  
If a claim relating to business models includes not only matter of business rules or methods but also technical features, the claim shall not be excluded from patentability under Article 25. | This revision has made clear the following:  
1. Business methods per se are still unpattentable; and  
2. In order to render a patent application relating to business methods patentable, the patent claim should include pertinent technical features.  
Under current examination practice, it is less common for patent examiners in China to reject a business method patent application on the grounds of Article 25 of the Patent Law than on the grounds of non-compliance with the requirements of a technical solution under Article 2.2 thereof. As such, these amendments may not bring much substantial influence on the examination practice in the short run. For patent drafting and patent prosecution, the applicants are advised to keep on stressing the technical attributes of the invention, i.e., the technical problem to be solved and the anticipated technical effect.  
On another note, the spirit of these amendments shows that China embraces and encourages inventions in such areas as finance, insurance, bonds and securities, investment, sales and marketing, advertising, and management, which all fall under the realm of business methods. Hence,
many patent practitioners, including our firm, are of the view that getting a business method patent in China is becoming easier. Having said that, it remains to be seen as regards by what concrete steps and with how much momentum China is going to put to practice its support of business method inventions.

Part II, Chapter 9
2. Examination Criteria of Invention Applications Relating to Computer Programs

Examination shall focus on solutions for which protection is sought for, i.e., solutions defined by each claim.

……

(1) If a claim merely relates to an algorithm, or mathematical computing rules, or computer programs per se, or computer programs per se recorded in mediums (such as tapes, discs, optical discs, magnetic optical discs, ROM, PROM, VCD, DVD, or other computer-readable mediums), or rules or methods for games, etc., it 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.

If all the contents of a claim, except its title of the subject matter, ... and does not constitute the subject matter of patent protection.

For example, computer-readable storage medium or a product of computer program that is merely defined by recorded program per se, or devices for computer games, etc., which are merely defined by game rules and does not include any technical features, e.g., those do not include any physical entity, does not constitute the subject matter of patent protection because it essentially merely relates to rules and methods for mental activities. However, the claimed medium in an patent application relating to physical characteristics improvement

According to the Patent Law and the Guidelines for Patent Examination ("the Guidelines"), "computer programs per se" fall under unpatentable rules and methods for mental activities. The Guidelines do not make a clear distinction in the wording between "computer programs" and "computer programs per se". This may result in "an invention relating to computer programs" being mistaken as "a computer program per se" in practice. For this reason, the amendments expressly point out that "an invention relating to computer programs" is different from "a computer program per se", and the former is a subject matter of patent protection.
thereof, for example, layer composition, magic channel spacing, materials, etc., does not fall into the cases mentioned above.

| Part II, Chapter 9  
| 3. Examination Examples for Invention Applications Relating to Computer Programs  
| The following are examination examples for invention applications relating to computer programs based on the above examination criteria.  
| ......  
| (3) Invention applications relating to computer programs which do not solve technical problems, or do not utilize technical means, or do not obtain technical effects, are not technical solutions as provided for in Article 2.2, and therefore are not subject matter of patent protection.  
|   [Example 8]  
| ...Therefore, this invention application is not the technical solution as provided for in Article 2.2 and is not the subject matter of patent protection.  
|   [Example 9] A system for learning foreign language with active selection of learning contents  
|   ---  
| Analysis and conclusion  
| This solution is to form a learning system by a set of computer program function modules, which can receive language files determined and input by users, compare sentences thereof with reordered sentences by users, and output comparing results to users. Although the learning system realizes the aim of control over learning process by the learning machine executing computer programs, the said learning machine is well-known electronic equipment, the division, reordering, comparison, and scoring of sentences neither improve the internal performance of the learning machine, nor cause Example 9 is deleted as the example no longer serves any significant guiding purposes. |
any technical change to the composition or function of the learning machine. What the system aims to solve is how to determine learning contents based on users' objective will, and thus does not constitute a technical problem. What is utilized is making learning rules artificially and following these rules without restriction of the laws of nature, and thus is not technical means. What is obtained is not technical effect in conformity with the laws of nature. Therefore, this invention application is not the technical solution as provided in Article 2.2 and is not the subject matter of patent protection.

