

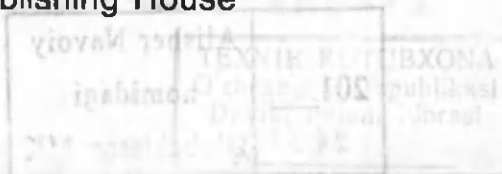
# **GUIDELINES FOR EXAMINATION**

( Promulgated and effective as of October 18 ,2001 ; Gazette of Guidelines for Examination No. 1 is promulgated as of May 26 ,2004 ,and effective as of July 1 ,2004 ; Gazette of Guidelines for Examination No. 2 is promulgated as of August 6 ,2004 ,and effective as of October 1 ,2004 )

**STATE INTELLECTUAL PROPERTY OFFICE OF  
THE PEOPLE'S REPUBLIC OF CHINA**

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Intellectual Property Publishing House



347-78-1161961000 190000

图书在版编目(CIP)数据

审查指南 = Guidelines For Examination/国家知识产权局制定.  
—北京:知识产权出版社,2005.6

ISBN 7-80011-991-2

I. 专… II. 国… III. 专利—审查—指南—英文  
IV. G306.3-62

中国版本图书馆 CIP 数据核字 (2005) 第 044569 号

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审查指南 (英文版)

国家知识产权局制定

责任编辑: 张丽荣 文字加工: 张 静

装帧设计: 段维东 责任出版: 杨宝林

知识产权出版社出版、发行

地址: 北京市海淀区马甸南村 1 号

通信地址: 北京市海淀区蓟门桥西土城路 6 号 邮编: 100088

http: //www. cnipr. com

(010) 82000893 (010) 82000860 转 8101

北京市兴怀印刷厂印刷

新华书店经销

2005 年 6 月第 1 版 2005 年 6 月第 1 次印刷

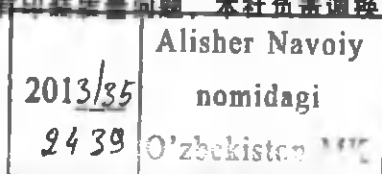
开本: 16 印张: 36.5 字数: 1060 千字

印数: 1~3200 册

ISBN 7-80011-991-2/D·243

定 价: 200 元

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P VII  
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**ORDINANCE**  
**OF**  
**THE COMMISSIONER OF THE STATE**  
**INTELLECTUAL PROPERTY OFFICE**

No. 12

These Guidelines for Examination, which are prepared in accordance with the Implementing Regulations of the Patent Law of the People's Republic of China, is hereby promulgated. It shall enter into force as of the date of promulgation. The Guidelines for Examination published on March 10, 1993 and the announcements amending the relevant provisions of those Guidelines published thereafter are abolished as of the same date.

Wang Jingchuan  
Commissioner  
October 18, 2001





## FOREWORD

The State Intellectual Property Office, as the Patent Administration Department under the State Council, entrusts the Patent Office ( hereinafter referred to as the Office ), which it has set up, with the task of receiving, examining and approving patent applications. The Office, on behalf and in the name of the State Intellectual Property Office, shall make various decisions relating thereto. The Patent Reexamination Board, set up by the State Intellectual Property Office, shall be responsible for examining requests for reexamination and invalidation, and making decisions accordingly.

In order to handle any patent application and patent - related request in conformity with the requirements of the law and in a correct, fair, objective, and timely way, the State Intellectual Property Office, according to Rule 121 of the Implementing Regulations of the Patent Law ( hereinafter referred to as the Regulations ), formulates these Guidelines for Patent Examination ( hereinafter referred to as the Guidelines ). As these Guidelines embody the Patent Law and its Regulations, they are the basis on which and the criterion according to which the Patent Office and the Patent Reexamination Board act and make decisions according to the law. Hence, they are also the rules which the interested parties should comply with at each aforesaid stage.

These Guidelines are, on the basis of the Guidelines of Examination of 1993, revised in accordance with the amended Patent Law ( promulgated on August 25, 2000 and entered into force as of July 1, 2001 ) and its revised Regulations ( promulgated on June 15, 2001 and entered into force as of July 1, 2001 ), practical working requirements being taken into consideration.

## FOREWORD

The first of the two volumes of this work is a history of the development of the theory of the structure of matter. It is a history of the ideas which have been advanced in the course of the development of the theory, and of the experiments which have been devised to test the validity of these ideas. The second volume is a history of the development of the theory of the structure of matter, and of the experiments which have been devised to test the validity of these ideas.

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## Explanatory Note of Using

1. These Guidelines are divided into five parts: Part I "Preliminary Examination", Part II "Examination as to Substance", Part III "Examination of International Applications Entering National Phase", Part IV "Examination of Requests for Reexamination and Invalidation", and Part V "Handling of the Patent Applications and other Matters". Parts I, II and IV are arranged in the order of the flow of the examination and approval procedures of patent applications. Part III is the specific provisions of the examination of international applications entering the national phase. Part V consists of the general rules which are applicable to the various procedures.

2. The various Parts of these Guidelines are divided into Chapters, each subdivided into Sections. The numbering of Sections by Arabic numerals is in four levels to show their positions. For example, in Part II, Chapter 3 (Novelty), Section 2.1.3.2 (Disclosure by Use) is in the 4th level, which is under Section 2.1.3 (Methods of Disclosure) of the 3rd level, whereas Section 2.1.3 is in Section 2.1 (Prior Art) of the 2nd level, and the latter is in Section 2 (Concept of Novelty) of the 1st level.

3. Before the various Parts, the General Table of Contents is established, which consists of the titles and page numbers of each of the Chapters of the various Parts. In each of the Parts, there is also a separate table of Contents, showing the titles and page numbers of the Chapters and Sections (down to the 4th level). Readers are advised first to consult the General Table of Contents to see in which Chapter of which Part the subject matter they want to look up is, then turn to the table of Contents of the relevant Part to see on which page it is.

4. The text of each Part begins from page 1, and the page number is preceded by the number of the Part in which it is. For example, "1-5" represents page 5 of Part I; "3-18" represents page 18 of Part III.

5. These Guidelines give instructions as to the practice and procedure to be followed by examiners. On the left side of the text, where it is required, are references indicating Article of the Law or Rule of the Regulations which provides authority for what is stated in the text. The reader may consult the relevant Articles or Rules while reading the text of the instructions.

## Abbreviation

This list is a sample of abbreviations of laws and regulations on the left side of the text of these Guidelines.

Art. 18	Article 18 of the Patent Law
Art. 22. 1	Paragraph one of Article 22 of the Patent Law
Art. 18. 1 – 2	Paragraph one to two of Article 18 of the Patent Law
Art. 24 (1)	Subparagraph one of Article 24 of the Patent Law
Art. 25. 1 (1)	Subparagraph one of Paragraph one of Article 25 of the Patent Law
Rule 1	Rule 1 of the Implementing Regulations of the Patent Law
Rules 20 – 23	Rules 20 to 23 of the Implementing Regulations of the Patent Law
Rule 26 (1)	Subparagraph one of Rule 26 of the Implementing Regulations of the Patent Law
Rule 18. 1 (4)	Subparagraph four of Paragraph one of Rule 18 of the Implementing Regulations of the Patent Law
Rule 101. 1 (3) – (4)	Subparagraph three to four of Paragraph one of the Implementing Regulations of the Patent Law
PCT Art. 23	Article 23 of the Patent Cooperation Treaty
PCT Art. 11 (3)	Article 11 (3) of the Patent Cooperation Treaty
PCT Art. 24 (1) (i) – (ii)	Article 24 (1) (i) – (ii) of the Patent Cooperation Treaty
PCT Rule 17	Rule 17 of Regulations Under the Patent Cooperation Treaty
PCT Rule 5. 2 (b)	Rule 5. 2 (b) of Regulations Under the Patent Cooperation Treaty
PCT Rule 13 <sup>bis</sup> . 3 (a)	Rule 13 <sup>bis</sup> . 3 (a) of Regulations Under the Patent Cooperation Treaty
PCT Rule 49. 5 (a <sup>bis</sup> )	Rule 49. 5 (a <sup>bis</sup> ) of Regulations Under the Patent Cooperation Treaty

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**Part I**  
**Preliminary Examination**

Part I  
Preliminary Examination

**Chapter 1****Preliminary Examination of Application for Patent for Invention****1. Introduction**

Article 34 of the Patent Law provides that where, after receiving an application for a patent for invention, the Office, upon preliminary examination, finds the application to be in conformity with the requirements of the Patent Law, it shall publish the application promptly after the expiration of 18 months from the date of filing. Upon the request of the applicant, the Office may publish the application earlier. Thus, the preliminary examination of any application for a patent for invention is an indispensable step in the examination and approval procedure after receipt of the application and before its publication.

The main tasks of the preliminary examination of any application for a patent for invention are as follows:

Art. 26  
Rule 16.1 -2  
Rule 44

(1) To check whether or not the application documents submitted by the applicant are in conformity with the provisions of the Patent Law and its Regulations. Where the Office finds that there is any defect which should be corrected, it shall notify the applicant to eliminate the defect by submitting correction so as to make the said documents meet the requirements for publication; or where the Office finds that there is any defect which cannot be corrected, it shall notify the applicant of its opinion after checking its application, stating the nature of the defect, and terminate the examination procedure by rejecting the application as early as possible.

Art. 30  
Art. 36  
Rule 45

(2) To check whether or not the other documents relating to the application, submitted by the applicant at the time of filing or thereafter, are in conformity with the provisions of the Patent Law and its Regulations. When the Office finds that there is any defect in these documents, it shall, depending on the nature of the defect, notify the applicant to eliminate the defect by submitting correction, or decide at once that the said documents shall be deemed not to have been submitted.

(3) To check whether or not the other documents relating to the application submitted by the applicant were furnished within the time limit prescribed in the Patent Law or its Regulations or specified by the Office. If the said documents were not furnished, or were furnished later than the time limit, the Office shall, depending on the circumstances, make a decision that

the application shall be deemed to have been withdrawn, or the said documents shall be deemed not to have been submitted.

Art. 68

Rule 92. 1

Rule 93

Rule 97

(4) To check whether or not the time limit of the payment of any relevant fee and the amount of such fee paid by the applicant are in conformity with the provisions of the Patent Law or its Regulations. If the fee is not paid, not paid in full or not paid within the time limit, the Office shall, depending on the circumstances, make a decision that the application shall be deemed to have been withdrawn or the relevant request not to have been made.

Rule 44. 1(1)

The scope of the preliminary examination of any application for a patent for invention is as follows:

(1) Whether or not the application contains the documents required by Article 26 of the Patent Law, and whether or not the form of those documents is obviously not in conformity with the provisions of Rule 17, 18, 19, 20 or 24 of the Implementing Regulations of the Patent Law, or is not in conformity with the provisions of Rule 118 or 120 of the Implementing Regulations of the Patent Law.

(2) Whether or not the application obviously falls under Article 5 or 25 of the Patent Law, or is not in conformity with the provisions of Article 18 or 19. 1 of the Patent Law, or is obviously not in conformity with the provisions of Article 31. 1 or 33 of the Patent Law, or of Rule 2. 1, 9, 18, or 20 of the Implementing Regulations of the Patent Law.

(3) Whether or not the other formalities and documents relating to the application are in conformity with the provisions of Rule 7, 8, 14, 16, 25, 31, 32, 33, 34, 37, 41, 42, 43, 45, 46, 86 or 98 of the Implementing Regulations of the Patent Law.

(4) Whether or not the payments of the relevant fees of the application have been made in accordance with the provisions of Rule 90, 92, 93 or 97 of the Implementing Regulations of the Patent Law.

The principles with which the preliminary examination shall comply are as follows:

(1) Where there is any defect in the application that can be eliminated by furnishing corrections; opportunity should be given to the applicant to make necessary corrections; where there is any defect in the application that cannot be eliminated, opportunity should be given to the applicant to make observations. Any decision of rejection shall be made only when the defect cannot



be eliminated after the applicant has made corrections or observations. Where it is necessary, two or more opportunities to make observations or corrections may be given to the applicant. In these circumstances, the examiner shall make sure that the time limit for the publication of the patent application provided by Article 34 of the Patent Law is adhered to.

(2) A comprehensive examination of the formality requirements of the application and other related documents shall be conducted so as to make the published documents meet the formality requirements. Where there are any substantive defects in the application, the applicant shall be informed of them and correction shall be made only when they will affect the publication of the application.

(3) The examiner should do his/her best to point out all the formality defects existing in the application documents by one rectification unless the application should be rejected.

(4) Where a decision shall be made that the application documents shall be deemed not to have been submitted, or the application shall be deemed to have been withdrawn or shall be rejected for reason that the application documents submitted by the applicant or the procedure started is not in conformity with the provisions of the Patent Law and its Regulations, the applicant shall be informed of the procedure which he may start subsequently.

(5) No matter what measure the examiner may take, he/she shall make a note in the paper file.

Art. 38  
Rule 44

## **2. Examination of Application Documents**

Where the application documents are not in conformity with the provisions of the following sections, the Office shall notify the applicant to make correction within the specified time limit. If the applicant fails to make any response within the specified time limit, the Office shall notify the applicant that the application shall be deemed to have been withdrawn or the documents shall be deemed not to have been submitted. Where any defect has not been corrected after the second notification of correction, a decision of rejection may be made.

Art. 26.2

Rule 17

**2.1 Request****2.1.1 Title of Invention**

The title of the invention shall state briefly and accurately the title of the subject matter for which the protection is sought by the application for a patent for invention. The title of the invention shall not include non – technical terms, such as the name of an individual or entity, trademark, code name or model, etc. . Nor shall it include any ambiguous terms, such as “and others”, “and its like” etc. . General terms shall not be used if they do not provide any information about the invention, for example, only such terms as “method”, “equipment”, “composition” and “compound” are used as the title of the invention.

In general, not more than 25 Chinese characters may be used in the title of invention. In special circumstances, with agreement of the examiner, the words used in the title of the invention may be increased up to 40, for example, the title of the invention in some fields of chemistry.

**2.1.2 Inventor**

The inventor shall be the person who has made creative contributions to the substantive features of an invention – creation. However, the examiner shall not examine whether or not the inventor whose name appears in the request meets the requirements of Rule 12 of the Implementing Regulations of the Patent Law in the procedures of examination of the Office.

The inventor shall be a natural person rather than an entity or any other organization. For example, it shall not be described as “xx subject matter group” etc. . The Inventor shall use his/her true name, and not his/her pen name or other informal name. Where there is more than one inventor, the names shall be indicated in the order from left to right.

The inventor may request the Office not to publish his/her name. Such request shall be made by the inventor himself/herself in writing. After the request for non – publishing the inventor's name is submitted, if it is considered to be in conformity with the requirements, the Office shall not publish the inventor's name in the Patent Gazette, separate pamphlets of patent application, and the certificate of patent. The inventor may not request his/her name to be published afterwards.

Foreign inventor may use his/her initials in foreign language

in the Chinese translation of his/her name. The initial of the first name shall be followed by a dot before the family name, such as M - Jones.

### **2. 1. 3 Applicant**

#### **2. 1. 3. 1 Chinese Individual or Entity**

For a service invention, the right to apply for a patent belongs to the entity to which the inventor belongs; While for a non - service invention, the right to apply for a patent belongs to the inventor. However, generally speaking, it is not necessary for the examiner to examine the status of the applicant indicated in the request. Where the applicant is a natural person, it may be presumed that the invention is a non - service invention, and the applicant has the right to file the patent application. If the subject matter of the application is obviously not a non - service invention, the applicant shall be invited to submit a proof of non - service invention provided by the entity to which the applicant belongs. Where the applicant is an entity, it may be presumed that the invention is a service invention, and the entity has the right to file the patent application. If the entity obviously does not possess the status of legal person or the status of legal person of that entity is questionable, such as the Scientific Research Division of a certain University or the Subject Matter Group of a certain Research Institute, the entity shall be invited to submit a document certifying its status as a legal person.

Where the applicant is a natural person, his/her true name, and not his/her pen name or other informal name, should be used. Where the applicant is an entity, its full official name, and not its abbreviation or its shorter name, should be used. The name of the entity indicated in the application documents shall be the same as it appears in the official seal of that entity.

#### **2. 1. 3. 2 Foreign Individual, Enterprise or Other Organization**

Article 18 of the Patent Law provides, "Where any foreigner, foreign enterprise or other foreign organization having no habitual residence or business office in China files an application for a patent in China, the application shall be treated under this Law in accordance with any agreement concluded between the country to which the applicant belongs and China, or in accordance with any international treaty to which both countries are par-

ty, or on the basis of the principle of reciprocity.”

Where the examiner has any doubt about the nationality, seat of the business office or the headquarters of the applicant indicated in the request, he/she may invite the applicant to provide a certificate of nationality or document certifying the seat of the business office or the headquarters in accordance with Rule 34(1) or 34(2) of the Implementing Regulations of the Patent Law. Where the applicant states in the request that it has a business office in China, the examiner shall invite the applicant to submit a document certifying that to be true by the local administration of industry and commerce. Where the applicant states that it has a habitual residence in China, the examiner shall invite the applicant to submit a document, provided by the public security department, certifying that he/she is permitted to reside in China for one year or longer.

Art. 18

After it is affirmed that the applicant is a “foreigner, foreign enterprise or other foreign organization having no habitual residence or business office in China”, the examiner shall examine whether or not the nationality of the applicant or the country in which it has its headquarters, as indicated in the request, is in conformity with one of the following three conditions:

(1) the country to which the applicant belongs has concluded with China an agreement affording patent protection to the nationals of each other;

(2) the country to which the applicant belongs is a country party to the Paris Convention for the Protection of Industrial Property (Hereinafter referred to as the Paris Convention);

(3) the Patent Law of the country to which the applicant belongs has provisions that foreigners shall be given patent protection on the basis of the principle of reciprocity.

The examination shall start from whether or not the country to which the applicant belongs (when the applicant is an individual, it is his/her nationality or habitual residence which decides; when the applicant is an entity, it is the seat of its headquarters or its real and effective business office which decides) is a country party to the Paris Convention. It is not necessary to examine whether or not there is any agreement concluded between the relevant country and China, providing for patent protection to the nationals of each other, because all of the countries which have concluded above agreements with China are now party to the Paris Convention. Only when the country to which the appli-

## Rule 34(3)

cant belongs is not a country party to the Paris Convention, then it is necessary to examine whether or not the Patent Law of that country has a provision giving patent protection to foreigners on the basis of principle of reciprocity. If the Patent Law of the said country has no express provision giving patent protection to foreigners on the basis of the principle of reciprocity, the applicant shall be invited to submit a document certifying that his/her country recognizes that Chinese citizens and entities are, under the same conditions as its own nationals, entitled to enjoy patent right and other related rights in that country. Where the applicant fails to submit such documents, the patent application shall be rejected in accordance with Rule 44 of the Implementing Regulations of the Patent Law, on the ground that it is not in conformity with the provisions of Article 18 of the Patent Law.

Where the applicant comes from the dependent territory of a country party to the Paris Convention, it shall be examined whether or not that country has declared that the Paris Convention is applicable to that territory.

Where the applicant belongs to a country which is not party to the Paris Convention and has no agreement on patent protection with China, but allows in practice Chinese citizens to enjoy patent rights or other related rights in that country, the application shall be handled as if that country would have a provision giving patent protection to foreigners on the basis of the principle of reciprocity.

Where the applicant is an individual, the initials in foreign language may be used in Chinese translation of his/her name. The initial of the first name shall be followed by a dot before the family name, such as, M· Jones. Titles used to show any academic degree, occupation, etc., for example "Dr.", "Prof.", shall not be used in the applicant's name. Where the applicant is an entity, it shall use its full official name. It is permitted to use certain title that indicates the status of independent legal person in accordance with the Patent Law of the country to which the applicant belongs.

### 2. 1. 3. 3 Application Filed Jointly by Chinese and Foreigner

Where an application is filed jointly by a Chinese person and a foreigner, the application shall be prosecuted in accordance with the provision of Sections 2. 1. 3. 1 and 2. 1. 3. 2 of this Chapter respectively.

**2. 1. 4 Patent Agency and Patent Agent**

Art. 19. 1  
Art. 20  
Rule 17(3)

Any patent agency shall be established in accordance with the provisions of the Regulations Governing Patent Agency and approved by the State Intellectual Property Office. Any foreign – related patent agency shall be designated by the State Intellectual Property Office.

Any patent agency shall use the full name which was registered in the State Intellectual Property Office, and which shall be the same as that appearing in the official seal of that patent agency which was affixed in the application documents. Any abbreviation or initials may not be used. The code number given by the State Intellectual Property Office to the patent agency shall be stated in the request.

The term “patent agent” refers to a person who holds a “Patent Agent Qualification Certificate” and has practiced in a patent agency and acquired a “Patent Agent I. D. Card” provided by the State Intellectual Property Office. The patent agent shall use his/her true name and fill in the number of his/her “Patent Agent I. D. Card” in the request. The applicant shall not appoint more than two patent agents for one patent application.

**2. 1. 5 Address**

Art. 26. 2  
Rule 17

The address (including the address of the applicant, patent agency or liaison person) in the request shall meet the requirements for quick and accurate postal delivery. The domestic address shall include the postcode number, the names of the province (autonomous region), municipality (autonomous prefecture), district and street, the number of the house, and the telephone number, or the names of the province (autonomous region), county (autonomous county), town (township) and street, the number of the house, and the telephone number, or the names of the municipality directly under the Central Government, district and street, the number of the house, and the telephone number. Where a post office box is available, it may be used in accordance with the stipulations. The name of the entity may be included in the address, but it cannot be used instead of the address. For example, one may not use xx University of xx Province as an address. Where the applicant is an entity, a liaison person shall be designated and the address of the liaison person shall be indicated. Where the applicant is an individual, a liaison person may also be designated as the addressee of the

mail sent by the Patent Office. Where the address is in a foreign country, the names of the country and city (county) shall be clearly indicated, and the detailed address in foreign language shall be appended.

## Rule 18

**2. 2 Description**

The first line on page 1 of the description shall state the title of the invention, which shall be the same as that appearing in the request and shall be located in the middle of the line. No such words as "Title of Invention" or "Title" shall be used before the title of the invention. A blank line shall be left between the title of invention and the text of the description.

The description shall contain the following parts, and each shall bear the headings respectively as follows:

- Technical Field;
- Background Art;
- Contents of the Invention;
- Description of the Figures;
- Mode of Carrying out the Invention.

Where there are no drawings in the description, the part of "Description of the Figures" shall be omitted.

As for the application relating to nucleotide or amino acid sequence, such sequence listing shall be a separate part of the description. The applicant shall at the time of filing submit a CD-ROM or disc which is in agreement with the sequence listing. The CD-ROM or disc shall be in conformity with the relevant prescriptions of the Office. Where the sequence listing recorded in the CD-ROM or disc is not in agreement with the sequence listing stated in the description, the sequence listing stated in the description shall prevail. Where no such CD-ROM or disc has been submitted, the applicant shall be invited to submit it within the specified time limit; if the applicant fails to submit it within the specified time limit, the application shall be deemed to have been withdrawn.

The text of the description may contain chemical formula, mathematical expressions, and tables, but drawings may not be included.

Where there are explanatory notes to the drawings in the text of the description, the drawings shall be included in the description.

## Rule 41

Where there are drawings in the description, there should

be explanatory notes to such drawings in the text of the description. Where there are explanatory notes to the drawings in the text of the description but the drawings or part of them are missing, the applicant shall be invited either to delete the explanatory notes to the drawings or to furnish the drawings within the specified time limit. If the applicant submits the drawings later, the date of their delivery at, or mailing to, the Office shall be the date of filing of the application; and the examiner shall issue a notification to change the date of filing and amend the date of filing in the database. If the explanatory notes to the drawings are to be deleted, the initial date of filing shall be retained.

Rule 120. 2               Where there are two or more pages in the description, the pages shall be numbered consecutively in Arabic numerals.

### 2. 3 Claims

Rule 20. 2               Where there are two or more claims, they shall be numbered consecutively in Arabic numerals. No words such as "claim" shall be used before the numerals.

Rule 20. 3               The claims may contain chemical or mathematical formulae, when necessary, they may also contain tables, but drawings may not be included.

Rule 120. 2               Where there are two or more pages in the claims, the pages shall be numbered consecutively in Arabic numerals.

### 2. 4 Drawings in Description

Rule 120. 1               The drawings in the description shall be executed in black ink with the aid of drafting instruments. The lines shall be uniformly thick and well-defined, dark enough, and free from color and alterations.

The oblique hatching of cross-sections should not impede the clear reading of the reference signs and leading lines.

Rule 19. 1               The same sheet of drawings may contain several figures. A single complete figure may be executed on several sheets; but the figures on each sheet must be independent ones. The figures on the several sheets shall be so arranged that when all the figures assembled to form a single complete figure, it would not affect the clarity of the various figures. No frame line shall be used around the figure.

Where there are two or more figures, they shall be numbered consecutively in Arabic numerals, and the word "Figure" shall be added before the number, for example, "Figure 1",



“Figure 2”.

Figures shall be preferably arranged in an upright position on a sheet or sheets, clearly separated from one another. Where it is necessary to arrange the figure not in an upright position because the cross dimension of the horizontal section of the part is obviously larger than that of the vertical section, it shall be presented sideways with the top of the figure at the left side of the sheet. Where there are two or more figures on one sheet and one of them is presented in that way, the rest of the figures shall be presented in the same way.

Rule 19. 3

Drawing reference signs shall be numbered in Arabic numerals. The same reference sign shall be used for the same part when it appears in different figures. The same reference sign shall be used to indicate the same part in various documents (the description and its drawings, claims, and abstract) of a patent application. However, it is not necessary for the reference signs to be consecutively numbered in each figure.

The size of the figure shall be appropriate, so that each detail of the figure shall be clearly distinguishable and suited for reproduction by means of photomechanical process, copy process and microform process, etc..

Rule 19. 2

The identical scale shall be adopted in the same figure. An additional figure of partial enlargement may be added in order to make certain part of the figure be shown distinctively. Explanatory words are prohibited in the figure except a single word or words that are indispensable. Such word or words shall be in Chinese, and its original language may be added in brackets where necessary.

Flow charts and diagrams are considered drawings, and indispensable notes and symbols shall be included in its frame. Under special circumstances, for example, when a metallographic structure or histiocyte is to be shown, photos may be used as drawings and they may be pasted on the sheet of drawings.

Art. 26. 1

## **2. 5 Abstract**

Where an application for a patent for invention is filed, the abstract of the description shall be submitted.

Rule 24. 1

### **2. 5. 1 Text of Abstract**

The abstract shall state the title of the invention and the

technical field to which the invention pertains. It shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the technical solution of that problem, and the principal use or uses of the invention. Where no title of invention is given or no gist of the technical solution is stated, the applicant shall be invited to make corrections. Where words of commercial advertising are included, they shall be deleted and the applicant shall be notified accordingly.

The text of the abstract shall contain not more than 300 Chinese characters (including punctuation). Where there are more than 300 Chinese characters, the examiner may make the text shorter, or invite the applicant to make abridgements. Where the abridgement is made by the examiner, he/she shall inform the applicant of the abridgement.

**Rule 24. 2****2. 5. 2 Drawing of Abstract**

Where the description contains drawings, the applicant shall suggest one figure which best characterizes the technical features of the invention as the figure accompanying the abstract. The figure accompanying the abstract shall be one of the drawings in the description. Where the applicant has not suggested or furnished such a figure, the examiner shall invite the applicant to make correction, or the examiner himself may designate one. In the latter case, the examiner shall invite the applicant to furnish two copies of the figure he has designated. Where the examiner considers that there is no suitable figure to be designated, he shall not invite the applicant to make correction.

Where the figure accompanying the abstract suggested and furnished by the applicant obviously cannot characterize the technical features of the invention, the examiner shall designate another one instead, and notify the applicant to furnish two copies of the figure so designated.

The scale and the distinctness of the figure accompanying the abstract shall be such that a reproduction with a linear reduction in size to 4cm x 6cm would still enable all details to be distinguished without difficulty.

The abstract may contain chemical formula which best characterizes the invention. Such chemical formula shall be deemed as the figure accompanying the abstract.

## 2. 6 Preliminary Examination of Two Types of Special Patent Applications

### 2. 6. 1 Divisional Application

#### 2. 6. 1. 1 Submission of Divisional Application

Rule 42. 1       Where an application for a patent contains two or more inventions, the applicant may submit a divisional application at its/ his own initiative.

Rule 42. 2       A divisional application shall be submitted after the Patent Office issues the notification to grant the patent right for the initial patent application, and before the expiration of two months for going through the formalities of registration from the date of receipt of the notification. After the expiration of the above – mentioned time limit, or where the patent application has been rejected and the rejection has taken effect, or the patent application has been withdrawn or is deemed to have been withdrawn, and the right has not been restored, no divisional application may be submitted.

Where any patent application is not in conformity with the provisions of Article 31 of the Patent Law, the applicant shall, according to the notification to divide the application or the notification of the Office's opinion after examination issued from the Office, make amendments to the application and keep its contents compatible with the requirements of unity prescribed in the Patent Law and its Regulations. The applicant may submit one or more divisional applications for the contents deleted from the initial application.

Rule 42. 3       The divisional application cannot change the kind of the initial patent application. For example, if the initial patent application is an application for a patent for invention, the divisional application should be an application for a patent for invention only. Similarly, the applicant of the divisional application may not change. That means, the applicant of the divisional application shall be the same as that of the initial application. Where this is not the case, a document certifying the assignment of the divisional application shall be submitted. The inventor stated in the divisional application shall be the inventor or part of the inventors stated in the initial application.

Rule 43. 3       Where the applicant submits a divisional application, the filing number and the date of filing of the initial application shall be

indicated in the request, and the complete documents of the initial application shall be submitted. With regard to the various certifying documents that have been submitted with the initial application, duplicate copies may be used when divisional application is submitted. Where the initial application is an international application, the applicant shall indicate the filing number of the international application in the brackets that follow the initial filing number. Where the international publication of the initial application is in a language other than Chinese, a copy of the application in that language shall be submitted together with a Chinese copy of the initial application.

#### **2.6.1.2 Preliminary Examination of Divisional Application**

The examiner shall check the following matters on the basis of the initial application:

(1) whether or not the initial date of filing indicated in the request of the divisional application is correct;

(2) whether or not the applicant in the divisional application is the same as that in the initial application. If not, whether or not the document certifying the assignment of the application is appended; whether or not the inventor is the inventor or part of the inventors stated in the initial application;

(3) whether or not a copy of the initial application documents is submitted. Where the right of priority is claimed, whether or not a copy of the priority documents of the initial application is submitted. Where the initial application is an international application, and a copy of the priority documents was not requested for the initial application, a copy of the priority documents shall not be required to be submitted for the divisional application;

(4) Whether or not, before the date of filing of the divisional application, the initial application was rejected and the rejection entered into force; whether or not the initial application was withdrawn or deemed to have been withdrawn and the right has not been restored; whether or not the date of filing of the divisional application is within two months from the date of receipt of the notification to grant the patent right for the initial application issued by the Office.

Where any of the requirements mentioned in (1), (2) or (3) is not met, the applicant shall be invited to make correction within a specified time limit. Where no correction is made within

the time limit, the divisional application shall be deemed to have been withdrawn, and the applicant shall be notified accordingly.

Where the date of filing of the divisional application is later than the expiration of the two months from the date of receipt of the Office's notification to grant the patent right for the initial application, or where the initial application on which the divisional application is based has been withdrawn or is deemed to have been withdrawn and the right has not been restored, or where the initial application has been rejected and the rejection has taken effect, the applicant shall be notified that the divisional application is deemed not to have been filed.

The various time limits prescribed by the Patent Law or its Regulations for the divisional application, such as the time limit for submitting the request for examination as to substance, or the time limit for submitting documents certifying the priority right, etc., shall be counted from the initial date of filing. Where the various time limits have expired when the divisional application is filed, the applicant may go through the various formalities within two months from the date of filing of the divisional application. Where the applicant fails to go through any of the formalities within the time limit, the divisional application shall be deemed to have been withdrawn and the applicant shall be notified accordingly.

The applicant shall pay all the fees for the divisional application the same as he shall pay for a new application. Where the time limit for paying the fees has expired, the applicant shall pay the fees within two months from the date of filing of the divisional application. If the fees are not paid or not paid in full within the time limit, the divisional application shall be deemed to have been withdrawn and the applicant shall be notified accordingly.

## **2. 6. 2 Application Relating to Biological Material**

### **2. 6. 2. 1 Filing of Application Relating to Biological Material**

Rule 25

The applicant of an application relating to biological material shall, in addition to the other requirements provided in the Patent Law and its Regulations, go through the following formalities:

(1) depositing a sample of the biological material with a depository institution designated by the State Intellectual Property Office before the date of filing, or, at the latest, on the date of filing (or the priority date where priority is claimed);

(2) stating, in the request and the description, the name and address of the depositary institution in which the sample of biological material was deposited, the date on which the sample was deposited, the accession number of the deposit, and the scientific name of the biological material (with its Latin name);

(3) giving in the application relevant information of the characteristics of the biological material;

(4) submitting, within four months from the date of filing, a receipt of deposit and a document certifying the viability of the biological material issued by the depositary institution.

#### **2.6.2.2 Preliminary Examination of Application Relating to Biological Material**

Where the applicant submits a receipt of deposit within the prescribed time limit, the examiner shall check the following matters on the basis of the receipt:

(1) whether or not the depositary institution is an institution designated by the State Intellectual Property Office for the depositary of the biological material sample;

(2) whether or not the date of deposit is before or on the date of filing (or the priority date where priority is claimed);

(3) whether or not the contents of the receipt of deposit are the same as those appearing in the request.

Where the requirement of (1) or (2) mentioned above is not complied with, the sample of the biological material shall be deemed not to have been deposited and the applicant shall be notified accordingly. Where the requirement of (3) mentioned above is not complied with, the applicant shall be invited to make correction within the specified time limit. If the applicant fails to make correction within the time limit, the sample of the biological material shall be deemed not to have been deposited and the applicant shall be notified accordingly.

Where the applicant fails to submit the receipt of deposit within the prescribed time limit, the sample of the biological material shall be deemed not to have been deposited and the applicant shall be notified accordingly.

Where, within four months from the date of filing, the applicant fails to submit the document certifying the viability of the sample of the biological material, and fails to give justified reasons for its omission, the sample of the biological material shall be deemed not to have been deposited and the applicant shall

be notified accordingly.

It shall be regarded as a justified reason that the depositary institution fails to certify the viability of the sample of the biological material and furnish the certifying document within the said four months.

Where the sample of the biological material ceases to be viable in the course of the transmittal of the sample to the depositary institution, the sample of the biological material shall be deemed not to have been deposited and the applicant shall be notified accordingly, unless the applicant proves that it/he is not responsible for the loss of viability of the sample of the biological material. Where the applicant submits such evidence, it/he may make a new deposit of the sample of the biological material that is identical with the original one within four months, and the initial date of deposit shall be the date of new deposit.

#### Rule 25.3

Where the application for a patent relates to the deposit of the biological material, the applicant shall, in the request and the description, indicate the scientific name of the biological material, the name and address of the depositary institution in which the sample of biological material is deposited, the date of and the accession number of the deposit, all of which shall be consistent with each other (see Section 7.3, Chapter 10 of Part II of these Guidelines). Where, at the time of filing, they are not indicated or are not consistent with each other, they shall be corrected within four months from the date of filing. If the applicant fails to make correction within the time limit, the sample of the biological material shall be deemed not to have been deposited.

After the applicant was notified that the sample of the biological material is deemed not to have been deposited, if it/he has any justified reason for objection, it/he may request the Office to restore its/his right in accordance with Rule 7.2 of the Implementing Regulations of the Patent Law. Except for other ones, the justified reasons in respect of the deposit of the sample of the biological material or the viability of the sample are as follows:

(1) It is the depositary institution which fails to furnish documents to certify the deposit of the sample of the biological material or the viability of the sample within four months, and it has furnished documents certifying this;

(2) The sample of the biological material ceases to be viable in the course of the transmittal of the sample to the depos

itary institution, for which the applicant is not responsible, and it/he has furnished documents certifying this.

After the Office has decided that the sample of the biological material is deemed not to have been deposited, if the rights cannot be restored even if the procedure of restoration has been started, or if the applicant does not request to start that procedure, the examiner shall, *ex officio*, delete the relevant statements contained in the request, with his/her seal affixed.

## **2. 7 Formality Examination of Requirements for Publication of Application**

When any patent application for invention is published, the text of the description, claims and abstract shall be neat and clear, free from alteration and interlineations. The lines of the drawings in the description and the figure in the abstract (including border line, dash dot line, hatch, center line, symbol line, etc.) shall be clearly discernible. Both characters and lines shall be in black and sufficiently dark and keep in a clean background. The text and drawings shall have no frame around them. The sheets of each element (request, description, claims, drawing, abstract) shall be numbered in order respectively.

Where the application documents are not in conformity with the requirements mentioned above, the applicant shall be invited to make correction within the specified time limit. Where no correction is made within the time limit, the patent application shall be deemed to have been withdrawn, and the applicant shall be notified accordingly.

When the patent application for invention is granted the patent right, the application documents shall, except the examiner may make some written amendments, meet the requirements for publication.

## **3. Examination of Other Documents and Relevant Formalities**

### **3. 1 Appointment of Patent Agency and Designation of Representative**

#### **3. 1. 1 Appointment of Patent Agency**

##### **3. 1. 1. 1 Appointment**

Article 19.1 of the Patent Law provides, "where any foreign-



Rule 44. 2

Rule 44. 1(1)

er, foreign enterprise or other foreign organization having no habitual residence or business office in China applies for a patent, or has other patent matters to attend to, in China, it/he shall appoint a patent agency designated by the State Intellectual Property Office to act as its or his agent." In the prosecution of the application, if it is found that such an applicant has appointed an ordinary patent agency but not a designated patent agency to act as its/his patent agent, the Office shall, through its/his patent agency, notify the applicant of its opinion after checking the application. If the applicant fails to make any response within the specified time limit, the application shall be deemed to have been withdrawn. Where, after the applicant has made its/his observations or the corrections, the Office still finds that the application is not in conformity with the provisions of Article 19.1, of the Patent Law, the application shall be rejected.

Any Chinese entity or individual may appoint a patent agency to apply for a patent and have other patent matters to attend to in the country.

The parties to the appointment are the applicant and the patent agency. Where there are two or more applicants, the parties are all of the applicants and their joint patent agency. After accepting the appointment, the patent agency shall designate its patent agents to handle the relevant matters. The said agents so designated shall not be more than two persons.

Where the appointment made by a Chinese entity or individual is not in conformity with the provisions, the patent agency shall be invited to make correction within the specified time limit. Where the patent agency fails to make any response within the time limit, or where the Office still finds that the correction is not in conformity with the provisions, it shall be deemed that no patent agency has been appointed, and the applicant and the patent agency shall be notified accordingly.

Where any patent application is filed by a foreigner, or jointly filed by a Chinese and a foreigner and the first applicant is a foreigner, the application shall be checked whether or not the appointed patent agency meets the provisions of Article 19.1 of the Patent Law.

Where any legal entity of Hong Kong, Macao, or Taiwan applies for a patent, or has other patent matters to attend to before the Office, it shall appoint a patent agency designated by the State Intellectual Property Office to act as its agent.

Where any individual of Hong Kong, Macao or Taiwan applies for a patent, or has other patent matters to attend to before the Office, he/she may appoint a patent agency designated by the State Intellectual Property Office or an ordinary patent agency to act as his/her agent.

Where any individual of Hong Kong, Macao or Taiwan and any legal entity of Hong Kong, Macao, or Taiwan jointly apply for a patent, or have other patent matters to attend to before the Office, they shall jointly appoint a patent agency designated by the State Intellectual Property Office to act as their agent. Where any individual or legal entity of Hong Kong, Macao, or Taiwan, and any individual or entity of the mainland jointly apply for a patent, or have other patent matters to attend to before the Office, and if the first applicant is an individual or legal entity of Hong Kong, Macao or Taiwan, they shall appoint a patent agency respectively in the same way as an individual or legal entity of Hong Kong, Macao or Taiwan would appoint a patent agency when it, he or she applies for a patent, or has other patent matters to attend to before the Office.

Where any legal entity or individual of Hong Kong, Macao or Taiwan applying for a patent before the Office entrusts an individual or entity in mainland China with the task of applying for a patent, instead of appointing a patent agency in accordance with the provisions of the Patent Law, the applicant shall appoint a patent agency in accordance with the provisions of the Patent Law within two months from the date of filing or within one month from the date of receipt of the notification of the Office. If the applicant fails to appoint a patent agency or fails to make any response within the time limit, the patent application shall be deemed to have been withdrawn. Where, after the applicant has made its/his observations or corrections, the Office still finds that the application is not in conformity with the relevant provisions of the Patent Law, it shall reject the application.

### **3. 1. 1. 2 Power of Attorney**

#### **Rule 16. 3**

Any applicant who appoints a patent agency for applying for a patent, or for having other patent matters to attend to before the Office, shall submit at the same time a power of attorney indicating the scope of the power entrusted.

Where any applicant appoints a patent agency, it/he shall sign a power of attorney indicating the scope of the power en-

trusted. The power of attorney shall be in the unified form prescribed by the Office, and shall indicate the title of the invention – creation, the names of the patent agency and the patent agent, which shall be the same as that appearing in the request. Where the appointment is made after the filing number of the application is accorded, the filing number shall also be indicated.

The power of attorney shall be signed or sealed by the applicant; where there are two or more applicants, the power of attorney shall be signed or sealed by all of the applicants, and the official seal of the patent agency shall be affixed.

Where any foreign applicant appoints a patent agency designated by the State Intellectual Property Office, a general power of attorney may be deposited with the Office. Where a due general power of attorney is received, the Office shall accord a number to it and notify the patent agency accordingly. After a general power of attorney has been deposited, when filing an application for patent, the applicant may submit a copy of the general power of attorney instead of the original power of attorney, and indicate the names of the patent agency and the patent agent, the title of the invention – creation and the number of that general power of attorney accorded by the Office. The official seal of the patent agency shall be affixed.

Where the power of attorney is not in conformity with the requirements, the applicant shall be invited to make correction within the specified time limit. If the applicant fails to make any response within the time limit, or the correction made by the applicant is not in conformity with the requirements, and if the application was filed by a Chinese individual or entity, it shall be deemed that the applicant has not appointed any patent agency, and the parties concerned shall be notified accordingly. Where the first applicant is a foreigner, it shall be handled in accordance with what is stated in the Section 3.1.1.1.

Where the applicant is a legal entity of Hong Kong, Macao or Taiwan, it shall appoint a patent agency designated by the State Intellectual Property Office and sign a power of attorney with full powers.

Where an individual of Hong Kong, Macao or Taiwan entrusts a patent agency with the task of applying for a patent, he/she may personally go through the formalities of appointment or entrust a relative or friend of his/hers in the mainland to go through the formalities on his/her behalf. If the appointment is

made by a relative or friend on his/her behalf, the applicant shall sign a mandate with full powers, in which the matters entrusted, names and addresses of the mandator and the mandatory shall be indicated. The mandate shall be signed by the mandator, with the date of the mandating indicated. Where there is such a mandate, the power of attorney for a patent agency may be signed or sealed by the entrusted relative or friend on behalf of the applicant.

### **3. 1. 1. 3 Dissolution and Resignation of the Appointment**

After the applicant appoints a patent agency, it/he may terminate the appointment. After the patent agency accepts the applicant's appointment, it may resign from the appointment as well. To terminate the appointment, the patent agency shall be notified in advance, and a request for a change of the patent agency in the bibliographic data shall be made to the Office. To resign from the appointment, the patent agency shall, together with a declaration of resignation from the appointment, request the Office to make a change in the bibliographic data. Before the termination or resignation takes effect, the acts done by the patent agency on behalf of the applicant shall continue to be effective. Where the formality for a change of the appointment of patent agency is in compliance with the Patent Law and its Regulations, both the applicant and the patent agency shall be notified accordingly.

### **3. 1. 2 Designation of Representative**

#### **3. 1. 2. 1 Designation**

Rule 16. 4

Where there are two or more applicants and no patent agency has been appointed, one of the applicants shall be designated as the representative. Unless otherwise stated in the request, the first applicant (the applicant first named in order) in the request shall be regarded as the representative by the Office.

