

## Revised Patent Examination Guidelines (I): China Loosening Rules on Patent Invalidation

Effective April 1, 2017, revised Guidelines for Patent Examination ("revised Guidelines") will take place, which guide patent examination procedures at the State Intellectual Property Office ("SIPO"). Of greatest interest are the facts that the revised Guidelines (i) loosen rules on patent invalidation procedure and (ii) relax barriers to software and business method patents. This short article will provide an updated analysis with respect to the former and our subsequent newsletter (to-be-distributed at the end of March) will offer our updates on the latter.

### Revised contents

	Guidelines for Patent Examination (Effective February 1, 2010)	Revised Guidelines for Patent Examination (Effective April 1, 2017)
1	<p>Chapter 3 in Part IV</p> <p>4.2 Addition of Causes for Invalidation</p> <p>(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.</p> <p>(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:</p> <p>(i) for claims amended by way of combination by the patentee, 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</p> <p>(ii) the addition is to change the causes for invalidation which are obviously inappropriate to the evidence submitted.</p>	<p>Chapter 3 in Part IV</p> <p>4.2 Addition of Causes for Invalidation</p> <p>(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.</p> <p>(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:</p> <p>(i) for claims amended by ways <b>other than deletion</b> by the patentee, addition of causes for invalidation is made <b>on the amended contents</b> within the time limit specified by the Patent Reexamination Board, and the added causes are explained concretely within the time limit; or</p> <p>(ii) the addition is to change the causes for invalidation which are obviously inappropriate to the evidence submitted.</p>
2	Chapter 3 in Part IV	Chapter 3 in Part IV

	<p>4.3.1 Presenting Evidence by the Petitioner</p> <p>(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.</p> <p>(2) Where the petitioner presents additional evidence after one month from the date of filing the request for invalidation, generally the Patent Reexamination Board will not take it into account, unless in any of the following cases:</p> <p>(i) concerning claims amended by way of combination or counter-evidence 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;</p> <p>(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</p> <p>(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.</p>	<p>4.3.1 Presenting Evidence by the Petitioner</p> <p>(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.</p> <p>(2) Where the petitioner presents additional evidence after one month from the date of filing the request for invalidation, generally the Patent Reexamination Board will not take it into account, unless in any of the following cases:</p> <p>(i) <b>concerning counter-evidence presented by the patentee</b>, 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;</p> <p>(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</p> <p>(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.</p>
3	Chapter 3 in Part IV	Chapter 3 in Part IV

	<p>4.6.2 Manners of Amendment</p> <p>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.</p> <p>Deletion of a claim means one (or more) claim, such as an independent claim or a dependent claim, is removed from the claims.</p> <p>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.</p> <p>Deletion of a technical solution means to remove one or more technical solutions from several parallel technical solutions defined in the same claim.</p>	<p>4.6.2 Manners of Amendment</p> <p>Subject to the above principles of amendments, the specific manners of amendment are generally limited to deletion of a claim, deletion of a technical solution, <b>further definition of a claim, and correction of obvious errors.</b></p> <p>Deletion of a claim means one (or more) claim, such as an independent claim or a dependent claim, is removed from the claims.</p> <p>Deletion of a technical solution means to remove one or more technical solutions from several parallel technical solutions defined in the same claim.</p> <p><b>Further definition of a claim means to incorporate one or more technical features as disclosed in other claims into the claim so as to narrow the protection scope.</b></p>
<p>4</p>	<p>Chapter 3 in Part IV</p> <p>4.6.3 Restrictions to Manners of Amendment</p> <p>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.</p> <p>The patentee may amend the claims by the way of combination within the time limit for response only in one of the following circumstances:</p> <p>(1) in response to the request for</p>	<p>Chapter 3 in Part IV</p> <p>4.6.3 Restrictions to Manners of Amendment</p> <p>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.</p> <p>The patentee may amend the claims <b>by the ways other than deletion</b> within the time limit for response only in one of the following circumstances:</p> <p>(1) in response to the request for invalidation;</p> <p>(2) in response to causes for invalidation or evidence added by the petitioner;</p>

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.	(3) in response to causes for invalidation or evidence not mentioned by the petitioner but introduced by the Patent Reexamination Board.
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## Our analysis

### Revisions to the contents

#### 1. A loosening of rules of claim amendments during invalidation

As indicated above, the revised Guidelines allow patentees to amend claims by incorporating limitations from other claims as well as to correct obvious errors. Previously patentees can only be able to delete claims, combine them or delete technical solutions in an attempt to protect claims during an invalidation procedure.