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<th>Part II, Chapter 9 5.2 Drafting of Claims</th>
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<td>The claims of an invention application relating to computer programs may be drafted as process claim or product claim, i.e., e.g., the apparatus for executing the process. No matter what kind of claim it is drafted as, the claim shall be supported by the description, represent the technical solution of the invention in its entirety and outline the essential technical features for resolving the technical problems, and do not describe resumptively the functions of the computer program and the effects those functions can produce only. If it is drafted as a process claim, the various functions to be performed by the computer program and the way to perform the functions shall be described in detail according to the steps of the process. If it is drafted as an apparatus claim, the various component parts and the connections among them shall be specified, and 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 the component parts may include not only hardware but also programs.</td>
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<td>The amendment herein shows that &quot;an apparatus for executing the process&quot; is only one of the manners of drafting an apparatus claim for an invention relating to computer programs, and that there are alternative drafting manners. In current practice, &quot;an apparatus for executing the process&quot; is the conventional manner of drafting an apparatus claim for an invention relating to computer programs. Nevertheless, to encourage inventions of relevant fields, SIPO will also accept other appropriate manners of drafting. As to what manners of drafting are acceptable, it remains to be seen in the course of putting the matter to practice.</td>
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Computer program-related inventions are characterised by the cooperative action of the software and the hardware, both of which are indispensable. However, it has been a long-standing belief among quite a number of patent practitioners that an apparatus claim relating to computer programs should only include program modules corresponding to method steps, with the exclusion of the hardware, that is, drafting the claim in the manner of "hardware plus software" is not allowable.

The amendments have clarified such sustained misconception by expressly stating that an apparatus claim relating to computer programs
may include not only software but also hardware. This helps to guide the applicant to directly depict in the claim the improvement in computer program flow brought by the invention.

As a matter of fact, some Chinese examiners have already accepted the drafting manner of "hardware plus software". It is expected that by means of this revision of the Guidelines, this manner of drafting, which can embody the essence of a computer program-related invention, will be more widely accepted and used.

The term "function module(s)" has been modified as "program module(s)" so as to avoid "function module(s)" from being interpreted as "functional limitation(s)". In the past, because of the use of the term "function module(s)", virtual modules in an apparatus claim are prone to be understood as functional limitations or functional features. The amendments have made it clear that in an apparatus claim relating to computer programs, "program modules", which are related to program flow, are distinct from "functional limitations".

It is important to differentiate between "program modules" and "functional limitations", because functional limitations/features, according to the Interpretation of the Supreme People's Court of China (2009), cover the embodiments in the description for implementing the functions and the equivalents of these embodiments. Hence, once a feature is regarded as a "functional limitation/feature", a narrower scope of protection will be construed for the feature. In fact, it has occurred in practice that the court deemed a module feature relating to program flow in an apparatus claim as a functional limitation, and further held that the scope of protection of the claim was unable to be determined due to the lack of embodiments in the description, which rendered the allegation of patent infringement untenable.

This revision is conducive to strengthening the patent protection for
Part II, Chapter 10
3. Sufficient Disclosure of Chemical Invention
3.4 Specific Mode for Carry Out the Invention

Chemistry is an experimental science, and a number of inventions in this field need to be verified by experimentation, therefore, the description generally shall include embodiments, in case of an invention of a product, for instance, those which specifically show how to make the product and how to use it.

(1) The number of embodiments needed in the description depends on the extent to which the technical features are generalized in the claim, such as the extent of generalization of parallel alternative elements and the range of selected values of data. The number of embodiments needed in a chemical invention varies depending on the nature and specific fields of technology of the invention. As a general rule, there shall be a sufficient number of embodiments for a person computer program-related inventions. Notwithstanding that, how the revision will be translated into practice in courts is still uncertain, given that the examination guidelines do not have binding effect on the courts. Meanwhile, the applicant, to be on the safe side, should give full depiction in the description of the software and hardware for realising the respective program modules in an apparatus claim, so as to place himself in an advantageous position in case he might get involved in infringement litigation concerning computer program-related patents.

Moreover, as China is positive and supportive of computer program-related inventions, for some significant inventions of this kind that are difficult to get granted elsewhere, such as the US given its post-Alice environment, the applicant may still consider filing the patent application in China.

The Guidelines before this revision set forth that whether the description of a chemistry invention is sufficiently disclosed is judged on the basis of the disclosure contained in the initial description and claims, and any experimental data submitted after the date of filing should not be taken into consideration.

This revision has clarified current stipulations by stating that in judging whether the description of a chemistry invention is sufficiently disclosed, the examiner should examine the experimental data submitted after the filing date. At the same time, it has also confined the technical effect proved by the supplementary experimental data to be the one that can be derived by a person skilled in the art from the disclosure of the patent application. In other words, where the supplementary experimental data are used for proving that a person skilled in the art can attain the technical effect based on the disclosure of the patent application, the examiner should take the data into consideration.
skilled in the art to understand how to carry out the invention and to assess that the invention can be carried out and achieve the effect as expected through the whole of the scope defined by the claims.