#### **3. 1. 2. 2 Right**

Except for the formalities directly relating to the joint rights, the representative shall have the right to handle various matters before the Office. The formalities directly relating to the joint rights refer to filing a patent application, appointing a patent agency, requesting an earlier publication of the application,

assigning the patent application, the right of priority or the patent right, withdrawing the patent application, withdrawing claiming the right of priority, and abandoning the patent right or the right of requesting a reexamination, etc. . The formalities directly relating to the joint rights shall be signed or sealed by all the owners of right.

### **3. 2 Claiming Right of Priority**

Claiming the right of priority means that the applicant claims in an application filed with the Office to enjoy a right of priority on the basis of one or more earlier filed applications in accordance with Article 29 of the Patent Law. Claiming the right of priority shall be in conformity with the provisions of Articles 29 and 30 of the Patent Law, Rules 32 and 33 of its Regulations, and the relevant provisions of the Paris Convention.

#### **3. 2. 1 Claiming Foreign Right of Priority**

Art. 29. 1

##### **3. 2. 1. 1 Earlier Application and Priority – Claiming of Subsequent Application**

Where any applicant files a patent application which contains a declaration claiming the priority of an earlier application filed in a foreign country, the examiner shall check whether or not the earlier application, as the basis of the right of priority, was filed in or for any country party to the Paris Convention. If the application was filed in a country not party to the Convention, the examiner shall check whether or not that country recognizes the right of priority of China on the basis of the principle of reciprocity. The examiner shall also check whether or not the applicant is entitled to claim application of the Convention, i. e. whether or not he/she is a national of a country party to the Convention, or check whether or not the applicant is a national of a country recognizing the right of priority of China on the basis of the principle of reciprocity.

Furthermore, the examiner shall check whether or not the subsequent application is filed within twelve months from the date of filing of the earlier application. If this requirement is not complied with, claiming priority shall be deemed not to have been made. Where there are two or more earlier applications, the priority period shall be calculated from the date of filing of the first application. Where a certain subsequent application is filed

later than the date on which the period of twelve months expired, claiming the priority of that earlier application shall be deemed not to have been made and the applicant shall be notified accordingly.

In the course of the preliminary examination, the examiner shall not check whether or not the earlier application is the first application defined by the Paris Convention, and whether or not the subject matter of the subsequent application is identical with that of the earlier application, unless the earlier application is obviously not in conformity with the relevant provisions of the Paris Convention, or the subject matter of the subsequent application is obviously different from that of the earlier application.

The earlier application may be an application for inventor's certificate defined in Article 4A of the Paris Convention.

### **3. 2. 1. 2 Declaration Claiming Right of Priority**

Art. 30

Where any applicant claims the right of priority, it/he shall make a written declaration in the request when the patent application is filed. If the applicant fails to do so, the claim to the right of priority shall be deemed not to have been made.

The applicant shall, in its/his written declaration, indicate the date and the number of filing of the earlier application, which is the basis of the right of priority, and the name of the country or the inter – governmental organization, in which the application was filed. If the written declaration fails to indicate or wrongly indicates the filing date of the earlier application and the name of the country or the inter – governmental organization in which the application was filed, the declaration shall be deemed not to have been made, and for this reason, the claim to the right of priority shall be deemed not to have been made.

Where multiple priorities are claimed, and the filing dates of part of the earlier applications or the names of part of the countries or inter – governmental organizations in which the earlier applications were filed, were not indicated or wrongly indicated in the written declaration, the claim to the relevant right of priority shall be deemed not to have been made. Where the filing number of the earlier application is not indicated or wrongly indicated in the written declaration, but the applicant has submitted a copy of the earlier application within the prescribed time limit, the applicant shall be notified to make correction within the specified time limit. If it/he fails to make any response within the time limit

or the correction submitted is not in conformity with the relevant provisions, the claim to the right of priority shall be deemed not to have been made.

### 3. 2. 1. 3 Copy of Earlier Application

The copy of the earlier application, which is the basis of the right of priority, shall be certified by the competent authority of the country or the inter – governmental organization in which the application was filed. The formality of the copy of the said application shall be in conformity with the international practice. At least, the name of the country or inter – governmental organization in which the application was filed, the name of the applicant, the date of filing and the filing number shall be indicated. Where the application is not in conformity with those requirements, the applicant shall be invited to make correction within the specified time limit. If it/he fails to make any response within the time limit, or if the correction submitted is not in conformity with the said requirements, it shall be deemed that no copy of the earlier application has been submitted, and, for this reason, the applicant shall be notified that the claim to the right of priority is deemed not to have been made. Where multiple priorities are claimed, the copies of all the relevant earlier applications shall be submitted. If this requirement is not satisfied, it shall be deemed that copies of the earlier applications has not been submitted, and, for this reason, the applicant shall be notified that the claim to the right of priority of the earlier application, a copy of which has not been submitted, is deemed not to have been made.

The copy of the earlier application shall be submitted within three months from the filing date of the subsequent application. If the said copy has not been submitted within the time limit, the claim to the right of priority shall be deemed not to have been made.

Where the certified copy of the earlier application which has been submitted to the Office is required to be submitted again, a duplicate copy may be used instead, provided the copy contains the filing number of the subsequent application in the file of which the certified copy of the earlier application is deposited.

## Rule 32. 2

**3. 2. 1. 4 Applicant of Subsequent Application**

The applicant(s) of the subsequent application claiming the right of priority shall be the same as the applicant, or at least one of the applicants recorded in the certified copy of the earlier application.

Where the applicants of the two applications are entirely different, and the right of priority of the earlier application has been assigned to the applicant of the subsequent application, a document certifying the assignment of the right of priority, signed or sealed by all of the applicants of the earlier application, shall be submitted at the same time of filing the subsequent application, or at the latest, within three months from the filing of the subsequent application. Where the earlier application has several applicants and the subsequent application has several different applicants, a document certifying the assignment of the right of priority, signed or sealed by all of the applicants of the earlier application, to all of the applicants of the subsequent application before the date of filing of the subsequent application shall be submitted; or a document certifying the assignment of the right of priority, signed or sealed respectively by the several applicants of the earlier application, to the applicants of the subsequent application before the date of filing of the subsequent application, shall be submitted.

Generally speaking, any document certifying the assignment of the right of priority, except where otherwise provided for in the certifying document, and shall be signed before the filing of the subsequent application. Where the applicant fails to submit such a certifying document or where the certifying document submitted is not in conformity with the requirements, the applicant shall be notified that the claim to the right of priority is deemed not to have been made.

**3. 2. 1. 5 Withdrawal of Claim to Right of Priority**

The applicant may withdraw its/his claim to the right of priority after the claim was made. Where the multiple priorities are claimed, the applicant may withdraw its/his claim to one or some of the rights of priority.

Where any applicant withdraws its/his claim to the right of priority, it/he shall make a written request.

Where the earliest priority date of a patent application is changed because of the withdrawal of a certain claim to the right



of priority, and the various periods of priority calculated from that priority date have not expired, these periods of priority shall be calculated from the new earliest priority date or the date of filing after the change. Where the request for withdrawal of the claim to the right of priority reached the Office later than fifteen months from the original earliest priority date, the time limit for the publication of the subsequent application shall be still calculated from the original earliest priority date.

After the claim to the right of priority has been withdrawn, the relevant requirements and measures regarding that claim to priority shall be untenable.

### **3. 2. 1. 6 Fee of Claim to Right of Priority**

Rule 90.1(4)  
Rule 92.2

Where any claim to the right of priority is made, the applicant shall pay the fee for claiming priority at the same time with the payment of the filing fee. If the fee is not paid or not paid in full within the time limit, the claim to the right of priority shall be deemed not to have been made.

Where the claim to the right of priority is withdrawn, the fee for claiming priority, which has been paid, shall not be refunded.

### **3. 2. 2 Claim to Domestic Right of Priority**

The claim to the right of domestic priority refers to the claim to the priority of a domestic earlier patent application, i. e. where any applicant within twelve months from the date on which it/he first filed an application for a patent for invention or utility model in China, files with the Office a subsequent application for a patent for the same subject matter, it/he may claim a right of priority. The applicant who claims a right of domestic priority may be either a Chinese or a foreigner.

#### **3. 2. 2. 1 Earlier Application and Subsequent Priority – Claiming Application**

Rule 33.2

The earlier application and the subsequent priority – claiming application shall be in conformity with the following provisions:

(1) The earlier application should be an application for patent for invention or for utility model, and not a divisional application of either of them, the earlier application should not be an application for patent for design;

(2) no foreign or domestic priority has been claimed for the subject matter of the earlier application;

(3) no patent right has been granted for the subject matter of the earlier application, i. e. no notification to grant a patent right for the subject matter of the earlier application has been issued;

(4) the subsequent application which claims to the right of priority has been submitted within twelve months from the filing date of the earlier application.

When the requirement referred to above in paragraph (3) is checked, the reference time shall be the filing date of the subsequent priority – claiming application, i. e. up to the filing date of that application, the Office has not issued a notification to grant the patent right for the subject matter of the earlier application. When the requirement referred to above in paragraph (4) is checked, where multiple priorities are claimed, the reference time shall be the filing date of the earliest application, i. e. the subsequent priority – claiming application should be filed within twelve months from the date of filing of the earliest application.

Where any of the above requirements is not complied with, the applicant shall be notified that the claim to the right of priority, or the claim to the priority of the earlier application that is not in conformity with the requirements, is deemed not to have been made.

When the claim to the right of priority is checked, if it is found that the notification to grant the patent right has been sent out by the Office, but the date of issue of the notification is later than the filing date of the subsequent application, and if the claim to the right of priority is in conformity with the requirements, the applicant shall be invited to return the said notification as soon as possible. When the Office receives the returned notification, the relevant fees which have been paid by the applicant shall be returned.

In the course of the preliminary examination, the examiner shall only check whether or not the subject matter of the subsequent application is obviously different from that of the earlier application, and the examiner shall not examine whether or not the subject matter of the earlier application and that of the subsequent application are identical in substance. Where the subject matters of the earlier application and the subsequent application are obviously different, the applicant shall be notified that the

claim to the right of priority is deemed not to have been made.

### **3. 2. 2. 2 Declaration Claiming Domestic Right of Priority**

Art. 30

Any applicant who claims the domestic right of priority shall make a written declaration in the request when the application is filed. If the applicant fails to do so, the claim to the right of priority shall be deemed not to have been made.

The applicant shall, in the declaration claiming the domestic priority, indicate the date of filing, the filing number of the earlier application, which is the basis of the right of priority, and the name of the country in which the application was filed (in this case, it is China). If the applicant fails to indicate or indicates wrongly any of those matters, the declaration shall be deemed not to have been made, and, for this reason, the claim to the right of priority shall be deemed not to have been made. Where multiple priorities are claimed but any of the relevant matters required to be indicated of the earlier applications have not been indicated or have been wrongly indicated in the written declaration, the relevant claim to the right of priority shall be deemed not to have been made.

### **3. 2. 2. 3 Copy of Earlier Application**

Rule 32. 2

The copy of the earlier application shall be prepared by the Office in accordance with the Implementing Regulations of the Patent Law, and it shall be deposited in the file of the subsequent application, provided that the prescribed fee for claiming priority has been paid.

### **3. 2. 2. 4 Applicant of Subsequent Application**

Rule 32. 2

The applicant of the subsequent priority – claiming application shall be the same as that appearing in the copy of the earlier application. If they are different, the applicant of the subsequent application shall submit a document certifying the assignment of the right of priority at the same time with the filing of the subsequent application. Where there is any difficulty in doing so, the said document shall be submitted within three months from the filing date of the subsequent application together with the reason for the delayed submission. That document shall be signed by all of the applicants of the earlier application before the filing of the subsequent application, unless otherwise prescribed in the certifying document. Where the applicant fails to submit such a

document or the certifying document fails to meet the requirements, the applicant shall be notified that the claim to the right of priority is deemed not to have been made.

### **3. 2. 2. 5 Withdrawal of Priority Claim**

The examination shall be conducted in accordance with the provisions of Section 3. 2. 1. 5 of this Chapter. However, the earlier application, which has been deemed to be withdrawn under Rule 33. 3 of the Implementing Regulations of the Patent Law, shall not be requested to be restored due to the withdrawal of the priority claim.

### **3. 2. 2. 6 Fee for Claiming Priority**

The examination shall be conducted in accordance with the provisions of Section 3. 2. 1. 6 of this Chapter.

### **3. 2. 2. 7 Procedure of Earlier Application Deemed to Be Withdrawn**

Rule 33. 3

Where the right of domestic priority is claimed, the earlier application shall be deemed to be withdrawn from the date on which the subsequent application is filed.

Where any claim to the right of domestic priority made by the applicant is, after the preliminary examination, found to be in conformity with the requirements, the applicant shall be notified that the earlier application is deemed to be withdrawn. Where two or more domestic priorities are claimed, if the claims are, after the preliminary examination, found to be in conformity with the requirements, the applicant shall be notified that the relevant earlier applications are deemed to be withdrawn.

Any application which is deemed to be withdrawn, cannot be restored.

## **3. 3 Disclosures without Prejudice to Novelty**

### **3. 3. 1 Scope of Application**

Article 24 of the Patent Law provides, an invention – creation for which a patent is applied for does not lose its novelty where, within six months before the date of filing ( or the priority date where priority is claimed ), one of the following events occurred;

(1) Where it was first exhibited at an international exhibition sponsored or recognized by the Chinese Government;

(2) Where it was first made public at a prescribed academic or technological meeting;

(3) Where it was disclosed by any person without the consent of the applicant.

With regard to the explanation of the events mentioned above, the reader is referred to Sections 5. 1, 5. 2 and 5. 3, Chapter 3 of Part II of these Guidelines.

**Rule 31. 2**

Where the event mentioned in instance (1) or (2) occurred, the applicant shall make a declaration in the request when the patent application is filed. Where the event mentioned in instance (3) occurred, if the applicant becomes aware of the event before the date of filing, it/he shall also make a declaration in the request when the patent application is filed.

Where the relevant declaration is not in conformity with the requirements mentioned above, the applicant shall be notified that its/his request for the enjoyment of a grace period is deemed not to have been made.

**3. 3. 2 Certifying Materials**

**Rule 31. 2 -3**

Where any request for the enjoyment of a grace period is made when the patent application is filed, the certifying materials shall be submitted by the applicant within two months from the date of filing of the application. In instance (3) mentioned in Section 3. 3. 1, if the applicant becomes aware of the event after the date of filing, it/he shall submit the certifying materials within the time limit specified by the Office (two months). Where the applicant fails to submit such materials within the time limit, it/he shall be notified that the request for the enjoyment of a grace period is deemed not to have been made.

The certifying materials of the international exhibition shall be provided by the sponsor of the exhibition, with its official seal affixed. The certifying materials of the academic or technological meeting shall be provided by the department or bureau concerned under the competent authority of the State Council, with its official seal affixed.

The certifying materials shall indicate the name of the exhibition or meeting, the date on which and the venue where it was held, the contents of the invention – creation and the date on which and the form in which it was exhibited or published, and a copy of the contents of the invention – creation shall be appended.

In the case of the disclosure by any person without the consent of the applicant, the date, form and contents of the disclosure shall be indicated in the certifying materials, which shall be signed or sealed by the person who gives evidence.

### **3. 4 Request for Examination as to Substance**

The procedure of examination as to substance of an application for a patent for invention shall commence mainly with the request of the applicant for an examination as to substance.

#### **3. 4. 1 Relevant Requirements of Request for Examination as to Substance**

Art. 35. 1

Rule 90. 1 (2)

Rule 93

Art. 36

The request for examination as to substance shall be made within three years from the date of filing ( or priority date where priority is claimed ) and the substantive examination fee shall be paid within the time limit.

When the applicant for a patent for invention requests examination as to substance, it/he shall furnish pre – filing date ( or pre – priority date where priority is claimed ) reference materials concerning the invention.

#### **3. 4. 2 Examination and Handling of Request for Examination as to Substance**

The request for examination as to substance shall be examined in accordance with the following requirements:

(1) Where the applicant has not submitted the request for examination as to substance within the time limit, the Office shall issue a notification of the expiration of the time limit;

(2) Where the request for examination as to substance has been made and the substantive examination fee has been paid within the time limit, but the application has not complied with other requirements, the applicant shall be invited to make correction within the specified time limit. If no correction is made within the time limit or if the correction is not in conformity with the requirements, the request for examination as to substance is deemed not to have been made, and the applicant is notified accordingly;

(3) Where the request for examination as to substance is submitted after the time limit has expired, or if the corrections are not in conformity with the requirements, or if the substantive examination fee is not paid or not paid in full within the time limit,

the application shall be deemed to be withdrawn;

(4) Where the request for examination as to substance is in conformity with the requirements, the applicant shall be notified that the application is to enter the procedure of substantive examination before the procedure of examination as to substance commences.

### **3. 5 Declaration Requesting Earlier Publication**

Rule 46

The request for earlier publication is applicable only to applications for patent for invention.

Where the applicant makes a request for earlier publication, the publication shall not be subject to any condition.

Where any declaration of request for earlier publication is checked to be in conformity with the requirements, preparations for publication shall be started promptly after the patent application passes the preliminary examination. Thus, any request made by the applicant for revoking the previous request for earlier publication shall be deemed not to have been made, and the application documents shall be published in due course.

### **3. 6 Declaration Withdrawing Application for Patent**

Art. 32

Rule 37. 1

Any applicant may request to withdraw its/his application for patent at any time before the patent right is granted. When withdrawing an application for a patent, the applicant shall make a request by using the form of "Declaration to withdraw an application for a Patent" prescribed by the Office.

When a request for withdrawing an application for patent is submitted, the withdrawal shall not be subject to any condition.

Where any request for withdrawing an application for patent is made, no matter whether or not a patent agency has been appointed, a document, signed or sealed by the applicant, certifying that it/he agrees to withdraw its/his patent application, must be submitted. Where there are two or more applicants, the certifying document must be signed or sealed by all of the applicants.

Where the declaration of requesting withdrawal of an application for patent is in conformity with the requirements, the applicant shall be notified accordingly. The applicant may not revoke the said declaration without any justified reason. Where the declaration of withdrawing was made in bad faith by a person who unlawfully usurped the right to the patent, the person who, on

the evidence of valid legal document, has the right to the patent may request that the declaration of withdrawing the application be revoked.

**Rule 37.2**

Where any declaration to withdraw an application for patent is submitted after the application has been sent to the editorial department of the Patent Gazette for making preparations for publication, the application documents shall be published as scheduled, but the examination procedures shall come to an end.

Where the application has been published, the filing number of the application that has been withdrawn shall be announced in the Patent Gazette.

**3.7 Changes in Bibliographic Data**

The bibliographic data of a patent application includes: the filing number, date of filing, title of invention – creation, classification symbol, information relating to priority (including the filing number and date of filing of the earlier application, and the country in which the earlier application was filed), information relating to the applicant or the patentee (including its/his name, nationality, address and postal code), name of the inventor, information relating to the patent agency (including its name, address and postal code, and name of the patent agent), information relating to the liaison person (including his/her name, address and postal code), and representative, etc.

Where any of the bibliographic data concerning information relating to personnel (referring to information relating to the applicant or patentee, name of the inventor, information relating to the patent agency, information relating to the liaison person and representative) has changed, the party concerned shall make a statement for change in the bibliographic data in accordance with the relevant provisions. Where any of other bibliographic data has changed, the Office shall make changes *ex officio* in the light of specific circumstances.

These Guidelines make provisions only for the necessary formalities to be complied with when any change in the bibliographic data is to be made.



### **3. 7. 1 Change of Name and Change of Right Owner**

#### **3. 7. 1. 1 Change of Name**

The change of name refers to the situation that there is no change in the party concerned (including applicant or patentee, inventor, patent agency, patent agent and liaison person) *per se*, but its/his name or nationality has altered or it/he has moved to a new address.

#### **3. 7. 1. 2 Change of Right Owner**

Change of right owner refers to any of the following circumstances:

(1) The owner of the right to apply for a patent or the patent right may change because of assignment or transfer by succession or gift of these rights or may change as a result of any dispute of the ownership of these rights. These changes lead to the increase or decrease of the number of the applicant or patentee, and consequently to a change in the name, nationality or address of the applicant or patentee.

(2) The inventor may change as a result of any dispute concerning the identity of the inventor. If the person incorrectly given as inventor is replaced, this may lead to a change in the number of the inventor, and consequently may lead to changes in the names of the inventors.

(3) The patent agency and the patent agent may change because their appointment is revoked or the patent agency is re-appointed as a result of the change of the applicant or patentee, or, during the prosecution of the application, because the patent agency has resigned or has been dismissed and re-appointed. This may lead to a change in the name and address of the patent agency and the name of the patent agent.

(4) The liaison person or representative may change because he/she is dismissed or replaced as a result of a change of the applicant or patentee. This may lead to a change in the name and address of the liaison person or representative.

### **3. 7. 2 Formalities of Making Changes**

#### **3. 7. 2. 1 Statement for Change in Bibliographic Data**

Where any change in the bibliographic data is requested, It is required to use the unified form prescribed by the Office.

Where one or more items of the bibliographic data of a patent application are asked to be changed at the same time, only one form of request is required to be submitted. Where one and the same item of the bibliographic data of several patent applications is asked to be changed, one form of request for each application is required to be submitted.

### **3. 7. 2. 2 Fee for Change in Bibliographic Data**

Rule 90. 1(4)

When a request for a change in the bibliographic data is submitted, the fee for a change in the bibliographic data shall be paid in accordance with the relevant provisions. The fee for a change in the bibliographic data in the patent fee schedule prescribed by the Office refers to the fee for each request for a change in the bibliographic data of each patent application.

### **3. 7. 2. 3 Time Limit for Paying Fee for Change in Bibliographic Data**

Rule 97

The fee for a change in the bibliographic data shall be paid within one month from the date on which the request concerned was submitted. If the fee is not paid or not paid in full within the time limit, the request for a change in the bibliographic data shall be deemed not to have been made unless otherwise prescribed in the provisions.

### **3. 7. 2. 4 Certifying Documents for Change in Bibliographic Data**

Art. 10

Rule 14

Rule 15. 1

(1) Where the name or address of the applicant, patentee, inventor, patent agency or patent agent is changed, it/he shall submit a certifying document issued by the local public security department, the administration department for industry and commerce or the competent authority at the higher level. Where his/her nationality is changed, he/she shall submit a certifying document issued by the competent authority of the State to which he/she belongs.

(2) Where any right is transferred as a result of a dispute of the ownership of the right of the applicant or patentee, or the inventor is changed as a result of a dispute of the identification of the inventor, the person requesting a change in the bibliographic data shall submit an agreement of transfer of the right signed or sealed by all of the interested parties if the dispute has been settled by negotiations; or the judgment of the people's court which has entered into force if the dispute has been settled by the

people's court. After receipt of the judgment, the Office shall inquire whether or not an appeal has been lodged. Where there is no response or definitely no appeal was lodged within the specified time limit (two months), the judgment shall be considered to have entered into force. If an appeal has been lodged, the interested party shall furnish documents certifying the appeal has been accepted and the original judgment of the people's court shall no longer have legal effect.

Where the dispute has been settled by the local administrative authority for intellectual property affairs (hereinafter referred to as AAIPA), the Office shall, after receipt of the decision of mediation, notify other interested parties and inquire whether or not legal proceedings have been instituted in the people's court. Where there is no response, or clearly no legal proceedings were instituted in the people's court within the prescribed time limit (two months), the decision of mediation shall be considered to have entered into force. If legal proceedings have been instituted in the people's court, the interested party shall furnish documents certifying that the legal proceedings have been accepted and the original decision of mediation of the AAIPA shall no longer have any legal effect.

(3) Where the right of the applicant or patentee has been transferred because of assignment or gift, and a request for a change in the bibliographic data is submitted, it/he shall submit the original contract of assignment or gift or its notarized copy. If such a contract is concluded by any legal entity, it shall be signed or sealed by the legal representative or authorized person, and the official seal or the seal specially used for concluding contracts shall be affixed. Where it is necessary, a notarized document shall be submitted. If the contract is concluded by any individual, it shall be signed or sealed by the person himself or herself. Where it is necessary, a notarized document shall be submitted. Where there are two or more patent applicants or patentees, a document certifying that all of the right owners have agreed the assignment or gift shall be submitted.

Where the assignor or the assignee of the assignment of the right to apply for a patent or the patent right is a legal entity or individual having no habitual residence or business office in Mainland China, any request for a change in the bibliographic data shall be in conformity with the following provisions:

(i) Where both the assignor and the assignee are overseas

residents or foreign legal entities, the original contract of assignment or its notarized copy signed or sealed by both parties shall be submitted to the Office.

(ii) Where the assignor is a legal entity or individual of Mainland China and the assignee is an overseas resident or legal entity, the original contract of assignment or its notarized copy signed or sealed by both parties, together with a document certifying approval of the assignment by the competent department for foreign trade and economic affairs of the State Council in conjunction with the science and technology administration department of the State Council shall be submitted.

(iii) Where the assignor is an overseas resident or legal entity and the assignee is a legal entity or individual of Mainland China, the original contract of assignment or its notarized copy signed or sealed by both parties shall be submitted.

(iv) In the instances mentioned above, any request for making a change of the right owner in the bibliographic data shall be made by the applicant or the patentee who is the assignor of the right to apply for a patent or the patent right, or the patent agency it/he has appointed.

The overseas resident or legal entity mentioned in instances (i) to (iii) refers to any foreigner, foreign enterprise or other foreign organization, and to any resident or legal entity of Hong Kong, Macao or Taiwan, having no habitual residence or business office in Mainland China. Where they have habitual residence or business office in Mainland China, they may assign the right to apply for a patent or the patent right in accordance with the provisions which are applicable to Chinese individuals or entities assigning the right to apply for a patent or the patent right.

(4) Where any applicant or patentee, which is a legal entity, requests to make changes in the bibliographic data in consequence of the reorganization, breakup, winding-up, bankruptcy or reform of the entity, or its merge with any other entity, it shall submit the relevant certifying documents which have legal effect.

(5) Where any applicant or patentee dies, the successor in title requesting a change in the bibliographic data shall submit a certifying document issued by the notary organization certifying that the requesting person(s) is the only legitimate successor(s) in title of the deceased applicant or patentee. The joint successors in title shall inherit jointly the right to apply for a patent or the

patent right except where otherwise provided in the Patent Law.

(6) Where a patent agency changes its name or address, it shall firstly request to make a change in the registration at the department in charge of the patent agencies in the State Intellectual Property Office. After the registration takes effect, the patent agency shall request to make changes in the bibliographic data of each patent application and patent for which it acts as the patent agency. The request for a change of the patent agent shall be made by the patent agency which is the employer of the patent agent.

(7) Where any patent agency changes because of its resignation, being discharged, or being appointed during the prosecution of the application, it shall submit the resignation, discharge of appointment or power of attorney.

#### **3. 7. 2. 5 Person Requesting Change in Bibliographic Data**

Where any applicant files an application for patent without appointing a patent agency, it shall be the responsibility of the applicant or the patentee, or its/his representative, to go through the formalities of making any change in the bibliographic data of the application. If the change was due to the assignment or succession of the relevant right or the settlement of a dispute over the question of ownership of the relevant right, the new owner of the relevant right (except where otherwise prescribed) may go through the formalities. Where any patent agency has been appointed to file an application, the patent agency shall go through the said formalities unless the approval of the establishment of the patent agency has been revoked in accordance with the Rules Governing Patent Agency.

#### **3. 7. 3 Handling of Request for Change in Bibliographic Data**

Where it is found after checking that the formalities of requesting to make a change in the bibliographic data are not in conformity with the provisions, the requesting person shall be notified to make correction. If the correction is still not in conformity with the requirements, the request for change shall be deemed not to have been made, and the requesting person shall be notified accordingly. If the formalities of requesting to make a change in the bibliographic data are found to be in conformity with the provisions, the requesting person shall be notified that the formalities are satisfactory, and it/he shall also be

informed of the bibliographic data before and after the change. If the change is required to be announced, the requesting person shall be informed the volume number and the issue number of the Patent Gazette in which the announcement is scheduled. Where the change in the bibliographic data relates to the transfer of the relevant right, both parties to the transfer shall be notified. At the same time the examiner shall complete the following:

(1) Change and check the relevant bibliographic data in computer database.

(2) Where the amount of the relevant fee is changed because of change of the owner of the relevant right, the party concerned shall be notified to make up the insufficiency in accordance with the new rate within the specified time limit. Where the fee is not paid or not paid in full within the time limit, it shall be treated as if it were not paid in full. Where the rate of the reduction and postponement of the payment is changed, the relevant mark in the database shall be changed and the requesting person shall be notified accordingly.

(3) Where the change will be announced in the Patent Gazette in accordance with the provisions, e. g. the change of the patentee, the information before and after the change shall be announced.

(4) Where the name or address of a patent agency is changed, or the approval of the establishment of patent agency is revoked in accordance with the Rules Governing Patent Agency, the examiner shall complete the following:

(i) As for the group change in bibliographic data and uniformly handling of dissolution of patent agencies, the bibliographic data in the computer shall be amended uniformly.

(ii) The declaration of a group change in bibliographic data and the uniformly handled notification of dissolution of the patent agency shall be put into the relevant application files.

(iii) Where the applicant of the patent application handled by the dissolved patent agency is a domestic legal person or individual, the first signatory of the applicant shall become the representative of the patent application automatically from the date of the announcement of the said dissolution (unless otherwise announced). The applicant may appoint another patent agency.

**Art. 10. 3                      3. 7. 4 Date of Entry into Force of Change of Right to Apply for Patent ( or Patent Right)**

The change of the right to apply for a patent ( or the patent right) shall take effect as of the date of registration of transfer of the right with the Office. The date of registration is the date of issuance of the notification on which of the satisfaction of the formalities for change issued by the Patent Office.

**Rule 44. 1 (1)                      4 Check on Obvious Substantial Defects**

**Rule 44. 2                      4. 1 Check According to Article 5 of Law**

According to Article 5 of the Patent Law, no patent right shall be granted for any invention – creation that is contrary to the Laws of the State or social morality or that is detrimental to public interest.

In checking whether or not the invention – creation is obviously contrary to the Laws of the State, or obviously contrary to social morality, or obviously detrimental to public interest, Section 2, Chapter 1 of Part II of these Guidelines should be consulted. If it is found that the entire contents or part of the contents of the application fall under one of the three aspects mentioned above, for example, if the applicant filed an application with the following or similar contents: “A kind of drug taking tool”, “A kind of tool for gambling and the method of its use”, or “A kind of safe which can arrest the thief automatically”, the Office shall notify the applicant of its opinion, stating the reasons, and request it/him to submit its/his observations ( if the entire contents are involved), or to delete the relevant part ( if only part of the contents is involved) within the specified time limit. If the observations submitted by the applicant are not sufficient to justify that the relevant invention does not fall under Article 5 of the Patent Law, or the applicant refuses to delete the relevant part of the invention without any fully justified reason, the Office shall reject the application. If the applicant has deleted the relevant part of the invention as requested by the Office, and added a few words or sentences which are indispensable from the context, it should be permitted.

**Rule 9**                      Any invention – creation that is contrary to Article 5 of the Patent Law, referred to in the above paragraph, shall not include the invention – creation merely because the exploitation of which is prohibited by the Laws of the State.

#### **4. 2 Check According to Article 25 of Law**

According to Article 25 of the Patent Law, no patent right shall be granted for any of the following subject matters:

- (1) scientific discoveries;
- (2) rules and methods for mental activities;
- (3) methods for the diagnosis or for the treatment of diseases;
- (4) animal and plant varieties;
- (5) substances obtained by means of nuclear transformation.

For processes used in producing products referred to in item (4) of the preceding paragraph, patent right may be granted in accordance with the provisions of the Patent Law.

In checking whether or not any invention for which a patent is applied for obviously falls under any of the subject matters for which no patent right shall be granted in accordance with Article 25 of the Patent Law, Section 2, Chapter 1 of Part II of these Guidelines should be consulted. If it is found that the entire contents of the application belong to one of the subject matters described in Article 25 of the Patent Law, for example, the applicant filed an application for patent for the following or similar contents: "A newly discovered minor planet", "A genetically engineered cow containing human gene", "A method for diagnosing diseases in a human body", the Office shall notify the applicant of its opinion, stating the reasons, and request it/him to submit observations within a specified time limit. If the applicant's observations fail to prove that the subject matter of the application is not one of the subject matters mentioned above, the application shall be rejected. If it is found that only a part of the contents of the application belongs to one of the subject matters mentioned above, and that part is difficult to be separated from the application, nothing can be done in the preliminary examination. It should be left to be handled in the proceeding of examination as to substance.

#### **4. 3 Check According to Article 31. 1 of Patent Law**

According to Article 31. 1 of the Patent Law, an application for a patent for invention shall be limited to one invention. Two or more inventions belonging to a single general inventive concept may be filed as one application.

In the proceeding of preliminary examination, it is not nec-



## Rule 42.2

essary to examine whether or not the application is in conformity with the requirements of Article 31.1 of the Patent Law. Exceptionally, if the application contains two or more inventions which obviously have not any relation with each other, and it is impossible to accord a single classification symbol for the subject matter of the application, the Office shall notify applicant of its opinion, and request it/him to amend the application so as to meet the requirement of unity. If the applicant refuses to do so without any justified reason, the application shall be rejected.

**4.4 Check According to Article 33 of Law**

According to Article 33 of the Patent Law, an applicant may amend its/his application for a patent for invention, but the amendment to the application may not go beyond the scope of the disclosure contained in the initial description and claims.

The amendments made by the applicant on its or his own initiative at the time of making a request for the examination as to substance in accordance with Rule 51 of the Implementing Regulations of the Patent Law shall not be checked in the preliminary examination. Only when the Office notifies the applicant of its opinion after preliminary examination and requests it/him to amend the application, it is necessary to check whether or not the amendments made by the applicant obviously go beyond the scope of the disclosure contained in the initial description and claims. If the amendments obviously go beyond the scope of the initial disclosure, for example, the applicant has amended the data or has expanded the scope of the numerical value, or has introduced a claim of a technical solution which has not any disclosure in the initial description, or has added one or more pages of the substantial contents of the invention which were not included in the initial description or claims, the applicant shall be notified accordingly. If the applicant fails to give sufficient reason to show the amendment does not go beyond the initial disclosure, and refuses to make any change to the amendments which are not in conformity with the provisions of Article 33 of the Patent Law, or the amendments submitted by the applicant are still not in conformity with the requirements, the application shall be rejected.

**4.5 Check According to Rule 2.1 of Regulations**

According to Rule 2.1 of the Implementing Regulations of

the Patent Law, "invention" in the Patent Law means any new technical solution relating to a product, a process or improvement thereof.

In the preliminary examination, it is only necessary to judge whether or not the "invention" described in the application for a patent constitutes a technical solution. If there are only descriptions of technical index, advantages and results but no description relating to the solution of a technical problem or even no description of technical contents, the Office shall notify the applicant of its opinion after checking its/his application. If no response is made within the specified time limit, the application shall be deemed to have been withdrawn. After the applicant has made its/his response, if the examiner still considers that the application is not in conformity with the provisions of Rule 2.1 of the Implementing Regulations of the Patent Law, the application shall be rejected and the reasons shall be stated accordingly. Where part of the technical features of the "invention" have been described in the application documents, it is not necessary for the examiner to determine whether or not the technical solution is complete or whether or not the solution can be carried out.

#### 4.6 Check According to Rule 18 of Regulations

The description shall not use any words or sentences that have no relation to technology. Nor shall it contain any commercial advertising or any language belittling or slandering other persons or products of other persons. However, pointing out objectively the problems existing in the background art shall not be regarded as a belittling act. The description shall include technical contents of the invention. Where the description is obviously not in conformity with those requirements, the Office shall notify the applicant of its opinion, stating the reasons, and request it/him to submit observations within a specified time limit. If the observations or corrections submitted by the applicant fail to remove the defects existing in the application, it shall be rejected according to the provisions of Rule 18 of the Implementing Regulations of the Patent Law.

In the preliminary examination, if part of the technical features of the invention are described in the description, and its form is in conformity with the requirements of Section 2.2 of this Chapter, it is not necessary to examine other substantial issues,

which shall be dealt with in the examination as to substance.

#### **4.7 Check According to Rule 20 of Regulations**

The claims shall state the technical features of the invention, and define clearly and concisely the extent of the patent protection asked for.

The claims shall not contain any words or sentences that have no relation to technology, such as “to ask for the protection of the right of production and sale under this patent”, etc. . Nor shall the claims contain any commercial advertising, or any language belittling, slandering or libeling other persons or products of other persons.

Where the claims are obviously not in conformity with those requirements, the Office shall notify the applicant of its opinion, stating the reasons, and request it/him to submit observations within a specified time limit. If the observations submitted by the applicant fail to remove the defects, the application shall be rejected according to Rule 20 of the Implementing Regulations of the Patent Law.

**Chapter 2****Preliminary Examination of Application for Patent for Utility Model****1. Introduction**

In accordance with the provision of Articles 3 and 40 of the Patent Law, the Office receives and examines patent applications for utility model. Where it is found after preliminary examination that there is no cause for rejection of the application, the Office shall make a decision to grant the patent right for utility model, issue the relevant patent certificate, and register and announce it. Hence, the preliminary examination of an application for a patent for utility model is a necessary procedure after the acceptance of an application for a patent for utility model, and before the grant of that application.

**Rule 44.1**

The scope of the preliminary examination of an application for a patent for utility model is as follows:

(1) Whether or not the application contains the patent application documents as provided in Article 26 of the Patent Law, and whether or not the application documents are in conformity with the requirements;

(2) Whether or not the application for a patent for utility model obviously falls under Article 5 or Article 25 of the Patent Law, or is obviously not in conformity with the provisions of Article 18 or Article 19.1 of the Patent Law, or is obviously not in conformity with the provisions of Article 26.3, 26.4, 31.1, or Article 33 of the Patent Law, or Rule 2.2, 13.1, 18-23, or 43.1 of the Implementing Regulations of the Patent Law, or is not entitled to a patent right in accordance with the provisions of Article 9 of the Patent Law;

(3) Whether or not other documents relating to the patent application documents are in conformity with the relevant provisions of the Patent Law and its Regulations.

**Rule 44.2**

The Office shall notify the applicant of its opinion after preliminary examination, and request it/him to submit observations or make corrections within a specified time limit. If no response is made within the specified time limit, the application shall be deemed to have been withdrawn. Where, after the applicant has submitted observations or made corrections, the Office finds that the application is still not in conformity with the provisions mentioned above, the application shall be rejected.

## 2. Formality Examination of Application Documents

In this regard, the relevant provisions in Section 2, Chapter 1 of Part I of these Guidelines shall apply *mutatis mutandis*.

## 3. Formality Examination of Other Documents

In this regard, the relevant provisions in Section 3, Chapter 1 of Part I of these Guidelines shall apply *mutatis mutandis*.

## 4. Examination of Application for Which No Patent Right Shall Be Granted

The relevant provisions of Chapter 1 of Part II of these Guidelines shall apply to the examination in accordance with the provisions of Article 5 and Article 25 of the Patent Law.

## 5. Examination of Subject Matter Protected by Patent for Utility Model

In this regard, the examination shall be made in accordance with the provisions of Rule 2.2 of the Implementing Regulations of the Patent Law.

### 5.1 Patent for Utility Model Protects Product Only

In accordance with the provisions of Rule 2.2 of the Implementing Regulations of the Patent Law, the patent for utility model protects only products that are objects manufactured by industrial methods and occupy a certain space.

All the processes (including the use of a product) and the objects which are naturally existing and not man-made are not protected by the patent for utility model.

The processes referred to above include the manufacturing processes, methods of use, methods of communication, processing methods, computer program or the method of applying a product to a specific purpose, etc.

For example, a process of manufacturing a kind of gear, a method of dust-eliminating in the workshop, a data processing method and naturally existing Yuhua stones, etc., all of them shall not be protected by the patent for utility model.

It should be noted that:

(1) Even if the title of the claimed subject matter of the application is a product, if the entire technical features in the independent claim constitute a process or a process in substance, it is not a product protected by the patent for utility model. For ex-

ample, a kind of wood toothpick which is characterized in that by processing the said wood toothpick into a predetermined shape, immersing the said wood toothpick in medical bactericide for 5 – 20 minutes, then taking it out and airing it.

(2) If the shape and structure features of a product were described in the preamble portion of the independent claim and only process feature was described in the characterizing portion, the examiner shall determine whether or not the part of the utility model which has made contributions to the prior art contains features of the shape or the structure of a product. If there are features of the shape or the structure, the applicant shall be notified to correct the claims so as to include these features in the characterizing portion of the independent claim. If there are no such features, that utility model is a product with identical shape and structure manufactured by different process, and may not be protected by the patent for utility model.

#### Rule 2.2

#### 5.2 Shape of Product

The shape of a product refers to certain space – shape possessed by the product, which can be observed from the outside.

The technical solution relating to the shape of a product may be the solution relating to either the three – dimensional shape of the product, such as the improvement of the shape of a cam or a cutter, or the two – dimensional shape of the product, such as the improvement of the cross – sectional shape of a profiled bar.

The product which has a non – fixed – form, such as the substance or material in gaseous state, liquid state, powder state or particle state, cannot be regarded as the shape feature of a product.

It should be noted that:

(1) The biological shape or naturally – formed shape cannot be regarded as the shape feature of a product. For example, neither the shape of a miniature tree growing in a potted landscape nor the shape of naturally – formed rockery can be regarded as the shape feature of a product.

(2) A non – fixed shape formed by means of arrangement or stacking can not be regarded as the shape feature of a product.

(3) A product may have a certain technical feature of a non – fixed shape, such as the substance in gaseous state, liquid

state, powder state or particle state, provided that it is defined by the structure feature of the product. For example, it is permitted to have ethyl alcohol of non – fixed shape included in the technical solution relating to the shape or structure of a thermometer.

(4) The shape of a product may be a space – shape which exists under specific circumstances, such as an ice – made cup with a certain novel shape, or a parachute, etc. . Again, for example, a kind of steel band packing case for transporting and storing the steel band, which consists of internal steel ring, external steel ring, binding band, external protection plate, and waterproof composite paper. However, when it is used to pack the steel band correlatively in accordance with the technical solution, a fixed space – shape will be formed, which is not arbitrary. Such a packing case may be protected by a patent for utility model.

(5) A product of raw material which has only changed its composition, such as plate materials and bar materials, the plate shape or bar shape has not made any contribution to the prior art, so it cannot be regarded as the shape feature of a product. However, if a special function or effect can be achieved from a change in its shape which is different from the previous ones, such shape may be protected by the patent for utility model.

## Rule 2.2

### 5.3 Structure of Product

The structure of a product refers to the arrangement, organization and correlation of each part of a product.

The structure of a product may be either the mechanical structure or the circuit structure. The mechanical structure refers to the relative position relationship, coupling relationship, and necessary mechanical matching relationship and so on of the components or parts of which the product consists. The circuit structure refers to the fixed connection relationship amongst the components or elements devices of which the product consists.

The composite layer may be regarded as the structure of the products. Carburized layer, oxide layer and so on of a product belong to the structure of the composite layer.

The molecular structure and component of a substance do not belong to the product structure protected by a patent for utility model. Therefore, if the improvement of the food, beverage,

flavorings and pharmaceuticals involves only changes in their chemical composition, component or content and does not involve the structure of the product, they are not objects protected by a patent for utility model. If the product claimed to be protected by a patent for utility model has only different molecular structure or component as compared with the prior art, nor shall it be protected by a patent for utility model. For example, a cup made of plastics with the same shape as a glass cup, or a welding rod which has only a change in the composition of soldering paste, shall not be protected by a patent for utility model.

**Rule 2.2****5.4 Technical Solution**

The technical solution refers to the collection of technical features that are adopted by the applicant to solve a technical problem in observance of the Laws of nature.

If the designing of the shape of a product or of the pattern, color, character, symbol, chart or the combination thereof in the appearance of a product does not solve any technical problem, it shall not be protected by the patent for utility model; for example, a can opener with the shapes of twelve animals representing the twelve Earthly Branches, used to symbolize the year in which a person is born; an architectural plane scheme; chess or cards and their like, of which the distinguishing features are just in their pattern design, like ancient poetry cards, chemical poker cards and so on.