Regarding obvious errors, before this revision, they only can be corrected at the application stage but not during an invalidation procedure.

At the preliminary examination stage, "obvious errors" is defined in section 8, Chapter 2, Part I, Guidelines for Patent Examination, as **"Obvious errors" means the incorrect contents which can be clearly judged from the context of the initial description and claims and without any possibility of other explanations or amendments.** This part indicates that the applicant may make corrections to the obvious mistakes, and the examiner may also make amendments ex officio.

At the substantive examination stage, the Guidelines for Patent Examination indicates in Section 5.2.2.2, Chapter 8, Part II, that the applicant may correct the obvious errors which can be discerned by a person skilled in the art, **i.e., grammar, wording, or typing mistakes are corrected. The amendment to such mistakes shall be the only correct solution deduced by said person from the whole and the context of the description.** The examiner may also make amendments to the obvious errors ex officio.

Therefore, it is very reasonable to bring the correction to obvious errors into the invalidation procedures this time.

Regarding further definition of a claim, the revised Guidelines clearly indicates that it means to incorporate one or more technical features

recited in other claims into the claim so as to narrow the claim protection scope.

In view of the revised Guidelines, the incorporation of one or more technical features offers great flexibility. "Other claims" include not only dependent claims without a reference relationship with each other, but also another independent claim.

#### 2. An addition of grounds for invalidation in view of claim amendments

In view of the flexibility of claim amendments during an invalidation procedure, the revised Guidelines accordingly specify the following:

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 ways other than deletion by the patentee, addition of causes for invalidation is made on the amended contents within the time limit specified by the Patent Reexamination Board, and the added causes are explained concretely within the time limit.

Firstly, the original "for claims amended by way of combination by the patentee" was replaced by "for claims amended **by ways other than deletion** by the patentee" in the revised Guidelines.

Secondly, the original "addition of causes for invalidation is made within the time limit specified by the Patent Reexamination Board" was replaced by "addition of causes for invalidation is made **on the amended contents** within the time limit specified by the Patent Reexamination Board" in the revised Guidelines. This is a restriction to the petitioner for invalidation, i.e., only allowing the addition of causes for invalidation on the contents amended by the patentee. In fact, before the revised Guidelines, an addition of grounds for invalidation is allowable given a new technical solution generated by claim amendments. Accordingly, the revised Guidelines clarify the



allowability.

### 3. A restriction on admissibility of later-submitted evidence

Another one that needs special attention is 4.3.1 Presenting Evidence by the Petitioner (item 2).

Before the revision, this part of contents is indicated as:

Where the petitioner presents additional evidence after one month from the date of filing the request for invalidation, generally the 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 counter-evidence 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;

After the revision, the circumstance of “amended by way of combination” was deleted and was not replaced with “amended by other ways”, but “counter-evidence presented” was only retained.

In other words, when the patentee amends a claim by way of further definition, **the petitioner cannot submit any evidence on the newly-formed technical solution**. However, before amendment, the petitioner may submit additional evidence on the technical solution formed by way of combination.

Further, by combining the addition of causes for invalidation with the petitioner’s presenting evidence, when the patentee amends a claim by way of further definition, the petitioner cannot submit any evidence on the newly-formed technical solution but can only supplement causes for invalidation. Possible invalidation grounds may include an amendment going beyond the original scope, lack-of-clarity, lack-of-support, lack-of-novelty or inventiveness in view of evidence previously submitted.

However, there may also be a certain restriction to the combination of evidence, in a hypothetical case for example:

Claim 1: A+B

Claim 2 referring to claim 1: C

Claim 3 referring to claim 2: D+F

Evidence 1 is used to assess independent claim 1. Evidence 2 is used to assess dependent claim 2. Evidence 3 is used to assess the technical feature D of dependent claim 3. Now, the technical feature D is incorporated into claim 1, and evidence 1 and evidence 3 can be used to assess

new claim 1. With an assumption that it is newly found that evidence 2 also discloses the contents related to the technical feature D, whether evidence 1 can be combined with evidence 2?

