



Hong Kong | Shenzhen | Macau

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*Amendments to the Patent Examination Guidelines will take effect on April 1<sup>st</sup>. We have taken a look and here is what we think.*

## **Amendments to the Patent Examination Guidelines by the Chinese Patent Office**

The China Patent Office (SIPO) just revised its Patent Examination Guidelines that will take effect on April 1, 2017. Here are the main changes to the guidelines and our opinion on these changes.

The main changes relate to:

1. The patent eligibility standard for software and business method patents;
2. Utilizing post-filing data for substantial examination;
3. Claim amendment requirements during invalidation procedures; and
4. The public availability of the documentations.

### **1. Software and Business method patents**

Revisions: Computer programs and business methods per se are still ineligible in China. However, inventions relating to computer program or business method may now be patentable. In other words, a claim including both business rules or computer programs and technical features should not be rejected on the ground of unpatentable subject matter of Article 25.

Comments: The standard has not been changed substantially. It just makes the literal requirement consistent with that in practice. Under previous versions of the Guideline, if the applicant can clearly and undoubtedly state technical features other than an abstract idea and the technical effect thereof, the patent application has a good chance to overcome a rejection under A25.

### **2. Utilizing post-filing data for substantial examination**

Revisions: Experimental data submitted after the filing date shall be considered and examined, though the technical effects proved thereby should be obvious for a skilled person in the art from the originally filed specification.

Comments: In current practice, post-filing data is unacceptable for overcoming rejections raised on the ground of lacking support in the specification or lacking full and clear description (A26.3/A26.4). This data, however, could be considered and found acceptable if such data is submitted for inventiveness rejection (A22.3), the data compares the invention and the closest prior

art, and the data with the asserted effect (not a simple conclusive statement) is clearly disclosed in the description. We understand that with this amendment, SIPO's practice will become more flexible in accepting post-filing experimental data. Meanwhile, although this amendment is for chemical inventions, we understand that this change also applies to mechanical and electrical inventions.

### **3. Claim amendment requirements during invalidation procedures**

Revisions: Applicant is allowed to amend the claims by incorporating one or more limitations from other claims. Applicant is also allowed to correct obvious errors in the claims.

Comments: The current rules thereof are very strict. The patentee is only allowed to delete or combine claims, or to delete technical solutions. It is not acceptable to add certain features (or limitations) of one claim into other claim(s) except for combining the two or more claims as a whole with all features cited therein.

The revised Guidelines bring more flexibilities for a patentee such that a certain feature, instead of the whole claim, could be incorporated into a broader claim (normally claim1) to keep the patent valid without unreasonably narrowing the scope of the patent.

There is also some case law about correcting obvious errors in the claims. This amendment provides a clearer requirement therefor. However, we still need more cases to understand how to prove what are obvious errors or what kind of evidence is required therefor.

### **4. The public availability of the documentations**

Revisions: The public are allowed to review and copy application documents including Office Actions, Search Reports and Decisions issued by the SIPO before the application is granted.

Comments: Before the E-inquiry System was launched, the above mentioned three kinds of documents were confidential until grant. Currently, the above mentioned documents and the amended claims submitted for responding to an office action are available on-line before grant. It is unclear whether SIPO wants to exclude the amended claims from the list. But, in the future, we hope amended claims, responses to office actions, and documents for post-grant procedure are accessible from SIPO's database during the examination stage.

Finally, one more interesting development, Chinese application documents including Office Actions, Search Reports, Decisions, amended claims and a response therefor together with its machine-translation are accessible in Global Dossier. It also makes SIPO's confidential requirement for amended claims and responses unnecessary and meaningless.

If you have any questions on the SIPO proposed amendments to computer software or business methods, or would like more information, please contact us at [eip@eipgroup.asia](mailto:eip@eipgroup.asia).

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