**Rule 2.2**  
**Art. 22.4****5.5 Technical Solution Fit for Practical Use**

In this regard, the relevant provisions of Chapter 5 of Part II of these Guidelines shall apply.

**Rule 2.2****5.6 New Technical Solutions**

An obviously not new technical solution refers to an utility model seeking protection which has been disclosed before the date of filing (or the priority date where priority was claimed), or which is an equivalent alternate or a simple combination of the prior Art. Any technical solution belonging to any of the following circumstances may be readily regarded as obviously not new technical solutions without searching:

- (1) where there are identical products which have been publicly sold or used;
- (2) where there is an earlier application of identical contents



published in the Chinese Patent Gazette;

(3) where the identical contents have been published in publications;

(4) where the applicant has claimed the grace period of not prejudicing the novelty of its/his application and has submitted supporting materials, but the supporting materials are found not in conformity with the requirements;

(5) where the technical solution is a simple combination of the prior art and does not produce any new technical effect, e. g. a waterproof poster board consisting of a plastic bag with the poster board placed therein;

(6) where any of the elements of a technical solution is changed, but the technical effect produced by the solution remains the same as or similar to the prior art, e. g. a mini - billiard table which has the identical shape and structure as one of the prior art but with the size reduced to one half.

#### **5.7 Medical Appliance Which Directly Affects Human Body by Electricity, Magnetism, Light, Sound, Radiation or the Combination thereof**

The medical appliance, which directly affects human body by electricity, magnetism, light, sound, radiation or the combination thereof has important bearing on the health and safety of persons. Therefore, the grant of patent right for utility model to such kind of product is only a decision made according to the requirements of preliminary examination. It does not mean that the product has met the conditions for being granted the market approval as required. The patentee should go through the necessary formalities of examination and approval according to the relevant laws and regulations before working the patent.

#### **6. Check on Description**

Check on the description shall be made in accordance with Article 26.3 of the Patent Law and Rule 18 of the Implementing Regulations of the Patent Law, including the following:

##### **Art. 26.3**

(1) The description shall set forth the utility model in a manner sufficiently clear and complete so as to enable a person skilled in the relevant field of technology to carry it out, which means that such a person can, without creative effort, carry out the technical solution of the utility model, solve the technical problem and achieve the expected technical effects according to

the contents of the description;

Rules 18.1 – 2

(2) The description shall state the title of the utility model, which shall be the same as that appearing in the request. The description shall include the technical field, background art, contents of the utility model, description of figures and mode of carrying out the utility model, and the title of each part shall be indicated respectively;

Rule 18.1(3)

(3) In the part of the contents of the utility model, it shall disclose the technical problem to be solved by the utility model, the technical solution adopted to solve the problem, and the advantageous effects of the utility model as compared with the prior art. These three parts shall be logical. That means, the description of the technical solution shall solve the technical problem and the advantageous effects shall be naturally obtained from such a technical solution;

Rule 18.1(5)

(4) In the part of the mode of carrying out, at least one optimally selected mode of carrying out the utility model shall be stated, and it shall be described with reference to the drawings;

Rule 18.3

(5) In the description the standard terms shall be used, the wording should be clear, the technical terminology adopted should be accurate to express the technical solution of the utility model. The description shall not contain such references to the claims as "as described in claim XX", nor shall it contain commercial advertising;

(6) The text of the description may contain chemical or mathematical formulae and charts, but no drawings, including flowchart, block diagram, diagram of curves and phase diagram, etc., which may be used as the drawings of the description only.

## 7. Check on Drawings of Description

In accordance with Rule 19 of the Implementing Regulations of the Patent Law, the Checking of the drawings of description shall including the following:

(1) No engineering blueprint or photos shall be used as drawings;

(2) Drawings must be executed by drawing instruments in accordance with the criterion of cartography. No frame line is allowed around the figures. Graphic line and outgoing line shall be in black, uniformly thick and well – defined. Drawings may not be executed by pencil, ball – pen, color pen, and no color is al-

- lowed in the figures;
- Rule 19.1 (3) The figures shall be numbered and arranged consecutively in Arabic numerical order as "Fig. 1", "Fig. 2";
- Rule 19.2 (4) The distinctness and scale of the drawings shall be as such that a reproduction with a linear reduction in size to two-thirds would still enable all details to be clearly distinguished;
- Rule 19.3 (5) The identical reference signs shall be used for the same spare parts and it shall be the same as appearing in the text of the description. The reference signs of the drawings mentioned in the description shall not be absent from the drawings;
- (6) Where there is more than one sheet of the drawings, the sheets shall be consecutively numbered in Arabic numerals;
- Rule 19.4 (7) The drawings shall not contain any other explanatory notes, except indispensable words which shall be in Chinese; where it is necessary to have the words in foreign language, the foreign words should be in brackets by the side of the Chinese translation;
- (8) The structure diagram, logic diagram and flowchart shall have necessary words and symbols contained in its frame, which shall be typed, or neatly and distinctively written in imitation Song typeface or formal script;
- (9) The identical scale shall be adopted in the same figure. An additional figure of partial enlargement may be added in order to make certain part of the figure shown distinctively.

## 8. Check on Claims

In accordance with Article 26.4 of the Patent Law and Rule 20 – Rule 23 of the Implementing Regulations of the Patent Law, the checking of the claims shall include the following:

- Rule 20.1 (1) The claims shall define clearly and concisely the matter for which protection is sought in terms of the technical features of the utility model;
- Rule 21.2 (2) An independent claim shall outline the technical solution of a utility model. Except where it is required to be expressed in another form, the independent claim shall contain a preamble portion and a characterizing portion. The preamble portion shall indicate the title of the subject matter of the technical solution of the utility model seeking protection, and those necessary technical features which the subject matter of the utility model share with the most related prior art. The characterizing portion shall state, in such words as "characterized in that..."
- Rule 22.1

or in similar expressions, the technical features of the utility model which distinguish it from the most related prior art;

Rule 21.3

Rule 23.1

(3) A dependent claim shall, by additional technical features, further define the claim that it refers to. It shall contain a reference portion and a characterizing portion. The reference portion shall indicate the serial number(s) of the claim(s) referred to, and the title of the subject matter, which is the same as that appearing in the independent claim. The characterizing portion shall state the additional technical features of the utility model;

Rule 22.3

(4) A utility model shall have only one independent claim, which shall precede all of the dependent claims relating to the same utility model;

(5) There shall be no technical features in the claim which are not to be protected by the patent for utility model, e. g. a technical feature relating to a process of manufacturing or a method of use of the product;

(6) The claims shall not include any feature that does not produce any technical effect;

(7) The contents which are stated in the claims but not in the description shall be added to the description;

(8) The claims shall state the features of shape or structure of a product. A certain shape or structure of a product may be defined by a feature of process only if the description of the shape or structure of a product is made clearer when it is defined by such process;

(9) The claim shall avoid using, as far as possible, any feature of function or effect to define the utility model. The characterizing portion may not state the function of the utility model alone. Only if the utility model cannot be defined by the feature of structure, or, if it is defined by the feature of structure, it is not so clear as it is defined by the feature of function or effect;

(10) The claim may not contain any sentences the technical meaning of which is ambiguous or uncertain.

Moreover, the claims shall be in conformity with the following formality requirements:

(1) Each claim shall consist of one sentence and the full stop may be used only at the end of each sentence. Each claim shall be expressed either in one natural paragraph, or in several lines or sub – paragraphs in one natural paragraph. Only a comma or a semicolon may be used at the end of the line or sub –

- paragraph where it is necessary. The sequence number may be placed before the line or subparagraph;
- Rule 20.2 (2) No title shall be used in claims;
- (3) Where there are several claims, they shall be numbered consecutively in Arabic numerals;
- Rule 20.3 (4) The claims may contain chemical or mathematical formulae but no drawings. They shall not, except where it is absolutely necessary, contain such references to the description or drawings "as described in part. . . of the description", or "as illustrated in Figure. . . of the drawings". The tabulation may be contained only when it is absolutely necessary;
- Rule 20.4 (5) In order to facilitate understanding of the technical solution described in the claims, the technical features mentioned in the claims may make reference to the corresponding reference signs in drawings of the description. Such reference signs shall be included after the corresponding technical features and placed in parenthesis. The reference signs shall be the same as those that appear in the drawings of the description;
- Rule 23.2 (6) A dependent claim shall refer only to a previous claim or claims. A multiple dependent claim referring to two or more previous claims shall refer to such claims in the alternative only, and shall not serve as a basis for any other multiple dependent claim.

## 9. Check on Abstract

- Rule 24 In accordance with Rule 24 of the Implementing Regulations of the Patent Law, checking of the abstract shall including the following:
- (1) The abstract shall indicate the title, the gist of the technical solution and the principal use or uses of the utility model, especially the technical features which represent the improvement of the shape or structure of the utility model as compared with the prior art. The abstract shall not be written as a commercial advertisement or an introduction of the product of a purely functional nature;
- (2) The abstract shall have no title. It may be written consecutively;
- (3) The abstract may contain chemical or mathematical formulae;
- (4) The whole text of the abstract shall contain not more than 300 Chinese characters;

(5) The abstract shall contain a figure which is selected by the applicant from the drawings of the description.

#### 10. Check on Corrected Documents

Check on the application documents for a patent for utility model shall be conducted in accordance with Article 33 of the Patent Law.

Rules 51.2 –3

The applicant may, on its/his own initiative, make amendments to the application documents of a patent for utility model within two months from the date of filing. The applicant may also amend the application documents in response to the Office's notification of its opinion after checking the application or notification of correcting the application documents in compliance with the requirements stated in the notification.

Art. 33

The amendments to the application documents of a patent for utility model may not go beyond the scope of the disclosure contained in the initial description and claims.

If the applicant when amending the application documents introduces any contents or immediate equivalents which cannot be directly derived by a person skilled in the art from the initial description and claims, such amendment shall be regarded as having gone beyond the scope of the disclosure contained in the initial description and claims.

If the applicant deletes one or more features from an application, it may also lead to going beyond the scope of the disclosure contained in the initial description and claims.

If any technical feature which is included in the initial claims but not described in the initial description is introduced into the description and its contents is extended in description, such amendment shall be regarded as going beyond the scope of the disclosure contained in the initial description and claims.

If any technical feature which is contained in the initial drawings but not stated in the initial description and claims has been introduced into the description, and some technical contents which cannot be directly derived from the initial drawings have been added, such amendment shall be regarded as going beyond the scope of the disclosure contained in the initial description and claims.

It should be noted that:

(1) The correction of obvious mistakes shall not be regarded as going beyond the scope of the disclosure contained in

the initial description and claims. "Obvious mistakes" 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;

(2) Any structure feature, which can be obviously seen from the drawings and has only one possible explanation, may be introduced into the description and included in the claims.

#### 11. Check on Requirement of Unity

The check on the requirement of unity of an application for a patent for utility model shall be conducted in accordance with the provisions of Article 31.1 of the Patent Law and Rule 35 of the Implementing Regulations of the Patent Law.

"Two or more utility models which may be filed as one application for a patent for utility model" refers to two or more independent claims of products which belong to a single general inventive concept but cannot be included in one claim.

#### Rule 35

Two or more independent claims of products which cannot be included in one claim may be regarded as belonging to a single general inventive concept, if they are in conformity with one of the following requirements:

(1) They possess one or more of the same specific technical features and solve the same technical problem;

(2) They are two or more products which are interrelated or form a complete set and possess corresponding special technical features.

In respect of the principles of examination and examples of the methods of judging unity, the provisions of Section 2.2.2.1, Chapter 6 of Part II of these Guidelines should be consulted.

In respect of the checking of unity of dependent claims, the relevant provisions of Sections 2.2.1(5) and 2.2.2.3, Chapter 6 of Part II of these Guidelines should be consulted.

Where two or more subject matters seeking the protection of a utility model patent in one application are obviously not in conformity with the requirement of unity, the Office shall notify the applicant that, the claims should be divided into two or more groups in accordance with the requirement of unity, and the applicant is invited to keep one group of claims and delete the others within the specified time limit. Where no response is made by the applicant within the time limit, the applicant shall be notified that the patent application is deemed to have been with

drawn. If the applicant refuses to make amendments to its/his application without any justified reason, the application shall be rejected. If the applicant deletes the claims which are not in conformity with the requirement of unity, the checking of the patent application shall be conducted in accordance with the provisions of "checking of correcting documents" in Section 10 of this Chapter. It should be noted that after deleting the claims which are not in conformity with the requirement of unity, the title of the utility model may have to be changed. Should this happen, the title shall be changed in accordance with the formalities required by the procedure of change in the bibliographic data. It is up to the applicant whether or not it/he files a divisional application for the deleted claims. The examiner shall not make any suggestion.

## 12. Check on Divisional Application

Rule 42.1

Rule 54.1

Where an application for a patent for utility model contains two or more utility models, the applicant may, either before the receipt of the notification to grant the patent right for a utility model or within two months from the date of receipt of the said notification, submit a divisional application. However, where the initial application has been rejected and the rejection has taken effect, or where it has been withdrawn or is deemed to have been withdrawn and the right has not been restored, no divisional application may be submitted.

Rule 42.2

If the Office finds that an application for a patent for utility model is not in conformity with the provisions of Article 31.1 of the Patent Law and Rule 35 of the Implementing Regulations of the Patent Law, it shall invite the applicant to amend its/his application within a specified time limit. The applicant may, upon having removed the defect which is not in conformity with the requirement of unity of the initial application, submit a divisional application to the Patent Office before the expiration of two months from the date of receipt of the notification to complete the formalities of registration.

The two kinds of divisional applications mentioned above shall be checked in respect of the following matters of their initial application:

(1) Whether or not the initial date of filing stated in the request of the divisional application is correct;

(2) Whether or not the applicant of the divisional application



is the same applicant of the initial application. If they are not the same person, whether or not a document certifying the transfer of the right is furnished. Besides, whether or not the inventor is the same inventor or part of the inventors of the initial application;

(3) Whether or not a copy of the initial application documents is submitted; where the right of priority is claimed, whether or not a copy of the priority documents of the initial application is submitted. Where the initial application is an international application, and a copy of the priority documents of the initial application is not required, a copy of the priority documents shall not be required for the divisional application;

(4) Before the filing date of the divisional application, whether or not the initial application has been rejected and the rejection has taken effect, or the initial application has been withdrawn or is deemed to have been withdrawn and the right has not been restored. Whether or not the date of filing the divisional application is before the expiration of two months from the date of receipt of the Patent Office's notification to grant the patent right and complete the formalities of registration.

Where any of the requirements referred to in item (1), item (2) or item (3) is not complied with, the applicant shall be invited to make necessary corrections within a specified time limit. Where no correction is made within the time limit, the divisional application shall be deemed to have been withdrawn, and the applicant shall be notified accordingly.

Where the applicant files a divisional application later than the expiration of the two-month time limit for completing the formalities of registration, or the initial application has been withdrawn or is deemed to have been withdrawn and the right has not been restored, or the initial application has been rejected and the rejection has taken in effect, the applicant shall be notified that the divisional application is deemed not to have been filed.

The various prescribed time limits for the divisional application, e. g. the time limit for submitting certifying documents of priority and so on, shall be counted from the initial date of filing. If any time limit has expired, the applicant may go through various formalities within two months from the date of filing of the divisional application. Where no formalities have been gone through within the time limit, the divisional application shall be

deemed to have been withdrawn, and the applicant shall be notified accordingly.

The various fees required to be paid for the divisional application shall be the same as for a new application. Where the time limit for paying any fee has expired, the applicant may make up the payment within two months from the date of filing of the divisional application. If any fee is not paid or not paid in full, the divisional application shall be deemed to have been withdrawn, and the applicant shall be notified accordingly.

#### Rule 43.1

The divisional application of a utility model shall not go beyond the scope of disclosure contained in the initial description and claims. Therefore, the examiner shall check the divisional application with reference to the initial description and claims. If the contents of the divisional application for a patent for utility model go beyond the scope of disclosure contained in the initial description and claims, the Office shall invite the applicant to make correction, that is, to delete the part which goes beyond the scope of disclosure contained in the initial description and claims. If the applicant refuses to make correction without any justified reason, the divisional application shall be rejected under Rule 43.1 of the Implementing Regulations of the Patent Law. The initial date of filing may be retained, if the divisional application for a patent for utility model does not go beyond the scope of the disclosure contained in the initial description and claims. The criteria of checking and the checking procedure of the divisional application are completely the same as that of a new application.

#### 13. Check on Priority Claim

In this regard, the provisions of Section 3.2, Chapter 1 of this Part shall apply.

#### 14. Check on Principle of First-to-File

During the procedure of preliminary examination, the examiner shall not check whether or not any application for a patent for utility model is in conformity with the provisions of Article 9 of the Patent Law, unless the examiner knows that two or more applicants have filed patent applications for the identical invention – creation when the application enters the procedure of the preliminary examination.

During the procedure of preliminary examination, the exam-

iner shall not check whether or not any application for a patent for utility model is in conformity with the provisions of Rule 13.1 of the Regulations, unless the examiner knows that a patent right has been granted for an identical invention – creation.

## **15. Procedure of Preliminary Examination**

### **15.1 Preparations for Check**

When the examiner receives an application for a patent for utility model, he/she shall first check the file of the application. Where the file is not in conformity with the requirements of starting the procedure, he/she shall not proceed to check it. It shall be returned to the management department of the file of the application for patent for utility model to make correction. The necessary requirements for starting the procedure of checking include the following:

(1) Documents: An application for a patent for utility model which enters the procedure of preliminary examination for the first time shall meet the requirements of Article 26.1 of the Patent Law and Rule 39 of the Implementing Regulations of the Patent Law, that is, the file must contain a request, a description (including drawings) and one or more claims of the application for a patent for utility model. The procedure of preliminary examination shall not start if any of the said documents is missing in the file, or the file contains any other document which does not belong to the same utility model. Where there are not enough copies of the documents in the file, it may be corrected during the procedure of the preliminary examination. The examiner shall also check whether or not there is any page missing from the documents of the first binding clip in the file folder or gazette pouch. If a page is missing from one of them, the correction may be made in the procedure of the preliminary examination. If the same page is missing from both of them, the procedure of the preliminary examination shall not start as well. Where the documents are not in the correct order, the examiner shall correct it.

In other procedures of the checking, the examiner shall check whether or not the documents submitted by the applicant belong to that same patent application.

(2) Fees: The examiner shall check the receipts or the record of the payment in the file as required by Rule 90 of the Implementing Regulations of the Patent Law and the relevant provisions on the amount of the fees. The examiner shall not start the

procedure of the preliminary examination if the fees are not paid or not paid in full.

### 15.2 Requirements of Check

In accordance with Rule 44.1 of the Implementing Regulations of the Patent Law, during the procedure of the preliminary examination of the application for a patent for utility model, the examiner shall, besides checking whether or not it contains the documents as provided in Article 26 of the Patent Law and other necessary documents, and whether or not those documents are in the prescribed form, check the matters provided in Rule 44.1 (2) of the Implementing Regulations of the Patent Law.

#### 15.2.1 Principles of Check

The examiner shall comply with the following principles in the procedure of the preliminary examination:

(1) Proceeding to check in proper order: Except for some special circumstances, the examiner shall proceed to check in order of the date of filing of the patent application for utility model or the time of receipt of the file of the patent application by the examiner, and ensure the procedure of the preliminary examination going on smoothly. he/she shall avoid keeping application files which have more defects or difficult problems long in his/her hands. "Special circumstances" refers to those circumstances in which the applicant requests by writing to the Office to check its/his application earlier or to defer the checking and the request is approved by the Commissioner of the Office. Under such circumstances, the examiner shall include the written request in the file for future reference.

(2) Principle of checking by means of writing: During the procedure of the preliminary examination, the checking shall be conducted on the basis of written documents which shall be included in the file. Except for the obvious clerical mistakes and symbol mistakes having no relation with any right, which may be corrected by the examiner *ex officio* under Rule 51.4 of the Implementing Regulations of the Patent Law, the examiner shall invite the applicant to make other corrections by replacement sheets. The original page shall be included in the file and not to be returned to the applicant. Where it is necessary to invite the applicant outside Beijing of an application to come for an interview or for a demonstration, it shall be reported to the director of

the competent division. Only upon the approval of the director, shall the invitation be sent to the applicant. Approval by the director is also required when it is necessary for the applicant to submit a sample of the invention – creation.

(3) Principle of burden of Producing Evidence: In the course of the preliminary examination of the application for a patent for utility model, it is necessary for the Office to possess sufficient legal basis and real facts before making a decision to reject an application. Arbitrary decision is not permitted. Especially when the relevant reason for rejection relates to any of the events as provided for in Section 5.6 of this Chapter, the decision shall clearly indicate the time and place of the public sale or use of the identical product before the filing date, or the name of the publication and its publishing date, where necessary, a copy with the relevant contents shall be appended.

(4) Principle of hearing: During the procedure of the preliminary examination of the application for a patent for utility model, the applicant has the right to submit its/his observations, requests and propositions. Before the Office makes any decision to reject an application, the applicant should be informed of the reasons for rejection and their supporting evidence, and it/he is invited to submit its/his observations. The reasons for rejection in the Office's decision shall not include any new reason and/or any new evidence which have not been brought to the attention of the applicant.

(5) Procedure – saving Principle: The examiner shall comply with the procedure of the preliminary examination for the application for a patent for utility model and shall complete the examination in the shortest procedure. Where any application shall be rejected, it is not necessary for the examiner to conduct the formalities checking in respect of that application and invite the applicant to correct the defects of that application, so as to save time and labor of the examiner and the applicant.

### 15.2.2 General Provisions

The procedure of the preliminary examination of an application for a patent for utility model shall be completed by one examiner who shall be responsible for the checking of that application. The seal of the examiner shall be affixed on the cover of the file and on each notification sent to the applicant. Where the examiner must be changed in the course of the preliminary exami-

nation, from the date of his/her taking over the work, the successor shall affix his/her seal on the cover of the file and on each notification. Such change of the examiner shall be approved by the leader at a higher level. Any examiner may not proceed to do checking in a name other than his/her own name.

When an application for a patent for utility model is to be rejected, the rejection shall be approved before sending out. In the procedure of reexamination of that application, the initial examiner's observations of the request for reexamination (the pre-reexamination observations) shall be approved by the director of the examination department concerned and the seal of that director shall be affixed on the observations.

The checking of the application for a patent for utility model shall be made by the examiner in the Office. Where there are problems in respect of an application which can be solved only after due investigation on the spot, the investigation may be conducted after the request of the applicant is approved by the director of the examination department concerned. The Office shall bear the expenses of the investigation.

The file of the patent application shall truly reflect the whole process of the checking. Nobody may change the procedure of the preliminary examination and alter the records of the procedure of the checking on the cover of the file or replace the documents in the file. Once any document has been stored in the file in the process of checking, it may not be returned to the applicant. Where any document is to be sent to the applicant, only the duplicate shall be sent to the applicant while the original shall be stored in the file. If the original document should be returned to the applicant, e. g. the original script of a business license, its duplicate shall be stored in the file.

Where it is difficult for an examiner to make a conclusion of checking in respect of an especially difficult application, it shall be submitted to the division or department of examination concerned for discussion. Where it is necessary, the director of the division or the department may organize a special meeting to discuss the relevant application. "Especially difficult application" refers to the application in which the technology contained is special and complicated, or the question to which the application relates has no provisions in these Guidelines, so that it is difficult to decide whether or not that application should be granted a patent right for utility model.

### 15.2.3 Requirements of File

#### (1) Number of copies of the notifications

Each of the various notifications issued by the Office shall have two copies, one shall be sent out after it is signed and sealed by the examiner, and the other one shall be kept in the file.

#### (2) Binding of the documents in the file:

The first record folder shall contain each of the copies of the documents submitted by the applicant on the date of filing, bound in the following order: a request, an abstract of the description, a figure of the abstract, claims, a description (including drawings) of the application for a patent for utility model, certified priority documents, reference materials for the checking, a power of attorney of the patent agency, a request for a reduction or postponement of the payment of fees, certifying documents for non – service invention and other certifying documents, and the notification of accepting the application.

The second record folder shall contain the duplicates of the notifications issued by the Office and the documents submitted by the applicant after accepting the application, which are bound in the following order: the documents submitted by the applicant on its/his own initiative, notifications from the Office, and the responses from the applicant. Where the Office sent many notifications and the applicant made many responses, the documents shall be bound in the chronological order. The order of each two – way communication is: the notification from the Office, the document taken out from the gazette pouch by the examiner, the response from the applicant, and the replacement sheet submitted by the applicant.

A complete set of documents of the gazette shall be included in the gazette pouch in such order: an abstract of the description, the figure to be included in the abstract, claims, a description and its appended drawings.

After going through the formalities of making changes in the bibliographic data during the procedure of the preliminary examination, the examiner shall include a copy of the notification to make changes in the bibliographic data in the first records folder, and placed it before the request of a patent for utility model.

#### (3) Handling documents

In the procedure of the preliminary examination of the application for a patent for utility model, the examiner shall check the

kinds and number of copies of the documents according to the check list in the request, check the payment of fees according to the receipts or records, conduct the formality checking in respect to the documents in the first record folder and the checking of obvious substantial defects in respect to the documents in the gazette pouch.

The examiner cannot add, delete or alter the initial application documents in the first record folder. All of the defects, if any, shall be corrected by the applicant. With regard to the documents in the gazette pouch, the examiner may make amendments to the abstract and to certain reference signs in the figure to be included in the abstract. However, when the Office sends a notification to grant the patent right, the examiner should ensure that the claims, the description and the drawings in the gazette pouch be clear, complete and in conformity with the requirements of the patent gazette, and free from any reference marks which were made by the examiner for the purpose of checking the application.

The examiner shall affix his/her personal seal on the cover of the file, and affix the seal of corresponding procedure of checking when each of the procedures is completed. When the notification to grant the patent right is sent, the examiner shall check the documents in the gazette pouch, fill in the list of the contents of the gazette pouch and affix his/her seal.

On the envelope, the examiner shall write the postal code, the name and address of the addressee, filing number, name of the department (the addressor) and the code number of the notification. The filing number, the title of the utility model and the names of all of the applicants shall be clearly indicated in the notification, and no abbreviated form should be used. In each steps of the procedure only one notification shall be sent out. Where a patent agency has been appointed, the addressee shall be the designated patent agent in that agency. Where no patent agency has been appointed but a liaison person has been designated, the addressee shall be the liaison person. Where no such liaison person has been designated, the addressee shall be the applicant. Where there are many applicants and a representative has been designated, the addressee shall be the representative. If no representative has been designated, the first applicant shall be the addressee.

Rule 5.1 -2



#### 15.2.4 Writing of Notification and Decision of Rejection

In the course of the preliminary examination of an application, the examiner shall invite the applicant in writing to go through various formalities. The various notifications shall be written from the point of view of a third person and not from the point of view of the examiner, i. e., "the applicant thinks that this application...", or "the examiner holds that this application...", and not "I hold that...". The notification shall include only contents relating to the application for a patent. Anything which has nothing to do with the patent application, especially those which may injure the reputation or personality of the applicant, may not be included. As a document which has legal effect, the notification shall be carefully and strictly worded; its meaning shall be clear, and its argument shall be well founded. The notification must not be loaded down with trivial details.

The notification concerning the final decision of a patent application (generally including the notification of the decision to grant the patent right for utility model, notification of the decision to reject the application, notification of the decision that the application is deemed to have been withdrawn, and notification of the application being withdrawn on the applicant's own initiative) shall be sent to all of the applicants of that application.

The notifications used in the course of checking the application for a patent for utility model include the notification of the decision to grant the patent right for utility model and to inform the applicant to go through the formalities of registration, the notification of the decision to reject an application, the notification of the decision that the application is deemed to have been withdrawn, the notification of the Patent Office's opinion after checking the application, the notification to make correction, the notification to check the application, the notification to hold an interview, records of interview, the notification to check the priority claim, and appendix to the notification. Among them, the notification of the decision to reject an application and the notification of the Office's opinion after checking the application shall state the reasons for which the decision is made.

The requirements for some of the notifications are as follows:

##### (1) Notification to make corrections

The notification to make corrections shall, except for the bibliographic data, include the following contents in its part of

the reasons:

(i) It shall point out the document to which the notification relates and at what time it is delivered or mailed;

(ii) It shall point out the document's specific defects and its non-compliance with the provisions of the Patent Law or the Implementing Regulations of the Patent Law or other relevant provisions;

(iii) It shall clearly and specifically state the opinions the examiner is inclined to give and the suggestions he/she may make, so that the applicant may understand his/her intention and eliminate the defects in a most expeditious manner;

(iv) It shall suggest the kind and number of copy of the document which is used to correct the defects;

(v) It shall specify the time limit within which the defects should be corrected;

(vi) The notification may use an appendix in which to inform the applicant of the defects which should be corrected, and a sample copy of the Office's correction may be appended for the applicant's reference.

(2) Notification of the Patent Office's opinion after checking the application

The notification of the Patent Office's opinion after checking the application shall, except for the bibliographic data, include following contents:

(i) It shall point out the title and the date of submission of the application document to which the notification relates;

(ii) It shall clearly and specifically point out the defects of the document, convincingly analyze them and indicate the provisions of the Patent Law, the Implementing Regulations of the Patent Law, or other relevant provisions with which the application document is not in conformity;

(iii) It shall state the opinion of rejection the Office is inclined to give in accordance with the provisions of the Patent Law or the Implementing Regulations of the Patent Law or other relevant provisions;

(iv) It shall specify a time limit within which the applicant should make its/his observations.

(3) Decision of rejection

The decision of rejection consists of the prescribed form and the text of the decision;

(i) The prescribed form: The bibliographic data, Article of

the Patent Law, Rule of the Implementing Regulations of the Patent Law or other relevant provisions on which the rejection is based, and the instructions for the subsequent procedure to be followed.

(ii) The text of the rejection includes brief of the case, reasons for rejection and the decision.

The part of the brief of the case shall contain the course of checking the application, and the facts existing in the application which require that it should be rejected. The purpose of this is to explain that the examiner conducted the checking fully in conformity with the procedure provided by the Patent Law.

The part of the reasons for rejection shall state in great detail the facts, reasons and legal basis on which the rejection is based. Where there are several reasons for which the application is required to be rejected, the examiner may put forward simultaneously all of them or only a part or one of them. However, the reason or reasons put forward must have been notified to the applicant. Otherwise the reason or reasons has to be first notified to the applicant in the form of the notification of the Office's opinion after checking the application. Where the rejection is made on the basis of a non-substantive reason, for example, a patent application does not meet the formality requirements after several notifications to make corrections, the decision may point out only the last corrected application in which there are still defects, but it is not necessary to make further analysis of the reasons for rejection. However, the applicant shall be entitled to have at least two opportunities for correction. Where the rejection is made on the basis of Article 26.3, 26.4, 31.1, or 33 of the Patent Law, or Rule 2.2 or Rules 18 to 23 of the Implementing Regulations of the Patent Law, the substantive defects of the application should be analyzed.

The part of the decision itself shall clearly indicate the Article of the Patent Law or the Rule of the Implementing Regulations of the Patent Law with which the application is not in conformity. It shall also indicate that the decision of rejection is made in accordance with Rule 44 of the Implementing Regulations of the Patent Law.

(4) Record of interview:

The record of interview shall, except for the bibliographic data, in its summary note down the issues discussed by the examiner and the applicant, and their respective opinions, and in

its conclusion state the examiner's opinion to deal with the application in accordance with the Patent Law, the Implementing Regulations of the Patent Law and other relevant provisions. The record shall take effect after it has been signed or sealed by both parties and affixed the special seal of examination. The record of interview after it takes effect is equivalent to the notification to make corrections or the notification of the Office's opinion after checking the application, therefore the examiner shall specify in the record of interview the time limit within which the defects shall be corrected.

#### **15.2.5 Requirements of Procedure of Preliminary Examination**

##### **(1) General statement**

In accordance with Rule 44.1 of the Implementing Regulations of the Patent Law, the preliminary examination of an application for a patent for utility model consists of two parts:

##### **(i) Formalities checking;**

(ii) Checking of obviously substantive defects (that is the checking of the matters provided in Rule 44.1 (2) of the Implementing Regulations of the Patent Law).

The relevant provisions of Part I, Chapter 1, Section 2 and Section 3 of these Guidelines shall apply to the formalities checking of the application for a patent for utility model, with reference to the relevant contents of Part V of these Guidelines. In respect of the checking of the obviously substantive defects of the application for a patent for utility model, Section 4 – Section 14 of this Chapter shall be consulted. Here are only the principal requirements of the procedure of the preliminary examination of the application for a patent for utility model.

##### **(2) Grant of the patent right**

Art. 40

Where it is found after the preliminary examination that the application for a patent for utility model complies with the requirements of the formalities checking and the checking of obviously substantive defects, the Office shall issue a notification of the decision to grant the patent right for utility model. The application for a patent for utility model for which a patent right may be granted includes the application which complies with the requirements of the preliminary examination without the necessity of correction and the application which complies with the requirements of the preliminary examination after defects being corrected. The notification to grant the patent right shall be made to all

of the applicants.

(3) Correction and Re – correction

Rule 44.1

Rule 44.2

Where an application for a patent for utility model has no substantive defects which may lead to rejection, but has some other defects which are not in compliance with the requirements of the Patent Law and the Implementing Regulations of the Patent Law and may be corrected in the course of examination, the applicant shall be notified to make necessary corrections.

Defects may either be corrected by the applicant on its/his own initiative, or be corrected by the applicant at the request of the Office.

Rule 51.2

Rule 51.3

In accordance with Rule 51.2 of the Implementing Regulations of the Patent Law, the applicant of an application for a patent for utility model may amend the application on its/his own initiative within two months from the date of filing. Usually, later than two months from the date of filing, the application for a patent for utility model has reached the stage of the preliminary examination, the applicant shall make necessary corrections in compliance with the Office's notification. If the applicant requests to make amendment to its/he application later than two months from the date of filing, the Office may decide, depending on circumstances, whether or not to accept the applicant's own amendment. For example, if the amendment is conducive to the preliminary examination of that application, the amendment may be accepted. Otherwise, it would not be accepted because they were submitted later than the time limit provided in Rule 51.2 of the Implementing Regulations of the Patent Law, and the applicant shall be notified accordingly. However, no matter the amendment is accepted or not, the amendment submitted by the applicant on its/his own initiative shall be kept in the file folder and shall not be returned to the applicant.

The matters which the Office requests to be corrected by the applicant include both matters of formality and obviously substantial defects. Matters of formality relate to the kinds, number of copies, use, filling in of the various forms and relevant certifying documents. Obviously substantial defects relate to the drafting of the description and claims, unity of application, amendment going beyond the scope of the disclosure contained in the initial description and claims, and so on.

When the applicant corrects its/his application at the request of the Office, if it/he has not corrected all of the defects in

the application documents, the Office may invite it/him to make correction again. However, in order to prevent the course of the preliminary examination from being drawn out, generally no more than three opportunities of correction would be given to an applicant. When the Office notifies the applicant to make correction for the third time, the notification should point out that if the third correction still does not comply with the requirements, the application shall be rejected in accordance with Rule 44.2 of the Implementing Regulations of the Patent Law.

When the applicant makes corrections at the request of the Office, it/he should correct its/his application within the time limit specified by the Office. If the applicant fails to make any response within the specified time limit, the Office shall notify the applicant that the application is deemed to have been withdrawn.

The applicant shall make correction in the form of amendments or other relevant corrected documents. If the corrected documents are the description and its drawings, the claims, and the abstract, two copies of each are required, if the corrected documents are other relevant documents, only one copy is required. The letter submitted by the applicant together with the corrected documents may be deemed as the amendments.

In accordance with Article 33 of the Patent Law, the contents of the applicant's amendment may not go beyond the scope of the disclosure contained in the description and claims submitted on the date of filing. Therefore, the examiner shall check the corrected description, drawings and claims with reference to the documents submitted on the date of filing.

(4) Notification of the Patent Office's opinion after checking the application and decision of rejection

Rules 44.1 -2

In the preliminary examination of the application for a patent for utility model, if the examiner finds that it does not contain the documents as provided in Article 26 of the Patent Law and other necessary documents, or it falls under the provision of Rule 44.1 (2) of the Implementing Regulations of the Patent Law, the Office shall notify the applicant of this opinion and invite it/him to state its/his observations or to correct its/his application within the specified time limit. If after the applicant made its/his observations or corrections, the defect pointed out in the notification has not been eliminated, the application shall be rejected.

The reason(s) for rejection may be one or two of the follow-

ing:

(i) After several times of correction the formality of the application documents or other necessary documents still does not meet the requirements, or the applicant refuses to make correction without any justified reason;

(ii) There are obviously substantive defects in the application documents.

A notification of the Patent Office's opinion after checking the application is an indispensable step before making a decision of rejection. In respect of the application which is intended to be rejected, the Office shall issue a notification of its opinion after checking to the applicant, inform it/him of the reasons for rejection and invite him or it to state its/his observations. Where the reasons for the intended rejection belong to the instance (i) mentioned above, it/he may, while making its/his observations, submit a copy of the replacement sheet of the new amendment at the same time. If the amendment meets the requirements, the Office shall grant the patent right. If it still does not comply with the requirements after several corrections, the Office shall reject the application. Where the reasons for the intended rejection belong to the instance (ii) mentioned above, if the observations of the applicant are tenable, and the formalities of the application meet the requirements, the Office shall grant the patent right. If the observations of the applicant are not tenable, or if they do not relate to the reasons for rejection, or they merely state that they do not agree with the reasons of rejection but without giving any convincing reason, the Office shall make a decision of rejection. If the applicant fails to state its/his observations or to make corrections within the specified time limit, the applicant shall be notified of the Office's decision that the application is deemed to have been withdrawn.

#### (5) Withdrawal of application

The applicant may withdraw its/his application for a patent for utility model at any time in the procedure of the preliminary examination. Where the application is filed by more than one applicant, the withdrawal shall be made by all of the applicants, and they all shall sign or seal the declaration of withdrawal. It is the right of the applicant to withdraw its/his patent application, and it is not necessary to give any reason for withdrawal. Once the declaration to withdraw the patent application takes effect, the applicant cannot withdraw the declaration.

The examiner only checks the formality requirements of the declaration to withdraw a patent application. If the declaration does not meet the requirements, the applicant shall be invited to make correction. If the declaration meets the requirements, it takes effect when the Office receives it. Once the declaration to withdraw takes effect, the examination of that application shall be concluded, and all documents submitted by the applicant relating to that application shall not be accepted thereafter.

(6) Request for an extension, application deemed to have been withdrawn and restoration of rights

Rule 42.2

Rule 44.2

If the applicant cannot make a response within the prescribed or specified time limit for justified reasons in the procedure of the preliminary examination of the application for a patent for utility model, the applicant may request for an extension of the time limit. If the applicant makes no response within the prescribed or specified time limit, and has not requested an extension of the time limit, the application shall be deemed to have been withdrawn. Where the application for a patent for utility model deemed to have been withdrawn since the applicant missed the deadline because of a justified reason or force majeure, the applicant may request the Office to restore its/his rights, in the case of justified reason within two months from the date of receipt of the notification from the Office, or, in the case of force majeure, from the date on which the impediment was removed, at the latest within two years immediately from the date of expiration. For the provisions of the request for extension and the restoration of an application being deemed to have been withdrawn, see the provisions in Sections 4, 5, and 6, Chapter 7 of Part V of these Guidelines. Where an application for a patent for utility model has been restored after being deemed to have been withdrawn, its examination shall continue from the point where the application is deemed to have been withdrawn.

Rule 7

#### **16. Pre – Examination and Continuation of Examination by Former Examination Department**

According to Rule 61 of the Implementing Regulations of the Patent Law, the examiner of the former examination department shall conduct an examination of the request for reexamination which was remitted by the Patent Reexamination Board, and issue a notification of opinions after examination within one month from the date of receipt of the remitted file. In respect of the requirements for the pre – examination by the former examination



department, see Section 5, Chapter 2 of Part IV of these Guidelines.

After the Patent Reexamination Board makes a decision to revoke the Office's decision rejecting an application, the examiner of the examination department who has made the decision of rejection shall continue to make examination of that application. In the course of the continuing examination, the examiner shall not, on the basis of the same facts and reasons, make a decision of rejection that are contrary to the decision of the Patent Reexamination Board.

### **Chapter 3**

#### **Preliminary Examination of Application for Patent for Design**

##### **1. Introduction**

Under Article 3 and Article 40 of the Patent Law, the Office receives and examines the application for a patent for design. Where it is found after preliminary examination that there is no cause for rejection of that application, the Office shall make a decision to grant the patent right for design, issue the certificate of patent for design, register and announce it. Therefore, the preliminary examination of application for a patent for design is an important procedure after receipt of an application for a patent for design and before granting the applicant a patent right for design.

##### **Rule 44.1**

The scope of the preliminary examination for an application for a patent for design is as follows:

(1) Whether or not the application contains the documents as provided in Article 27 of the Patent Law, and whether or not those documents comply with the relevant provisions of the Patent Law and its Regulations, especially whether or not the drawings or photographs of the design are in conformity with the requirements;

(2) Whether or not the application obviously falls under Article 5 of the Patent Law, or is not in conformity with the provisions of Article 18 or 19.1 of the Patent Law, or is obviously not in conformity with the provisions of Article 31.2 or Article 33 of the Patent Law, or of Rule 2.3, 13.1, or 43.1 of the Implementing Regulations of the Patent Law, or is not entitled to a patent right in accordance with the provisions of Article 9 of the Patent Law;

(3) Whether or not other documents relating to the application meet the relevant requirements stipulated in the Patent Law and its Regulations.

##### **2. Examination of Application Documents**

Article 27 of the Patent Law provides that, where an application for a patent for design is filed, a request, drawings or photographs of the design shall be submitted, and the product incorporating the design and the class to which that product belongs shall be indicated.

## 2.1 Request

The applicant shall use the request in the form that is currently prescribed by the Office.

### 2.1.1 Name of Product Incorporating Design

The name of the product incorporating the design shall be indicated in the request. It shall indicate briefly and precisely the product which seeks protection. It shall contain preferably 1 – 7 Chinese characters, at most not more than 15 Chinese characters.

The name of the product shall comply with the following requirements:

(1) The name of the product shall generally be in conformity with the name in the International Classification for Design.

(2) The name of the product shall be in agreement with the content of that design.

(3) The use of the following names shall be avoided:

(i) names containing the name of a person, a place, a company, a trademark, a code, a model or a historical age;

(ii) generic or abstract names, such as “stationery”, “cooking utensils”, “musical instruments”, “building articles” etc. ;

(iii) names containing the structure, function or effect of the product, such as “oil – saving engine”, “human body height – increasing shoe – pad”, etc. ;

(iv) names with specification or numerical unit of the product, such as “21 – inch Color TV set”, “one pair of gloves”, “a pair of chopsticks”, etc. ;

(v) names containing the shape or color of the product, such as “red coat”, “pyramid ruler”, etc. ;

(vi) names in shortening form, for example, “chessboard” shall not be named as “chess”, “toy car” shall not be named as “car”, etc. ;

(vii) names in foreign language;

(viii) names containing the contents of the design, for example, a “schoolbag” named as a “schoolbag with the pattern of a panda” or with the pattern of an animal or a plant.

### 2.1.2 Classification

The applicant shall, in the relevant column of the request of an application for a patent for design, indicate the class to which

the product belongs, i. e. the class of the product in the International Classification for Design. Where the applicant is not clear about the class to which the product belongs, it/he shall indicate the technical field to which the product belongs or the place the product is to be used.

#### 2.1.3 Creator

In this regard, the provisions concerning the inventor in Section 2.1.2, Chapter 1 of this Part shall apply *mutatis mutandis*.

#### 2.1.4 Applicant

In this regard, the provisions concerning the applicant in Section 2.1.3, Chapter 1 of this Part shall apply *mutatis mutandis*.

#### 2.1.5 Patent Agency and Patent Agent

In this regard, the provisions in Section 2.1.4, Chapter 1 of this Part shall apply.