### *Practical considerations for claim amendments*

#### 1. Allowable amendments to claims

In some jurisdictions, the patent system is designed to have a mechanism of amending patent documents after grant, such as reissue procedures in U.S., revision trial procedures in Japan, etc., so as to provide institutional guarantee for the patentee to improve the stability of his patents. China does not have a separate mechanism of amending patent documents after grant. The patentee can only make some certain amendments by limited manners of amendment in limited opportunities during invalidation procedures prior to this revised Guidelines. Therefore, when there lacks a separate mechanism of amending patent documents after grant, it is imperative to moderately loosen the manners of amending patent documents in invalidation procedures.

In practice, the patentee hopes that the manners of amending patent documents can be more flexible; the technical features as disclosed in the claims and description are allowed to be incorporated; and obvious errors are allowed to be corrected. However, since the protection scope of the patent right is determined by the contents of claims, and the granted and announced claims have publicity, the amendments to patent document cannot damage the reliance interest of the public. After comprehensive consideration, the manners of amending patent documents are moderately loosened [1].

Nevertheless, whether the scale of such loosening will be too large; whether it will cause some issues in invalidation procedures; whether it will bring especially great uncertainty so that it cannot be expected whether the product falls into the protection scope of claims; these are to be tested by patent practice after implementation.

#### 2. Admissible evidences presented by the petitioner

As previously mentioned, the revised Guidelines impose a restriction to the petitioner’s presenting evidence. SIPO provides the following reasoning: where the patentee amends claims by way of incorporating the technical features as disclosed in other claims, since he does not incorporate the technical features as not defined previously in claims, the petitioner only needs to adjust the mode of combination of evidence which has been submitted, and does not need to separately present additional evidence. Therefore, the above restrictions are made [1].

The patent attorney can foresee that there may further be a pursuit of shortening the cycle of invalidation examination behind such amendments. In addition, there may also be a consideration that the request for invalidation may be filed for many times.

### *Impact on practice*

Generally speaking, the revised Guidelines are for the benefits of patentees. As for the petitioner, the predictability is reduced with more restrictions.

The revised Guidelines is set to go into effect on April 1, and are applicable to all invalidation procedures which have not been closed yet or will be filed. In view of this applicability, the patentee or the petitioner shall consider adjusting the

strategies in invalidation procedures. For example, the petitioner shall present evidence as much as possible at the time of filing a request for invalidation and when presenting additional grounds within one month. Although the patentee has a greater flexibility when amending claims, he shall avoid causing other defects.

Patent invalidation is strategic. However, claim amendments in invalidation will be directly related to how to draft a patent application at the application stage. Given the flexibility of amending claims from a granted claim set and the restriction of introducing contents from the specification, patent attorneys shall pay more attentions to the claim drafting to ensure a stereoscopic protection so that the patent can stand through invalidation challenges in the next decade or twenty years.

[1]SIPO website Newly-amended Guidelines for Patent Examination will Enter into Force on April 1, [http://www.sipo.gov.cn/zcfg/zcjd/201703/t20170306\\_1308646.htm](http://www.sipo.gov.cn/zcfg/zcjd/201703/t20170306_1308646.htm)

*The newsletter is not intended to constitute legal advice. Special legal advice should be taken before acting on any of the topics addressed here.*

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Ms. Zhang has been working in intellectual property for over 15 years, including 3 years in patent substantive examination, 5 years in patent invalidation and reexamination, and 7 years in patent agency. Ms. Zhang specializes in the research of combining patent law with patent practices by being involved in several research projects by Patent Reexamination Board. Ms. Zhang also master compiled "Case Study of the Patent Reexamination Board: Other Substantive Conditions for Granting a Patent". With both patent examiner and patent attorney experiences, Ms. Zhang is good at providing clients with overall litigation strategy basing on their needs. She specializes in patent invalidation and litigation in mechanical and electronic fields. Ms. Zhang has served for a number of domestic and international well-known clients including Philip, LG, Delta, ZTE with complicated and influential patent invalidation and litigation cases and obtained client's trust and the high praise. Among the successful cases representing by Ms. Zhang, the SuperD's patent invalidation case was selected as one of Patent Reexamination Board's top ten case in 2015, and the Joyoung's patent invalidation and administrative litigation cases was selected as one of National Intellectual Property's major cases in patent field in 2015.