3.5 Supplementary Experimental Data

Whether or not the description is sufficiently disclosed is judged on the basis of the disclosure contained in the initial description and claims. Any embodiment and experimental data submitted after the date of filing shall not be taken into consideration.

With respect to the experimental data submitted after the date of filing, they shall be examined by the examiner. The technical effect proved by the supplementary experimental data should be one that can be derived by a person skilled in the art from the disclosure of the patent application.

As regards whether the post-filing experimental data can be used for supporting sufficient disclosure of the description, the Supreme People's Court of China in Judgment No. Xingtizi 8/2014 for the Atorvastatin invention invalidation case held that: if the post-filing experimental evidence for supporting sufficient disclosure of the description can prove that a person skilled in the art, given his knowledge level and cognitive ability as of the date of filing, may carry out the invention through the disclosure in the description, such experimental evidence should be taken into consideration, and should not be rejected simply because the evidence is submitted after the date of filing.

It shows that the focus of examination on the supplementary experimental data for supporting sufficient disclosure of the description would be shifted to whether a person skilled in the art can derive the technical effect proved by the supplementary experimental data from the disclosure of the patent application.

We suggest that the applicant, while submitting experimental data after the date of filing, also provide a detailed explanation that the technical effect proved by said experimental data has been recited in the description of the patent application or can be derived from the disclosure of the patent application.

This revision, however, does not touch upon the use of supplementary experimental data on proving that the claims possess inventive step (Article 22.3) or the claims are supported by the description (Article 26.4).
Part IV, Chapter 3
4.2 Addition of Clauses for Invalidation
(1) Where the petitioner raises additional causes for invalidation within one month from the date of submitting the request, he shall explain the causes concretely within this period; otherwise the Patent Reexamination Board will not take them into account.

(2) 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, unless in any of the following circumstances:
(i) for claims amended by way of combination a means other than deletion by the patentee, addition of causes for invalidation is made in respect of the amended contents within the time limit specified by the Patent Reexamination Board, and the added causes are explained concretely within the time limit; or
(ii) the addition is to change the causes for invalidation which are obviously inappropriate to the evidence submitted.

Rule 67 of the current Implementing Regulations of the Patent Law states that: "After a request for invalidation is accepted by the Patent Reexamination Board, the person making the request may add grounds or supplement evidence within one month from the date when the request for invalidation is filed. Additional grounds or evidence which is submitted after the said time limit may be disregarded by the Patent Reexamination Board." However, where a claim has been amended by the patentee by way of combination, the petitioner would be given a chance to raise additional causes for invalidation.

As this revision has duly relaxed the manners of amendment to patent documents (see our comments below regarding Section 4.6.2 on Manners of Amendment in Chapter 3 of Part IV of the Guidelines), it is correspondingly stated under the section on "Addition of Causes for Invalidation" that the petitioner may raise additional causes for invalidation "for claims amended by a means other than deletion by the patentee" (generally confined to the manners of "further limitation for a claim" and "rectification of an obvious error"), and the additional causes should be "in respect of the amended contents" only.

4.3 The Time Limit for Presenting Evidence
4.3.1 Presenting Evidence by the Petitioner
(1) Where the petitioner presents additional evidence within one month from the date of filing the request for invalidation, he shall explain concretely the relevant causes for invalidation with reference to the additional evidence within this period; otherwise the Patent Reexamination Board will not take it into account.

(2) Where the petitioner presents additional evidence after one month from the date of filing the request for invalidation, generally the

The Guidelines before this revision stipulate that for claims amended by way of combination by the patentee, the invalidation petitioner may submit supplementary evidence and such submission is not subject to the restriction of filing within one month from the date when the request for invalidation is filed.

Following the due relaxation of the manners of amendment to patent documents in this revision (see our comments below regarding Section 4.6.2 on Manners of Amendment in Chapter 3 of Part IV of the Guidelines),
Patent Reexamination Board will not take it into account, unless in any of the following cases:

(i) concerning claims amended by way of combination or counterevidence presented by the patentee, the petitioner presents additional evidence within the time limit specified by the Patent Reexamination Board, and explain the relevant causes concretely with reference to the additional evidence within this period;

(ii) by the closure of oral proceedings, the petitioner presents such evidence of common knowledge in the skilled art as those in a technical dictionary, technical manual, or textbook, or such complementary evidence for meeting the legal requirement for evidence as a notarial document or the original, and explain the relevant causes concretely with reference to the additional evidence within the period; or

(3) Where the petitioner presents evidence in a foreign language, the time limit for submitting the Chinese translation thereof is the same as that for presenting the evidence.