### 2.2 Drawings or Photographs

According to the provisions of Rule 27.3 of the Implementing Regulations of the Patent Law, the applicant shall, in respect of the subject matter of the product incorporating the design which is in need of protection, submit the relevant views and stereoscopic drawings or photographs, so as to clearly show the subject matter for which protection is sought. Concerning the “relevant views and stereoscopic drawings or photographs”, so far as the product with a three – dimensional design is concerned, if the main points of the design of the product involve six sides, the applicant shall submit orthographic projection of six – side views; if the main points of the design of the product involve the view of one side or several sides only, the applicant may submit orthographic projection view and space diagram of the side concerned. So far as the product with plane design is concerned, if the main points of the design of the product involve the view of one side only; the applicant may submit the orthographic projection view of the relevant side only; if the main points of the design of the product involve the view of two sides, the applicant shall submit the orthographic projection views of the two relevant sides.

The titles of the six – side views are front view, back view, left view, right view, top view and upward view. The title of each

view shall be indicated under the relevant view.

#### 2.2.1 Size

In accordance with Rule 27.1 of the Implementing Regulations of the Patent Law, the size of the figure in the drawings or photographs submitted shall not be smaller than 3cm x 8cm (except for that of a long and thin article), nor larger than 15cm x 22cm. Moreover, a reproduction with a linear reduction in size to two – thirds should still enable all details of the outline of the product to be clearly distinguished.

#### 2.2.2 Drawings

Rule 120.1

The drawings shall be made in accordance with the State standards of technical drawing and mechanical drawing in black ink with the aid of drawing instruments. No pencil, crayon or ball – pen may be used. And no blueprint, sketching, mimeograph may be used.

#### 2.2.3 Photographs

The photographs shall be taken in accordance with the rule of orthographic projection. The outline of the photograph shall be clear. The highlight, shadow, or background object shall be avoided.

#### 2.2.4 Color

Where the design seeking protection contains color, drawings or photographs in color shall be submitted in duplicate. The drawings in color shall be made with paint that is fast and not likely to fade or run.

#### 2.2.5 Notification of Correction

Where the content of an application for a patent for design cannot be correctly determined from the indications of the request and drawings or photographs, the applicant shall be invited to make necessary corrections. The defects that may be corrected mainly refer to the following:

(1) where the method, state, purpose, etc., of the use of the product which incorporates the design is not clear, such as a schematic drawing, a city planning sketch.

(2) where the relation of projection of the views is wrong, such as the upside down direction of the view, or the reversed

direction of use of the sheets of the drawings or photographs of the design.

(3) where the content of the design cannot be correctly expressed because the drawings or photographs are not clear enough, or the size of the figure is too small, or there is a reflection of light, shadow or background object though the figure is clear.

(4) where the contents of the pattern, material or size of a product incorporating the design cannot be understood by a person skilled in the relevant field of the technology (for example, in the case of a type of anti-counterfeit mark, if it is an invisible pattern, the drawing of the design of the revealed pattern shall be submitted).

(5) where the design has several different states, but only one state is displayed in the views (for example, in the case of a folded chess case, its opening state is a chess case with a chess table, chessboard, but its folded state is a chess case, the respective views of different states of the chess case shall be submitted).

(6) where, in the drawings or photographs of the design, there are figures or words which should be covered and cannot be regarded as the specific content to be protected by a patent for design, such as the portrait of a person, trademark, symbol, well-known book, or a well-known building, or there are lines which should be deleted, such as a shadow line, indicative line, dotted line, central line or dimension line.

(7) where the views of a three-dimensional product have any of the following circumstances;

(i) the ratio of the various views is not consistent;

(ii) the drawings are not made in accordance with the method of making orthographic projection or the photographs are not made in accordance with the relations of orthographic projections;

(iii) where the main points of the design of the product involve six sides, there are not six-sided views, but excepting the following:

the back view may be omitted if it is identical or symmetrical with the front view;

the left view (or the right view) may be omitted if it is identical or symmetrical with the right view (or the left view);

the top view (or the upward view) may be omitted if it is i-

identical or symmetrical with the upward view (the top view);

the upward view may be omitted in the case of the large – scale mechanic apparatus, or mechanic apparatus with fixed position or the articles with bottoms not often be seen.

(8) where the view of a product with plane design has any of the following circumstances:

(i) the ratio of various views is not consistent;

(ii) the main points of the design of the product involve two sides, but there are not two sides views (however, if the back view is identical or symmetrical with the front view or there is no design in back view, the back view may be omitted).

(9) where, in the case of a long and thin product (such as the measuring rule or section bar), the middle part of the product is omitted in the drawing, but the double parallel dot dash lines or natural geosutures are not used.

(10) where the six – side views or two – side views cannot fully express the design, and no exploded view, sectional view, enlarged view or stereoscopic view, etc. which is necessary to fully express the design is submitted.

(11) where the section and the cut – off part of the sectional view has any of the following circumstances:

(i) no section line or the line is incomplete in the sectional view;

(ii) the dot dash line, symbol and direction showing the place of section is incomplete or even lack of them to indicate the cut – off position (however, it is not necessary to indicate the mark to express the cut – off from the central part).

(12) where there is an enlarged view of a certain part but the position of that enlarged part in the relevant drawing is not indicated.

(13) where the design relates to a combination product consisting of two or more pieces of articles (the combination of the separable products, such as detachable cabinet), in addition to the corresponding views of the combination state, the views of each part of the combination are also required when it is necessary, but the drawings submitted are not sufficient or do not meet this requirement.

(14) where the design of transparent articles has any of the following circumstances:

(i) where the outer layer has no color and pattern and the inner layer has a pattern but is not drawn as the practical pattern

which is visible through the transparent part, e. g. , a snuff bottle;

(ii) where the outer layer and inner layer have two or more kinds of shapes, patterns and colors but are not expressed separately.

### 2.3 Brief Explanation

#### Rule 28.2

The brief explanation is a short description of the main points of the design, the omitted views, and the colors for which protection is sought. Thus, only the following contents may be described in this part:

(1) the designs are identical or symmetrical in front and at the back, the left and right sides, the top and the bottom of the product, indicating the omitted view;

(2) the state of the product is changeable, such as a folded umbrella, a movable toy;

(3) the transparent parts of the product;

(4) the unit pattern of a plane product which is connected in two sides or four sides and has no fixed limits, such as printed cotton fabric, wallpaper;

(5) the length of a long and thin product part of which is omitted in drawing;

(6) the special material which a product is made of;

(7) the design containing color for which protection is sought;

(8) the use, method of use or function of a newly developed product;

(9) the main points of the design.

The brief explanation shall not contain any commercial advertisement and shall not be used to indicate the function and structure of the product.

### 2.4 Classification of Patent for Design

The Office shall classify the applications for patent for design in accordance with the published International Classification for Designs and accord appropriate classification numbers. The classification shall be made on the basis of the product indicated in the drawings or photographs, and reference being made to the writings in the "title of the product incorporating the design" and "the class in which it belongs to, the technical field in which it belongs to or the place for it to be used" in the request.



#### **2.4.1 Check of Application Documents**

The classification examiner shall check the following contents before the classification is made;

(1) whether or not the notification of acceptance has been included in the file;

(2) whether or not the filing number and the date of filing are indicated in the request;

(3) whether or not the class of the product is indicated in the request;

(4) whether or not the product shown in the drawings or photographs of the design is in conformity with the title of the product indicated in the request.

In the course of the checking, if it is found that the notification of acceptance has not been included in the file, or the filing number or the date of filing is not indicated in the request, the file shall be returned to the Receiving Division for handling.

Where the class to which the product belongs is not indicated in the request or the product shown in the drawings or photographs of the design is not in agreement with the title of the product indicated in the request, the Office shall notify the applicant of its opinion after checking and invite it/him to make necessary correction.

#### **2.4.2 Determination of Classification Number**

Where the application documents comply with the requirements mentioned above, the classification examiner shall conduct the classification of the product incorporating the design for which a patent is applied for in accordance with the International Classification for Design, accord it appropriate class, subclass and sequence numbers, and write them in the relevant columns of the cover of the file. The data shall be stored in the computer. Afterwards, the file shall be sent to the Procedure Management Division.

#### **2.4.3 check of Classification of Special Products**

(1) Where the use, method of use, or function of some newly developed products are not indicated in the brief explanation, or the classification of some products cannot be made because their use, methods of use or function are not clear, the Office shall notify the applicant of its opinion after checking and invite it/him to make correction, state the use, method of use or

function of the product, and, where it is necessary, furnish reference figures to show its state of use. After the applicant makes corrections or observations, the classification examiner shall conduct reclassification in accordance with the provisions of Section 2.4.2 of this Chapter.

(2) Where two or more designs are included in one application, a classification number may first be given in accordance with the title indicated in the request. Where a divisional application is required, a notification to make correction shall be sent to the applicant at the next step of the procedure.

(3) Two classification numbers may be given to a product which possesses two or more functions and the first classification number shall be the main number.

### **3. Checking of Other Relevant Documents**

#### **3.1 Appointment of Patent Agency and Designation of Representative**

In this regard, the provisions of Section 3.1, Chapter 1 of this Part shall apply.

#### **3.2 Claim of Right of Priority**

Where the applicant claims the right of priority, the provisions of Article 29 and Article 30 of the Patent Law, Rule 32 and Rule 33.1 of the Implementing Regulations of the Patent Law and the relevant provisions of the Paris Convention shall apply.

In accordance with Article 29 of the Patent Law, only foreign priority may be claimed for an application for a patent for design, that is, where, within six months from the date on which any applicant first filed in a foreign country an application for a patent for design, it/he files in China an application for a patent for the same subject matter, it/he may, in accordance with any agreement concluded between the said foreign country and China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of mutual recognition of the right of priority, enjoy a right of priority.

##### **3.2.1 Earlier Application and Subsequent Priority – Claiming Application**

Where the applicant files an application for a patent for design with the Patent Office and claims the right of priority of the application filed earlier in a foreign country, the examiner shall

examine whether or not the earlier application, as the basis of the priority, has been filed in a country party to the Paris Convention, or whether or not the earlier application is a regional application or international application which is filed for a country party to the Paris Convention. Where the applicant of an application claiming the right of priority belongs to a country not party to the Paris Convention, the examiner shall examine whether or not that country recognizes the priority of China. The examiner shall also examine whether or not that applicant may enjoy the rights provided by the Paris Convention, that is, whether or not that applicant is a national or resident of a country party to the Paris Convention or of a country which recognizes the priority of China. Where the conclusions from those two examinations are negative, the applicant shall be notified that the claim of the priority right is deemed not to have been made.

The examiner shall further examine whether or not the subsequent application claiming right of priority was filed within six months from the date of filing of the earlier application. If the subsequent application was filed later than the six – month period, the priority claim shall be deemed not to have been made. Where there are two or more earlier applications, the period shall be counted from the date of filing of the earliest application. Where over six months have passed from the date of filing of the earliest application, the applicant shall be notified of that fact and the priority claim is deemed not to have been made.

In the preliminary examination, the question whether or not the earlier application was the first application as defined by the Paris Convention shall not be examined.

### **3.2.2 Declaration of Claiming Right of Priority**

In this regard, the provisions of Section 3.2.1.2, Chapter 1 of this Part shall apply.

### **3.2.3 Copy of Earlier Application**

In checking the copy of the earlier application, except for the contents stated in Section 3.2.1.3, Chapter 1 of this Part, the examiner shall also check whether or not the subsequent priority – claiming application has the same subject matter of design as that of the earlier application.

Where the drawings or photographs of the subsequent application document are not completely identical with those of the

earlier application, but it may be concluded from the drawings or photographs what they seek protection for is the identical design of the identical product, it may be determined that the subject matters of the design of both the subsequent application and the earlier application are the same, and the subsequent application may enjoy the date of priority. For example, the applicant of the earlier application furnished the front view, back view, left view and space diagram of a product. While the applicant of the subsequent application furnished the front view, back view, left view, right view and top view of the same product, and it is indicated in the brief explanation that since the bottom of the product is not often seen so the upward view is omitted. If the front view, back view and left view of the subsequent application are identical with those of the earlier application, and the right view and top view have been clearly shown in the space diagram of the earlier application documents, it may be concluded that the subject matters of the two application are identical, and the subsequent application may enjoy the priority of the earlier application.

Where the subsequent application is a combination application containing two or more designs, the subject matter of one of the designs is identical with that of an earlier application, that design of the subsequent application may enjoy the priority of the earlier application.

Where the design of the subsequent application is a combination of the designs of several earlier applications, it may be concluded that the subject matter of the design of the subsequent application is different from those of the earlier applications, the subsequent application cannot enjoy multiple priorities.

#### **3.2.4 Applicant of Subsequent Application**

In this regard, the provisions of Section 3.2.1.4, Chapter 1 of this Part shall apply.

#### **3.2.5 Fee for Claiming Priority**

In this regard, the provisions of Section 3.2.1.6, Chapter 1 of this Part shall apply.

#### **3.2.6 Withdrawal of Priority Claim**

In this regard, the provisions of Section 3.2.1.5, Chapter 1

of this Part shall apply.

### **3.3 Disclosure Causing No Loss of Novelty**

#### **3.3.1 Scope of Application**

In this regard, the provisions of Section 3.3.1, Chapter 1 of this Part shall apply.

#### **3.3.2 Certifying Materials**

In this regard, the provisions of Section 3.3.2, Chapter 1 of this Part shall apply.

### **3.4 Declaration to Withdraw Patent Application**

In this regard, the provisions of Section 3.6, Chapter 1 of this Part shall apply.

### **3.5 Change in Bibliographic Data**

In this regard, the provisions of Section 3.7 of Chapter 1 of this Part shall apply.

## **4. Check According to Rule 44.1(3) of the Regulations**

### **4.1 Check According to Article 5 of Law**

Article 5 of the Patent Law provides that no patent right shall be granted for any invention – creation that is contrary to the laws of the State or social morality or that is detrimental to public interest.

According to Section 2, Chapter 1 of Part II of these Guidelines, the checking shall include three aspects; whether or not the design applying for a patent is obviously contrary to the laws of the State, whether or not it is obviously contrary to social morality, and whether or not it is obviously detrimental to public interest. If the examiner finds that the entire contents or part of the contents of an application for a patent for design belong to one of the three aspects, the Office shall notify the applicant of his/her opinion after checking, stating the reasons, and invite him or it to make its/his observations (where the entire contents of the application are involved), or to delete the relevant part (where part of the contents of the application is involved), within a specified time limit. If the reasons submitted by the applicant are not sufficient to justify in saying that the application does not fall under Article 5 of the Patent Law, or the applicant refuses to delete the relevant part without any justified reason, the Office shall

make a decision to reject the application.

To be “contrary to the laws of the State” refers to a design which has violated the laws stipulated by the National People's Congress or the Standing Committee of the National People's Congress according to the legislative procedure.

For example, since any application for a patent for design which takes the national flag or national emblem as the pattern of a product violates the law of National Flag and Law of National Emblem, no patent right may be granted to that application.

To be “detrimental to public interest” means that the exploitation or application of the design may harm the interest of the public or society, or may affect the normal order of the State and society.

For example, where the words or pattern of any application for a patent for design relate to a major national political event or religious belief and consequently are detrimental to public interest, hurt the people's or national feeling, or propagates feudalism and superstition, no patent right may be granted to that application. For another example, no patent right may be granted for the special coin in commemoration of China's resumption of sovereignty of Hong Kong and Macao.

#### 4.2 Check According to Article 31.2 of Law

Article 31.2 of the Patent Law provides that an application for a patent for design shall be limited to one design incorporated in one product. Two or more designs which are incorporated in products belonging to the same class and being sold or used in sets may be filed as one application.

Where any application for a patent for design which is obviously not in conformity with the provisions mentioned above, the Office shall, in accordance with Rule 42.2 of the Implementing Regulations of the Patent Law, invite the applicant to amend its/his application within a specified time limit. If it/he fails to make any response within the specified time limit, the Office shall notify it/him that the application is deemed to have been withdrawn. If the applicant refuses to amend its/his application without any justified reason, the Office shall make a decision to reject the application, and the applicant shall be notified accordingly.

##### 4.2.1 Design of Products in Set

Rule 44.1(3)

Rule 44.2

#### 4.2.1.1 Same Class

In accordance with the provisions of Article 31.2 of the Patent Law and Rule 36.1 of the Implementing Regulations of the Patent Law, one of the conditions for two or more designs to be filed as one application is that the said two or more designs are incorporated in products belonging to the same class, that is, the products belonging to the same subclass in the International Classification for Designs.

For example, both articles are used for dining, such as plate, saucer, cup and bowl; and articles used for cooking, such as pot, basin, dining knife and dining fork, are classified in Class 07 (household wares are not included in the other classes). However, plate, saucer, cup and bowl used for dining are classified in Subclass 07 -01; pot and basin are classified in Subclass 07 -02, and dining knife and dining fork are classified in Subclass 07 -03. As a result, pot, bowl and dining knife do not belong to the same Subclass, they cannot be filed in one application. On the other hand, because bowl and saucer belong to the same Subclass, they may be filed as one application. However, it should be noted that the articles be in the same subclass is not the only condition for two products being filed as one application, the requirements concerning being sold or used in sets as provided in Article 31.2 of the Patent Law shall also be complied with.

#### 4.2.1.2 Sold or Used in Set

In accordance with the provisions of Article 31.2 of the Patent Law and Rule 36.1 of the Implementing Regulations of the Patent Law, where two or more designs are filed as one application, it requires not only that the products incorporating the designs belong to the same class, but also that the products should be sold or used in sets, that is, the products incorporating the designs have the same designing concept and are customarily sold or used at the same time.

Two or more products of the same class may be filed as one application if they meet certain requirements. Such combined products are usually referred to as a set of products. A set of products shall have two or more products which are customarily sold and used in set. And they have the same designing concept and the same designing style.

##### (1) Concept of Set of Products

A set of products consists of two or more independent products, each of which has its own features and value of use, while all of them combined in use may produce the value of the set using together, such as a set of coffee utensils consisting of coffee cup, coffee pot, milk pot and sugar pot. A set of products does not refer to the collection consisting of a number of component parts which merge into an organic whole. Only all of them combined together can produce an independent value of use, but each of the component part alone has no independent value of use. For example, poker playing cards, building blocks, and plug-in toy unit shall be regarded as one product, and can be filed only as one application. But they are not a set of products.

(2) Sold at the same time

The meaning of being sold at the same time shall be limited to the products which are customarily sold at the same time, that is, the products which are usually sold in set on the market, such as the five-piece beddings consisting of bedspread, sheet, pillow case and the like. The products which are sold together for the purpose of promotion cannot be filed as a set of products, such as school bag and pencil box. Although a pencil box will be given as a gift when a school bag is sold, they cannot be regarded as having been customarily sold together at the same time and they cannot be filed as a set of products.

(3) Used at the same time

"Used at the same time" refers to the circumstances when people use one product of the set, they often associate it with the existence of other products of the set; it does not necessarily mean the using of the products of the set at the same moment. That is, the products, such as coffee cup, sugar pot and milk pot of the coffee utensils, are related to each other in the course of use, therefore that will be in conformity with the principle of used at the same time.

(4) Various products having the same designing concept

The "same designing concept" refers to the unity of the style of designing of each of the products of the set. That means the design of the shape, pattern or their combination, or the combination of the color with shape or pattern of the various products of the set is unified.

Unity of the shape refers to that each component product is characterized by a specific molding, or the combination relation between the component products is constituted on the basis of a



specific molding. Under such circumstances, the products shall be regarded as being in conformity with the unity of the shape.

The unity of the pattern refers to that the design of the pattern and its subject matter, composition, form of expression, color, and so on, of each product of the set shall be unified. If one aspect of them is different, the pattern of the products shall be regarded as not unified. For example, where the subject matter of the design of the coffee pot is orchid, while the subject matter of the design of the coffee cup is a panda, since the selected subject matters of design are different and the styles of design are different too, the principle of unity and coordination is not complied with. Since the products are not a set of products, the designs of them cannot be filed as one application.

The unity of the color cannot be considered alone. It must be considered comprehensively with the shape and pattern of each component product. Where the shape and pattern of each product complies respectively with the principle of unity and coordination, if the color of the products is the same, the designs may be filed as one application; If the color of each component product is quite different and the harmony of the entirety is damaged, the designs cannot be filed as one application.

Two or more designs which are in conformity with the provisions mentioned above can be filed as one application, and the sequence number of each design shall be marked before the title of the view of each product incorporating the design.

#### **4.2.1.3 Each Component of Set of Products to Comply with Requirements of Grant**

It should be noted that an application for a patent for design in respect of a set of products, except for compliance with the general requirements mentioned above, each component product shall comply with the requirements of grant of the patent right. If one of the component products fails to comply with the requirements, the designs of the complete set of products shall not be qualified to be granted the patent right.

#### **4.2.2 Examination of Divisional Application**

##### **4.2.2.1 Legal Basis of Divisional Application**

Under the provisions of Rule 42.1 of the Implementing Regulations of the Patent Law, where an application for a patent for

design contains two or more designs, the applicant may, before the expiration of the time limit of two months from the date of receipt of the notification to grant the patent right for the design and going through the formalities of registration, submit to the Office a divisional application. However, in respect of an application which has been rejected and the rejection is effective, or which has been withdrawn or deemed to have been withdrawn and has not been restored, no divisional application may be submitted.

Under the provisions of Rule 42.2 of the Implementing Regulations of the Patent Law, where the Office finds that an application for a patent for design is not in conformity with the provisions of Article 31.2 of the Patent Law and Rule 36 of the Implementing Regulations of the Patent Law, it shall invite the applicant to amend the application within a specified time limit. The applicant may, when it/he deletes one or more surplus designs from the initial application to comply with the requirement of unity, submit to the Office one or more divisional applications for one or more patent for the deleted designs.

#### 4.2.2.2 Requirements Relating to Divisional Application

“Divisional application” refers to the situation where the initial application for a patent for design contains two or more designs, the applicant takes one of the designs out from the initial application and makes it the subject matter for which a new application for a patent for design is filed. The new application is the divisional application and may enjoy the date of filing of the initial application.

The new divisional application shall be checked whether or not it complies with the following requirements:

Rule 42.1

Rule 54.1

(1) The divisional application shall be filed before the expiration of the period of two months from the date of receipt of the notification to grant the patent right for the initial application and to invite the applicant to go through the formalities of registration, and the initial patent application has not been rejected (or although it has been rejected, the rejection has not taken effect), or has not been withdrawn or has not been deemed to have been withdrawn;

(2) The applicant of the divisional application must be the same as that of the initial application. Where they are not the same, a document certifying assignment of the right shall be

submitted. The creator of the design of divisional application shall be the creator or part of the creators of the initial application;

(3) When the divisional application is filed, a copy of the initial application shall be submitted. Where the priority is claimed, a copy of the priority documents of the initial application shall also be submitted;

(4) Where the initial application for a patent for design contains two or more designs, the design of the divisional application shall be one or more of the designs taken out from the initial application;

(5) When a divisional application is filed, at least one design shall be left in the initial application and the rest shall be the subject matter of the divisional application(s);

(6) Where the design of the initial patent application is a design of the whole product, the applicant is not allowed to take out the design of part only of the product as the subject matter of the divisional application. For example, where an application is filed to protect the design of a motorcycle, no divisional application may be made for the design of its spare parts or components.

Where a divisional application is found to be not in conformity with the requirement of item (1), the Office shall issue a notification that the divisional application is deemed not to have been filed. Where the application is found to be not in conformity with the requirements of items (2) and (3), the Office shall notify the applicant to make correction within the specified time limit. If no correction is made within the time limit, the Office shall issue a notification that the divisional application is deemed to have been withdrawn. Where a divisional application is found to be not in conformity with the requirements of items (4) and (5), the Office shall notify the applicant of its opinion after check and invite it/him to make amendments within a specified time limit. Where no response and no amendments are made within the time limit, the Office shall issue a notification that the divisional application is deemed to have been withdrawn. Where the applicant refuses to make amendments but without sufficient reason, the Office shall make a decision to reject the divisional application. Where the application is found to be not in conformity with the requirement of item (6), the Office shall notify the applicant of its opinion after checking. If no response is made within the specified

time limit, the Office shall issue a notification that the divisional application is deemed to have been withdrawn. Where the applicant insists that its/his application is a divisional application but without sufficient reason, the Office shall make a decision to reject the divisional application.

#### **4.3 Check According to Article 33 of the Patent Law**

In accordance with the provisions of Article 33 of the Patent Law, the amendment made by the applicant to its/his application for a patent for design may not go beyond the scope of the disclosure as is shown in the initial drawings or photographs.

Rule 51.2

Rule 51.3

The applicant for a patent for design may amend the application documents for a patent for design on its/his own initiative within two months from the date of filing. Furthermore, upon the receipt of the Office's notification to make amendment, the applicant shall amend the application as required by the notification.

##### **4.3.1 Amendment on Applicant's Own Initiative**

Rule 51.2

In respect of the amendment made on the applicant's own initiative, it shall be checked first whether or not the amendment was made within two months from the date of filing. Where the amendment was made later than that time limit, except for the amendment corrected the defects in the initial application, the Office shall issue a notification that the amendment is deemed to have not been made in accordance with Rule 51.2 of the Implementing Regulations of the Patent Law. Where the amendment is made within the time limit, it shall be checked whether or not it goes beyond the scope as shown in the initial drawings or photographs. If the amendment goes beyond the said scope, the applicant shall be notified that the amendment is not in conformity with the provisions of Article 33 of the Patent Law. Where, after the applicant made its/his response, the Office still finds that the amendment to the application goes beyond the said scope, the application shall be rejected in accordance with Article 33 of the Patent Law and Rule 44 of the Implementing Regulations of the Patent Law.

##### **4.3.2 To Amend According to Notification**

Rule 51.3

Where the applicant makes amendment to its/his application according to the Office's notification but the amendment goes beyond the scope of the initial drawings or photographs, it/he

shall be notified that the amendment is not in conformity with the provisions of Article 33 of the Patent Law. Where, after the applicant made its/his response, the Office finds that the amendment to the application still goes beyond the scope of the initial drawings or photographs, it shall reject the application in accordance with Article 33 of the Patent Law and Rule 44 of the Implementing Regulations of the Patent Law.

**Rule 51.4****4.3.3 Contents May Be Amended by the Office on Its Own Initiative**

In the course of the preliminary examination, the Office may, on its own initiative, correct the obvious defects in the documents of the patent application mentioned in Sections 2.1, 2.2 and 2.3 of this Chapter, and notify the applicant accordingly. The contents which may be corrected by the Office on its initiative mainly refer to followings:

- (1) obvious mistake in the title of the product;
- (2) obvious mistake in the name of the view;
- (3) obvious mistake in the direction of the view;
- (4) Mistake in the direction of the Form of "Drawings or Photographs of the Design";
- (5) the figures and words in the drawings or photographs of the design which cannot be protected as the specific contents of the design and should be covered, for example: the portrait of a person, trademark, symbol, well-known book, or well-known building; and the lines in the drawings which should be deleted, for example: shadow line, indicating line, dotted line, central line or dimension line;
- (6) the descriptions in the brief explanation which obviously does not relate to the contents of the drawings or photographs of the design, for example: the descriptions of the structure of the product.

**4.4 Check According to Rule 2.3 of the Regulations**

In accordance with the provisions of Rule 2.3 of the Regulations, "design" in the Patent Law means any new design of the shape, the pattern or their combination, and the combination of the color with shape or pattern, of a product, which creates an aesthetic feeling and is fit for industrial application.

#### **4.4.1 Shape, Pattern or Their Combination and Combination of Color with Shape or Pattern of Product**

The carrier of a design must be a product. A “product” refers to any article produced by industrial methods. Handicrafts, agricultural products, livestock products or natural products, which cannot be produced repeatedly, shall not be the carrier of the design.

What constitutes a design is the shape, the pattern or their combination and the combination of the color with shape or pattern. Generally, the color of a product alone cannot constitute a design unless the change of the color of a product constitutes a pattern. The combinations that may constitute a design include: the shape of a product; the pattern of a product; the shape and pattern of a product; the shape and color of a product; the pattern and color of a product; the shape, pattern and color of a product.

“Shape” refers to the design of the molding of a product, that is, the external outline of a product presented by the move, change or combination of the dot, line or side of the external part of the product. That is the result of the synchronal design, manufacture of the structure, external shape and so on of a product.

“Pattern” refers to the figure constituted on the surface of the product by means of the arrangement or combination of the line, character, symbol or color piece. Pattern may be created by drawing or other means which are able to embody the designing conception of the creator. The pattern of a product shall be permanent and visible, and not flickering or visible only under specific conditions.

“Color” refers to the color or combination of colors applied on the product. The natural color of the raw material appeared on a product is not the color of the design.

The three elements, that is, shape, pattern and color, are inter – dependent, and sometimes it is difficult to define their boundary. For example, the arrangement of many color pieces may constitute a pattern.

#### **4.4.2 New Design Fit for Industrial Application**

To be “fit for industrial application” refers to a design which may be used in industry and may be manufactured in batches.

A new design refers to a design that is a newly planned de-

sign of a product. An obviously not new design refers to a design which is known without search in the course of examination that, before the date of filing or priority of the application for a patent for design under examination, there is an identical or similar design for which an earlier patent application has been filed with the Office and published in the China Patent Gazette. It also refers to a design which is known in the course of examination that, before the date of filing or priority of the application for a patent for design under examination, products incorporating the identical or similar design has been publicly used or sold in China, or the contents of the application under examination have been publicly disclosed in a publication in China and abroad.

#### **4.4.3 Subject Matter for Which No Design Patent Shall Be Granted**

The following are examples of products the designs of which shall not be granted patents for design according to the provisions of Rule 2.3 of the Implementing Regulations of the Patent Law:

(1) any fixed building, bridge and the like which depends on their specific geographic conditions and cannot be rebuilt elsewhere.

(2) any product which has no fixed shape, pattern or color because it contains the substance which has no fixed shape, such as gas, liquid or powder.

(3) any component part of the product which cannot be partitioned or sold or used separately, such as the heel of socks, the brim of a hat, the handle of a cup, and so on.

(4) in the case of any product consisting of several component parts which have different shape or patterns, if the component part is not a product which has any value of independent use, no patent right may be granted for such component. For example, a plug-in piece which cannot be inserted by an identical plug-in pieces to form a specific shape or pattern cannot be used independently, nor does it constitute an independent product, consequently no protection of a patent for design shall be granted for such a product. Only when such plug-in pieces are connected together with other plug-in pieces and turn into a kind of toy, and an application for a patent for design incorporating the design of such a toy is filed, a design patent may be granted.

(5) any product which cannot be perceived by the visual sense or the shape, pattern or color of which is difficult to be determined with the naked eye.

(6) any design for which the protection is sought is not the design of the state of normal product, for example the design of the state of an animal made with a handkerchief.

(7) any design the main body of which is the original shape, pattern or color of the natural object.

(8) any work which belongs wholly to the field of fine arts.

(9) any design which is constituted only by geometric shapes or patterns of common sight in the field of the relevant product.

(10) the fonts, sound or meanings of the general words and number shall not be the contents of the design seeking protection.

#### **4.5 Examination According to Article 9 of the Law and Rule 13.1 of the Regulations**

Article 9 of the Patent Law provides: "where two or more applicants file applications for patent for the identical invention – creation, the patent right shall be granted to the applicant whose application was filed first."

Rule 13.1 of the Implementing Regulations of the Patent Law provides: "For any identical invention – creation, only one patent right shall be granted." This provision lays down the principle of no double – patenting.

In the preliminary examination of the application for a patent for design, the examiner will not conduct the examination of whether or not an application for a patent for design is in conformity with the provisions of Article 9 of the Patent Law and the Rule 13.1 of the Implementing Regulations of the Patent Law, unless the examiner is aware in the course of preliminary examination that, there are two or more applicants filing applications for patent for the identical design respectively or the applicant has filed another application for a patent for design which has identical contents.

This Section shall explain only the principle of judgment of the "identical invention – creation" stated in Article 9 of the Patent Law and Rule 13.1 of the Implementing Regulations of the Patent Law and the methods of handling under various circumstances, but not including the application for a patent for design



which shall be examined according to Rule 2.3 of the Implementing Regulations of the Patent Law. In other words, where the earlier application has been published and is part of prior art, the examination of the later application shall be conducted according to Rule 2.3 of the Implementing Regulations of the Patent Law, and not Article 9 of the Patent Law and Rule 13.1 of the Implementing Regulations of the Patent Law.

#### **4.5.1 Principles of Judgment**

In the judgment of whether or not two or more designs constitute the “identical invention – creation” stated in Article 9 of the Patent Law and Rule 13.1 of the Implementing Regulations of the Patent Law, it shall be determined on the basis of the designs incorporated in products as shown in the drawings or photographs of the relevant two applications for a patent for design or patents for design.

“Identical designs” refers to two designs that are identical with or similar to each other. The meaning of identical or similar designs includes two aspects: products being identical (or similar) and designs being identical (or similar). The identical products mean the use and function of the products are completely identical, while the similar products refer to the products which have the same use but different functions. To judge whether or not the designs are identical (or similar) is a comprehensive judgment on the design of the shape, pattern and color of the identical (or similar) products.

#### **4.5.2 Method of Handling**

##### **4.5.2.1 Different Applicants**

Where two applicants filed applications for patent for the identical design successively, the later application shall be handled in the following way:

Where the earlier application has not been granted the patent right and both earlier and later applications are in conformity with other requirements for being granted the patent right, the patent right shall be granted to the applicant whose application was filed first according to Article 9 of the Patent Law. After the patent right has been granted to the earlier application, the Office shall notify the applicant of the later application that its/his application is not in conformity with the provisions of Rule 13.1 of

the Implementing Regulations of the Patent Law. Where the earlier application has been granted the patent right, the applicant of the later application shall be notified of the Office's opinion after checking its/his application. If the applicant fails to make any response within the specified time limit, the later application shall be deemed to have been withdrawn. If, after the applicant has made its/his observations, the Office still finds that the later application is not in conformity with the requirements of Rule 13.1, the later application shall be rejected.

Where two applicants filed applications on the same day for patent for the identical design and both applications are in conformity with other requirements for being granted the patent right, the Office shall, according to Rule 13.2 of the Implementing Regulations of the Patent Law, notify the applicants to hold consultations among themselves to decide the person(s) who shall be entitled to file the application. If the applicants fail to make any response within the specified time limit, both applications shall be deemed to have been withdrawn. If the applicants fail to reach any decision in the consultations, or, after the applicants have made observations or amendments to the applications, the Office still finds that the applications are not in conformity with the requirements of Rule 13.1, both applications shall be rejected.

#### **4.5.2.2 Same Applicant**

Where the same applicant files applications for patent for the identical design successively and both applications are in conformity with other requirements for being granted the patent right, but no patent right has been granted to any of them, the Office shall notify the applicant that its/his later application is not in conformity with the provisions of Rule 13.1 of the Implementing Regulations of the Patent Law unless it/he withdraws its/his earlier application. Where the applicant fails to make any response within the specified time limit, its/his later application shall be deemed to have been withdrawn. Where the applicant insists to maintain its/his later application and refuses to withdraw its/his earlier application without any justified reason, its/his later application shall be rejected. Where its/his earlier application has been granted the patent right, the Office shall notify the applicant of its opinion after checking its/his later application and states that the application is not in conformity with the provi-

sions of Rule 13.1 of the Implementing Regulations of the Patent Law. If the applicant fails to make any response within the specified time limit, the application shall be deemed to have been withdrawn. If the applicant insists to maintain the later application without any justified reason, the later application shall be rejected.

## Chapter 4

### Patent Classification

#### 1. Introduction

This Chapter involves the classification of the patent for invention and the patent for utility model only. For the classification of the patent for design, provisions in Section 2.4, Chapter 3 of this Part shall apply.

The Patent Office adopts the "International Patent Classification" (Int. CI) to conduct the classification for an application for patent for invention and an application for patent for utility model.

The latest Chinese version of the "International Patent Classification" shall be the working text of the classification. Where there is divergence of interpretation, the latest English or French text shall prevail.

The purposes of classification are as follows:

- (1) Establishment of patent files which have value for patent search;
- (2) Distribution of applications for patent for invention or for utility model to the competent examination departments;
- (3) Classifying the applications for patent for invention or for utility model by means of the classification symbols, so that they could be published or announced in systematical way.

#### 2. Contents of Classification

The classification departments shall classify the technical subject matter of each application for patent for invention or utility model, provide a complete classification symbol which represents the inventive information of an invention or utility model, and if necessary, provide the indexing code which is related to these classification symbols at the same time.

The inventive information of the invention or utility model mentioned above refers to the technical information relating to the invention or utility model *per se*, i. e. the technical information which directly relates to the technical subject matter of the application for patent for invention or utility model seeking patent protection.

The technical information expressed by the indexing code mentioned above refers to the supplement of the classified information (such as, indication of the basic composition of a com-

pound or a mixture or the component cluster of a compound) or the indication of the use or application of a classified technical subject matter.

### **3. Technical Subject Matter**

#### **3.1 Determination of Technical Subject Matter**

##### **3.1.1 General Principle**

The determination of the technical subject matter shall be mainly made on the basis of the claims, and the description (including the drawings) shall be taken into consideration in an appropriate manner.

##### **3.1.2 Entireness**

Where the determination of the technical subject matter is made mainly on the basis of the claims, the examiner shall understand the technical contents of the claims in its entirety. Where the determination of the technical subject matter is made on the basis of the independent claims, the technical features indicated in the preamble portion shall be combined with the technical features indicated in the characterizing portion.

##### **3.1.3 Emphases**

Where the determination of the technical subject matter is made mainly on the basis of the claims, emphases shall be put on the independent claim; where there are more than one independent claim, emphases shall be put usually on claim 1.

##### **3.1.4 Combination with Description**

Taking appropriate consideration of the description (including the drawings) in determining the technical subject matter is to correctly understand or clarify the technical features indicated in the claims and constituting the technical scheme seeking protection.

##### **3.1.5 Methods for Determination of Technical Subject Matter**

(1) Generally, the determination of the technical features is made mainly on the technical features stated in the preamble portion of the independent claim, and the technical features stated in the characterizing portion are to restrict the preamble portion.

## Example 1:

A building board used for wall or roof, characterized in that it consists of sheets, each of which is rectangle and comprises four parts, the surface shape of each part is hyperbolic paraboloid. . .

The technical subject matter is: a sheet building board, used for wall or roof, characterized in shape.

## Example 2:

A crude oil composition with an improved pour – point which comprises wax – bearing crude oil and an effective amount of pour – point depressant additive, wherein the additive mainly consists of polymer selected from copolymer of ethene and acrylonitrile and tripolymer.

The technical subject matter is: a crude oil composition characterized in an additive consisting of the polymer of the copolymer and tripolymer containing ethene and acrylonitrile.

## Example 3:

A mechanical shock absorber of cotton textile machine, characterized in that viscoelastic materials stick on the steel plate so that the two materials combine as one entire piece.

The technical subject matter is: a mechanical shock absorber of cotton textile machine, characterized by sticking viscoelastic materials on steel plate to combine them as one entire piece.

## Example 4:

A speaker, the piezoelectric ceramic sheet being connected at one end of the tubular shell by press, and the speaker opening being at the other end, with two metal contacts being on the piezoelectric ceramic sheet, characterized in that a layer of vibration shell is installed on the outside of the speaker shell, being connected with the edge of the speaker opening, and there is an interval between the two shells to comprise a twin shell.

The technical subject matter is: a piezoelectric ceramic sheet speaker, characterized by twin shell.

(2) Under special circumstances, i. e. , where the subject matter described in the preamble portion of the independent claim has no specific location in the Classification, the determination of the technical subject matter shall be made mainly on the basis of the technical features recorded in the characterizing portion, and the technical features recorded in the preamble portion shall be regarded as the restriction to the characterizing portion.

## Example 1:

A switch, comprises a shell, the control device, wire tunnel, and open & close contact being equipped in the shell cover, characterized in that a light transmitting board made of transparent materials and a glow bulb indicating switch position are equipped under the opening of the shell cover.

The technical subject matter is: a device of a switch capable of indicating the position of the switch.

## Example 2:

An active dye compound, characterized in that the process of synthesis is by means of enzyme, . . .

The technical subject matter is: use of enzyme to synthesize an active dye compound.

## Example 3:

A timing clock comprising of a shell and a cassette mechanism, characterized in that the shell is made of ceramic material, its appearance is. . .

The technical subject matter is: the shell of a timing clock made of ceramic material. . .

(3) In very particular cases, that is, where the claims describe the invention or utility model in an extremely summarized or common way, to the effect that, based on these information, it is impossible to get hold of the technical subject matter to make the classification. Under such circumstances, the judgment shall be made on the basis of the technical problems solved by the invention or utility model, the technical schemes, technical results or embodiments recorded in the description.

## Example 1:

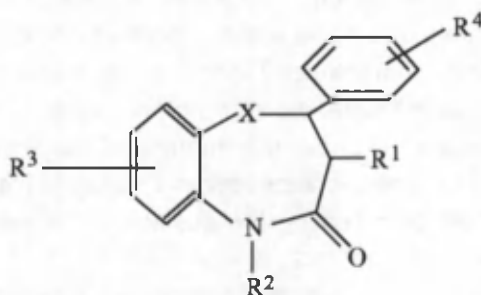
A process of sharing a general purpose motor for electrical home appliances, characterized in that no special purpose motor is equipped with the electrical appliances, when the process is in use, the general purpose motor is equipped with the electrical home appliances by means of spring, belt, lath, dog screw and nut, and the general purpose motor is to be disassembled after use.

The technical subject matter judged from the embodiment is: the installation components and assembling method of the motor used in the tub of the wave - disc - type semi - automatic duplex washing machine.

## Example 2:

A process of preparing the following compounds and their

pharmaceutically acceptable salt;



Wherein

When X is CH, S, R is...

The technical subject matter judged from the embodiment is: a process of preparing [1 - (trans, 3, 4)] - 1 - [2 - (dimethylamino) cyclohexyl] - 1, 3, 4, 5 - tetrahydro - 4 - (4 - methoxyphenyl) - 3 - methyl - 6 - (trifluoromethyl) - 2H - 1 - benzazepine - 2 - one monohydrochloride.

### 3.2 Categories of Technical Subject Matter

The technical subject matter is related either to the features or functions of an object *per se* or to its use or application.

Here, the word "object" refers to any technical object in its broad sense, no matter it is tangible or intangible, such as process, product or apparatus.

#### 3.2.1 General Object

The technical subject matter is a general object, that is, it relates to the feature or function of the object, but is irrelevant to the specific field where it is used, or the technical feature of the object will not be affected without consideration of the scope of application.

Example 1:

A woodscrew which has 20° skewed slots and can be used to tap screw thread.

Example 2:

A process of preparing 1,2,4 - triazolo [1,5 - C] pyrimidine - 2 - sulfamoyl Compound.

Example 3:

A generator rotor core used in diesel locomotion, which is characterized in the shape and arrangement of coil slot.

Example 4:



A cutting machine, which is characterized in having a disk cutter turned around a move shaft.

### **3.2.2 Objects Suited for Specific Use or Purpose**

The technical subject matter is an object which is suited for specific use or purpose, that is, an object which is intentionally improved or manufactured for a known use or purpose.

For example, a DC vibration massager, in which there are two coils coiled around the frame; the shake of the massager head is driven by the back and forth movement of a moving core in the coils.

### **3.2.3 Special Use or Application of an Object**

The technical subject matter is the special use or application of an object.

For example, the insecticide, acaricide or aphicide containing the mixture of dimethyl - (2,2 - dichloro vinyl) phosphate and 0,0 - dimethyl - S - N - (2 - chlorophenyl) - N - butanoyl-amino dithiophosphate.

### **3.2.4 Classifying an Object into a More General System**

The technical subject matter is to classify an object into a more general system.

For example, a vehicle hanger bracket of single wheel, in which there are several tumblers, two of them are band spring themselves. Here, the band spring is included in the class of vehicle hanger bracket.

### **3.2.5 Being Both a General Object and an Object Related to Its Use or Application**

The technical subject matter is both a general object and an object related to its use or application. That is, it relates both to the feature or function of the object itself and to its specific application or its specific application or combination in a more general system.

For example, a camera characterized in being able to load more than one rolls of film and expose a specific roll of film when necessary as well as its installation to the plane.

## **4. Method of Classification**

### **4.1 Classification According to Entireness**

It is advised to classify the technical subject matter from its entirety as much as possible rather than classify the each component part of the technical subject matter respectively.

Example 1:

A tumbler auto – control bridge telescopic slot device consisting of middle girder, elastic sealing element, transverse – joist, supporting spring, transverse – joist sealing box and so on, characterized in that each transverse – joist ...

To classify the bridge telescopic slot device as a whole, it is to be classified into E01D19/06.

Example 2:

A solid waste disposal system consists of import device and apparatuses of sorting, smashing, metal retrieving, plastic retrieving, fertilizer making and so on.

To classify the solid waste disposal system as a whole, it is to be classified into B09B3/00.

#### 4.2 Classification According to Function

The technical subject matters mentioned in Section 3.2.1 of this Chapter are classified into their positions in accordance with the function; where there is no such function position in the Classification, it is to be classified into the proper application position.

Example 1:

A process of preparing compound 1,2,4 – triazolo [ 1,5 – C ] pyrimidine –2 – sulfamoyl.

To classify according to its function, it is to be classified into C07D487/04.

Example 2:

A cutting machine which has a disk cutter turned around sliding shaft.

To classify according to its function, it is to be classified into B26D1/157.

Example 3:

For a covering flux stripper, no function position is existed in the Classification. According to judgment, the covering flux stripper is mainly used for stripping the sheath of cable.

To classify according to application, it is to be classified into H02G1/12.

#### 4.3 Classification According to Application

The technical subject matters mentioned in Sections 3.2.2, 3.2.3 and 3.2.4 of this Chapter shall be classified into their po-

sitions according to their application; where there is no such application position in the Classification, they shall be classified into their proper function positions.

**Example 1:**

A DC vibration massager, characterized in having two coils coiling around the frame; the shake of the massage head is driven by the back and forth movement of a moving core in the coils.

To classify according to application, it is to be classified into A61H23/02 in.

**Example 2:**

An insecticide, acaricide or aphicide, characterized in containing the mixture of two kinds of active composition.

To classify according to application, it is to be classified into A01N sub - class.

**Example 3:**

A vehicle hanger bracket of single wheel, characterized in having several tumblers, two of them are band spring.

To classify according to application, it is to be classified into B60G3/00.

**Example 4:**

A refrigerator protection device for overload, overvoltage and time delay startup.

There is no specific application position for refrigerator emergency protective - circuit in the Classification. Judging from experience, it is an emergency protective - circuit device.

To classify according to application, it is to be classified in H02H subclass.

#### **4.4 Classification by Both Function and Application**

The technical subject matters mentioned in Section 3.2.5 of this Chapter shall be classified both in function position in accordance with its function and in application position in accordance with its application. Where there is no such function position, it shall be classified in the application position only; where there is no such application position, it shall be classified in function position only.

**Example 1:**

A camera, being able to load more than one rolls of film and expose a specific roll of film when necessary as well as its installation to the plane.

To classify both according to function to G03B19/06, and to classify according to application to B64D47/08.

**Example 2:**

A generator suited for use in illumination for bicycle and animal – drawn cart. The generator is equipped with a gear – ratio – adjustable gearbox and can be easily coupled with the wheel.

There is no application position in the Classification for this product, it is to be classified in H02K7/116 only in accordance with its function.

Where, in classifying a technical subject matter mentioned in Section 3.2.4, i. e. , to classify it according to application by means of including it into a more general class, if the inherent features of the object are involved, further classification in accordance with its function shall be needed.

#### **4.5 Classification of Independent Claim and Dependent Claim**

Classification shall be carried out for each independent claim and for the important information contained in each dependent claims.

The important information contained in the dependent claims refers to the information which has value for the establishment of searchable patent files, i. e. useful for the examiner to conduct examination of applications for patent or for the public to search certain technical information.

#### **4.6 Steps for Classifying Technical Subject Matter**

##### **4.6.1 Compound**

Where the technical subject matter is a compound, it is to be judged at the very start whether it relates only to the application of the compound. If yes, it shall be classified according to its application or use position only; if the answer is no, it needs to decide whether the application or use of the compound is a component part of its main technical features. If yes, it is to be classified both in Class C and in the application or use position of the compound; if no, it is to be classified in Class C only.

##### **4.6.2 Chemical Mixture or Composition**

Where the technical subject matter is a chemical mixture or composition, it is to be judged at the very start whether there is a position in the Classification for the object. If no, it shall be

classified according to its application or use position only. If yes, it is to be decided whether its application or use is a component part of its main technical features. If yes, it shall be classified in the position of mixture or composition and the position of its application or use; if no, it is to be classified in the position of mixture or composition only.

#### **4.6.3 Preparation or Disposition of Compound**

Where the technical subject matter is the preparation or disposition of a compound, it is to be decided at the very start whether there is a position for preparation or disposition in the Classification. If yes, it is to be classified in the position of the compound and the position for preparation or disposition; if no, it is to be classified in the position of the compound only.

#### **4.6.4 Equipment or Process**

Where the technical subject matter is an equipment or process for producing or processing an object, it is to be decided at the very start whether there is a position for equipment or process in the Classification. If yes, it is to be classified in the position of the equipment or process; if no, it is to be decided whether there is a position for the process using the equipment or a position for the equipment using the process. If yes, it is to be classified in the position of the equipment or process; if no, it is to be classified in the position for the object manufactured or processed by the equipment or process.

#### **4.6.5 Manufactured Article**

Where the technical subject matter is an article, it is to be decided at the very start whether there is a position for the article in the Classification. If yes, it is to be classified in the position of the article; if no, it is to be decided whether there is an appropriate position for its function. If yes, it is to be classified in the appropriate function position; if no, it is to be classified in the position for its application or use.

#### **4.6.6 Multi – Steps Process, Equipment**

Where the technical subject matter is a multi – step process, equipment, it is to be decided at the very start whether there is a position for the combination of the various processes or equipments in the Classification.

(1) If yes, it is to be decided whether the position relates to any individual unit of the combination. If yes, it is to be classified in the position of the combination and the position of the individual unit; if no, it is to be classified in the position of the combination only.

(2) If there is no position for the combination, it is to be decided whether it relates to any individual unit of the combination. If yes, it is to be classified in the position of the product produced by such combination and the position of the individual unit. If no, it is to be classified in the position of the product produced by such combination.

#### **4.6.7 Parts, Structural Elements**

Where the technical subject matter relates to parts, structural elements, it is to be decided at the very start whether it suits or is used only for specific equipments. If yes, it is to be classified in the position for the special equipments. If not, it is to be decided whether there is a position for the parts/ elements of general use in the Classification. If yes, it is to be classified in the position for parts/ elements of general use; if not, it is to be classified in the position for the appropriate equipment.

### **5. Selection of Indexing Codes**

#### **5.1 Indexing Code List**

##### **5.1.1 Indexing Code List for Specific Use**

There are subclasses for the specific Indexing Code List and the Indexing Code List Group in the Classification. These Indexing Codes are used for indexing only and can be directly selected when used for supplemental indexing for the classified information, such as B29K subclass.

##### **5.1.2 Indexing Code List for Common Use**

Under the Common –use Indexing Code List in the Classification, the classification symbol of the Group and Subgroup of the category which can be used both as classification symbol and indexing code category is identified by inserting a vertical line on their left. When the classification symbol is used as indexing code, the slant “/” in the classification symbol of the category shall be substituted by colon “:”. Taking A01N25/00 for example, when it is used as an indexing code, it shall be ex-

pressed as A01N25:00.

## **5.2 Usage of Indexing Code**

### **5.2.1 Consecutive – Use of Indexing Code**

It is indicated in the Notes of Classification that the indexing codes in certain positions shall be used together with relevant classification symbols. Each group of consecutive – use indexing code shall be expressed in round brackets respectively. In the round brackets, the classification symbol is listed first and then followed by the indexing code. Between the classification symbol and indexing code, there is a comma, such as (C08F210/16, 214:06).

### **5.2.2 Indexing Code of Non – Consecutive – Use**

It is indicated in the Notes of Classification that the indexing codes in certain positions shall be used independently without indicating the relevant classification symbols, such as B29K9:06.

## **6. Marking of Classification Symbol and Indexing Code**

### **6.1 Method of Marking**

The classification symbol and the indexing code shall be separated by a double – slant. The classification symbol is listed in front of the double – slant, the indexing code of consecutive – use is listed behind the double – slant and then followed by the indexing code of non – consecutive – use. Wherein, the classification symbol and the indexing code of non – consecutively – use is separated by a comma, and there should be no punctuation mark on either left or right side of the round brackets of the consecutive – use of indexing code.

Example 1:

C08F210/16,255/04// (C08F21016,214:06)  
(C08F255/04,214:06)

Example 2:

B29C65/08//B29K83:00, B29L23:18

### **6.2 Sequence of Classification Symbol**

The classification symbols are arranged in the order of the claims on which they have their basis. In which, the first classification symbol shall be acquired generally from independent claim 1. When classification is made according to the embodi-

ments recorded in the invention or utility model, the classification symbols shall be in the order of the embodiments on which they are based. Wherein, the first classification symbol shall be acquired from the embodiment recorded first, unless the applicant has indicated otherwise or the examiner considers a specific embodiment most important. Under such circumstances, the classification symbol acquired from the indicated embodiment shall be arranged first.

### 6.3 Reading of Classification Symbol and Indexing Code

“/” in the classification symbol shall be read as “slant”. For example, A01B3/00 shall be read as A zero one B three slant zero zero.

“:” in the indexing code shall be read as “colon”. For example, B29L1:00 shall be read as B two nine L one colon zero.

## 7. Mark X

### 7.1 Meaning of Mark X

(1) The single mark X indicates that the technical subject matter on issue can't be classified in any position in the Classification.

(2) Mark X behind the Classification symbol indicating Part, Class or Subclass (such as AX, A01X or A01BX) shall mean that although the technical subject matter on issue is included in the said Part, Class or Subclass, there is no appropriate position in the subordinating Class, Subclass or Group for it to be classified.

(3) Mark X behind the Classification symbol indicating Group (such as G01N3/00X) shall mean that where there is no appropriate Group for the technical subject matter on issue, the marked Group is the closest one to it, but for the said technical subject matter, it is not exact.

### 7.2 Use of Mark X

Where the examiner for classification considers that it is necessary to use mark X for an application, he/she shall fill in a “Notification of Suggestion to Use Mark X” and reports to the Director of the relevant division. The Director of the division, if so agrees, shall consult with relevant examination departments and draft a “Report of Suggestion to Use Mark X” together with the classification assistant of the examination department.



Where the examiner for the examination as to substance considers it necessary to use Mark X, he/she shall fill in a "Notification of Suggestion to Use Mark X" and submit to the director of his/her division. Where the Director agrees with the suggestion, he/she shall report to the Director General of the department and contact with the department in charge of classification in the Department of Preliminary Examination and Procedural Administration. If agreed, the department in charge of classification in the Department of Preliminary Examination and Procedural Administration shall draft a "Report of suggestion to Use Mark X" together with the classification assistant of that department.

Mark X can be used on file only after the above - mentioned "Report of Suggestion to Use Mark X" has been signed by the Directors General of the Preliminary Examination and Procedural Administration Department and the relevant department, and ratified by the competent Commissioner of the Patent Office.



**Part II**  
**Examination as to Substance**

Part II

Introduction to the Study of the History of the United States

**Chapter 1****Inventions – Creation for Which No Patent Right Shall Be Granted****1. Introduction****Art. 1**

The granting of the patent right for inventions – creations should foster the spreading and application of invention – creation, promote the development and innovation of science and technology, and meet the needs of the redization of socialist modernization. Considering the interests of the State and society, certain restriction is made in the Patent Law in respect of the scope of patent protection. On the one hand, Article 5 of the Patent Law provides that no patent right shall be granted for any invention – creation that is contrary to the laws of the State or social morality or that is detrimental to public interest. On the other hand, Article 25 of the Patent Law provides a list of the subject matters for which no patent rights shall be granted.

**2. Inventions – Creations for Which No Patent Right Shall Be Granted According to Article 5 of the Patent Law**

According to the provisions of Article 5 of the Patent Law, no patent right shall be granted for any invention – creation if its disclosure, use or manufacture is contrary to the laws of the State or social morality or detrimental to public interest. This is a general principle. The meaning of the laws of the State, social morality and public interest is quite broad. They may change at different periods of time and in different places. Sometimes the law may be amended and certain restrictions may be removed. Therefore, the examiner shall pay special attention to this point when he/her conducts examination on the basis of Article 5.

**Art. 5****2. 1 Inventions – Creations Contrary to the Laws of the State**

“The laws of the State” refers to the laws formulated and promulgated by the National People's Congress or its Standing Committee in accordance with the legislative procedure. They do not include the administrative rules and regulations.

No patent right shall be granted for any invention – creation the purpose of which is contrary to the laws of the State. For example, an invention – creation relates to any gambling equipment, device or tool; any drug – taking appliance; any equipment used to make counterfeit money, bill, official document, certificate, seal, historic relics are the inventions – creations

which are contrary to the laws of the State and no patent rights shall be granted for them.

Where the purpose of an invention – creation *per se* is not contrary to the laws of the State, but it is contrary to the laws of the State if it is abused, it is not excluded from being granted the patent right. For example, various poisons, narcotics, sedatives and analeptics which are for the use of medical treatment, and playing cards, chess and any board game which are for the use of entertainment, are not contrary to the laws of the State.

Rule 9 of the Implementing Regulations of the Patent Law provides that any invention – creation that is contrary to the laws of the State referred to in Article 5 of the Law shall not include the invention – creation merely because the exploitation of which is prohibited by the laws of the State. It means that, where the laws of the State merely restrict or limit the manufacture, sale or use of the product of an invention – creation, the product *per se* and the processes of its manufacture do not belong to the invention – creation that is contrary to the laws of the State. For example, although the manufacture, sale or use of weapons manufactured for the purpose of national defense is restricted by the laws of the State, these weapons *per se* and their processes of manufacture are the subject matters for which patents may be granted.

#### Art. 5

#### 2. 2 Inventions – Creations Contrary to Social Morality

“Social morality” refers to ethical or moral concepts and rules generally accepted by the public as reasonable. Its connotation is based on certain cultural backgrounds. Its connotations will continuously change with time and social progress. It varies from area to area. The social morality referred to in the Patent Law shall be applied within the territory of China.

The patent right shall not be granted for an invention – creation which is objectively contrary to social morality. For example, the patent rights shall not be granted for inventions – creations such as a design with violence, murder or obscene picture or photograph, a product of artificial sexual organs or its substitute which is not for medical use, or a method of mating between human – being and animal.

Art. 5

**2. 3 Inventions – Creations Detrimental to Public Interest**

“Detrimental to public interest” refers to that the exploitation or use of an invention – creation may cause detriment to the public or society or may interfere with the normal order of the State and society. Examples are as follows:

Where any invention – creation the purpose of which is to cause disability to other persons or to damage the property of others, for example, an anti – theft device which may cause loss of sight of both eyes for thieves, and the method of making such a device, it shall not be granted the patent right.

Where any invention – creation the manufacture or use of which may seriously pollute the environment or destroy ecological balance, it shall not be granted the patent right.

Where any patent application the words or pattern of which relates to an important political event of the State or to religious belief, and hurts the people's feeling or national sentiments, or propagates feudalism or superstition, it shall not be granted the patent right.

However, if any invention – creation that may be detrimental to public interest is due to its abuse, or that creates a positive effect and produces a certain defect at the same time, for example, a pharmaceutical product that has side effects on the human body, the examiner shall not refuse to grant the patent right for such an invention – creation on the ground that it is “detrimental to the public interest”.

**2. 4 Inventions – Creations Partially Contrary to Article 5 of Law**

An application is called partially contrary to provisions of Article 5 of the Law if part of the application contains a certain substance that is contrary to the laws of the State, or social morality or detrimental to public interest, but the rest of the application is lawful. In the case of such an application, the Office shall notify the applicant to amend its/his application, that is, to delete the part which is contrary to the provisions of Article 5 of the Law. If the applicant refuses to delete the part which is contrary to the Law, no patent right shall be granted.

Take the example of an invention – creation relating to “slot marble game machine”. When the player achieves a certain amount of points, the machine will eject certain amount of money. The Office shall notify the applicant to delete or change the part of ejecting money in order to make it a simple slot marble game

machine. Otherwise, even if it is a new technical solution possessing inventiveness, no patent right shall be granted for it.

### **3. Subject Matters Unpatentable According to Article 25 of Law**

Where any subject matter for which a patent is applied belongs to any of the five items of Article 25. 1, of the Patent Law, shall not be granted the patent right. The provisions of the said Article and paragraph shall apply to both inventions and utility models.

#### **Art. 25. 1(1)**

#### **3. 1 Scientific Discoveries**

“Scientific discoveries” refers to the revelations of phenomena or varying processes and their features and laws which objectively exist in the natural world. A scientific theory is the summary of the understanding of the natural world, and it is the discovery in a broader sense. All of these are the extension of the cognition of the people. Because these discovered substances, phenomena, processes, features or laws are different from the technical solution of reforming the objective world, they are not the inventions – creations in the sense of the Law. Therefore, no patent rights shall be granted for such kind of discoveries. For example, no patent right shall be granted for the discovery of the photosensitive property of a silver halide under illumination. However, the patent right may be granted to the photographic film and the process to produce the film in accordance with this discovery. Another example: no patent right shall be granted for a discovery of a natural substance existing in its natural state unknown before. This is deemed merely a discovery. (For the examination of patent applications involving a substance which is separated or extracted from the nature for the first time, see Section 2. 1, Chapter 10 of this Part. )

It should be noted that, although there is an essential difference between invention and discovery, they are closely related. Usually, many inventions are made on the basis of discoveries. In turn, inventions promote discoveries. Such close relation between inventions and discoveries is especially prominent in “the use invention” of chemical substances. When the specific property of a certain substance is discovered, the use invention utilizing this property will be made accordingly.



Art. 25. 1(2)

Rule 2. 1

**3. 2 Rules and Methods for Mental Activities**

"Mental activities" refers to man's thinking movement. They originate from man's thinking and produce abstract results through inference, analysis and judgment, or they can only indirectly act on the nature and produce results through the medium of man's thinking movement. They are only the rules and methods guiding people to think, distinguish, judge and memorize the information. Because mental activities do not adopt technical means or follow the laws of nature, nor do they solve any technical problem or create any technical effect, they do not constitute a technical solution. Mental activities are not in conformity with the provisions of Rule 2. 1 of the Implementing Regulations of the Patent Law. They fall into the scope as provided in Article 25. 1(2) of the Patent Law. Therefore, no patent rights shall be granted for the rules and methods which guide mental activities.

When judging whether or not an application for a patent for an invention involving rules and methods for a mental activity belongs to the subject matter for which the patent right may be granted, the following rules shall be observed:

(1) If an invention merely involves rules and methods for mental activities, i. e. , the rules and methods *per se* for mental activities, no patent right shall be granted for it, such as:

- special methods to examine an application for a patent;
- methods and systems of organization, production, commercial activities, economic management, etc. ;
- traffic rules, a scheduling program, or rules of a contest;
- methods of deduction, inference, or operation;
- rules of book classification, methods of editing a dictionary, methods of information searching, and patent classification;
- rules and methods of editing a calendar;
- operating instructions of an instrument or a piece of equipment;
- grammar of various languages and rules of coding of Chinese characters;
- computer languages and their calculating rules;
- short-cut counting method or relevant pithy formulae;
- mathematical theories and methods of conversion;
- methods of psychological test;
- methods of teaching, lecturing, training and beast training;

- rules and methods of various games and entertainments;
- methods of statistics, accounting, and bookkeeping;
- music scores, recipes or chess manual;
- methods of eliminating diseases, body – building or keeping healthy;
- methods of general surveys of diseases and population censuses;
- methods of information formulations;
- computer programs as such

(2) If an invention, as a whole, is not a rule or method for a mental activity but part of the invention belongs to the rule or method for a mental activity, the applicant should not be completely excluded from the possibility of being granted the patent right. It is required to make concrete analysis and deal with the application in the following two ways:

(i) If the contribution of the invention made to the prior art lies only in the part involving a rule or method for a mental activity, the invention shall be regarded as a rule or method for a mental activity and no patent right shall be granted;

(ii) If the contribution of the invention made to the prior art do not or not only lie in the part involving a rule or method for a mental activity, the invention shall not be refused to be granted the patent right according to the provisions of Article 25.1(2) of the Patent Law.

In respect of the question whether or not the application for a patent for invention involving a computer program belongs to a rule or method as provided in Article 25.1(2), see the relevant content of Chapter 9 of this Part.

#### Art. 25.1(3)

### 3.3 Methods for Diagnosis or for Treatment of Diseases

“Methods for the diagnosis or for the treatment of diseases” refers to the methods, taking live human or animal bodies as the immediate object for executing the methods, of distinguishing, determining or eliminating the cause or focus of diseases.

For humanitarian and socially ethical reasons, doctors are free to choose various methods and conditions in the course of diagnosis and treatment of the diseases. Moreover, the said methods are directly executed on live human or animal bodies, so they cannot be applied in industry. The methods are not inventions – creations in the sense of the Law. Therefore, no patent right shall be granted for the methods for the diagnosis or for

the treatment of diseases.

However, all instruments and devices for implementing the methods for the diagnosis or for the treatment of diseases, or the substances and materials used in the course of diagnosis or treatment of diseases, belong to the subject matters for which the patent right may be granted.

### **3. 3. 1 Methods for the Diagnosis of Diseases**

“Method for the diagnosis of diseases” refers to the whole process of distinguishing, studying and determining the cause or focus of diseases on live human or animal bodies.

#### **3. 3. 1. 1 Inventions Belonging to Diagnostic Methods**

Any method that relates to the diagnosis of a disease shall be regarded as a diagnostic method for which no patent right may be granted only if the method complies with the following three requirements:

- (1) It is executed on a live human or animal body;
- (2) Its immediate purpose is to obtain the diagnostic result of a disease;
- (3) It covers the entire process of the diagnosis.

When determining whether or not an invention of method that relates to the diagnosis of a disease is actually a method for the diagnosis of a disease, the examiner should not only consider whether or not the said method in the form of its description meets all of the above – mentioned requirements, but also analyze whether or not the said invention meets these requirements in substance. Take the example of an invention that merely involves the method of obtaining physiological parameter from the human body. It does not meet the above – mentioned three requirements in the form of its description. However, if the diagnostic result of a disease can be achieved directly in accordance with the medical knowledge of the prior art as long as the said physiological parameter is known, the invention is in substance a method for the diagnosis of a disease for which no patent right shall be granted.

According to the above – mentioned rule, the following are examples of methods for which no patent rights shall be granted:

Methods of feeling pulse, foot diagnostic methods, X – ray diagnostic methods, ultrasonic diagnostic methods, gastrointes-

tinal radiography diagnostic methods, endoscopic diagnostic methods, isotope tracing diagnostic methods and infrared noninvasive diagnostic methods.

### 3.3.1.2 Inventions Which Are not Diagnostic Methods

Not all inventions of methods relating to diagnosis are excluded from patent protection. There are some inventions of methods which look like to have relations with the diagnosis of a disease, or their ultimate purpose is the diagnosis of a disease, but their immediate purpose is not the diagnosis of a disease, therefore, they shall not be refused to be granted the patent right according to the provisions of Article 25.1(3) of the Law. The following are examples of inventions of methods of this kind:

(1) The immediate purpose of the method is not to obtain the diagnostic result but only the information and/or the method to process the information (shape parameters, physiological parameter or other parameters) as an intermediate result from a live human or animal body. (It should be explained that, the information will be regarded as intermediate result only if the diagnostic result required by the treatment may not be achieved directly from the information *per se* in accordance with the medical knowledge of the prior art);

(2) Methods to treat or test the tissue, body fluid or excrement that has been removed from a human or animal body;

(3) Methods of pathologic anatomy employed on a dead human or animal body.

### 3.3.2 Methods for the Treatment of Diseases

“Methods for the treatment of diseases” refers to the process of stopping, relieving or eliminating the cause or focus of a disease in order to allow the live human or animal body to restore or obtain health or to relieve pain.

Methods for the treatment of diseases include various methods which serve the purpose of treatment or which is of the nature of treatment. The methods for immunity or for the prevention of diseases are regarded as methods for the treatment of diseases.

If a method contains both a purpose of treatment and a purpose of non – treatment, the method which is clearly indicated as a method used for a “purpose of non – treatment” shall be patentable, otherwise no patent right shall be granted.

### 3. 3. 2. 1 Inventions Belonging to Methods for Treatment of Diseases

Methods for the treatment of diseases for which no patent right shall be granted refer to methods carried out on live human or animal bodies and the immediate purpose of which is the treatment or prevention of diseases.

The following methods belong to or shall be regarded as methods for the treatment of diseases for which no patent right shall be granted :

(1) methods of surgical operation treatment, methods of medicine treatment, psychotherapeutics;

(2) methods of acupuncture, anesthesia, manipulation, massage, scraping treatment, qigong, hypnosis, medicated bath, air bath, sunshine bath, forest bath and nursing which serve the purpose of treatment of diseases;

(3) methods making use of irradiating, radiating, stimulating the human or animal body by electricity, magnetism, sound, light or heat which serve the purpose of treatment;

(4) methods making use of coating, freezing, diathermy or other means which serve the purpose of treatment;

(5) various immune methods for the prevention of diseases;

(6) auxiliary methods for performing treatment by a surgical operation or medicine treatment, such as a method for the treatment of a body organ or tissue returning to the same body, a method of hemodialysis, a method of monitoring the degree of an anesthesia, a method of taking medicines orally, a method of injecting medicines, or a method of applying medicine externally;

(7) methods of fertilization, contraception, increasing the number of sperm, adosculation, embryonic transfer or other means which serve the purpose of treatment;

(8) methods of cosmetic surgery, limb - stretching, weight - reducing, height - increasing which serve the purpose of treatment;

(9) methods for treatment of human or animal wounds, such as a method of disinfecting wound or bandaging a wound;

(10) other methods with the purpose of treatment, such as methods of artificial breathing, or methods of oxygen therapy.

It should be noted that although no patent right shall be granted for methods for the treatment of diseases by medicine,

the medicine *per se* is patentable. For the examination of a patent application that involves medical use of the relevant substance, see Chapter 10, Section 3.5.2 of this Part.

### 3.3.2.2 Inventions not Belonging to Methods for Treatment of Diseases

Where the purpose or the immediate purpose of a method *per se*, which is carried out on human or animal body, is not for treatment of diseases, the grant of the patent right may not be refused according to the provisions of Article 25.1(3) of the Patent Law. Examples are as follows;

(1) methods of making artificial limb or prothesis for the purpose of treatment of an incomplete limb or organ, and methods of measurement for the purpose of making such artificial limb or prothesis. For example, a method of making false teeth, including making teeth mould in the mouth cavity of the patient and making false teeth outside of the body. Although its ultimate aim is treatment, the purpose of the method *per se* is to make proper false teeth;

(2) method of stockbreeding through treatment of animals by methods of non – surgical operation to change their growing features, such as, methods to accelerate growth of the live lamb, improve the quality of mutton or increase the output of sheep's wool by applying certain electromagnetic stimulation;

(3) methods of slaughtering animals;

(4) methods for the treatment of dead human or animal body, such as methods of anatomy, beautification of the body, antiseptis of the body, or specimen making methods;

(5) pure methods for cosmetology, i. e. , methods for cosmetology which are not invasive to the human body or do not produce wounds, including the methods for deodorization, protection, decoration or beautification for the purpose of non – treatment and locally performed at the position which can be seen by people such as skin, hair, nail, or tooth;

(6) methods to make human or animal which are in a state of non – pathogenic feel comfortable, happy, or methods to supply oxygen, negative – oxygen ion or moisture under the special circumstances like diving, anti – toxin;

(7) methods for killing bacteria, viruses, lice, or flea exterior to the human or animal body (on skin or hair, except for on wounds and infections).

### 3.3.2.3 Methods of Surgical Operation

“Methods of surgical operation” refer to the traumatic or invasive curing or treating method practised on living human or animal body by an instrument, such as incisions, resection, stitching, tattooing and so on. No patent right shall be granted for such a method of surgical operation. However, a method of surgical operation practiced on a dead human or animal body belongs to the subject matter for which the patent right may be granted if it does not violate the provisions of Article 5 of the Patent Law.

A method of surgical operation for the purpose of treatment belongs to the method for treatment of the diseases, for which no patent shall be granted in accordance with Article 25.1(3) of the Patent Law.

Art. 22.4 For the examination of methods for surgical operation for non – treatment purpose, see Chapter 5 of this Part.

Art. 25.1(4)

### 3.4 Animal and Plant Varieties

Animals and plants are living substances. According to the provisions of Article 25.1(4) of the Patent Law, no patent right shall be granted for animal and plant varieties. In the Patent Law, an animal refers to the life – form which cannot synthesize carbohydrate and protein by itself and maintains alive only by absorbing natural carbohydrate and protein. The plant mentioned in the Law refers to the life – form which maintains its life by synthesizing carbohydrate and protein from the inorganic substances, such as water, carbon dioxide and mineral salt, through photosynthesis. Usually such plant is immovable. The animal and plant varieties may be protected by other laws besides the Patent Law. For example, the new varieties of plant may be protected by Regulations of the People's Republic of China on Protection of New Varieties of Plants.

Moreover, according to Article 25.2 of the Patent Law, patent right may be granted for the processes used for producing animal and plant varieties. The said processes refer to the non – biological processes. The processes to produce animal or plant mainly through biological method are not included.

Whether or not a process is “mainly through biological method” depends on the degree of human technical involvement. If the human technical involvement is the controlling and decisive factor for achieving the result or effect of that process,

that process is not “mainly through biological method”, thus a patent right may be granted. For example, the patent right may be granted for the method of raising high – yield – milk dairy cattle through irradiation, or the method of raising lean – meat pig by improving the method.

The so-called micro-organism invention refers to an invention relating to producing a chemical substance (such as an antibiotics) or decomposing a substance from various micro-organisms, such as bacteria, fungus, and virus. Both micro-organism and the process of producing the micro-organism may be protected by the patent right. For the examination of the application for a patent for micro-organism invention see the relevant contents in Chapter 10 of this Part.

Art 25.1(5)

### **3.5 Methods of Nuclear Transformation and Substances Obtained by Means of Nuclear Transformation**

The methods of nuclear transformation and the substances obtained by means of nuclear transformation relate to the important State interests of economics, national defense, scientific research and public life. Monopolization by individual or entity is inappropriate. Therefore, no patent right shall be granted for such inventions.

#### **3.5.1 Methods of Nuclear Transformation**

“Methods of nuclear transformation” refers to the processes of one or more atomic nucleus forming one or more new atomic nucleus through fission or fusion, such as the methods of magnetic mirror traps and close trap for realizing the nuclear fusion reaction and various reactors for realizing nuclear fission. No patent right may be granted for these methods. However, the particle acceleration methods, which increase the energy of the particles to realize the nuclear transformation (such as electron line acceleration method, electron standing-wave acceleration method, electron clash method, electron circular acceleration method and so on) are not methods of nuclear transformation, and they are subject matters for which the patent right may be granted.

The various equipments, devices and their replacement components and parts used for realizing the nuclear transformation are subject matters for which the patent right may be granted.



**3. 5. 2 Substances Obtained by Means of Nuclear Transformation**

The substances obtained by means of nuclear transformation primarily refer to various radioisotopes manufactured and produced by accelerator, reactor or other nuclear reaction apparatus. The patent right shall not be granted for such isotope.

However, the application of the said isotope and the device or equipment used for producing such isotope are subject matters for which the patent right may be granted.

**Chapter 2****Description and Claims****1. Introduction**

Any application for a patent for invention shall include a description (where necessary, drawings are required) and its abstract, and claims. Any application for a patent for utility model shall include a description (including drawings), and its abstract, and claims. The description and claims shall comply with the relevant requirements of the Patent Law and its Regulations. These requirements mainly involve Article 26 of the Patent Law and Rules 18 –24 of the Implementing of the Patent Law.

This Chapter shall make general provisions for the main contents of the description and claims and their drafting requirements. For further provisions of the description and claims of the application for a patent for invention in the fields of computer program and chemistry, see relevant contents of Chapter 9 and Chapter 10 of this Part.

**2. Description**

Art. 26. 1

In accordance with the provisions of Article 26. 1 of the Patent Law, there shall be a description in an application for a patent for invention or utility model.

In accordance with Rule 39 of the Implementing Regulations of the Patent Law, submission of the description is one of the indispensable conditions that determine the date of filing of an application for a patent for invention or utility model.

Art. 26. 3 –4

Art. 56

The description and its drawings are mainly used to disclose the invention or utility model in a manner sufficiently clear and complete, so as to enable a person skilled in the relevant field of technology to understand and carry out the invention or utility model. The description and its drawings are also used to support the claims and interpret the claims when determining the extent of protection of the patent for invention or utility model.

Rule 18

Each part of the description shall be written in accordance with the prescribed manner and order. It shall use standard terms and be in clear wording.

**2. 1 Requirements to Be Complied with by Description**

Article 26.3 of the Patent Law provides that the description shall set forth the invention or utility model in a manner sufficiently clear and complete so as to enable a person skilled in the relevant field of technology to carry out the invention or utility model. In other words, the description shall comply with the requirement of sufficient disclosure of the invention or utility model.

For the meaning of "a person skilled in the relevant field of technology", see Section 2. 2, Chapter 4 of this Part.

Art. 26.3

**2. 1. 1 Clarity**

The contents of the description shall be clear. The description shall meet the following requirements:

**(1) Clear subject matter**

The description shall, starting from the prior art, clearly set forth what the invention or utility model wants to do and how to do so as to enable a person skilled in the relevant field of technology to understand explicitly the subject matter of the invention or utility model for which protection is sought. In other words, the description shall disclose the technical problem the invention or utility model aims to solve and the technical solution adopted to solve the problem; and state, with reference to the prior art, the advantageous effects of the invention or utility model. Such technical problem, technical solution and advantageous effects shall be adapted to one another and without any self – conflict or disconnection.

**(2) Accurate wording**

The description shall use terms of the technical field to which the invention or utility model relates. The wording of the description shall accurately indicate the technical contents of the invention or utility model without any ambiguity or equivocation so as to enable persons skilled in the relevant field of technology to clearly and correctly understand the invention or utility model.

Art. 26.3

**2. 1. 2 Completeness**

A complete description shall include the contents provided in Rule 18 of the Implementing Regulations of the Patent Law. Any technical contents which are required for the understanding and carrying out of the invention or utility model should not be lacking.

A complete description shall include the following contents:

(1) contents which are indispensable for helping people to understand the invention or utility model, such as the description of the field of technology to which the invention or utility model pertains, the state of the background art and the brief description of the drawings if any.

(2) contents which determine whether or not the invention or utility model possesses novelty, inventiveness and practical applicability, such as the technical problem the invention or utility model aims to solve, the technical solution adopted to solve the problem, and the advantageous effects of the invention or utility model.

(3) contents which are required for carrying out the invention or utility model, such as the mode of the technical solution adopted to solve the technical problem of the invention or utility model.

Where the invention or utility model has overcome a prejudice, the description shall explain why the invention or utility model is said to have overcome the prejudice, the difference between the new technical solution and the prejudice, and the technical means adopted to overcome the prejudice.

It should be pointed out that, all of the relevant contents which a person skilled in the relevant field of technology cannot obtain directly and solely from the prior art shall be included in the description.

#### Art. 26.3

##### 2.1.3 Practical Applicability

"Can be carried out by a person skilled in the relevant field of technology" means that the person skilled in the relevant field of technology can, in accordance with the contents of the description, and without further inventive effort, carry out the technical solution of the invention or utility model, solve the technical problem and achieve the expected technical effects.

The following are examples of circumstances in which the technical solution described in the description are regarded as unable to be carried out due to lack of technical means to solve the technical problem:

(1) The description sets forth only a task and/or assumption, or only a willingness and/or result, without describing any technical means to enable a person skilled in the relevant field of technology to carry it out;

(2) The description sets forth the technical means, but the means are so ambiguous and vague that a person skilled in the relevant field of technology cannot carry it out according to the contents of the description;

(3) The description sets forth the technical means, but a person skilled in the relevant field of technology cannot solve the relevant technical problem by adopting the said means;

(4) The subject matter of an application is a technical solution consisting of several technical measures, but one of them cannot be carried out by a person skilled in the relevant field of technology according to the description;

(5) The description sets forth a concrete technical solution without experimental evidence. However, the solution can only be established upon confirmation by the experimental result.

## **2.2 Manner and Order of Presentation of Description**

### **Rule 18.1**

In accordance with the provisions of Rule 18 of the Implementing Regulations of the Patent Law, the description of an application for a patent for invention or utility model shall state the title of the invention or utility model, which shall be the same as it appears in the request. The description shall include the following:

(1) Technical field: specifying the technical field to which the technical solution seeking protection pertains;

(2) Background art: indicating the background art which can be regarded as useful for the understanding, searching and examination of the invention or utility model, and when possible, citing the documents reflecting such art;

(3) Contents of the invention or utility model: disclosing the technical problem the invention or utility model aims to solve and the technical solution adopted to solve the problem; and stating, with reference to the prior art, the advantageous effects of the invention or utility model;

(4) Description of figures: briefly describing each figure in the drawings, if any;

(5) Mode of carrying out the invention or utility model: describing in detail the optimally selected mode contemplated by the applicant for carrying out the invention or utility model; where appropriate, this shall be done in terms of examples, and with reference to the drawings, if any.

- Rule 18. 2           The manner and order mentioned above shall be followed by the applicant for a patent for invention or utility model, and each of the parts shall be preceded by a heading, unless, because of the nature of the invention or utility model, a different manner or a different order would result in a better understanding and a more economical presentation.
- Rule 18. 3           The description of the invention or utility model shall use standard terms and be in clear wording, and shall not contain such references to the claims as “as described in claim...”, nor shall it contain commercial advertisement.
- Rule 18. 4           Where an application for a patent for invention contains disclosure of one or more nucleotide and/or amino acid sequence, the description shall contain a sequence listing in compliance with the standard prescribed by the Office. The sequence listing shall be submitted as a separate part of the description, and a copy of the said sequence listing in machine – readable form shall also be submitted in accordance with the provisions of the Office.
- The following is a detailed explanation of the manner and order mentioned above.
- Rule 18. 1           **2. 2. 1 Title**
- The title of the invention or utility model shall be clear and concise. It shall appear at the middle of the top of the first page of the text of the description.
- The title of the invention or utility model shall be written in accordance with the following requirements:
- (1) The title of the invention or utility model in the description shall be the same as it appears in the request. Normally a title shall contain not more than 25 Chinese characters;
- (2) Use the technical terms generally adopted in the technical field to which the invention or utility model pertains preferably the technical terms appearing in the International Patent Classification. The title shall not use non – technical terms;
- (3) Reflect clearly and concisely the subject matter and the kind (product or process) of the technical solution of the invention or utility model seeking protection so as to be helpful to the classification of the application for a patent;
- (4) The title shall comprehensively reflect various categories of inventions included in the application. For example, if an application includes two inventions—a zipper product and the

process of making the zipper, its title shall be stated as “ zipper and its making process ”;

(5) The title shall not contain a name of a person or place, trademark, model or a name of goods, and so on. Nor shall it contain commercial advertising.

Rule 18. 1(1)

**2. 2. 2 Technical Field**

The technical field of the invention or utility model shall be the specific technical field to which the technical solution of the invention or utility model pertains or directly applies, and not the more general or adjacent technical field, nor the invention or utility model *per se*. The specific technical field usually relates to the lowest position in which that invention or utility model may be classified according to the International Patent Classification. For example, an invention relating to an excavator cantilever. The inventive feature is a change from the rectangular section of the cantilever of the prior art to elliptic section. The technical field to which it pertains may be drafted as “this invention relates to an excavator. Especially to an excavator cantilever” (specific technical field), and not “this invention relates to a building machinery” (more general technical field), nor “this invention relates to the elliptic section of an excavator cantilever” or “this invention relates to the excavator cantilever that has an elliptic section” (invention *per se*).

Rule 18. 1(2)

**2. 2. 3 Background Art**

The part of the background art in the description of an invention or a utility model shall indicate the background art which is useful for the understanding, searching and examination of the invention or utility model, and cite the documents reflecting such art. Especially it shall cite the prior art documents which contains the technical features stated in the preamble portion of the independent claim of the invention or utility model, that is, the documents relating to the prior art which are closest to the application for a patent for invention or utility model. The documents cited in the description may be either patent documents or non – patent literature, such as journal, magazine, manual and book and so on. Where the description cites a patent document, it shall indicate at least the name of the country, publication number and, preferably, the publication date of the patent document. Where non – patent literature is cited, it shall indicate its detailed

source.

Moreover, the problems and defects exist in the background art, which relate only to the problem and defect solved by the technical solution of the invention or utility model, shall be objectively described in this part. Where it is possible, the reasons why such problems or defects existed and the difficulties encountered in solving them should also be included.

The cited document shall also comply with the following requirements;

(1) The cited document should be publicly published. Besides paper form, an electronic publication or other forms of publications are included as well.

(2) The date of publication of the cited non – patent literature or foreign patent documents shall be earlier than the date of filing of the application; and the date of publication of the cited Chinese patent document shall be earlier than the date of publication of the application.

(3) Where the cited document is a foreign patent document or foreign non – patent literature, the citation shall indicate the reference and relevant information of the cited document in the language used when the cited document was promulgated or published. Where the cited document was translated into Chinese, the original language shall be indicated.

If the cited document satisfies those requirements, its contents shall be regarded as having been disclosed in the description of the relevant application. However, whether or not such citation has satisfied the requirement of sufficient disclosure of an invention or utility model, see Paragraph 9, Section 2.2.6 of this Chapter.

**Rule 18.1(3)**

**2.2.4 Contents of Invention or Utility Model**

This part shall clearly and objectively include the following contents:

(1) The technical problem to be solved

The technical problem which the invention or utility model wants to solve refers to the technical problem existing in the prior art which the invention or utility model aims to solve. The technical solution disclosed in the application for a patent for invention or utility model shall be able to solve these problems.

The technical problem which the invention or utility model aims to solve shall be written in accordance with the following re-



quirements:

(i) to point out the defect or deficiency existing in the prior art against which the invention or utility model is directed;

(ii) to describe in positive and concise words objectively and with good grounds the technical problem which the invention or utility model aims to solve, and further to describe the technical effects.

No commercial advertisement shall be used in the description of the technical problem which the invention or utility model aims to solve.

The description of an application for a patent may contain one or more technical problems that the invention or utility model aims to solve, and the technical solutions for solving these technical problems shall be disclosed in the description. Where one application contains several inventions or utility models, all of the technical problems aimed to be solved stated in the description shall be related to a single general inventive concept.

#### (2) Technical solution

The core of an application for a patent for invention or utility model is the technical solution disclosed in the description.

The technical solution is the assembling of technical measures adopted by the applicant for solving the technical problem. Usually, the technical measures are represented by technical features.

“Disclosing the technical solution of the invention or utility model adopted to solve the technical problem”, referred to in Rule 18.1 (3) of the Implementing Regulations of the Patent Law, means describing clearly and completely the technical features of the technical solution adopted by the invention or utility model to solve the technical problem. This part shall at least include the technical solution of the independent claim containing all the essential technical features, and may also include the technical solutions for further improvement containing other additional technical features.

Generally, the part of the technical solution in the description shall first state the technical solution of the independent claim, in words similar to or identical with those used in the independent claim, that is, in the form of the assembling of its essential technical features to clarify the essence of an invention or utility model. Where necessary, this part shall state the relations between the assembling of the essential technical features and

the effects of the invention or utility model.

Then, this part shall describe the additional technical features of the invention or utility model, to reflect the technical solution of a dependent claim by which further improvement is made to the invention or utility model.

Where one application contains more than one invention or utility model, the technical solution of each invention or utility model shall be described separately.

### (3) Advantageous effects

The description shall clearly and objectively state the advantageous effects of the invention or utility model as compared with the prior art.

"Advantageous effects" refer to the direct effects brought about by the technical features which constitute the invention or utility model, or the effects which are bound to produce from those technical features.

Advantageous effects are the important basis to determine whether the invention represents "a notable progress", or whether the utility model represents "progress".