The Guidelines after the revision have removed the stipulations that allow the petitioner to submit supplementary evidence within a specified period "in respect of claims amended by way of combination" to avoid the procedure from being unreasonably prolonged.

Hence, in respect of amendment to the claims by the patentee during the invalidation stage, the petitioner will not be allowed to present supplementary evidence after one month from the date of filing the invalidation request. However, in respect of counterevidence presented by the patentee, the petitioner may still submit supplementary evidence within the specified period and state the relevant invalidation causes with reference to the filed evidence. Moreover, before the close of oral proceedings, the petitioner may submit evidence of common knowledge or such evidence as notarial document or the original for meeting the legal requirement for evidence.

Note: during the invalidation stage, amendment is restricted to the claims only where the amendment is for patent documents for invention or utility model, and for design patent documents, no amendments are allowed.

Part IV, Chapter 3
4.6.2 Manners of Amendment

Subject to the above principles of amendments, the specific manners of amendment are generally limited to deletion of a claim, combination of claims, and deletion of a technical solution, further limitation for a claim, and rectification of an obvious error.

Deletion of a claim means one (or more) claim, such as an where the patentee amends a claim by "further limitation for a claim", technical features from other claims are incorporated into the claim. The petitioner only needs to adjust the combination of the evidence already filed, with no need for submission of supplementary evidence because the amendment involves no technical features newly introduced to the claims. The Guidelines after the revision have removed the stipulations that allow the petitioner to submit supplementary evidence within a specified period "in respect of claims amended by way of combination" to avoid the procedure from being unreasonably prolonged.

Hence, in respect of amendment to the claims by the patentee during the invalidation stage, the petitioner will not be allowed to present supplementary evidence after one month from the date of filing the invalidation request. However, in respect of counterevidence presented by the patentee, the petitioner may still submit supplementary evidence within the specified period and state the relevant invalidation causes with reference to the filed evidence. Moreover, before the close of oral proceedings, the petitioner may submit evidence of common knowledge or such evidence as notarial document or the original for meeting the legal requirement for evidence.

Note: during the invalidation stage, amendment is restricted to the claims only where the amendment is for patent documents for invention or utility model, and for design patent documents, no amendments are allowed.

The Guidelines before this revision are overly strict on post-grant amendment to patent documents, confining the allowed amendment to deletion of a claim, combination of claims, and deletion of a technical solution during the invalidation procedure. In contrast to this, patentees long for more flexibility in the manners of amendment to the patent documents in practice, such as allowing the incorporation into a claim of
Combination of claims means that two or more claims dependent on a same independent claim and having no relation of dependency are combined together. Under this circumstance, all the technical features of the combined dependent claims constitute a new claim. The new claim shall contain all the technical features of each of the dependent claims thus combined. The dependent claims subordinated to a same independent claim shall not be combined together unless the independent claim is amended.

Deletion of a technical solution means to remove one or more technical solutions from several parallel technical solutions defined in a same claim.

Further limitation for a claim means incorporation into a claim one or more technical features recited in other claims so as to narrow the scope of protection.
### Part IV, Chapter 3

#### 4.6.3 Restrictions to Manners of Amendment

Before the Patent Reexamination Board makes a decision on the request for invalidation, the patentee may either delete a claim or delete a technical solution contained in a claim.

The patentee may amend the claims by **means other than deletion** within the time limit for response only in one of the following circumstances:

1. In response to the request for invalidation;
2. In response to causes for invalidation or evidence added by the petitioner;
3. In response to causes for invalidation or evidence not mentioned by the petitioner but introduced by the Patent Reexamination Board.

As this revision has duly relaxed the manners of amendment to patent documents during the invalidation stage, there is further clarification under the section "Restrictions to Manners of Amendment" that amendment other than by way of deletion of a claim or a technical solution within the time limit for response is allowed only under three circumstances. In other words, the two manners of amendment, namely, "further limitation for a claim" and "rectification of an obvious error", within the time limit for response are applicable to three circumstances only.

### Part V, Chapter 4

#### 5.2 Contents Allowed for Consultation and Photocopying

1. For a patent application for invention before publication and a patent application for utility model or design before the announcement of the grant of patent right, the applicant or agent thereof may consult or photocopy the relevant contents in the said patent application files, including the application documents, the formality documents directly relating to the application, notifications and decisions sent to the applicant in the preliminary examination procedure, and the text of the observations submitted by the applicant in response to the notifications.

2. For the file of a patent application for invention which has been published and whose grant of patent right has not been announced, the scope of disclosure has been extended to cover the information during the substantive examination.