Usually, advantageous effects may find their expression in the improvement of productivity, quality, precision and efficiency; decrease of energy consumption, raw materials and working procedures; simplification of the processing, operation, control or application; improvement or radical cure of environment pollution, or the appearance of useful function, etc.

Advantageous advantages may be described by way of the analysis of the structural features of the invention or utility model combined with theoretical description, or the citation of experimental data. It is not enough just to conclude that the invention or utility model possesses the advantageous effects.

However, no matter what method is used to explain the advantageous effects, the invention or utility model should be compared with that of the prior art and point out where the invention or utility model is different from the prior art.

The advantageous effects of the invention or utility model in the fields of mechanics and electricity may, under certain circumstances, be explained by the structural features in conjunction with the manner of the invention or utility model brought into play. However, for the inventions in the field of chemistry, under most circumstances, it is not suitable to use the above method to explain their advantageous effects. Their advantageous

effects are explained by means of experimental data.

In the case of certain fields, such as taste or smell, as there is no suitable measuring method to be adopted, they have to be judged by human sensory organs. Their advantageous effects may be described by means of statistical experimental results.

Where the advantageous effects are explained by citing experimental data, the necessary experimental conditions and methods shall be explained.

Rule 18.1(4)

**2.2.5 Description of Figures**

Where there are drawings in the description, the title of each figure in the drawings shall be stated and the contents expressed by the drawings briefly explained. Where there are quite a lot of components and parts, the titles of the specific components and parts in the drawings may be included in the form of a list.

Where there are two or more figures, the description shall briefly describe all of the figures.

For example, an application for a patent for an invention entitled "An Energy - saving System of the Fire - coal Boiler", includes four figures in its description. The captions of the figures are as follows:

Fig. 1 is the front view of the fire - coal energy - saving system;

Fig. 2 is the side view of the said energy - saving system in Fig. 1;

Fig. 3 is the view along the A direction in Fig. 2;

Fig. 4 is the B - B sectional view in Fig. 1.

Rule 18.1(5)

**2.2.6 Mode of Carrying Out**

The optimally selected mode of carrying out of the invention or utility model is an important part of the description, which is extremely important for the sufficient disclosure, understanding and carrying out of the invention or utility model, as well as for the support and explanation of the claims. Consequently, the description shall describe in detail the optimally selected mode contemplated by the applicant for carrying out the invention or utility model. Where appropriate, this shall be done in terms of examples, and with reference to the drawings, if any.

The optimally selected mode of carrying out of the invention or utility model shall embody the technical solution for solving the technical problem adopted in the application, and shall also de-

scribe in detail the technical features of the claims so as to support the claims.

The description of the optimally selected mode of carrying out of the invention or utility model should be detailed (with reference to the drawings, if any), so as to enable a person skilled in the relevant field of technology to carry out the invention or utility model without any inventive effort.

The example is the illustration of the optimally selected mode of carrying out the invention or utility model. The number of examples shall be determined in accordance with the nature of the invention or utility model, the technical field to which the invention or utility model pertains, status of the prior art and the scope of protection of the claims.

The description may give only one example, if that is sufficiently to support the technical solution described in the claims. Where a claim (especially an independent claim) covers a broad scope and the features generalized by the claim cannot find its basis in one example, the description should give more than one example in order to support the scope of protection of the claims. Where the range of numerical value involved in the claims is quite broad, the description shall give examples with the values near both ends and at least one with the median value.

Where the technical solution of an invention or utility model is comparatively simple, if the part relating to the technical solution in the description gives a clear and complete explanation of the subject matter of an application for a patent for invention or utility model, the applicant need not repeat the explanation in the part relating to the mode of carrying out in the description.

In the case of a product invention or utility model, the mode or example of carrying out shall describe the mechanical structure, electro-circuit structure or chemical components, and the interrelationship between the various parts of which the product consists. In the case of movable products, if the description of various parts of which the product consists will not enable a person skilled in the relevant field of technology to understand and carry out the invention or utility model, the description shall also contain the process of the activity or operating steps.

In the case of a process invention, the description shall contain the steps of the process, including the technological conditions expressed by different parameters or scope of parameter.

The detailed description of the most nearly related prior art or the technical feature in common with the most nearly related prior art may, in general, not be included in the part of the mode of carrying out of the invention or utility model, but the technical feature of an invention or utility model which is distinct from that of the prior art, or the additional technical features in the dependent claim shall be sufficiently described in detail so as to enable a person skilled in the relevant field of technology to carry out the technical solution. It should be noted that, for the convenience of examination and in order to help the public understand directly the invention or utility model, the applicant may not omit those contents which are indispensable to comply with the requirements as provided in Article 26.3 of the Patent Law by citing either other documents or other paragraphs of the description. They shall be concretely written in the description.

Where the description describes the mode of carrying out an invention or utility model with reference to the drawings, the adopted reference signs or symbols shall be the same as those appeared in the drawings and placed after the corresponding technical terms without brackets. For example, an illustration relating to the connection of the circuits may be written as "resistor 3 is connected with capacitor 5 through the collector of triode 4", and not written as "3 is connected with 5 through 4".

#### Rule 18.3

#### 2.2.7 Other Requirements for Writing of Description

The contents of the description shall use accurate terms and be in clear wording. In other words, the contents of the description shall be clear and definite, and without any ambiguousness, vagueness or contradictions so as to enable a person skilled in the relevant field of technology to understand the description easily.

The description shall use the technical terms of the technical field to which the invention or utility model pertains. As for the terms of natural science, the standard scientific terms shall be used if there is a prescribed one set forth by the State. If there is no such standard terms, the terms established by the persons through long use in the relevant technical field may be adopted, the scientific and technological term known by only a few people or most recently appearing terms may also be adopted, or the terms in foreign language (with Chinese transliteration or free translation) may be used directly, but the meaning of the terms

must be clear to the persons skilled in the relevant field of technology, and no misunderstandings may occur. Where necessary, self-defining terms may be used with clear and definite definition or explanation. Generally speaking, the description shall not use terms which already have basic meaning in the relevant field of technology to express the meaning which is not included in the original idea, in order to avoid misunderstanding or confusion. The scientific and technological terms and symbols used in the description shall be consistent from the beginning to the end.

The description shall be written in Chinese. However, under the prerequisite that no different meaning may be produced, some particular words may be written in a language other than Chinese. When a non-Chinese technical term is used in the description for the first time, it shall be annotated by Chinese translation or explained in Chinese.

For example, an application may use non-Chinese expressions under the following circumstances:

(1) The technical terms well-known by persons skilled in the relevant field of technology may be expressed in a non-Chinese language. For example, erasable and programmable read-only memory is expressed by the term of "EPROM"; central processing unit is expressed by the term of "CPU". However, it is not allowed to continuously use non-Chinese technical terms in one sentence with the result that the sentence is difficult to understand;

(2) As for measuring units, mathematic symbols, mathematic expressions, various programming languages, computer programs, representation symbols with special meaning (such as the abbreviation of China State Standard—GB) and so on, non-Chinese expression may be used.

Besides, the references and title of cited foreign patent document, patent application, and non-patent literature shall use their original language. Where necessary, the Chinese translation shall be put in brackets.

The measuring unit used in the description should be the legal measuring unit of the State, including international system of unit and other State-selected unit. Where necessary, the description may use other measuring unit well known in the relevant technical field, but the legal measuring unit of the State shall be indicated simultaneously.

Where it is inevitable to use the name of goods in the de-

scription, it shall be followed by its model, specification, function and manufacturer.

The description should avoid defining the substance or product by use of the registered trademark.

Rule 19

### 2. 3 Drawings

Art. 26. 3

The drawings are a component part of the description.

The function of the drawings is to supplement the explanation in the text of the description with figures to enable a person to intuitively and visually understand each technical feature and the whole technical solution of an invention or utility model. The function of the drawings in applications for a patent in the fields of mechanics and electricity is even more obvious. Therefore, the drawings shall clearly reflect the contents of the invention or utility model.

The drawings in an application for a patent for invention may be dispensed with if the description can set forth the technical solution of an invention in words in a sufficiently clear and complete manner.

An application for a patent for utility model must contain drawings.

Rule 19. 3

Where several figures are included in an application for a patent, the drawing reference sign for the same technical feature (or the same object) shall be the same for all of the figures. The identical drawing reference sign used in the description and in the drawings shall represent the same technical feature (or the same object). Reference signs not mentioned in the text of the description shall not appear in the drawings. Reference signs not mentioned in the drawings shall not appear in the text of the description either.

Rule 19. 4

The drawings shall not contain any other explanatory notes, except words which are indispensable. However, as for drawings like flow chart or block diagram, the necessary words or signs shall be written in its blocks.

Rule 19. 1

Rule 19. 2

For the requirements for making the drawings, see Section 2. 4 , Chapter 1 of Part I of these Guidelines.

Rule 24

### 2. 4 Abstract

The abstract is the summary of the contents disclosed in the description. It is merely a piece of technical information with no legal effect.

The contents of the abstract do not belong to those of the original disclosure of an invention or utility model. Therefore, they cannot be relied upon later to make amendments to the description or claims. They cannot be used to interpret the scope of protection of the patent right.

The abstract shall comply with the following requirements:

Rule 24.1 – 2

(1) The abstract shall indicate the title of the invention or utility model, and the technical field to which the invention or utility model pertains, clearly reflect the technical problem which it aims to solve, the gist of the technical solution which is adopted to solve that technical problem and the principal use or uses of the invention or utility model. The main thing of the contents is the technical solution. The abstract may contain the chemical formula which best characterizes the invention;

Rule 24.2

(2) In applications for patent which contain drawings, the applicant shall designate and furnish a figure which best characterizes the main technical features of the invention or utility model;

Rule 24.2

(3) The scale and the distinctness of the figure shall be as such that a reproduction with a linear reduction in size to 4cm x 6cm would still enable all details to be clearly distinguished;

Rule 24.2

(4) The whole text of the abstract shall contain not more than 300 Chinese characters, and there shall be no commercial advertising in the abstract.

Moreover, reference signs appearing in the text of the abstract shall be put between parentheses.

### 3. Claims

The claims shall be supported by the description, and shall define clearly and concisely the matter for which protection is sought in terms of the technical features of the invention or utility model. The contents and writing of the claims are stipulated in Article 26.4 of the Patent Law and Rules 20 – 23 of the Implementing Regulations of the Patent Law.

Rule 21.1

The claims shall contain at least one independent claim, and may also contain dependent claims.

#### 3.1 Claim

##### 3.1.1 Kinds of Claims

According to the nature of claims, they are divided into two



basic kinds, namely, claims to a physical entity ("product claim") and claims to an activity ("process claim"). The first basic kind of claim includes any physical entity (product, apparatus) which is produced by man's technical skill. The second basic kind of claim includes activities with element of course of time (process and use). Claims to a physical entity include claims to articles, substances, materials, tools, apparatus and equipment. Claims to an activity include claims to manufacturing process, methods of use, communication methods, methods of handling, methods of applying a product for a specific purposes, etc.

The purpose of classifying the claims is to define the scope of patent right.

### 3. 1. 2 Independent and Dependent Claims

#### Rule 21.2

The independent claim shall outline the technical solution of an invention or utility model, and state the essential technical features necessary for the solution of its technical problem.

The essential technical features refer to the indispensable technical features of an invention or utility model to solve its technical problem, the sum total of when is sufficient to constitute the technical solution of the invention or utility model and to distinguish it from other technical solutions of the background art.

Among the claims of an application, the scope of protection of the invention or utility model defined by the independent claim is the broadest one.

#### Rule 21.3

Where one claim contains all the technical features of another claim of the same category, and further defines the technical solution of the claim which it refers to, that claim is a dependent claim. Because the dependent claim goes a step further to define the claim which it refers to by additional technical features, the scope of protection of the dependent claim falls into that of the claim which it refers to.

The additional technical features of a dependent claim may be technical features for further defining those of the claim it refers to, or newly introduced technical features.

An application shall have at least one independent claim in the claims. Where there are two or more independent claims in the claims, the one written in the first position is called the first independent claim, and others are called parallel independent claims. The examiner shall take note that sometimes a parallel

independent claim may also refer to the preceding independent claim (for example, a parallel independent claim may be written like “an apparatus for the carrying out of the process of claim 1, ...”; or “a process for the manufacture of the product of claim 1, ...” etc.). Under such circumstances, the subject matter described in the parallel independent claim is a different kind of invention, which cannot be regarded as a dependent claim. Under some circumstances, a claim in the form of a dependent claim (i. e., including the reference portion of a dependent claim) is not necessarily a dependent claim in substance. For example, claim 1 states “a machine tool with feature X”. Another later claim states “a machine tool according to claim 1 is characterized in that it replaces X by Y”. Here, the later claim is also an independent claim. The examiner shall not regard the later claim as a dependent claim just from the form of the claim.

### 3. 2 Requirements to Be Satisfied by Claims

Article 26. 4 of the Patent Law provides that the claims shall be supported by the description and shall state the extent of the patent protection asked for. Moreover, Rule 20. 1 of the Implementing Regulations of the Patent Law provides that the claims shall define clearly and concisely the matter for which protection is sought in terms of the technical features of the invention or utility model.

#### Art. 26. 4

#### 3. 2. 1 Support in Description

The claims shall be based on the description. It means that the claims must be supported by the description. Claims shall not only be supported by the description in the form of expression, but also be supported by the description in substance. In other words, the technical solution seeking protection in each claim should be the technical solution which can be directly derived or acquired by summarization by a person skilled in the relevant field of technology from the contents disclosed in the description, and the extent of the claim shall not go beyond the scope of the contents included in the description.

Usually, claims are generalizations from one or more modes or examples of carrying out of the technical solution disclosed in the description. The generalization of the claim should be appropriate so as to keep its extent of protection corresponds just right with the contents disclosed in the description. The examiner

shall judge whether the generalization of the claim is appropriate in the light of the relevant prior art. An invention which opens up a whole new field of technology is entitled to more generality in the claims than one that is concerned with advances in a known field of technology. A claim of appropriate generalization is one that does not go beyond the scope of the initial disclosure of an application for a patent, nor does it cause loss of any of the applicant's rights and interests to which it/he is entitled.

Where the generalization of a claim includes the contents inferred by the applicant and it is difficult to determine and evaluate their results in advance, the examiner shall regard the generalization as going beyond the scope of the initial disclosure. Under such circumstances, the examiner shall invite the applicant to make amendments in accordance with Article 26.4 of the Patent Law on the ground that the claim cannot find its support in the description.

Take the example of "a method of affecting substances by high frequency electric energy" which is a claim of broad generalization. If the description contains only one embodiment concerning "eliminating dust from the gas by high frequency electric energy", without stating that other substances may also be affected by high frequency electric energy, and if it is difficult for a person skilled in the relevant field of technology to determine and evaluate the results of affecting other substances by high frequency electric energy in advance, the claim should be regarded as not supported by the description.

Another example of "a method of treating seeds of a plant by controlling the freezing time and extent" which is also a claim with broad generalization. If the description contains only a method of treating one kind of seeds of plant and nothing about any method of treating other plant seeds, and if it is difficult for a horticulturist to determine and evaluate the results of treating other kinds of plant seeds by such a method in advance, the claim should be regarded as not supported by the description. Only when the general relationship between this kind of plant seeds and other kinds of plant seeds is included in the description, or sufficient number of embodiments are disclosed in the description, a horticulturist is thus able to understand how to use this method to treat the plant seeds, can the claim be regarded as being supported by the description.

In respect of a claim with broad generalization and relating

to the whole class of materials or machines, if it is fairly supported by the description, and there is no reason to doubt that the invention or utility model cannot be carried out within the scope of the claim, then the claim may be accepted even if it is of broad scope. However, if the information given in the description is insufficient to enable a person skilled in the relevant field of technology to extend the teaching of the description to the scope claimed by using routine methods of experimentation or analysis, the examiner shall invite the applicant to explain that a person skilled in the relevant field of technology can readily extend the invention or utility model to the scope claimed on the basis of the information given in the description; otherwise, the examiner shall invite the applicant to restrict the claim. For example, in respect of a claim of "a method of treating synthetic resin moulding to obtain changes in characteristics", if examples described in the description relate only to thermoplastic resin, and the applicant cannot prove that this method is also applicable to thermosetting resin, then the applicant should restrict the scope of the claim to thermoplastic resin.

Where the description of the technical solution with a feature contains only one embodiment, and the feature in the claim is defined in terms of function, if a person skilled in the relevant field of technology could understand that the function may be carried out by other means which are not stated in the description, the claim is permitted to be defined in terms of function. However, if the function described in the description is carried out in a particular way, without other alternative means being stated, and if a claim is formulated in such a way as to embrace other means or all means of performing the function, it is not permitted. Furthermore, if the description merely states in vague terms that other means may be adopted, but a person skilled in the relevant field of technology does not understand what these methods are and how they are used, then it is not permitted to have a claim defined in terms of function.

When determining whether the claims are supported by the description, the examiner should take the whole contents of the description into account and not merely the part of embodiments of the description. If other parts of the description include the contents of the specific mode or example of carrying out the invention or utility model, that is to say, the generalization of the claims is appropriate as judged by the whole contents of the de-

scription, then the examiner shall regard the claims as being supported by the description.

Art. 33

Where parts or all of the contents of the technical solution seeking protection are disclosed in the claims of the application as filed, but are not mentioned anywhere in the description, the applicant is permitted to add those contents to the description. However, in so doing it would only help the claims to appear being supported by the description in form. It does not mean that the claims are also supported by the description in substance. Only when the technical solution seeking protection by the claims can be directly obtained or acquired through generalization by a person skilled in the relevant field of technology from the contents disclosed in the description, may the claim containing that technical solution be regarded as really being supported by the description.

3. 2. 2 Clarity

Rule 20. 1

The clarity of the claims is extremely important for defining the extent of protection of an invention or utility model.

The claims shall be clear. It means that, first, each of the individual claims shall be clear. Second, it means all of the claims as a whole shall be clear as well.

First, the category of each claim shall be clear and in agreement with the subject matter of the invention or utility model seeking protection. A product claim is applicable to a product invention, and may be described in terms of the structural features of the product. A process claim is applicable to a process invention, and may be described in terms of the technical features of a technical process, operating conditions, steps or procedures.

Second, the extent of protection defined by each claim shall be clear. The extent of protection of a claim shall be understood in accordance with the meaning of the words used by the claim. In particular cases, where the description gives a word a special meaning and that word is used in the claim, if the scope of protection of the claim is defined clearly because of the definition of the word in the description, such use should be permitted. Usually, a product claim shall avoid as far as possible defining the invention in terms of features of function or effect. Only when a technical feature cannot be defined by a feature of structure, or if it is defined by a feature of structure, the meaning of the claim

is not as clear as it is defined by a feature of function or effect, and, in addition, that function or effect can be directly and positively confirmed by the experiment or operation fully stated in the description, may a product claim be defined an invention in terms of a feature of function or effect. However, the applicant may not make use of features of function or effect to broaden the extent of protection at will, so as to avoid the scope of protection of the claim from being made unreasonable. Claims of features of pure function should especially not be allowed to appear. The functional feature in the claim shall be understood as including all the modes by which the said function can be carried out.

The standard technical terms set forth by the State shall be used in the claims. Exceptions are not allowed unless they are absolutely necessary. No jargon, local dialect or self – created terms may be used.

Any words which have uncertain meanings, such as “thick”, “thin”, “strong”, “weak”, “high temperature”, “high pressure”, “very broad scope” and other similar words shall not be used in the claims, unless such words have a generally accepted exact meaning in a specific field.

Any claim should not include expressions like “such as”, “it is better...”, “especially”, “where necessary”, “etc.”, “or the like” and so on, since those expressions used in a claim may produce different extent of protection, or the extent of protection may not be clearly defined by such expressions.

Generally, the words “about”, “approximately” or other similar words may not be used in the claims. If such words appear in a claim, the examiner shall determine whether the use of such words may cause the claim ambiguous. If not, the words may be accepted. However, when considering novelty or inventiveness, if the use of such words makes the invention or utility model not clearly distinguishable from the prior art, then the use of such words cannot be accepted.

Finally, the claims as a whole should be clear as well. This means that the reference relations between the claims should be clear (see Section 3.3 of this Chapter).

### 3.2.3 Conciseness

The claims shall be concise. This means, first, Individual claims shall be concise, and second, the claims in their entirety shall be concise too. For example, there shall not be two or

more claims of the same category and having substantially the same extent of protection in one application.

The number of claims shall be reasonable. It is allowed to have a reasonable number of dependent claims in the claims to define the optimally selected technical solution of the invention or utility model.

The wording of the claims shall be concise. Except for the technical features, no unnecessary statement of cause or reason may be included, nor shall it contain commercial advertising.

In order to avoid unnecessary repetition of the identical content among the claims, where possible, the claims shall be drafted in the form of referring to the preceding claim as much as possible.

### 3.3 Requirements for Writing of Claim

Since the extent of protection of a claim is defined by the technical features described therein assembled as a whole, so each claim shall have only one full stop at its end.

Rule 20.2

If there are two or more claims, they shall be numbered consecutively in Arabic Numerals.

Rule 20.3

The technical terminology used in the claims shall be consistent with that used in the description. The claims may contain chemical formulae, chemical reaction formulae or mathematical formulae but no illustrations or drawings. They shall not, except where absolutely necessary, contain such indications as "as described in part... of the description", or "as illustrated in figure ... of the drawings" or the like. "Absolutely necessary" refers to a situation where a specific shape of an invention which can be defined by drawings only and not by words. Under such circumstances, the words "as illustrated in figure..." or the like may be used in the claims.

Usually, a claim shall not contain tables, unless the subject matter of the invention may be expressed more clearly by tables.

Rule 20.4

The technical features mentioned in the claims may, in order to facilitate understanding the technical solution of the claims, make reference to the corresponding reference signs in the drawings of the description. Such reference signs shall be placed in parentheses and after the corresponding technical features. They shall not be construed as limiting the extent of protection of the claims.

The use of parentheses shall be avoided as far as possible

in the claims except for the reference signs of drawings or other necessary situation.

Generally, one claim shall be described in one paragraph. However, where there are many technical features, the contents and their interrelationship are quite complicated, and it is difficult to make the relationship clear by punctuations and signs, one claim may be described in separate lines or paragraphs.

Where the claim is supported by the description, it is permitted to make a generalized definition of the invention or utility model. Usually there are two modes of generalization as follows:

(1) Generalization by using general concepts. For example, "gas laser" may be used to generalize He - Ne laser, argon ion laser, carbon monoxide laser, carbon dioxide laser and so on; " $C_1 - C_4$  alkyl" may be used to generalize methyl, ethyl, propyl and butyl group; "belt drive" may be used to generalize flat belt drive, vee belt drive and odontoid belt drive.

(2) Generalization by using parallel selection. This is, by using the words "or" or "and", to keep two or more features in parallel, such as, "features *A*, *B*, *C* or *D*". Another example, "to select one substance from a group consisting of *A*, *B*, *C*, and *D*".

When parallel selection is used for generalization, the specific contents to be generalized by parallel selection shall be equivalent. The contents generalized by a general concept cannot be juxtaposed after a specific concept by "or". Furthermore, the meaning of the concepts generalized by the parallel selection shall be clear. For example, in the statement of "*A*, *B*, *C*, *D* or other similar ones (equipment, process, substance)", the meaning of the concept of "similar ones" is not clear, so it cannot be placed in parallel with the specific products or processes (*A*, *B*, *C*, *D*).

The examiner shall pay special attention to whether the said generalizations broaden the scope of protection of the invention or utility model and whether they are supported by the description. If there is reason to doubt the appropriateness of the generalization, or if no basis is found for such generalization in the description, the examiner shall invite the applicant to furnish evidence and state the reasons for such generalization. If the examiner finds the contents generalized in the claims from the prior art, such as certain specific concept, it means the generalization of the claim is too broad. The examiner shall invite the appli-



cant to make further limits to the claim.

### 3.3.1 Requirements for Writing of Independent Claim

In accordance with the provisions of Rule 22.1 of the Implementing Regulations of the Patent Law, an independent claim of an invention or utility model shall contain a preamble portion and a characterizing portion, and be presented in the following form:

(1) a preamble portion: indicating the title of the subject matter of the technical solution of the invention or utility model for which protection is sought, and those essential technical features of the invention or utility model which, in combination, are part of the most nearly related prior art;

(2) a characterizing portion: stating in such words as "characterized in that ..." or in similar expressions, the technical features of the invention or utility model which distinguish it from the most nearly related prior art. Those features, in combination with the features stated in the preamble portion, serve to define the scope of protection of the invention or utility model.

It is further stipulated in Rule 22.3 of the Implementing Regulations of the Patent Law that an invention or utility model shall have only one independent claim, which shall precede all of the dependent claims relating to the same invention or utility model. The intention of this stipulation is to make the claims as a whole more clear and concise.

In the preamble portion of the independent claim, the essential technical features of the subject matter of the invention or utility model that are in common with the most nearly related prior art refer to those technical features of the technical solution of the invention or utility model seeking protection which are in common with those of a single document of the most nearly related prior art. Where it is appropriate, it is preferable to select a single document of the prior art which is most nearly related to the invention or utility model to "draw a line of demarcation".

In the preamble portion of the independent claim, it needs only to state, in addition to the title of the subject matter of the technical solution of the invention or utility model for which protection is sought, those essential technical features of the prior art which are closely related and common to the technical solution of the invention or utility model. Take the example of an invention relates to a photographic camera. The main point of the invention is the improvement of the focal plan shutter of the cam-

era. In the preamble portion, it needs only to describe “a photographic camera including a focal plan shutter...”, and there is no need to refer to the other known features of the parts of a camera such as lens and view – finder. In the characterizing portion of the independent claim, it is necessary to state the essential technical features of the invention or utility model which are different from those of the most nearly related prior art. Those distinguishing technical features and the technical features described in the preamble portion combine to constitute the whole essential technical features of an invention or utility model and define the extent of protection of the independent claim.

The purpose of an independent claim divided into two portions is to show to the public more clearly, in all of the technical features of an independent claim, which are the common technical features of the invention or utility model and the most nearly related prior art, and which are the technical features of the invention or utility model different from those of the most nearly related prior art.

In accordance with Rule 22.2 of the Implementing Regulations of the Patent Law, where the two – part form of claiming mentioned above is not appropriate to be followed because of the nature of the invention or utility model, the independent claim may be drafted not in two parts. The following are examples:

- (1) inventions which open up a whole new field;
- (2) inventions made by combining several known technology integer of equal status, the gist of the invention lying in the combination;
- (3) inventions of improvement of known processes, the gist of improvement lying in the omission of certain substance or material, the substitution of one substance or material for another substance or material, or the omission of a step;
- (4) known inventions improved by making certain changes in the parts of known system, or in their interrelationship.

### 3.3.2 Requirements for Writing of Dependent Claim

In accordance with the provisions of Rule 23.1 of the Implementing Regulations of the Patent Law, any dependent claim of an invention or utility model shall contain a reference portion and a characterizing portion, and be presented in the following form:

- (1) a reference portion; indicating the serial number(s) of the claim(s) referred to, and the title of the subject matter;

(2) a characterizing portion: stating the additional technical features of the invention or utility model.

#### Rule 23.2

Any dependent claim shall refer only to the preceding claim or claims. Any multiple dependent claim, which refers to two or more claims, shall refer to the preceding one in the alternative only, and shall not serve as a basis for any other multiple dependent claims.

The reference portion of the dependent claim shall indicate the serial number(s) of the claim(s) referred to, followed by the title of the subject matter of the claim(s) referred to. For example, the reference portion of a dependent claim shall be written as: "A metal fiber drawing system according to claim 1, ...".

A multiple dependent claim is a dependent claim which refers to two or more claims. The form of reference of the multiple dependent claim includes the preceding independent claim and dependent claim, or two or more preceding dependent claims.

Where a dependent claim is a multiple dependent claim, the serial numbers of the claims referred to shall use the word "or" or a word synonymous with "or" between them, that is to show the claims are referred to in an alternative way. For example, the reference portion of the dependent claim may be drafted as following, "... according to claim 1 or claim ...", "... according to claim 2, 4, 6 or 8 ...", or "... according to any one of claims 4 - 9 ...".

A multiple dependent claim which refers to two or more claims shall not serve as a basis for any other multiple dependent claim. For example, if in claim 3 states: "A zoom system of a video camera according to claim 1 or 2, ...", it is not allowed to draft claim 4 as: "A zoom system of a video camera according to claim 1, 2 or 3 ..." since claim 3 referred to is a multiple dependent claim.

The characterizing portion of a dependent claim may define the technical features of the preceding claim (independent claim or dependent claim). Where the preceding independent claim is in the form of two parts, the following dependent claim may further define the features not only in the characterizing portion but also in the preamble portion.

All of the dependent claims which are directly or indirectly dependent on a certain independent claim shall be grouped together after that independent claim and before other independent claims.

## Chapter 3

### Novelty

#### 1. Introduction

In accordance with the provisions of Article 22.1 of the Patent Law, any invention or utility model for which patent right may be granted must possess novelty, inventiveness and practical applicability. Hence, novelty is one of the indispensable requirements which any invention or utility model for which a patent is applied has to comply with before a patent right is granted.

With the provisions of Article 22.2 of the Patent Law, Rules 2.1, 2.2, and 30 of the Implementing Regulations of the Patent Law, any invention or utility model which possesses novelty shall be a new technical solution which is different from the prior art and different from the invention or utility model described in an application for a patent which was filed by any other person with the Patent Office before the date of filing and published on or after the date of filing.

The contents of this Chapter mainly relate to the concept of novelty, the principles and guidelines of examination of novelty, the disclosures not causing loss of novelty and the handling of the identical inventions – creations.

Art. 22.2

#### 2. Concept of Novelty

Novelty means that, before the date of filing, no identical invention or utility model has been publicly disclosed in publications in the country or abroad, or has been publicly used or made known to the public by any other means in the country, nor has any other person filed previously with the Patent Office an application which described the identical invention or utility model and was published on or after the said date of filing.

In accordance with Rule 30 of the Implementing Regulations of the Patent Law, any technology which has been publicly disclosed in publications in the country or abroad, or has been publicly used or made known to the public by any other means in the country, before the date of filing, is prior art. Moreover, in order to prevent applications for patent for the identical inventions or utility models from being patented again, when considering novelty, the examiner shall take into account the applications which have been filed by any other person before the date of filing with the Patent Office and was published on or after the

said date of filing. Therefore, in accordance with the provisions of Article 22.2 of the Patent Law, an invention or utility model possessing novelty shall be not only different from the prior art, but also different from the contents of applications for patent filed by any other person with the Patent Office before the date of filing and published on or after the date of filing.

As a result, whether or not an application for a patent for invention or utility model possesses novelty relates not only to the prior art but also to the contents of patent applications filed by any other person with the Patent Office before the date of filing and published on or after the date of filing.

## 2.1 Prior Art

In the sense of the Patent Law, the prior art shall be the technical contents that are available to the public before the date of filing. In other words, the prior art shall be in such a state that it is available to the public before the date of filing, and shall include such contents from which the public can obtain substantial technical knowledge.

It should be noted that the technical contents which are in a state of being kept secret do not belong to the prior art because they are not available to the public. The state of being kept secret relates not only to a situation where the obligation to keep secret arises from express confidential agreements, but also to a situation where the obligation to keep secret arises from social customs or commercial practices, that is, from tacit agreements or understanding.

However, if a person with the obligation to keep secret violates his agreement or tacit understanding and reveals the technological secrets to third parties, they shall become part of the prior art.

In accordance with Rule 30 of the Implementing Regulations of the Patent Law, the definition of the prior art has relations with the time and territory of disclosure and the mode of disclosure. These points are explained as follows.

Art. 22.2  
Rule 30

### 2.1.1 Time Coverage

The decisive moment for determining prior art in respect of an invention or utility model for which an application for patent is filed is the date of filing, or the priority date where priority is claimed. Broadly speaking, so far as an application is con-

cerned, all of the technical contents disclosed before the date of its filing fall into the scope of prior art, but those disclosed on the date of filing are not included.

Art. 22.2  
Rule 30

### **2. 1. 2 Territory Coverage**

The decisive area of district for determining prior art depends upon the means of disclosure of technical contents. So far as disclosure by publications is concerned, all the technical contents disclosed any where in the world fall into the domain of prior art. So far as disclosure by use or any other means is concerned, only the technical contents disclosed in the country fall into the domain of prior art.

Art. 22.2  
Rule 30

### **2. 1. 3 Forms of Disclosure**

The forms of disclosure of the prior art include disclosure by publications, disclosure by use and disclosure by other means .

#### **2. 1. 3. 1 Disclosure by Publications**

The publications in the sense of the Patent Law mean the independently existing tangible disseminating carriers of technical or designing contents, which shall state clearly their issuer or publisher and their date of issue or publication.

The publications in above – mentioned sense include various printed or typed paper documents, such as patent documents, scientific and technological magazines and books, academic theses, professional documents, textbooks, technical manuals, officially published proceedings or technical reports, newspapers, brochures, sample books, product catalogues, etc .. They also include the tangible carriers made by other materials, such as, various microfiches, films, negative films, magnetic tapes, gramophone records, CD – ROMs made by means of electronics, optics, photography.

Publications are not restricted by the district where, or the language or manner in which it was made available to the public, nor by its age.

The amount of distribution of the publication is of no importance, and whether or not it has been read by any one or known by the applicant is also of no importance.

As for the publications with the words “Restricted Publication”, if they are truly required to be kept confidential and circulated to a specific extent, they do not belong to the scope of the

“publications” in the sense of the Patent Law.

The printing date of a publication shall be regarded as the date of disclosure. If only a specific month/year or year is indicated as the printing date of a publication, the last day of the month or December 31 of that year shall be regarded as the date of disclosure.

If the examiner has some doubt about the date of disclosure of a publication, he/she may invite the person who has submitted the publication to furnish evidence.

#### **2. 1. 3. 2 Disclosure by Use**

A disclosure by use means that by use of the technical solution in public makes it disclosed to the public or placed in a situation in which anyone can know about them. Even if the structure or the function of the product or equipment which is used can be known only after it has been disassembled or broken apart, it is still regarded as disclosure by use.

Disclosure by use includes the situation that, not only by producing, using, selling or importing publicly, but also by demonstrating or exhibiting a model publicly, any member of the public could gain knowledge of the technical contents. However, if no explanation of the technical contents is given at the exhibition or demonstration so that a person skilled in the relevant field of technology is unable to know the structure and function of product or the composition of materials exhibited or demonstrated, the exhibition or demonstration shall not be regarded as constituting disclosure by use.

The date on which the public can know the product or process shall be regarded as the date of disclosure by use.

#### **2. 1. 3. 3 Disclosure by Any Other Means**

Other means of disclosure to the public mainly refer to oral disclosure, such as talking, reporting, speaking at symposium, broadcasting or televising and any other means which make the technical contents known to the public. The date of talking, reporting or speaking shall be regarded as the date of disclosure. In respect of the broadcasts sent by radio or television and the contents of movie which can be received by the public, the date on which they are broadcast or shown, shall be regarded as the date of disclosure.

Other means of disclosure also include the materials of infor-

mation and the visual information, such as poster, drawing, photo, model, sample book, specimen and the like which are demonstrated at stands or are placed in display windows which are open to the public, the date of public demonstration shall be regarded as the date of disclosure.

## 2. 2 Conflicting Application

In accordance with the provisions of Article 22. 2 of the Patent Law, when determining the novelty of a patent application (the later application), an application for a patent for the identical invention or utility model (the earlier application) filed by any other person with the Patent Office before the date of filing of the later application and published on or after the said date of filing will destroy the novelty of the later application. In determining novelty, for convenience's sake, the said earlier application which is prejudicial to novelty is called a conflicting application.

Art. 9

Rule 13. 1

For one invention – creation, only one patent right shall be granted. In order to avoid repeatedly granting patent rights to applications for patent for identical invention or utility model, the examiner when considering novelty shall conduct a search for whether or not there is any conflicting application to prejudice the novelty of the application or patent for invention or utility model.

When making a search to determine whether or not there is any conflicting application, the examiner shall note that he/she should examine not only the claims but also the description (including drawings) of the initial text of the earlier application. This means that the whole contents of the earlier application play a prejudicial role.

Since contents of the conflicting application is not included in the “existing technology” provided in Rule 33 of the Implementing Regulations of the Patent Law, contents of the conflicting application shall be considered only for determining the novelty and not for determining the inventiveness of an invention or utility model.

The conflicting application may also be constituted by an international application for a patent for identical invention or utility model filed by any other person before the date of filing of another application and entered the Chinese national phase and published in Chinese on or after the said date of filing.

Moreover, the conflicting application refers to the application for the identical invention or utility model filed by any other



person only before the date of filing of a later application. It does not include the application for the identical invention or utility model filed by any other person on the date of filing of a later application or by the applicant himself or itself of the later application (for the handling of the latter two applications, see Section 6 of this Chapter).

### 2.3 Reference Documents

Generally speaking, because the examiner does not know the technologies disclosed by use or made known to the public by other means in China, the prior art involved in the procedure of examination as to substance mainly refers to the technologies disclosed in publications.

In order to determine whether or not an application for a patent possesses novelty and inventiveness, the examiner searches the prior art for documents (including patent documents and non-patent literature) relating to the application for patent and the conflicting application documents for judging novelty, and compares these documents with the application for patent being examined. These documents are called reference documents.

Cited reference document may be one document or several documents. The cited contents may be either the whole contents of each document, or part of one document.

Reference documents are objectively existing technical materials. When citing the contents of the reference documents to judge the novelty and inventiveness of an application, it shall be determined by the disclosed technical contents of the reference documents. So far as a person skilled in the relevant field of technology is concerned, the implied technical contents that can be derived from the reference documents without any ambiguity also belong to the contents of disclosure. However, it is not allowed to broaden or narrow the contents of reference documents at will. If there are drawings appended in a reference documents, they may be cited. However, the examiner should note, when citing the drawings, only the technical features that can be obviously perceived from the drawings belong to the contents of disclosure. The contents inferred from the drawings or the size and its relationship measured from the drawings without any written explanation cannot be regarded as the contents of disclosure.

A reference document that clearly and completely discloses the technical solution of an application for a patent for invention or utility model will destroy the novelty of that application.

### **3. Principles and Criteria of Examination of Novelty**

It shall be considered whether or not an application for a patent for invention or utility model possesses novelty only when the invention or utility model possesses practical applicability.

#### **3.1 Principles of Examination**

The following principles shall be complied with when novelty is examined:

(1) Identical inventions or utility models. When an application for a patent for invention or utility model (later application) being examined is compared with the relevant contents of the prior art or with an application for a patent for the invention or utility model filed by any other person with the Patent Office before the date of filing of the later application and published on or after the said date of filing (earlier filed and later published application), if their technical fields, technical problems to be solved and technical solutions are the same in substance, and their prospective effects are the same, they shall be regarded as identical inventions or utility models.

(2) Separate comparison. When determining novelty, the examiner shall compare each claim of an application for a patent for invention or utility model separately with the relevant technical contents disclosed in each item of the prior art or with each earlier filed and later published application, and not with a combination of the contents disclosed in several items of the prior art or several earlier filed and later published applications, or with a combination of several technical solutions disclosed in one reference document. That is to compare separately with each item of the prior art. It is not permissible to combine separate items of the prior art together. This principle is suitable for determining novelty of an application for a patent for invention or utility model. It is different from the principle of determining the inventiveness of an application for a patent for invention or utility model (see Section 3.1, Chapter 4 of this Part).

#### **3.2 Criteria of Examination**

“Identical inventions or utility models” means that their technical fields, technical problems to be solved and technical solu

tions are the same in substance, and their prospective effects are the same. This shall be used as the criterion for judging novelty.

The followings are a few circumstances which often occur in determining novelty.

### 3. 2. 1 Invention or Utility Model with Identical Contents

Where the claimed subject matter of an application for a patent for invention or utility model is identical with the technical contents disclosed in a reference document, or there are only simple changes in wording, such an application for a patent for invention or utility model does not possess novelty. Furthermore, the concept of "identical contents" mentioned above shall be understood as including the sole content derivable directly from the reference document. For example, a technical solution of an application for a patent for invention is "a motor rotor core made of Nd - Fe - B permanent magnet having a tetragonal crystal structure and a main phase of  $\text{Nd}_2\text{Fe}_{14}\text{B}$  intermetallic compound". If the reference document discloses "a motor rotor core made of Nd - Fe - B magnet", the above - mentioned patent application for invention will lose novelty, since it is well known to a person skilled in this field of technology that the so - called "Nd - Fe - B magnet" means the Nd - Fe - B permanent magnet having a main phase of  $\text{Nd}_2\text{Fe}_{14}\text{B}$  intermetallic compound and a tetragonal crystal structure.

### 3. 2. 2 Specific ( Lower Level ) Concept and Generic ( Upper Level ) Concept

If the claimed subject matter of an application for a patent for invention or utility model is compared with the prior art or the invention or utility model of the earlier filed and later published patent application, and the difference between them lies merely in the fact that the technical features of the same category of the former is defined in terms of generic ( upper level ) concepts and those of the latter is defined in terms of specific ( lower level ) concepts, the specific disclosure of the technical features takes away the novelty of the invention or utility model application defined in terms of generic ( upper level ) concepts. For example, a product "made of copper" disclosed in the reference document takes away the novelty of an identical product "made of

metal” claimed in an application for patent. However, the disclosure of this copper product does not take away the novelty of the identical product made of any specific metal other than copper.

On the contrary, any disclosure by generic (upper level) concepts does not take away the novelty of the invention or utility model of an application for patent defined by specific (lower level) concepts. For example, a product “made of metal” disclosed in a reference document does not take away the novelty of an identical product “made of copper” claimed in an application for a patent. Another example: if the difference between an application for a patent for invention and the reference document lies merely in that “chlorine” has been used in the patent application to replace “halogen” or other specific halogen “fluorine” of the reference document, the disclosure of “halogen” or “fluorine” in the reference document does not take away the novelty of the application for a patent for invention which uses “chlorine” to define it.

The above – mentioned criterion is also suitable for comparing whether or not the technical features of the same category are identical in the determination of inventiveness.

### 3. 2. 3 Direct Substitution of the Customary Means

If the difference between the technical solution of an application for a patent for invention or utility model and that of the reference document is merely a direct substitution of the customary means employed in the relevant field of technology, the application for a patent for invention or utility model does not possess novelty. For example, where the prior art has disclosed a device using screw fastening, whereas the application for a patent for invention or utility model replaces the screw fastening by bolt fastening only, the application does not possess novelty.

### 3. 2. 4 Numerical Value and Range of Value

Where there exists a technical feature defined by numerical values or a range of continuously changing numerical values in the technical solution for which protection is sought in an application for a patent for invention or utility model, such as temperature, pressure, the constituents of a mixture and a group of compounds (e. g. ,  $C_nH_{2n+2}$ , wherein “n” is an integer), and the rest of the technical features are identical with the prior art or

the invention or utility model claimed in an earlier filed and later published patent application, the novelty of the invention or utility model claimed in the application being examined shall be determined in accordance with the following provisions:

(1) Where the above defined technical feature is discrete numerical values, and the corresponding technical feature of the reference document is a range of continuously changing numerical values between two extreme values, the latter can take away the novelty of the technical solution defined by the value identical to any one of the two extreme values, but not the novelty of the technical solution defined by all the specific values between the two extreme values unless these specific values in between are specifically disclosed already in the reference document. For example, if the range of temperatures disclosed in a reference document is only  $0^{\circ}\text{C} \sim 100^{\circ}\text{C}$ , whereas the temperatures defined in the technical solution claimed are  $0^{\circ}\text{C}$ ,  $38^{\circ}\text{C}$ ,  $65^{\circ}\text{C}$  and  $100^{\circ}\text{C}$ , the rest of the technical features are identical, then the technical solution defined by  $0^{\circ}\text{C}$  and  $100^{\circ}\text{C}$  does not possess novelty, but the technical solution defined by  $38^{\circ}\text{C}$  and  $65^{\circ}\text{C}$  does possess novelty. Another example, if the reference document only discloses, by a general formula, a group of compounds  $\text{C}_x\text{H}_{2x+2}$ , wherein  $X=1 \sim 4$ , then  $\text{CH}_4$  and  $\text{C}_4\text{H}_{10}$ , which are extreme values of the group when  $X=1$  and  $X=4$  respectively, take away the novelty of compounds  $\text{CH}_4$  and  $\text{C}_4\text{H}_{10}$  claimed, but not the novelty of  $\text{C}_2\text{H}_6$  and  $\text{C}_3\text{H}_8$  that are the intermediate values (see Chapter 10 of this Part for the relevant specific judgments).

(2) Where the above defined technical feature is a range of continuous numerical values, and a wider range of numerical values and a number of specific numerical values of embodiments within the range are given in the reference documents, if these numerical values of embodiments fall within the range of the numerical values of the technical solution claimed, then the technical solution does not possess novelty.

(3) Where the above defined technical feature is a range of continuous numerical values, and a numerical value disclosed in the reference document falls within this range, the claimed technical solution defined by that range of numerical values does not possess novelty.

(4) Where the above defined technical feature is a range of continuous numerical values, a wider range of continuous numerical values has been disclosed in the reference documents,

and the said two ranges of numerical values have a common extreme value or overlap in part, the claimed technical solution defined by the narrower range of numerical values does not possess novelty.

The examiner should note, if the ranges of numerical values of the technical solutions stated in (3) and (4) above can satisfy the conditions stipulated in Section 5.2.2.1 (2), Chapter 8 of this Part, the claimed technical solution defined by the amended range of numerical values possesses novelty.

(5) Where the above defined technical feature is a range of continuous numerical values, which have not been disclosed in the reference documents, nor included numerical values disclosed in the reference documents, the technical solution defined by that range of numerical values possesses novelty.

(6) Where the above defined technical feature is a range of continuous numerical values, a wider range of numerical values has been disclosed in the reference document, and there are no common extreme values or overlap in part for both ranges, the claimed technical solution defined by the narrower range of numerical values possesses novelty.

(7) Where the above defined technical feature is a range of continuous numerical values, which is selected from the range of numerical values disclosed in the reference document in order to resolve a specific technical problem existing in the reference document or achieve a special effect, the claimed technical solution defined by the selected range of numerical values possesses novelty.

(8) Where the above defined technical feature is a discrete numerical value or a range of continuous numerical values, which have been disclosed in the prior art to admonish persons skilled in the relevant field of technology not to adopt that range of numerical values, the application for a patent for invention or utility model which overcomes such prejudice possesses novelty.

The above – mentioned criteria are also appropriate for comparing whether or not the technical features in the same category are identical in determining inventiveness.

#### 4. Right of Priority

Art. 29. 1

Where, within twelve months from the date on which any ap-

plicant first filed in a foreign country an application for a patent for invention or utility model, it/he files in China an application for a patent for the same subject matter, it/he may, in accordance with any agreement concluded between the said foreign country and China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of mutual recognition of the right of priority, enjoy a right of priority. Such kind of right of priority is called a right of foreign priority.

Art. 29. 2  
Rule 33

Where, within twelve months from the date on which any applicant filed first in China an application for a patent for invention or utility model, and if it/he files with the Patent Office an application for a patent for invention or utility model and if for the same subject matter, on the basis of the earlier application for a patent for invention, or an application for a patent for utility model or invention on the basis of the earlier application for a patent for utility model, it/he may enjoy a right of priority. Such right of priority is called domestic priority.

Art. 29. 1

#### 4. 1 Right of Foreign Priority

##### 4. 1. 1 Conditions for Entitlement to Right of Foreign Priority

An application for patent which is to enjoy the right of foreign priority shall comply with the following conditions:

(1) After the applicant first filed in a foreign country an application for a patent for an invention – creation (earlier foreign application), it/he files in China an application for a patent for the same subject matter (subsequent application filed in China).

(2) So far as an invention or utility model is concerned, the date of filing of the subsequent application filed in China shall not be later than twelve months from the date of filing of the earlier foreign application.

(3) The foreign country where the applicant first filed an application has an agreement concluded with China, or is a country, the same as china, party to an international treaty, or which recognizes the right of priority.

The entitlement of the invention – creation to the foreign priority right has no relation with the final result of examination of the earlier foreign application. Provided that the date of filing of the earlier application has been established in the relevant foreign country, that application can be used as the basis for claiming

the foreign priority.

#### **4. 1. 2 Definition of Invention – Creation with Identical Subject Matter**

The “inventions or utility models with the same subject matter” means that their technical fields, technical problems to be solved and technical solutions are identical in substance, and their prospective effects are identical. It should be noted that they are “identical”, it does not mean that their wordings or descriptions are exactly the same.

The examiner shall note that the subject matter of the subsequent application filed in China, being the technical solution defined in the claims, may claim the right of priority of the earlier foreign application, provided that the technical solution had been described in the foreign application. It is not necessary for it to be contained in the claims of the foreign application.

#### **4. 1. 3 Effect of Right of Foreign Priority**

After having first filed an application in a foreign country, the applicant files an application for a patent for invention – creation within the prescribed period of priority in China for the same subject matter, the subsequent application will be regarded as if it had been filed on the same date as the earlier foreign application. Consequently, the effect of its/his subsequent application filed in China will not be destroyed because of any filing of application for the same subject matter, or publication or exploitation of such invention – creation by any other person during the priority period, that is between the filing date of the earlier foreign application and the filing date of the subsequent application.

Furthermore, it is possible for any other person to file an application for a patent for the same subject matter of the invention – creation during the period of the right of priority. Because of the effect of the right of priority, no patent right may be granted to such an application. That is to say, because of the existence of the earlier foreign application which is used as the basis of a right of foreign priority, the application for a patent for the same subject matter of the invention – creation filed by any other person between the date of first foreign filing and the date of subsequent filing in China possesses no novelty, so no patent right may be granted to it.



#### 4. 1. 4 Foreign Multiple Priorities and Foreign Partial Priority

In accordance with the provisions of Rule 33.1 of the Implementing Regulations of the Patent Law, an applicant may claim one or more priorities for an application for a patent. Where multiple priorities are claimed, the priority period for the application shall be calculated from the earliest priority date.

The provisions concerning foreign multiple priorities and foreign partial priority are as follows:

(1) Any application for a patent claiming multiple priorities shall comply with the requirements for unity as provided in Article 31 of the Patent Law and Rule 35 of the Implementing Regulations of the Patent Law.

(2) The earlier foreign applications which are the basis of the multiple priorities may be filed in different countries. For example, a subsequent application filed in China contains two technical solutions *A* and *B*. Solution *A* was disclosed in an application first filed in France, and solution *B* was disclosed in an application first filed in Germany. These applications were filed in France and Germany respectively within twelve months before the date of filing of the subsequent application filed in China. Under such circumstance, the subsequent application filed in China is entitled to multiple priorities, i. e., solution *A* is entitled to the priority date in France and solution *B* is entitled to the priority date in Germany. If the solutions *A* and *B* are alternative technical solutions and they are described by a word "or" in one claim of the subsequent application filed in China, the subsequent Chinese application is entitled to multiple priorities, and it has two different priority dates. However, if the technical solution disclosed in the subsequent application filed in China is a combination of different technical features disclosed respectively in two or more earlier foreign applications, no right of priority may be claimed. For example, the technical solution disclosed in the subsequent application filed in China is a combination of technical feature *C* disclosed in one earlier foreign application and technical feature *D* disclosed in another earlier foreign application, but the technical solution containing both features *C* and *D* has never been disclosed in the above-mentioned two earlier foreign applications, the subsequent application filed in China is not entitled to claim the right of foreign priority on the basis of the two earlier foreign applications.

(3) The application claiming right of foreign priority may, in

addition to the technical solution(s) disclosed in the application as the basis of the right of foreign priority, contain one or more new technical solutions. For example, in a subsequent application filed in China, in addition to the technical solution contained in the earlier foreign application, a new technical solution which further improves or perfects that solution, has also been described, such as adding a dependent claim which reflects the new mode of carrying out or the new embodiment in the description, or adding an independent claim which is in conformity with the requirements of unity. Under such circumstances, the examiner shall not refuse to recognize a right of priority or reject the application for the reason that the technical solution added in the claims of the subsequent application filed in China was not disclosed in the earlier foreign application. The invention – creation contained in the subsequent application filed in China which is the same subject matter as that disclosed in the earlier foreign application should be entitled to the right of priority, the effective date of which shall be the date of filing of the earlier foreign application, i. e. , the priority date. The effective date for the newly added technical solution is the date of filing of the subsequent application filed in China. Because part of the technical solution of the subsequent application filed in China is entitled to the right of foreign priority, it is called foreign partial priority.

Art. 29. 2

#### 4. 2 Right of Domestic Priority

##### 4. 2. 1 Conditions of Entitlement to Right of Domestic Priority

Any application which is in compliance with the following conditions may enjoy the right of priority:

(1) It only applies to applications for a patent for invention or utility model.

(2) After the applicant first filed an application for a patent for invention or utility model in China (the earlier application filed in China), it/he files another application for a patent for the same subject matter with the Patent Office (the subsequent application filed in China).

(3) The date of filing of the subsequent application filed in China should not be later than twelve months from the date of filing of the earlier application filed in China.

Rule 33. 2

However, when the subsequent application is filed, if the subject matter of the earlier application falls under any of the foll

owing circumstances, it may not be taken as the basis for claiming domestic priority:

- (1) where the applicant has claimed foreign or domestic priority;
- (2) where it has been granted a patent right;
- (3) where it is a divisional application filed as prescribed in Rule 42 of the Implementing Regulations of the Patent Law.

It should be noted that where the applicant claims the domestic priority, the first application filed in China, which is taken as the basis of the domestic priority, shall be deemed to have been withdrawn from the date on which the subsequent application is filed.

#### **4. 2. 2 Definition of Invention or Utility Model with Identical Subject Matter**

In this regard, the provisions of Section 4. 1. 2 of this Chapter (Definition of the Invention – creation with Identical Subject Matter) shall apply.

#### **4. 2. 3 Effects of Right of Domestic Priority**

In this regard, the provisions of Section 4. 1. 3 of this Chapter (Effects of Foreign Right of Priority) shall apply.

#### **4. 2. 4 Domestic Multiple Priority and Domestic Partial Priority**

The provisions of Rule 33. 1 shall apply not only to foreign multiple priorities but also to domestic multiple priorities. The requirements for the domestic multiple priorities and the domestic partial priority are as follows:

(1) An application for a patent claiming multiple priorities shall comply with the requirement of unity provided in Article 31 of the Patent Law and Rule 35 of the Implementing Regulations of the Patent Law.

(2) The subsequent application filed in China contains several technical solutions. For example, if it contains three technical solutions *A*, *B*, and *C*, which have been disclosed respectively in three earlier applications filed in China, the subsequent application filed in China may claim multiple priorities, that is, the technical solutions *A*, *B* and *C* shall take the dates of filing of the three earlier applications filed in China as their dates of priority respectively.

(3) The technical solution seeking protection in a subse-

quent application filed in China is  $A$ , which contains embodiments  $a_1$ ,  $a_2$ , and  $a_3$ , wherein only  $a_1$  has been disclosed in the earlier application filed in China. Only  $a_1$  is entitled to the domestic priority, others are not entitled to the domestic priority.

(4) The subsequent application filed in China contains technical solution  $A$  and embodiments  $a_1$  and  $a_2$ , wherein solution  $A$  and embodiment  $a_1$  have been disclosed in the earlier application filed in China. The subsequent application filed in China may claim priority for  $A$  and  $a_1$ , while embodiment  $a_2$  is not entitled to the domestic priority.

It should be pointed out that, if it is not sufficient to support the scope of protection of solution  $A$  by embodiment  $a_1$  only, the applicant may supplement embodiment  $a_2$  to support solution  $A$ . However, if  $a_2$  is already known to the public when the subsequent application is filed in China,  $a_2$  shall be deleted and the extent of protection of  $A$  shall be limited as far as it can be supported by  $a_1$ .

(5) After the earlier application filed in China and the subsequent application filed in China, the applicant filed a second subsequent application. The earlier application contains only technical solution  $A_1$ ; the first subsequent application contains technical solutions  $A_1$  and  $A_2$ , and it claims the domestic priority for  $A_1$  on the basis of the earlier application filed in China. The second subsequent application contains technical solutions  $A_1$ ,  $A_2$  and  $A_3$ . So far as the second subsequent application is concerned, it may claim the right of priority for technical solution  $A_2$  on the basis of the first subsequent application. However, since the first subsequent application has claimed the right of priority for technical solution  $A_1$ , the second subsequent application may not claim the right of priority for it again on the basis of the first subsequent application, but it may claim on the basis of the earlier application filed in China. Because both subsequent applications claim the right of priority on the basis of the earlier application filed in China, they may lead to double patenting. If this happens, it is not in compliance with the provisions of Rule 13.1 of the Implementing Regulations of the Patent Law and shall be handled according to Section 6.2 of this Chapter.

## 5. Disclosure Causing No Loss of Novelty

Article 24 of the Patent Law provides that an invention – creation for which a patent is applied does not lose its novelty where, within six months before the date of filing, one of the fol-

lowing events occur:

(1) where it is first exhibited at an international exhibition sponsored or recognized by the Chinese Government;

(2) where it is first made public at a prescribed academic or technological meeting;

(3) where it is disclosed by any person without the consent of the applicant.

The above provisions shall be explained as follows.

#### **5.1 Invention – Creation First exhibited at an International Exhibition**

According to the provisions of Article 24 (1) of the Patent Law, if an invention – creation for which a patent is applied was first exhibited within six months before the date of filing at an international exhibition sponsored or recognized by the Chinese Government, it does not lose its novelty.

The international exhibitions sponsored by the Chinese Government include those sponsored by the State Council, various ministries or commissions, or sponsored by other authorities or local government with the approval of the State Council. The international exhibitions recognized by the Chinese Government include those held in foreign countries recognized by the State Council and various ministries or commissions. The so – called international exhibition means an exhibition where the exhibits include those not only from the host country but also from other foreign countries.

In accordance with the provision of Article 22.2 of the Patent Law, the exhibits displayed at the exhibition held in foreign countries will not become prior art, whereas the publications distributed at an exhibition held in a foreign country will become prior art. However, the invention – creation disclosed in publications distributed at an international exhibition held in a foreign country recognized by the Chinese Government to introduce the exhibits may enjoy the grace period provided in Article 24 of the Patent Law.

#### **5.2 Invention – Creation First Made Public at Prescribed Academic or Technological Meeting**

In accordance with the provisions of Article 24 (2) of the Patent Law, if an invention – creation for which a patent is applied was first made public within six months before the date of

filing at a prescribed academic or technological meeting, it does not lose its novelty.

**Rule 31. 1**

The prescribed academic or technological meeting means any academic or technological meeting organized by the competent department concerned of the State Council or by the national academic or technological association. It does not include the academic or technological meetings organized by any sponsor at the level of province or lower, or by any organization entrusted by ministries or commissions under the State Council or national academic association, or organized in the name of themselves. The disclosure of an invention – creation made in the latter occasions will lead to the loss of its novelty unless there is a confidential arrangement in the meeting.

**5. 3 Invention – Creation Disclosed by Any Person without Consent of Applicant**

In accordance with the provisions of Article 24(3) of the Patent Law, if an invention – creation for which a patent is applied was disclosed within six months before the date of filing by any person without the consent of the applicant, it does not lose its novelty.

Any disclosure of an invention – creation by any person without the consent of the applicant, includes not only the disclosure by any person who fails to comply with an explicit agreement or tacit promise to keep the invention – creation confidential, but also the disclosure by any person who learn about the invention – creation from the inventor or applicant by means of threat, fraud, espionage or the like. The disclosure under either circumstance is contrary to the intention of the applicant.

**5. 4 Grace Period**

An invention – creation for which a patent is applied will not lose its novelty within six months before the date of filing where any of the events provided in Article 24 of the Patent Law occurred. In other words, even if any of these events occurred, the relevant invention – creation will not become prior art which will affect the said application. That period of six months is called the grace period.

The effect of the grace period is different from that of the right of priority. So far as the grace period is concerned, the prescribed disclosures made by the applicant (including invent-

or) or by any third person who learns about the contents of the invention – creation from the inventor by legal or illegal means, are merely regarded as not causing loss of novelty and inventiveness of the invention – creation for which an application for patent is filed. While the invention – creation which has been disclosed has, in fact, become part of the prior art. The prescribed disclosures merely do not cause loss of novelty to the relevant invention – creation for which an application for patent is filed within a limited period. The date of the said disclosure is not regarded as the date of filing of the relevant application. Therefore, if any third person makes an identical invention independently during the grace period and files an application for patent before the applicant. According to the principle of the first – to – file, the applicant has no right to be granted the patent right. On the other hand, since the invention – creation has become part of the prior art after the disclosure made by the applicant (including inventor), the patent application filed by the third person loses novelty and so no patent right may be granted to it/his either.

If, within six months from the date on which any event described in Article 24 of the Patent Law occurs, the applicant discloses the relevant invention – creation again before it/he files an application for a patent for that invention – creation, so long as the disclosure does not belong to any of the prescribed events, the later disclosure will take away the novelty of the application it/he will file thereafter.

#### Rule 31. 3

Where any invention – creation for which a patent is applied falls under the provisions of Article 24(3) of the Patent Law, the Office may, when it deems necessary, require the applicant to submit the relevant certifying documents to verify the date of occurrence of the event and the substantial contents of the disclosure.

#### Rule 31. 4

Where the applicant fails to make a declaration and submit certifying documents as required in Rule 31.2 of the Regulations, or fails to submit certifying documents within the specified time limit as required in Rule 31.3 of the Implementing Regulations of the Patent Law, its/his application shall not enjoy the grace period of novelty provided in Article 24 of the Patent Law.

When a dispute arises as to the application of Article 24 of the Patent Law, the party requesting to enjoy the effect of the provision shall bear the burden of proof or make a convincing statement.

## 6. Handling of Identical Inventions – Creations

Rule 13.1 of the Implementing Regulations of the Patent Law provides that, for any identical invention – creations, only one patent right shall be granted. This provision determines the principle that no double patenting is permitted.

This Section merely involves the principle of judgment for the provision of Rule 13.1 of the Implementing Regulations of the Patent Law and the modes of handling various relevant situations, but not including the examination of applications for patent for invention which may be conducted in accordance with the provisions of Article 22.2 and 22.3 of the Patent Law. In other words, those earlier applications (or patents) which have become prior art or conflicting applications after disclosure shall be examined in accordance with the provisions of Article 22.2 and 22.3 of the Patent Law rather than the provisions of Rule 13.1 of the Implementing Regulations of the Patent Law.

### 6.1 Principles of Judgment

“Identical inventions – creations”, referred to in Rule 13.1 of the Implementing Regulations of the Patent Law, means that the inventions – creations seeking protection by two applications are identical. When making a judgment, a comparison shall be made between the contents of the claims of the two applications or patents for invention or utility model. The description and the appended drawings may be used to interpret the claims.

The inventions or utility models seeking protection by claims of two applications or patents are identical means that their fields of technology, technical problems to be solved and the technical solutions are in substance identical, and their prospective results are identical as well.

When making a judgment, each claim of the two applications or patents shall be compared respectively. If it is found that the contents of a claim of one application or patent is identical with that of certain claim of another application or patent, it shall be regarded that the inventions – creations seeking protection are identical.

Where the contents of the descriptions of two applications or patents are identical, but the contents of their claims are different, the inventions – creations seeking protection shall be regarded as not identical. For example, where both descriptions of two applications filed by the same applicant contain a product



and a process to produce the product, if the claims of one application seek to protect the product, and the claims of the other application seek to protect the process, the inventions – creations seeking protection shall be regarded as different.

## **6. 2 Method of Handling**

### **6. 2. 1 Handling of Two Applications**

#### **6. 2. 1. 1 Same Applicant**

During examination, if it is found that the same applicant has filed two applications for the same invention – creation, and if these two applications are in conformity with other requirements of patentability, the applicant shall be notified to make a selection or amendments. Where the applicant fails to make any response within the specified time limit, if the dates of filing of two applications are different, the later application shall be deemed to have been withdrawn; if the dates of filing of two applications are the same, both of them shall be deemed to have been withdrawn. Where, after the applicant has made its/his observations or amendments, the applications are still not in conformity with the requirements of Rule 13. 1 of the Implementing Regulations of the Patent Law, one of the applications shall be rejected and the other application shall be granted the patent right.

#### **6. 2. 1. 2 Different Applicants**

During examination, if it is found that two applicants filed separately applications for patent for identical inventions – creations on the same date, and these applications are in conformity with other requirements for the grant of patent right, the applicants shall be notified to hold consultations among themselves to decide the person or persons who shall be entitled to file the application in accordance with the provisions of Rule 13. 2 of the Implementing Regulations of the Patent Law. If the applicants fail to make any response within the specified time limit, both applications shall be deemed to have been withdrawn. If the consultation fails, or, after the applicants have made their observations or amendments, the applications are still not in conformity with the provisions of Rule 13. 1 of the Implementing Regulations of the Patent Law, both applications shall be rejected.

### 6. 2. 2 Handling of One Application and One Patent

During the examination of an application, if it is found that another application filed by the same applicant for the identical invention – creation has been granted the patent right, and if the application being examined is in conformity with other requirements for the grant of the patent right, the applicant shall be notified to make a selection. At this time, the applicant may either abandon the patent right which it/he has been granted or withdraw the application to which no patent right has yet been granted. If the applicant fails to make any response within the specified time limit, the application shall be deemed to have been withdrawn. Where, after the applicant has made its/his observation or amendments, the application is still not in conformity with the provisions of Rule 13. 1 of the Implementing Regulations of the Patent Law, the application shall be rejected. Where the applicant selects to abandon the patent right which it/he has been granted, it/he shall submit a written declaration to abandon that patent right when it/he makes response to the Office's notification. At this time, the Office shall make a decision to grant the patent right to the patent application which is in conformity with the requirements for the grant of the patent right and the applicant shall be notified accordingly. The written declaration to abandon the patent right shall be sent to the examination department concerned. The Office shall register and announce it. It shall be indicated in the announcement that the earlier patent right shall cease owing to abandonment as of the date on which the later patent right takes effect.

**Chapter 4****Inventiveness****1. Introduction**

In accordance with the provisions of Article 22.1 of the Patent Law, any invention or utility model for which a patent right may be granted must possess novelty, inventiveness and practical applicability. Therefore, possessing inventiveness is one of the indispensable requirements for the grant of the patent right to an invention or utility model.

In accordance with the provisions of Article 22.3 of the Patent Law and Rule 30 of the Implementing Regulations of the Patent Law, in comparison with the prior art, the invention that possesses inventiveness shall have prominent substantive features and represent a notable progress, and the utility model that possesses inventiveness shall have substantive features and represent progress.

The contents in this Chapter primarily relate to the concept of inventiveness of invention, principles and criteria of examination of inventiveness of invention, judgment of inventiveness for different kinds of inventions and focal points to be noted when inventiveness is examined. For the examination of inventiveness of utility model, see Section 2, Chapter 6 of Part IV of these Guidelines

**2. Concept of Inventiveness of Invention**

Art. 22.3

Inventiveness of invention means that, as compared with the existing technology before the date of filing, the invention has prominent substantive features and represents a notable progress.

**2.1 Existing Technology**

In accordance with Rule 30 of the Implementing Regulations of the Patent Law, the existing technology referred to in Article 22.3 of the Patent Law means any technology which has been publicly disclosed in publications in the country or abroad, or has been publicly used or made known to the public by any other means in the country, before the date of filing, that is, prior art.

The contents of a patent application filed by any other person with the Office before the date of filing of the application be-

ing examined and published after the said date of filing, which is referred to in Article 22.2 of the Patent Law, do not fall in the scope of prior art, and so shall not be taken into account when inventiveness of the invention contained in the application being examined is evaluated.

## **2.2 Person Skilled in the Relevant Field of Technology**

Whether or not an invention possesses inventiveness shall be evaluated on the basis of the knowledge and ability of the person skilled in the relevant field of technology. The person skilled in the relevant field of technology, who is also known as the person skilled in the art, refers to a fictional "person" who is presumed to be aware of all of the common technical knowledge existing before the date of filing or priority in the technical field to which the invention pertains, and to have had access to everything in the state of art and possess the normal means and capacity for routine experimentation before that date. However, he does not have creative capacity. If the technical problem to be solved impels that person to seek its solution in another technical field, he should also have access to the relevant technologies and common technical knowledge existing before the date of filing or priority, and have the capacity for routine experimentation in that field.

The purpose of establishing such a concept is to unify the standard of examination and to avoid the influence of the subjective sense of the examiner as far as possible.

## **2.3 Prominent Substantive Features**

An invention possessing prominent substantive features means that, having regard to the prior art, it is non-obvious to a person skilled in the art. If the person skilled in the art can obtain the invention by logical analysis, inference or limited experiment on the basis of the prior art, the invention is obvious, and has no prominent substantive features.

## **2.4 Notable Progress**

An invention representing a notable progress means that the invention may produce useful technical effects as compared with the closest prior art. For instance, the invention has overcome the disadvantages and deficiencies of the existing technology, or has provided a technical solution with a different conception to

solve certain technical problem, or the invention represents certain new trends of technology.

### **3. Principles and Criteria of Examination of Inventiveness of Invention**

The determination as to whether or not an invention possesses inventiveness shall be considered only when that invention has novelty.

#### **3.1 Principles of Examination**

In accordance with Article 22.3 of the Patent Law, when the inventiveness of an invention is examined, the examiner shall examine whether or not the invention possesses prominent substantive features and whether or not it represents a notable progress.

When evaluating whether or not an invention possesses inventiveness, the examiner shall consider not only the essence of the technical solution of the invention, but also the technical problem solved and the technical effects produced by the invention. These shall be considered as a whole.

In examining whether there is inventiveness, it is permissible to combine together the disclosures of different technical solutions in one or more reference documents. That is different from the principle of "separate comparison" which is adopted in the examination of novelty (see Section 3.1, Chapter 3 of this Part).

If an independent claim possesses inventiveness, there is no need to examine the inventiveness of any dependent claim under that independent claim.

#### **3.2 Criteria of Examination**

When the inventiveness of an invention is evaluated, Article 22.3 of the Patent Law should be the governing criterion. In order to help to know well that criterion, the guidelines for the examination on prominent substantive features and notable progress are given as follows.

##### **3.2.1 Prominent Substantive Features**

If the technical solution of the claimed invention is unobvious as it is compared with the prior art, it possesses prominent substantive features. If it is obvious, it does not possess prominent substantive feature.

Usually it takes three steps to judge whether the claimed

technical solutions is obvious according to the following criterion of examination.

(1) Determining the closest prior art

The closest prior art refers to a technical solution in the prior art which is most nearly related to the claimed invention and is the basis for determining whether or not the claimed invention has the prominent substantive features. Usually, the closest prior art may be a known combination in the same technical field as the claimed invention, and its technical problem to be solved, technical effects or intended use are closest to the claimed invention, and/or has disclosed the greatest number of technical features in common with the claimed invention; or although it is in a different technical field, it is capable of performing the function of the invention and has disclosed the greatest number of technical features in common with the invention. It should be noted that when determining the closest prior art, account should be first taken of the prior art in the same or similar technical fields.

(2) Determining the distinguishing features of the invention and the technical problems practically solved by the invention

During the examination, the examiner shall objectively analyze and determine the technical problem practically solved by the invention. To do this the examiner shall determine the distinguishing features of the claimed invention as compared with the closest prior art and then determine the technical problem that is practically solved by the invention on the basis of the technical effect of the distinguishing features. The technical problem practically solved by the invention in this sense, means the technical task of improving the closest prior art to achieve a better technical effect.

During the examination, because the closest prior art determined by the examiner may be different from the prior art described in the description by the applicant, therefore the determined technical problem practically solved by the invention on the basis of the closest prior art may not be the same as that described in the description. Under such circumstances, the "technical problem" shall be re-determined on the basis of the closest prior art held by the examiner.

The extent of such re-determination of the "technical problem" may have to be fixed on the concrete conditions of each particular invention. As a principle, any technical effect of an in-

vention may be used as the basis to re – determine the technical problem, as long as the said effect is derivable from the contents of the description by a person skilled in the art.

(3) Judging whether or not the claimed invention is obvious to a person skilled in the art

At this step, it shall be judged, on the basis of the closest prior art and the technical problem practically solved by the invention, whether or not the claimed invention is obvious to a person skilled in the art. In the course of judging, it is required to be ascertained whether or not there is any inspiration in the prior art as a whole. That is, whether or not the prior art has given the inspiration of applying the said distinguishing features to the closest prior art to solve the existing technical problem (that is, the technical problem practically solved by the invention). Such inspiration would prompt a person skilled in the art to improve the closest prior art and accomplish the claimed invention when he is confronted with the said technical problem.

Under the following circumstances, the “technical inspiration” is usually regarded as existing in the prior art:

(i) The said distinguishing feature is a common knowledge, such as the technical means disclosed in the public textbook or reference book which may solve the re – determined technical problem; or the habitual technical means solving the re – determined technical problem in the relevant technical field;

(ii) The said distinguishing feature is the technical means which is interrelated with the closest prior art, such as the technical means disclosed in the other part of the same reference document, the function of which is the same as that of the distinguishing feature for solving the re – determined technical problem in the claimed invention;

(iii) The said distinguishing feature is the relevant technical means disclosed in another reference document, the function of which is the same as that of the distinguishing feature for solving the re – determined technical problem in the claimed invention.

### 3.2.2 Notable Progress

When evaluating whether or not an invention possesses notable progress, the examiner shall primarily consider whether or not the invention produces useful technical effects. Usually, the invention shall be regarded as producing useful technical effects and possesses notable progress in the following situations:

(1) As compared with the closest prior art, the invention has a better technical effect. For example, the quality is improved; the output of production is increased; the energy is saved; pollution of environment is prevented and controlled, etc. ;

(2) The invention provides a technical solution which has different technical conception from the closest prior art. Its technical effect may basically reach that of the closest prior art;

(3) The invention represents certain trend of the development of new technology;

(4) The invention has obvious positive technical effects, even if it has some negative effects on other aspects.

### **3.3 Auxiliary Criteria of Examination**

Usually, the question as to whether or not an invention possesses inventiveness shall be examined according to the criteria of examination described in Section 3.2 of this Chapter. In order to help the judging of inventiveness, some auxiliary criteria which may be of use under specific circumstances are given as follows.

#### **3.3.1 Invention Which Solves Technical Difficulty Unsolved and Long – Waiting to Be Solved**

An invention shall be regarded as possessing prominent substantive features and notable progress and possessing inventiveness if it solves, through hard work of the inventor, a technical difficulty which had been eagerly desired to be solved for a long time in a certain field of technology. For example, since farming began farmers had longed for solving the problem of permanently marking farm animals ( such as milk cow ) without causing pain to the animals or damage to the hide. An inventor has successfully solved this technical problem by an invention of freeze – branding on the basis of a discovery that hide can be depigmented by freezing. That invention possesses inventiveness.

#### **3.3.2 Invention Overcomes Technical Prejudice**

Technical prejudice refers to technical personnel's knowledge of a certain technical problem in a field of technology during a certain period of time that departs from the objective facts and leads persons to believe that there is no other possibilities.



It hinders persons from carrying out research and development in that field of technology. If an invention is made by overcoming such technical prejudice and adopting the technical means which was abandoned by persons due to the technical prejudice, the invention shall be regarded as possessing prominent substantive features and notable progress, that is, inventiveness. For example, it was generally believed that the more smooth of the interface of the commutator and brush of an electric motor is, the better of the contact is, and the smaller of the current consumption is. According to an invention, a rough microgroove was made on the surface of the commutator. As a result, the electric consumption is even smaller than that with the smooth surface. Because the invention has overcome the technical prejudice, it possesses inventiveness.

### **3. 3. 3 Invention Produces Unexpected Technical Effect**

“An invention produces an unexpected technical effect” means that, as compared with the prior art, the technical effect of an invention produces a “qualitative” change, that is new performance; or it produces a “quantitative” change which was unexpected. It is impossible for a person skilled in the art to expect or infer such qualitative or quantitative change in advance. If an invention produces an unexpected effect, it means the invention possesses notable progress on the one hand, and it also means that the technical solution of the invention is non – obvious and possesses prominent substantive features on the other hand. The invention possesses inventiveness. For the relevant examples, see Sections 4. 2 – 4. 5 of this Chapter.

### **3. 3. 4 Invention Achieves Commercial Success**

Where an invention achieves commercial success, if such success is directly brought about by the technical feature of an invention, it means that the invention has useful effect on the one hand, and it is non – obvious on the other hand. Such kind of invention possesses prominent substantive features and notable progress. It possesses inventiveness. However, if the success is brought about by other factors, such as the improvement of sale methods or commercial advertising, the invention cannot be regarded as possessing inventiveness.

## **4. Judgment of Inventiveness of Various Types of Inventions**

It should be noted that the division of the types of the inven-

tion in this Section mainly depends on the characteristics of the distinguishing features of the invention from the closest prior art. Such division is used for reference only. During the examination, the examiner should make his/her fair judgment according to the specific conditions of each case rather than applying these examples mechanically.

The following are examples to illustrate the judgment of inventiveness of various types of inventions.

#### **4.1 Invention Which Opens Up a Whole New Field**

The invention opening up a whole new field is one of a totally new technical solution, unprecedented in the history of technology. It has ushered in a new epoch in the development of human science and technology at a certain period of time.

As compared with the prior art, the invention opening up a whole new field possesses prominent substantive features and notable progress. It has inventiveness. For example, the four great Chinese inventions—compass, papermaking, letterpress and gunpowder belong to inventions opening up a whole new field. The following inventions are also regarded as inventions of that type: steam engine, filament lamp, radio, radar, laser and so on.

#### **4.2 Combination Invention**

The combination invention refers to a new technical solution constituted by combination of certain technical solutions to solve a certain technical problem existing in the prior art.

If the combined technical features are functionally supporting each other and produce a new technical effect, in other words, if the technical effect of the combination is better than the total sum of the effects of each of the technical features combined, such combination possesses prominent substantive features and notable progress. That is an invention possessing inventiveness. Whether or not each of the technical features is known or partially known to the public does not affect the inventiveness. For example, the invention of "A deep refrigerating treatment and process of chemical plating Ni - P - rare earth" is a combination of publicly known refrigeration treatment and chemical plating. According to the prior art, after deep refrigeration treatment, the work piece needs unconventional tempering treatment to eliminate stress, so as to stabilize its structure and

properties. While according to the present invention, after deep refrigeration treatment, there is no tempering or seasoning treatment in respect of the work piece, while the process of chemical plating is performed in the plating liquid of  $80^{\circ}\text{C} \pm 10^{\circ}\text{C}$ . To do this, according to this invention, the tempering or seasoning treatment is eliminated, while the work piece still has stable matrix structure and the plating film which possesses the features of anti-friction and anti-corrosion and has a good adhesion with the matrix. It is difficult for a person skilled in that technical field to expect the technical effect of this kind of combination. Therefore, that invention possesses inventiveness.

However, if an invention is merely a grouping – together of certain publicly known products or processes, each of them still works as usual and the general technical effect is the summation of the technical effect of each part, and there are no functional supports between the combined technical features, then the combination is merely a simple grouping – together. It does not possess inventiveness. For example, an invention of a ball – pen with electronic watch merely fixes a publicly known electronic watch on the ball – pen. After combination, each of them still plays its own role, without functional support between them. This combination is only a simple grouping – together, therefore, it does not possess inventiveness.

Moreover, if the combination is only a change of the publicly known structure, or it falls into the scope of the development of common technology without unexpected technical effects, the invention does not possess inventiveness.

#### 4. 3 Selection Invention

The selection invention refers to purposefully selecting the smaller range of alternatives or individual one which is not mentioned in the prior art from a larger range of alternatives disclosed in the prior art. This is a common type of invention in the field of chemistry, the judgment of inventiveness of which is mainly with reference to the technical effect of the invention. If the selected technical solution produces unexpected technical effect, it possesses prominent substantive features and notable progress. It has inventiveness. For example, an invention that relates to a process of producing thiocloroformate. It is disclosed in one of the reference documents that the proportion of catalytic agent carboxylic acid amide and/or urea to 1mol raw

material mercaptain is  $>0 \sim 100\text{mol}\%$ . In the given example, the amount of the catalytic agent is  $2 \sim 13\text{mol}\%$ , and it is indicated that the productivity starts to increase from  $2\text{mol}\%$  of the amount of catalytic agent. Moreover, the professional personnel in that field of technology generally improve productivity by increasing the amount of catalytic agent. According to the present invention, less amounts of catalytic agent are selected ( $0.02 \sim 0.2\text{mol}\%$ ), but the productivity is increased  $11.6\% \sim 35.7\%$ , which is greatly beyond the scope of expected productivity. Moreover, the invention has simplified the process of the reactant. All of these show that the technical solution selected by this invention has produced unexpected effects and thus the invention possesses inventiveness.

However, if the invention is only a selection among a number of equally possible alternatives, and the selected solution does not produce an unexpected effect, it does not possess inventiveness. For example, there are many heating processes in the prior art. In one invention, a common known electrically heating process was selected for a known heating – adopted chemical reaction, and that invention does not produce an unexpected effect. Thus, it does not possess inventiveness.

Where an invention selects specific dimensions, temperature range or other parameter from a possible and limited scope, while such selection may be made through conventional means by a person skilled in the art, that invention does not possess inventiveness. For example, an invention relates to a process for carrying out a known reaction and is characterized by a specified rate of flow of an inactive gas. The determination of the flow rate may be obtained through conventional calculations by a person skilled in the art. Therefore, this invention does not possess inventiveness.

An invention does not possess inventiveness if the selection can be directly derived from the prior art. For example, an invention that improves the thermal stability of a composition Y is characterized by the use of a specified minimum content of component X in composition Y. This can be derived from the curve indicating the relations between the contents of component X and the thermal stability of composition Y. Therefore, it does not possess inventiveness.

#### 4. 4 Invention Involving the Application of Known Measures and Use – Invention

The invention involving the application of known measures refers to an invention which is made by transferring the use of a prior art from one technical field to another technical field. Where such a transfer produces an unexpected effect or overcomes a difficulty which has never been encountered in that technical field, it possesses prominent substantive features and notable progress. It has inventiveness. For example, an invention relates to the submarine aileron. According to the prior art, the submarine stays at an arbitrary place under water based on the principle that the specific gravity of its deadweight and the water are identical. It goes up by operating horizontal cabin to create a buoyant force. But the airplane flies in the air completely by the buoyant force produced by the main wings. The invention draws lessons from the technical means of the plane and applied the main wings of the plane to the submarine. As a result, the buoyant force or sinking force of the submarine is created by the function of the movable board, which is used as aileron of the submarine, so that the rise and fall performance of the submarine is greatly improved. Because many difficulties has to be overcome to apply the technology in the air to those under water, this invention produces extremely good results. It possesses inventiveness.

However, if the transfer of use is carried out between the identical or similar fields of technology and does not produce unexpected effects, such invention does not possess inventiveness.

The use invention refers to the invention by which a known product is used for a new purpose. If the new use can produce an unexpected effect, the use possesses prominent substantive features and notable progress. The invention possesses inventiveness. For example, sinituho, used to be a wood bactericide, is used as a herbicide and produces an unexpected effect. It is an invention which possesses inventiveness.

However, if the new use merely makes use of a publicly known property of a known material, it does not possess inventiveness. For example, the use of a known composition, used to be a lubricant oil, as a cutting agent in the same field of technology does not possess inventiveness.

#### 4. 5 Invention Involving Substitution of Elements

The invention involving substitution of elements includes the

inventions of changed relations of elements, the inventions of substituted elements and the inventions of omitted elements.

(1) The invention of changed relation of elements means that, as compared with the prior art, the parameters, such as shape, size, proportion, position, functional relation and so on, are changed. If the quality, function or use of the invention is changed due to the change of the relation of the elements, and produces an unexpected effect, it possesses prominent substantive features and notable progress. Thus the invention possesses inventiveness. For example, an invention of a grass mower is characterized by the fact that the oblique angle of the blade of the mower is different from that of the traditional mower. The effect is that the oblique angle enables the blade to be auto-ground, while the angle of the blade in the prior art has no such effect. The invention produces an unexpected effect through a change in the relation of elements, so it possesses inventiveness.

On the other hand, if the said change cannot produce an unexpected effect, the invention will not possess inventiveness. For example, there is a measuring device in the prior art, the division circle of which is fixed but the hand turns. A new invention of measuring device changes the relation of elements: the division circle turns but the hand is fixed. The difference between the invention and the prior art is obvious: one has a fixed division circle with a turning hand, the other has a fixed hand with a turning division circle. But such a change doesn't produce any unexpected effect, so it does not possess inventiveness.

(2) The invention of substituted elements refers to the invention which is made as a result of that a certain element of a known product or process is substituted by another element. If the substitution produces an unexpected effect, the invention possesses prominent substantive features and notable progress. It has inventiveness.

However, if the invention is an equivalent substitution of known means which has the same function, or for the sake of solving the same problem, the use of a recently developed material with the same function to substitute the corresponding material in a publicly known product, or the use of a publicly known material to substitute a certain material in the publicly known product, while the similar use of this publicly known material is publicly known, and such uses do not produce any unexpected

technical results, the invention does not possess inventiveness. For example, an invention relates to a pump which differs from the prior art in which its motive power is provided by a hydraulic motor instead of an electric motor. Such an invention of equivalent substitution does not possess inventiveness. Another example: an electric cable comprises polyethylene sheath bounded to metallic shield by an adhesive. An invention uses a newly developed adhesive just publicly known before the date of filing to be suitable for polymer – metal bonding to substitute the conventionally used adhesive. This invention does not possess inventiveness.

(3) The invention of omitted elements refers to the invention that omits one or more elements of a known product or process. If, as compared with the prior art, an invention is made by omitting one or more elements (for example, a product invention omits one or more parts; a process invention omits one or more steps), all of the functions still remain, or it produces an unexpected effect, it possesses prominent substantive features and notable progress. The invention possesses inventiveness.

However, if the corresponding function disappears accordingly after one or more elements is omitted, the invention does not possess inventiveness.

## **5. Points to Be Noted When Inventiveness Is Examined**

### **5.1 Way by Which Invention Is Made**

The way of making an invention, either it is arduous or it is easy, does not affect the evaluation of the inventiveness of an invention. Most inventions are the fruits of the creative work of inventors. They are the summarization of long time scientific research or production practice. However, there are some inventions made by accident. For example, the known tire of motor vehicles has good strength and anti – abrasion. It was made by a technician by accident who wrongfully added 30% carbon black instead of 3% when he was preparing materials for producing black rubber. Facts show that the rubber with 30% carbon black possesses the unexpected high strength and anti – abrasion. Although it was made by accident, the inventiveness of the invention was not affected.

### **5.2 Avoiding to Be Wise after Invention**

When judging the inventiveness of an invention, because the examiner has already known very well the contents of the in-

vention, it is easy for him/her to underestimate the inventiveness of the invention and make the mistake of "hindsight". he/she should always bear in mind that the evaluation shall be made by a person skilled in the art on the basis of comparison with the prior art before the date of filing of the invention, so as to reduce and avoid the effect of the subjective feeling.

### **5.3 Consideration of Unexpected Technical Effect**

When judging the inventiveness, considering the technical effect will be useful to evaluate correctly the inventiveness of the invention. As Section 3.3 of this Chapter states, where the invention produces an unexpected technical effect as compared with the closest prior art, it may be ascertained that the invention possesses inventiveness, and the examiner needn't doubt whether or not the technical solution has the prominent substantive feature. However, it should be noted that, if the examiner can, by the method stated in Section 3.2 of this Chapter, determine the technical solution of invention is non-obvious for a person skilled in the art, and the technical solution produces useful technical effect, the invention possesses prominent substantive feature and notable progress. It has inventiveness. Under such circumstances, it shall not put undue stress on whether or not the invention produces unexpected technical effect.

### **5.4 Examination of Invention Claimed for Protection**

The question of whether or not an invention possesses inventiveness is directed at the claimed invention. Therefore, the evaluation of inventiveness shall be directed at the technical solution defined by the claims. The technical feature of the invention which makes contribution to the prior art, such as the technical feature by means of which the invention produces an unexpected technical effect, or the technical feature by means of which the invention overcomes the technical prejudice, shall be included in the claims. Otherwise, even if it is disclosed in the description, it shall not be taken into account when evaluating the inventiveness of the invention. Moreover, the evaluation of the inventiveness shall be directed at the whole technical solution defined by the claims, that is, to evaluate whether or not a technical solution, rather than a specific technical feature, possesses inventiveness.