The Guidelines before this revision stipulate that for the file of a patent application for invention which has been published and whose grant of patent right has not been announced, only those contents in the file until the date of the publication may be consulted and copied. Such stipulations are unfavourable to the dissemination of technology and may affect the public's prompt obtainment of patent examination information and supervision of patent examination work.

This revision has expanded the scope of disclosure of patent examination information to facilitate its availability to the public. For the file of an invention patent application which has been published and whose grant of patent right has not been announced, the scope of disclosure has been extended to cover the information during the substantive examination.
announced, the contents in the file which may be consulted and copied relate to those before the date of the publication, including the application documents, formality documents directly relating to the application, publication documents, notifications and decisions sent to the applicant in the preliminary examination procedure, and the text of the observations submitted by the applicant in response to the notifications, and the notifications, search reports, and decisions sent to the applicant during the substantive examination procedure.

(3) For the file of a patent application for which grant of patent right has been announced, the contents in the file which may be consulted and copied include the application documents, the priority documents, the formality documents directly relating to the application, pamphlet of patent application for invention, pamphlet of patent for invention, pamphlet of patent for utility model or pamphlet of patent for design, Patent Register, and evaluation report of patent, and the various notifications, search reports, and decisions issued by the Patent Office or the Patent Reexamination Board to the applicant or parties concerned, and the text of the observations 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 and invalidation, etc.).

(4) For the file of patent applications which are still in reexamination or invalidation procedure and have not been closed, where consultation and photocopying of the file is necessary due to special needs, the contents in the file before starting the current procedure may be consulted and copied upon the approval of the competent authorities in accordance with the relevant provisions of above-mentioned items (1) and (2).

(5) Except for the contents mentioned above, consultation or photocopying of other documents shall not be allowed.
| Section 7.4.2 Time Limit of Suspension Due to Execution Assistance of Property Preservation | With a view to effectively addressing the issue concerning execution of court rulings in force, the revised Civil Procedural Law of China effective 1 January 2013 has reinforced the requirements on relevant government agencies in providing execution assistance for distraining and freezing of properties.

Patent right as an intangible asset can be protected by property preservation by order of the court. This revision has made adaptive amendment to the stipulations on suspension procedure, by stating that the patent office should cease the suspension according to the time limit for property preservation as stated in the civil order and the Notification on Assistance in Execution, and should extend any suspension in compliance with relevant stipulations where the court asks for continuation of the property preservation. |
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<td>For the suspension due to execution assistance of property preservation asked by the People's Court, the suspension period is generally six months. The suspension shall cease six months after the date of receiving the civil order. The suspension shall cease according to the time limit for property preservation as stated in the civil order and the Notification on Assistance in Execution. Where the People's Court orders to continue adopting measures of property preservation, it shall serve the Patent Office with a Notification on Assistance in Execution for keeping on the preservation before the expiration of the time limit for suspension. The suspension may be extended six months if the Notification on Assistance in Execution complies with the regulations set forth in Section 7.3.2.1 of this chapter after being checked. The time limit for suspension shall not exceed 12 months for a preservation verdict made during the execution procedure by the same court for the same case. If the preservation verdict is made during trial procedure, the time limit for preservation can be extended accordingly.</td>
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<td>7.4.3 Time Limit of Suspension Concerning Invalidation Procedure</td>
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<td>With respect to patents in the invalidation procedure, the duration for suspension as requested by the party concerned in a dispute over the ownership of right or asked by the People's Court to assist in execution of property preservation shall not exceed one year. The Patent Office will resume the relevant procedures on its own initiative once the time limit of suspension expires.</td>
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7.5.2 Cessation of Suspension Procedures Due to Execution Assistance of Property Preservation Asked by the People's Court

After the time limit for suspension expires, where there is no request of the People's Court to continue the preservation, the examiner shall issue a Notification of Cessation of Suspension to notify the People's Court and the applicant (or patentee), resume the relevant procedure, and announce the discharging of preservation of the patent right. Where is a waiting list in turn of the preservation request, the preservation request on the top of the waiting list shall be executed from the date on which the previous preservation comes to an end. The time limit for suspension is the duration of property preservation as stated in the civil order and the Notification on Assistance in Execution. The examiner shall issue the Notification of Cessation of Suspension to the previous People's Court and the applicant (or patentee), issue the Notification of Commencement of Preservation Procedure to the People's Court on the top of the waiting list and the applicant (or patentee), indicate the commencement date and the cessation date of execution assistance of property preservation, and announce the property preservation of patent right.

This revision has made adaptive amendment to align with the amendment to the Civil Procedure Law in relation to suspension procedure.