## Chapter 5

### Practical Applicability

#### 1. Introduction

In accordance with the provisions of Article 22. 1 of the Patent Law, any invention or utility model for which patent right may be granted must possess novelty, inventiveness and practical applicability. Therefore, possessing practical applicability is one of the indispensable requirements for an invention or utility model to be granted the patent right.

According to the provisions of Article 22. 4 of the Patent Law, an invention or utility model which possesses practical applicability should be a technical solution which can be made or used by technical personnel in the relevant field of technology and can produce effective results.

The contents of this Chapter mainly relate to the concept of practical applicability and the principles and criteria of the examination of practical applicability.

#### 2. Concept of Practical Applicability

##### Art. 22. 4

Practical applicability means that the subject matter of a patent application for invention or utility model must be one that can be made or used industrially and produce positive effective results.

An invention or utility model for which a patent right has been granted shall be one that can solve a technical problem and be exploited. In other words, if the invention is a product (including subject matter for invention or utility model), it can be made industrially and solve the technical problem; if it is a process (subject matter for invention only), it can be used industrially and solve the technical problem. Only when the application for a patent for a product or process satisfies such conditions, can the patent right be granted.

The term "industry" refers to industry, agriculture, forestry, fishery, animal husbandry, communication and transportation, culture and sports, articles of daily use, medical equipment, etc.

The "technical solution", which can be made or used in industry, refers to any exploitable technical solution which is in conformity with the Patent Laws of nature and possesses technical features. It does not mean that technical solutions must use

machines or manufacture products. They may be, for example, a process for dispersing fog, or a process for converting energy from one form to another.

“Producing positive effective results” means that the economic, technical or social effective results produced by an invention or utility model is expected by a person skilled in the art on the date of filing of an application. These results shall be positive and advantageous.

### **3. Principles and Criteria of Examination of Practical Applicability**

It must be evaluated whether an application for a patent for invention or utility model possesses practical applicability before the examination of novelty and inventiveness.

#### **3.1 Principles of Examination**

The examination of practical applicability of an application for a patent for invention or utility model shall be in conformity with the following principles:

(1) The basis of examination shall be the entire contents of the technology disclosed in the description (including the drawings) and claims submitted on the date of filing and not merely the contents disclosed in the claims;

(2) The criterion of judging whether a technical solution can be exploited is to judge whether it can be carried out by a person skilled in the art;

(3) Practical applicability has nothing to do with how the invention or utility model was created or whether it has been exploited.

#### **3.2 Criteria of Examination**

The provision of Article 22.4 of the Patent Law is the basis for determining whether or not an application for a patent for invention or utility model possesses practical applicability.

Some typical situations of not possessing practical applicability are described as follows.

##### **3.2.1 Non – Reproducibility**

The subject matter of an application for a patent for invention or utility model which has practical applicability shall possess reproducibility. Conversely, the subject matter of an application for a patent for invention or utility model without reproducibility does not possess practical applicability.

The term "reproducibility" means that a person skilled in the art is, according to the disclosed technical contents, able to carry out again and again the technical solution adopted in the application for a patent for the solution of a technical problem. *Such repeated exploitation shall not rely on any random elements and the results obtained shall be the same.*

However, the examiner shall take note that there is an essential difference between the low rate of finished product for which a patent for invention or utility model is applied for and non-reproducibility. The former refers to the product which can be exploited again and again, and the low rate of finished product may be caused by certain technical conditions (such as environmental cleanliness, temperature and so on) not fulfilled in the course of exploitation; whereas the latter refers to such a situation that even when all the necessary conditions are fulfilled, a person skilled in the art still cannot achieve the results which the technical solution aimed to achieve.

### 3. 2. 2 Contrary to the Law of Nature

An application for a patent for invention or utility model possessing practical applicability shall comply with the laws of nature. An application for a patent for invention or utility model which is contrary to the laws of nature cannot be exploited. So it does not possess practical applicability.

The examiner shall take a special note of the subject matter of applications for patent for invention or utility model which violates the laws of energy conservation, such as perpetual motion machines. They certainly do not possess practical applicability.

### 3. 2. 3 Product Utilizing Unique Natural Conditions

An application for a patent for invention or utility model possessing practical applicability may not be a unique product restricted by natural conditions. The only product which is made by utilizing specific natural conditions and cannot be moved forever does not possess practical applicability. It should be noted that the components *per se* of the said product cannot be regarded as not possessing practical applicability just because the said product does not possess practical applicability.

### **3.2.4 Methods of Surgery on Human or Animal Body for No Treatment Purposes**

Methods of surgery include methods for treatment and not for treatment. Methods of surgery for treatment is a subject matter referred to in Section 3.3, Chapter 1 of this Part which is excluded from patentability. Methods of surgery not for treatment, such as methods of cosmetic surgical operation, methods of obtaining bezoar from living cattle body by surgical operation as well as the method of surgical operation for assisting diagnosis, like the surgical operation adopted before coronary arteriography etc., do not possess practical applicability because these methods are practiced on living human or animal body, they cannot be exploited industrially.

### **3.2.5 No Positive Effect**

The technical solution of an application for a patent for invention or utility model possessing practical applicability should produce expected positive effects. The technical solution of an application for a patent for invention or utility model which obviously does not produce benefit, is divorced from the needs of society, seriously pollutes the environment, seriously wastes energy or resources, or injures the health of human beings, does not possess practical applicability.

### **3.2.6 Methods of Measuring Physiological Parameters under Limit Conditions of Human Bodies**

When the physiological parameters of a human body under conditions of the limit are to be measured, it is necessary for man to stay under such conditions. But this would constitute a threat to man's life. Moreover, the limits which each man can endure are different. It would need experienced personnel to determine the specific limit of each man according to its conditions. Therefore, such methods cannot be used industrially and do not possess practical applicability.

The following methods are regarded as not possessing practical applicability:

(1) The method of measuring the degree of cold – resistance of a human or animal by gradually decreasing the temperature of a human or animal body;

(2) The method of non – invasive examination for measuring the metabolic function of the coronary artery through increasing

the workload of the coronary artery step – by – step by decreasing oxygen partial pressure of the inhaling air and observing the compensation reaction of the coronary artery from dynamic change of the artery blood pressure.

## **Chapter 6**

### **Unity of Invention and Divisional Application**

#### **1. Introduction**

An application for patent shall comply with the provisions on unity of invention as provided in the Patent Law and its Implementing Regulations. The requirement of unity of invention for an application for a patent for invention or utility model is provided in Article 31.1 of the Patent Law and Rule 35 of the Implementing Regulations of the Patent Law. Provisions concerning the amendment or division of the patent application which do not comply with the requirement of unity of invention are provided in Rules 42 and 43 of the Implementing Regulations of the Patent Law.

This chapter is divided into two parts which are unity of invention and divisional application respectively. In the part of unity of invention, it mainly relates to the basic concept of unity of invention, and the principles and methods of the examination of unity of invention. In the part of divisional application, it mainly relates to circumstances under which an application should be divided, the requirements to be satisfied when dividing an application and the examination of divisional application.

The provisions on unity of invention in this Chapter mainly relate to the application for a patent for invention, but the basic concept and principles apply also utility models. For the examination of unity of invention with regard to an application for a patent for utility model, please refer to the relevant contents in Chapter 2, Part 1 of these Guidelines. In respect of the examination of the unity invention with regard to an application for a patent for design, please refer to the contents in Chapter 3, Part 1 of these Guidelines. In respect of the examination of the unity of invention with regard to the application for a patent for invention in the field of chemistry, please refer to the contents of Section 6, Chapter 10 of this part of these Guidelines.

#### **2. Unity of Invention**

##### **2.1 Basic Concept of Unity of Invention**

###### **2.1.1 Requirement of Unity of Invention**

Art. 31.1

By unity of invention, it means that an application for a patent for invention or utility model shall be limited to one invention

or utility model. Two or more inventions or utility models belonging to a single general inventive concept may be filed as one application. That is, where there are several inventions or utility models in one application, the application is acceptable if these inventions or utility models are so linked as to form one single general inventive concept. This is the requirement of unity of invention for an application for a patent.

The main concerns of the requirement of unity of invention for an application for patent are as follows:

(1) Economic consideration; so as to prevent the applicant from obtaining patent protection for several different inventions or utility models by paying fees for only one patent.

(2) Technological consideration; so as to facilitate the classification, search and examination of an application for a patent.

The lack of unity of invention does not have prejudice to the validity of a patent. Therefore, lacking unity of invention shall not be taken as a ground to invalidate a patent.

### 2. 1. 2 General Inventive Conception

It is stipulated in Rule 35 of the Implementing Regulations of the Patent Law that two or more inventions or utility models belonging to a single general inventive concept shall be technically interrelated and contain one or more of the same or corresponding specific technical features. The expression "specific technical features" shall mean the technical feature or features that play a substantial role in the contribution that each of those claimed inventions or utility models makes over the prior art.

The above – mentioned provision indicates a way for determining whether two or more inventions or utility models claimed in an application belong to a single general inventive concept. That is, two or more inventions belonging to a single general inventive concept shall be technically interrelated. The interrelation between the inventions is embodied in their respective claims in the form of the same or corresponding special technical features.

The expression of "specific technical features" is also defined in the above – mentioned provision. It is a concept specifically created for the evaluation of unity of invention of an application for patent. It shall be understood as the technical features that embody the contributions the invention has made over the prior art, i. e. the technical features which make the invention,

compared to the prior art and considered as a whole of the each invention seeking protection, possessing novelty and inventiveness.

In conclusion, the expression of "belonging to a single general inventive concept" as provided in Article 31 of the Patent Law refers to the situation that the inventions possess the same or corresponding special technical features.

## **2. 2 Examination of Unity of Invention**

### **2. 2. 1 Principles of Examination**

In carrying out the examination of unity of invention with regard to an application for a patent for an invention, the following principles shall be observed by the examiner:

(1) When judging whether a group of inventions claimed in an application satisfies the requirement of unity of invention in accordance with the provisions of Article 31. 1 of the Patent Law and Rule 35 of the Implementing Regulations of the Patent Law, it is to determine whether the substantive contents of the technical solution described in the claims belong to a single general inventive concept, i. e. to determine whether these claims contain one or more of the same or corresponding special technical features which make the claimed inventions technically interrelated. This judgment is conducted in accordance with the terms of the claims. Where necessary, the contents of the description and the drawings may be consulted.

(2) The claims of two or more inventions belonging to one single general inventive concept may be written as any one of the following six combinations:

(i) independent claims of the same category for two or more products or processes which cannot be included in one claim;

(ii) an independent claim for a product and an independent claim for a process specially adapted for the manufacture of the said product;

(iii) an independent claim for a product and an independent claim for a use of the said product;

(iv) an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product;



(v) an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for an apparatus specially designed for carrying out the said process;

(vi) an independent claim for a process and an independent claim for an apparatus specially designed for carrying out the process.

Wherein, the "same category" in Item (i) means the types of independent claims are the same, i. e. , two or more inventions claimed in one patent application only involve either product inventions or process inventions. So long as the one or more corresponding specific technical features can make more than one product invention or process invention technically interrelated, it is allowable to include more than one independent claim in one patent application.

Items (ii) – (vi) relate to the combinations of two or more independent claims in different categories.

As for the combination of an independent claim for a product and an independent claim for a process specially adapted for the manufacture of the said product, the use of the "specially adapted" process is to obtain the claimed product, and the process and the product are technically interrelated. However, the expression "specially adapted" does not mean that the said product could not be manufactured by any other process.

With respect to the combination of an independent product claim and the independent claim for its use, the use cannot but depends on the special features of that product, and they are technically interrelated.

As for the combination of an independent claim for a process and that for an apparatus specially designed for carrying out the process, the "specially designed" apparatus shall be suitable for carrying out the process, and the contribution over the prior art made by this apparatus shall correspond to that made by the process. However, the expression "specially designed" does not imply that the said apparatus could not be used to carry out other processes or the said process could not be carried out by other apparatus.

The unity of invention is not affected by whether the independent claims in different categories are drafted by way of references, which is only a difference in form. For example, an independent claim for a process specially adapted for the manu-

facture of product A, which is parallel with an independent claim for product A, may be drafted as "a process for the manufacture of product A of claim 1, ...". It also may be drafted as "a process for the manufacture of product A, ...".

(3) Enumerated above are the six examples of combination of two or more independent claims in the same category or different categories which are allowed to be included in one application and their proper order, they are, however, not exhaustive. In other words, on the premise of belonging to a single general inventive concept, it is possible to use other kinds of combinations besides the said combinations. Conversely, if the two or more independent claims do not belong to one single general inventive concept, though their combination form may be in conformity with one of the six examples enumerated above, it is not allowed to be included in one application.

(4) In evaluating whether two or more inventions belong to one single general inventive concept, it does not matter whether these inventions are claimed in separate independent claims or in one claim involving several alternatives. For both cases the criterion for the determination of unity of invention shall be the same. The latter case occurs often in a Makush claim. Refer to section 6.1, Chapter 10 of this Part for the examination of unity of invention with regard to a Makush claim. Moreover, the order of the claims shall not affect the determination of the unity of invention of an invention.

(5) In general, there may be the problem of unity of invention among the independent claims, and the examiner only need to take it into consideration in such situation. There usually exists no lack of unity of invention between the dependent claim and the independent claim to which the dependent claim is subordinated. However, where for a claims dependent in form but independent in substance, an examination of unity of invention shall be conducted to them.

Where an independent claim cannot be granted patent right for lack of novelty or inventiveness, it is then necessary to consider whether among the dependent claims there exists the unity of invention.

(6) For some applications, the question of the unity of invention may be decided before the search of the prior art; but for some other applications, the question of the unity of invention could be decided only after taking into consideration the result of

the search of the prior art. Where the different inventions contained in an application do not obviously belong to a single general inventive concept, the examiner may decide that the application does not satisfy the requirement of unity of invention before the search is conducted. For example, there are two independent claims of a herbicide and a mower respectively in one application. Because there are no same or corresponding technical features between the two, nor is it possible for them to have the same or corresponding specific technical features, it is obvious that the invention has no unity of invention, the conclusion may be made before the search is conducted. However, since what the specific technical feature defines is the contribution made by an invention over the prior art and is to be compared with the prior art, it can be decided only after considering the state of the prior art. To this end, for quite a lot of the applications, the unity of invention may be decided only after the search has been made.

If after being compared with the prior art, the novelty or inventiveness of the first independent claim of an application is denied, the question of whether the rest of the independent claims parallel to it belongs to the one single general inventive concept shall be determined anew.

### 2. 2. 2 Examination of Unity of Invention, Methods and Examples

In general, the method of analyzing whether a group of inventions possess unity of invention consists of the following steps.

(1) Compare the subject matter of the first invention with the relevant prior art to identify the "specific technical feature" that plays a substantial role in the contribution the invention makes over the prior art.

(2) Determine whether the second invention contains one or more specific technical features which are same to or correspond with that in the first invention, so as to determine whether these two inventions are technically interrelated.

(3) If, between the inventions, there exists the one or more same or corresponding specific technical features, i. e. , the inventions are technically interrelated, it may come to the conclusion that they belong to a single general inventive concept. Conversely, if there exists no technical interrelation between the different inventions, it may come to the conclusion that they do not

belong to a single general inventive concept and it may be determined that they do not possess unity of invention.

Combined with the basic concepts, the principles of examination and the methods of examination of unity of invention, the following are the examples for demonstrating the points of examination of unity of invention.

#### 2. 2. 2. 1 Unity of Invention of Independent Claims in the Same Category

Example 1:

Claim 1: A conveyer belt *X* characterized by feature *A*.

Claim 2: A conveyer belt *Y* characterized by feature *B*.

Claim 3: A conveyer belt *Z* characterized by feature *A* and *B*.

There is no conveyer belt characterized by feature *A* or *B* disclosed in the prior art. From the perspective of the prior art, such conveyer belt is non – obvious and it is not relevant between *A* and *B*.

Explanation: Claims 1 and 2 do not contain the same or corresponding technical features. Therefore, it is impossible for them to have the same or corresponding special technical features. They are not technically interrelated and do not possess unity of invention. Feature *A* of claim 1 is the specific technical feature that plays a substantial role to the contribution that the invention makes over the prior art. Claim 3 contains the specific technical feature *A*, therefore, claim 1 and claim 3 contain the same specific technical feature and they possess the unity of invention. Similarly, the same specific technical feature *B* exists in both claim 2 and claim 3, thus they possess the unity of invention.

Example 2:

Claim 1: A transmitter characterized by the time axis expander for video signals.

Claim 2: A receiver characterized by the time axis compressor for video signals.

Claim 3: An apparatus for conveying video signal characterized by that it consists of the transmitter in claim 1 and the receiver in claim 2.

The use of the time axis expander and time axis compressor in the relevant field of the technology has neither been disclosed nor implied in the prior art, i. e. the use is non – obvious.

Explanation: The specific technical feature of claim 1 is the time axis expander of the video signal, and the specific technical feature of claim 2 is the time axis compressor of the video signal. The expander and compressor are interrelated and cannot be used separately. Claim 1 and claim 2 have specific technical features corresponding with each other and they possess unity of invention. As claim 3 contains the specific technical features of both claim 1 and claim 2, it possesses unity of invention with claim 1 or with claim 2 respectively.

Example 3:

Claim 1: A plug characterized by feature A.

Claim 2: A socket characterized by a feature corresponding to feature A.

The plug characterized by feature A and the corresponding socket have not been disclosed or implied in the relevant field of technology, and they are non-obvious.

Explanation: Claim 1 and claim 2 have corresponding specific technical features, and the claimed plug and the socket are interrelated and have to be used together, thus there is unity of invention between claim 1 and claim 2.

Example 4:

Claim 1: A control circuit with feature A for a D. C. motor.

Claim 2: A control circuit with feature B for a D. C. motor.

Claim 3: An apparatus comprising a D. C. motor control circuit with feature A.

Claim 4: An apparatus comprising a D. C. motor control circuit with feature B.

From the perspective of the prior art, A and B are the technical features reflecting the contributions to the prior art made by the inventions respectively, and A and B are not interrelated.

Explanation: Feature A is the specific technical feature of claims 1 and 3, and Feature B is the specific technical feature of claims 2 and 4. However, there is no technical relevance between A and B. Therefore, claim 1 and claim 3, and claim 2 and claim 4 have the same specific technical features and possess unity of invention. And since there is no similar or corresponding specific technical features between claim 1 and claim 2 or 4, or between claim 3 and claim 2 or 4, they do not meet the requirements of unity of invention.

Example 5:

Claim 1: A filament A for a lamp.

Claim 2: A lamp B using filament A.

Claim 3: A searchlight comprising a lamp B which uses filament A and a swivel arrangement C.

Compared with the lamp and the filament disclosed in the documents of the prior art, lamp filament A is new and possesses inventiveness.

Explanation: Since lamp filament A, the same specific technical feature, is present among the three claims, there is unity of invention among them.

Example 6:

Claim 1: A method B for making product A.

Claim 2: A method C for making Product A.

Claim 3: A method D for making product A.

Compared with the prior art, product A is new and possesses inventiveness.

Explanation: Product A is the same specific technical feature of the said three process claims, and there is unity of invention among these three processes of B, C, and D. Of course, product A per se may be the subject matter of a product claim. If product A is a known product, it shall not be regarded as the specific technical feature of the inventions. In such situation, the unity of invention among the three processes shall be re-evaluated.

#### 2.2.2.2 Unity of Invention of Independent Claims in Different Categories

Example 7:

Claim 1: A compound X.

Claim 2: A method of preparing compound X.

Claim 3: The use of compound X as an insecticide.

(1) Situation 1: The compound X possesses novelty and inventiveness.

Explanation: Compound X is the same technical feature of these three claims. Being the technical feature reflecting the contributions to the prior art made by the invention, it is called the specific technical feature. Hence, claim 1, claim 2 and claim 3 have the same specific technical features, and there is unity of invention among them.

(2) Situation 2: After search, the examiner finds that the compound X does not possess novelty and inventiveness compared with the prior art.

Explanation: No patent right may be granted to claim 1 since it does not possess novelty or inventiveness. The common technical feature of claim 2 and claim 3 is still the compound X. However, since the compound X has not made a contribution to the prior art, it is not the common specific technical feature. Moreover, there is no corresponding specific technical feature between claim 2 and claim 3. Therefore, the same or corresponding specific technical feature does not exist between claim 2 and claim 3.

Example 8:

Claim 1: A high strength and corrosion resistant stainless steel strip consisting essentially of (in percent by weight): Ni = 2.0 ~ 5.0, Cr = 15 ~ 19, Mo = 1 ~ 2, and the balance Fe having a thickness of between 0.5 and 2.0mm, and a 0.2% yield strength over 50kg/mm<sup>2</sup>.

Claim 2: A method of producing a high strength and corrosion resistant stainless steel strip consisting essentially of (in percent by weight): Ni = 2.0 ~ 5.0, Cr = 15 ~ 19, Mo = 1 ~ 2, and the balance Fe, comprising the steps in following order:

- (1) hot rolling to a thickness of between 2.0 and 5.0mm;
- (2) annealing the hot rolled strip at the temperature of 800°C ~ 1000°C;
- (3) cold - rolling the strip to a thickness of between 2.0 and 5.0mm; and
- (4) annealing at the temperature of 1120°C ~ 1200°C for 2 ~ 5 min.

Compared with the prior art, the stainless steel belt of which the 0.2% yield strength over 50kg/mm<sup>2</sup> possesses novelty and inventiveness.

Explanation: Unity of invention is present between claim 1 and claim 2. The specific technical feature of product claim 1 is the 0.2% yield strength over 50kg/mm<sup>2</sup>. The steps in process claim 2 are adapted for producing the stainless steel strip which has such yield strength. Although this feature is not apparent from the wording of claim 2, it is clearly disclosed in the description. These process steps are the corresponding specific technical features of the strength feature defined in product claim 1.

Claim 2 may be drafted by way of making reference to claim 1, and the unity of invention shall not be affected. For example:

Claim 2: A method of producing stainless steel strip as claimed in claim 1, comprising the following steps:

(Steps (1) ~ (4) are the same as the above and are omitted here.)

Example 9:

Claim 1: A coating material containing dustproof substance X.

Claim 2: A method of coating cloth product by the coating material as claimed in claim 1, consisting of the following steps: (1) spraying and atomizing the coating material by compressed air; (2) directing the atomized coating material to the cloth product after it passes through a electrode assembly A and is electrified.

Claim 3: A spraying machine including an electrode assembly A.

Compared with the prior art, both the coating material containing substance X and the electrode assembly A are new and possess inventiveness. However, the process of atomizing coating material and directing the atomized and electrified coating material to the cloth product is known.

Explanation: Unity of invention is present between claim 1 and claim 2, and the coating material containing substance X is their common specific technical feature. Unity of invention is also present between claim 2 and claim 3, because the electrode assembly A is their common specific technical feature. However, unity of invention does not exist between claim 1 and claim 3, since they do not have a common or corresponding specific technical feature.

Example 10:

Claim 1: A process for treating textile, characterized by spraying the textile material with a special coating material A under the specific condition B.

Claim 2: A kind of textile material obtained by the spraying process of claim 1.

Claim 3: A spraying machine used in the process of claim 1, characterized in that it includes a nozzle C providing a better distribution of the coating material on the textile material.

The process of treating textile materials by coating materials has been disclosed in the prior art, but it does not include the process of coating by a special coating material A under the specific condition B (such as temperature, irradiance, etc.) as claimed in claim 1. Moreover, the textile material claimed in claim 2 possesses an unexpected feature. The spray nozzle C is



new and has inventiveness.

Explanation: The specific technical feature in claim 1 is the use of specific process conditions corresponding to what is made necessary by the use of the special coating material. The textile material claimed in claim 2 is obtained after the treatment by the said special coating material in the specific condition. Therefore, claim 1 and claim 2 possess corresponding specific technical feature and have unity of invention. Since the spraying machine claimed in claim 3 has no common specific technical features with claims 1 and 2, claim 3 does not possess unity of invention with claim 1 or claim 2.

Example 11:

Claim 1: A process of manufacture comprising step A and step B.

Claim 2: An apparatus specially designed for carrying out step A.

Claim 3: An apparatus specially designed for carrying out step B.

No documents of prior art relating to the process claimed in claim 1 have been found.

Explanation: Step A and Step B are the specific technical features reflecting respectively the contribution over the prior art made by the inventions. Unity of invention is present between claim 1 and claim 2, and between claim 1 and claim 3. As there is no same or corresponding specific technical feature between claim 2 and claim 3, they do not possess unity of invention.

Example 12:

Claim 1: A burner characterized in that there are tangential fuel inlets into a mixing combustion chamber.

Claim 2: A process for making a burner, characterized in that it includes the step of forming tangential fuel inlets into a mixing combustion chamber.

Claim 3: A process for making a burner, characterized by casting procedure.

Claim 4: An apparatus for making a burner, characterized in that it includes a unit X connecting the tangential fuel inlet pipe with the mixing combustion chamber.

Claim 5: An apparatus for making a burner, characterized in that it includes an automatic control unit D.

Claim 6: A method for making carbon black by the burner as claimed in claim 1, characterized in that it includes the step

of tangentially introducing fuel into a mixing combustion chamber.

The burner consisting of non – tangential fuel inlets and the mixing combustion chamber has been disclosed in the documents of prior art. From the perspective of the prior art, the burner having tangential fuel inlets is neither known nor obvious.

Explanation: Unity of invention is present among claims 1, 2, 4 and claim 6. The specific technical feature among them involves the tangential fuel inlets. While the same or corresponding specific technical features are not present among claim 3 or claim 5 and claim 1, 2, 4 or 6. As a result, claim 3 or claim 5 cannot be included in this application. Besides, there is no unity of invention between claim 3 and claim 5. It is necessary to emphasize that even if the preamble portion of claim 3 has been rewritten as “a process for making a burner as claimed in claim 1”, and the preamble portion of claim 5 has been rewritten as “an apparatus for making burner as claimed in claim 1”, since the technical feature in the characterizing portions of these two claims has no with the tangential fuel inlets, there is still no same or corresponding specific technical feature or unity of invention between them and claim 1, 2, 4 or 6. Similarly, since there is no same or corresponding technical feature between claim 3 and claim 5, they do not possess unity of invention.

#### 2. 2. 2. 3 Unity of Invention of Dependent Claims

According to the principle mentioned in 2. 2. 1 (5) of this Chapter, the problem of lack of unity of invention does not happen in respect of the dependent claims which are in conformity with the requirements of the Patent Law and the independent claim on which it depends, even if the dependent claim comprises other inventions.

For example, an independent claim relates to a new process for making cast iron. In a specific embodiment, the cast iron has been produced under a certain scope of temperature by the process claimed in that claim. Under such circumstances, a dependent claim may be drafted to claim the protection of the scope of the temperature. Even if the temperature has not been mentioned in the independent claim, there shall be no question of lack of unity of invention in respect of this dependent claim and the independent claim.

Another example, claim 1 is a method characterized in u-

sing B as the raw material for making product A. Claim 2 is a method as claimed in claim 1, characterized in that the raw material B is prepared by material C for making product A. Since claim 2 contains all of the technical features of claim 1, so, no matter whether the process of the preparation of raw material B by material C is an invention, it shall not be considered that between claim 1 and claim 2 there is lack of unity of invention.

One more example, claim 1 claims a turbine rotor blade characterized in that the blade is shaped in a specified manner, while claim 2 is a turbine rotor blade as claimed in claim 1 characterized in that the blade is made of alloy A. In this example, even if the alloy A is new and it may constitute an independent invention itself and its use in turbine rotor blade is inventive, there shall be no problem of lack of unity of invention between claim 2 and claim 1.

It should be noted that under certain circumstances there may be lack of unity of invention among claims which are dependent in form but independent in substance. For example, claim 1 claims a contactor possessing features A, B, and C, while claim 2 is a contactor as claimed in claim 1, wherein the feature C is replaced by feature D. Because the contactor claimed in claim 2 does not contain all of the features of the contactor claimed in claim 1, claim 2 is not a dependent claim of claim 1, it is rather an independent claim. The question of whether there is unity of invention between the two claims shall be considered in accordance with the principles of the examination on unity of invention in respect of independent claims of the same category.

Where an independent claim cannot be granted patent right for lack of novelty, inventiveness etc., there may exist lack of unity of invention among its dependent claims.

For example:

Claim 1: A display characterized with features A and B.

Claim 2: A display as claimed in claim 1 characterized with additional feature C.

Claim 3: A display as claimed in claim 1 characterized with additional feature D.

(1) Situation 1: Compared with the display disclosed in the prior art, the display having features A and B as claimed in claim 1 has novelty and inventiveness.

Explanation: Claims 2 and 3 are dependent claims that fur-

ther define the extent of protection of the invention claimed claim 1, therefore there is unity of invention among claims 1, 2 and 3.

(2) Situation 2: Viewing from the combination of two reference technical documents, the display as claimed in claim 1 does not possess inventiveness. Whereas features C and D are respectively the technical features which have contributions over the prior art and there is no relevance between them.

Explanation: Since claim 1 does not possess inventiveness, no patent right may be granted to it. For claim 2 and claim 3, as far as the determination of unity of invention is concerned, they shall be regarded as independent claims. And the specific technical feature C in claim 2 and the specific technical feature D in claim 3 are neither same nor corresponding features. Therefore, there is no unity of invention between claim 2 and claim 3.

### **3. Divisional Application**

#### **3.1 Scenarios of Divisional Application**

To meet the requirement of unity of invention, the applicant shall be invited to make amendments (including making divisional applications) to its/his application under any of the following circumstances:

(1) Two or more inventions that do not comply with the requirement of unity of invention are claimed in the initial claims.

Where two or more inventions not belonging to one single general inventive concept are claimed in the initial claims, the examiner shall invite the applicant to limit the application to a single invention (usually the invention claimed in claim 1). The applicant may file divisional applications for the remaining inventions.

(2) No unity of invention between the invention claimed in the independent claim newly introduced or replaced in the amended application documents and the invention claimed in the initial claims.

In the process of examination, the invention described only in the description originally is added into the original claims as a independent claim or has replaced the initial independent claim by the applicant when amending the claims, and there is no unity of invention between this invention and the invention claimed in the original claims. Under such circumstances, the examiner shall invite the applicant to delete the added invention from the claims. The applicant may file a divisional application for the deleted invention.

(3) One of the independent claims fails to satisfy the requirements of novelty or inventiveness, and there is no unity of invention among the others claims.

The lack of novelty or inventiveness of one independent claim (usually claim 1) leads to the fact that the other parallel independent claims or even their dependent claims no longer have common or corresponding specific technical features, i. e. they no longer have unity of invention, and have to be treated as divisional applications. For example, an application comprises a product, a process for making the product and a use of the product. It is found after search and examination that the product is a known product. Then, it is obvious that there couldn't be any same or corresponding specific technical features between the remaining independent claims for the process for making the product and the use of the product. Therefore, it is necessary to divide the application.

The above - mentioned division of application may be made either by the applicant on its /his own initiative, or under the request of the Patent Office. It should be noted that as the division of application should be a voluntary act on the part of the applicant, the examiner shall only invite the applicant to amend the application claims to make the two or more inventions not complying with the requirement of unity of invention into an application claiming for only one invention or to amend the application into two or more inventions belonging to one single general inventive concept. Whether divisional applications should be filed for the other inventions claimed in the application after the amendment, it is for the applicant to decide.

Moreover, one or more divisional applications may be divided from one application. And one or more divisional applications may be further divided from one divisional application. This mainly depends on the actual needs and the possibilities that may have .

### 3. 2 Requirements to Be Met for Divisional Application

A divisional application shall meet the following requirements:

#### (1) Applicant of divisional application

The applicant of a divisional application shall be the applicant of the initial application or its/his assignee or successor. The inventor of the divisional application shall also be the invent-

or or part of the inventors of the initial application.

(2) Time of making divisional application

Rule 42. 1

Rule 54. 1

Where the application is regarded as not meeting the requirement of unity of invention by the Patent Office, the application shall be amended to one invention or to several inventions belonging to one single general inventive concept by the applicant within the specified time limit of the Patent Office. As to whether it's necessary to file divisional applications for the one or several inventions divided from the application, it is a voluntary act of the applicant. According to Rule 42 of the Implementing Regulations of the Patent Law, the applicant may, before the expiration of the time limit of two months from the receipt of the notification of grant of patent right from the Patent Office to go through the registration proceedings, submit a divisional application to the Patent Office. Therefore, the applicant may either file divisional applications before the Patent Office issues the notification of grant of patent right or within two months from the date of receipt of the notification of grant of patent right.

Similarly, filing of divisional application on the initiative of the applicant may be made either before the Patent Office issues the notification of grant of patent right or within two months from the date of receipt of the notification of grant of patent right.

Rule 42. 1

However, it is to be noted that where an application has been rejected and the rejection has taken effect, or an application has been withdrawn or is deemed to have been withdrawn and no restoration of right has occurred, no divisional application may be filed.

(3) Kind of protection of divisional application

It is stipulated in Rule 42.3 of the Regulations that the divisional application may not change the kind of protection of the initial application. This means that the divisional application divided from the initial application for a patent for invention shall be an application for a patent for invention and the divisional application divided from the initial application for a patent for utility model shall be an application for a patent for utility model. Otherwise, the divisional application shall be treated as a new application for patent.

(4) Text of divisional application

For a divisional application, at the beginning of its description, i. e. before the technical field to which the invention belongs of the description, it shall indicate the application from

which it is divided, and the date of filing, the application number and the title of the invention – creation of the initial application.

When filing the divisional application, a copy of the initial application shall be submitted; if right of priority is claimed, a copy of the priority document of the initial application shall also be submitted.

(5) Contents of divisional application

Rule 53(4)

The divisional application shall not go beyond the scope of disclosure contained in the initial application, otherwise it shall be rejected on the ground that it does not comply with the provisions of Rule 43.1 of the Implementing Regulations of the Patent Law.

(6) Description and claims of divisional application

The claims of the initial application and the divisional application shall claim protection of different inventions respectively. However, their descriptions may have variations. For example, inventions A and B may be included in the initial application, after the division of application, the initial application may claim for the protection of A, the description of the initial application may still include inventions A and B, or keep invention A only. If the claims of the divisional application claim for the protection of B, the description of the divisional application may still include inventions A and B, or cover B only.

### 3.3 Examination of Divisional Application

Under the circumstances where it is necessary to divide an application, the examination of the division of application which includes both the examination of the divisional application and the initial application after the division shall be performed in accordance with Rules 42 and 43 of the Implementing Regulations of the Patent Law.

(1) In accordance with Rule 43.1 of the Implementing Regulations of the Patent Law, the divisional application shall not go beyond the scope of the disclosure of the initial application. Otherwise, the examiner shall invite the applicant to make amendments. If the applicant does not make the amendments, the divisional application shall be rejected by the examiner in accordance with Rule 53.4 of the Implementing Regulations of the Patent Law on the ground that it does not conform with the provisions of Rule 43.1 of the Implementing Regulations of the Patent Law.

(2) In accordance with Rule 42.2 of the Implementing Regulations of the Patent Law, where an application is not in conformity with the provisions of Article 31 of the Patent Law and Rule 35 of the Implementing Regulations of the Patent Law, the examiner shall invite the applicant to amend the application within a specified time limit, i. e. , to change the initial application to one invention or to several inventions belonging to one single general inventive concept within the said time limit. Meanwhile, the examiner shall remind the applicant that the application shall be deemed to have been withdrawn, if without justified reasons, response has not been made within the time limit; and if the initial application has not been changed to an application in conformity with the requirement of unity of invention without sufficient reasons, the examiner may reject the application on the ground that it does not conform with the provisions of Article 31.1 of the Patent Law. Similarly, the divisional application that is not in conformity with the requirement of unity shall be treated in the same way.

(3) Except for the examination conducted in accordance with Rules 42 and 43 of the Implementing Regulations of the Patent Law, the rest of the examination shall be conducted as it does to a regular application.



**Chapter 7****Search****1. Introduction**

Each application for a patent for invention shall go through the search before being granted patent right. In the substantive examination procedure for an application for patent for invention, search constitutes a very important step. The objective of the search is to find out the reference documents closely related or relevant to the subject matter of the application from the prior art, or to find out the conflicting applications or the documents which may avoid double patenting in order to decide whether the subject matter of the application possesses novelty and inventiveness as required in Article 22.2 and 22.3 of the Patent Law, or meets the requirement of Rule 13.1 of the Implementing Regulations of the Patent Law.

Art. 57  
Rule 55

The provisions of this Chapter shall apply to the search of patent for utility model and the short-term patent of Hong Kong Special Administrative Region.

The results of the search shall be recorded in the search report.

This Chapter involves mainly the search documents for use in the examination, the subject matter of the search, the preparation prior to the search, the strategy of the search, and the search report, etc..

**2. Search Documents for Use in Examination****2.1 Patent Documents for Use in Search**

The search in the substantive examination procedure for an application for patent for invention is mainly conducted in the patent documents which are used for the search. The patent documents which are used for the search mainly include the search files for examination in the IPC order and in paper form and the patent documentation of the various countries in serial number; the patent documents of various countries in microfiche and the patent documentation of various countries in E-form (computer searchable database).

The search files used by the Patent Office mainly include: the publication descriptions of the Chinese patent applications for patent for invention, the descriptions of the Chinese patents for utility models, US patent specifications, publication descrip-

tions of the European patent applications, publication descriptions of the PCT international patent applications and the classified patent abstracts of various countries, etc. . The patent documentation in E – form used by the Patent Office for search mainly includes; the publication descriptions of the Chinese patent applications for invention, the descriptions of the Chinese patents for utility model, the publication descriptions of the European patent applications, the publication descriptions of the PCT international patent applications, the US patent specifications, the publication descriptions of the Japanese patents and utility models, and the classified patent abstracts of various countries, etc. .

## **2. 2 Non – Patent Literature for Use in Search**

Besides conducting search in the patent documents, the examiner, if necessary, shall also search the non – patent literature which mainly includes; foreign and domestic scientific and technological books, periodicals, index tools and manuals in paper form or E – form.

## **3. Subject Matter of Search**

### **3. 1 Text of Application Forming Basis of Search**

The text of the application forming the basis of the search usually includes the initial claims and the description (including the drawings, if any) submitted by the applicant on the date of filing. Where amendments have been made to the claims and/or the description by the applicant upon the request of the examiner in accordance with Rule 44 of the Regulations of the Patent Law or on its/his own initiative in accordance with Rule 51. 1 of the Implementing Regulations of the Patent Law, the text of the application forming the basis of the search shall be the claims and/or description submitted by the applicant at the latest time and are in conformity with the provisions of Article 33 of the Patent Law ( see Section 4. 1, Chapter 8 of this Part).

### **3. 2 Search of Independent Claim**

Search shall direct mainly to the claims of the application and with due regard to the description and its drawings. The examiner should, at the very start, take the technical solution defined by the independent claim as the subject matter of the search, and the emphasis shall be given to the inventive concept of the independent claim. Therefore, the search shall not be confined to the literal wording of the independent claim, nor

shall it be broadened to include the each detail that may be derived from a consideration of the description and the drawings.

### 3. 3 Search of Dependent Claim

If the novelty or inventiveness of the independent claim is questioned by the reference documents found in the search of the subject matter defined by the independent claim, then for assessing the novelty and inventiveness as required by Article 22.2 and 22.3 of the Patent Law, it is necessary to take the technical solution additionally defined by the dependent claim as the subject matter of the search, and one or more additional international classification units shall be searched. However, further search may not be conducted for the additional features of the dependent claim that are of trivial technical value or are generally known in the prior art.

Where the search results have revealed that the subject matter defined by the independent claim possesses novelty and inventiveness, it is not necessary generally to conduct further search to the technical solution defined by its dependent claims.

### 3. 4 Search of Claims Characterized by Combination of Elements

For claims characterized by a combination of features A, B, and C, the examiner, when carrying out the search in the patent documents, should first direct the search to those international classification units which relate to the combination of A + B + C, and at the same time to those units of the sub-combinations of A + B, B + C, and A + C, as well as the single feature (element) of A, B, and C. If no reference documents are found in those units, in order to assess the inventiveness of the combination of A + B + C, the examiner shall further direct the search, with regard to the each feature and their sub-combinations, to the patent documents in other international classification units.

### 3. 5 Search of Claims of Different Categories

Where the application contains claims of different categories (product, process, apparatus or use), the examiner shall direct the search to all of these claims. In certain circumstances, even though the application contains claims of only one category, it may be necessary to conduct the search which directs to the relevant subject matter in other categories. For example, when the search is directed to a claim relating to a chemical process, in

order to determine its inventiveness, in addition to search the process claim itself, the search shall also cover the final product made by the process, unless they are obviously known products.

### **3.6 Search of Description and Drawings**

In addition to search the technical solution defined by the claims, i.e. the subject matter of the application seeking protection (hereinafter refers to the subject matter of the application), it may be necessary for the examiner to carry out, sometimes, the search which directs to the other substantive contents which further define the subject matter of the application disclosed in the description and its drawings. This is because when the applicant amends its/his claims, it is possible for it/him to add them into the claims. For example, in an application relating to an electric circuit, the technical solution defined by the claims only relates to the function and the manner of operation of the circuit, but an important transistor circuit has also been disclosed in detail in the description and the drawings. Under such circumstances, when conducting the search, it shall not direct to the function and the manner of operation of the circuit defined by the claims only, but shall cover also the transistor circuit. Thus, even if the applicant introduces the transistor circuit into the claims in the later amendments, the examiner will not need to perform supplementary search. However, no search is necessary for the invention included in the description which has no unity of invention with the subject matter defined by the claims, because they are not allowed to be introduced into the claims in the later amendment (see Section 5.2.1(3), Chapter 8 of this Part).

## **4. Time Coverage of Search**

### **4.1 Time Coverage of Search for Relevant Documents**

For an application for a patent for invention, the examiner shall search all the relevant patent documents and non – patent literature disclosed before the date of filing in China. The advantage of doing so is that the examiner may not need to verify the validity of priority, except for the situations in which the priority must be verified as described in Section 4.6.1, chapter 8 of this Part. For example, when reference documents in the period of priority which can destroy the novelty or inventiveness of the application are found.

#### 4.2 Time Coverage of Search for Conflicting Applications

In order to determine whether there is a conflicting application which has prejudice to the novelty of the subject matter of an application for a patent for invention, the examiner shall also search the following:

(1) All of the patent applications in the same or relevant technical fields filed by other person prior to the date of filing of the application and which have already been published within the eighteen months from the date of filing of the application;

(2) All of the PCT international applications designating China, filed by other person with the International Receiving Office, prior to the date of filing of the application and which have already been published within the eighteen months from the date of filing of the application and which are in the same or relevant technical fields. This is to find out the international applications which are identical with and may constitute the conflicting applications of the application after its entering of the national phase of China according to the provisions of the Patent Cooperation Treaty (PCT).

#### 5. Preparation Prior to Search

##### 5.1 Study of Relevant Documents

If the following documents have been cited in the description of the patent application, the examiner shall find them out and study them when necessary:

(1) documents cited as the basis of the subject matter of the application;

(2) technical background documents relating to the technical problem which the invention intends to resolve;

(3) documents which can help the examiner to understand the subject matter of the patent application.

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If these documents are necessary for the understanding and the evaluation of the subject matter of the application to the extent that the examiner cannot carry out a meaningful search without them, and if they are not available in the Chinese Patent Office, then the examiner shall postpone the search and ask the applicant to provide a copy of these documents within a prescribed time limit. The search shall not be carried out until the copy of the documents is received (see Sections 3.2.4 and 3.2.5, Chapter 8 of this Part).

If the documents cited in the description obviously have no direct relevance with the subject matter of the application, the

examiner may not take such documents into account.

If the applicant has submitted the search report of foreign countries, the examiner shall read the documents cited in the search report, especially those that may affect the novelty and inventiveness of the subject matter of the application.

### **5. 2 Verification of IPC Symbol of Application**

In order to determine the patent documentation (mainly referring to the search files in paper form and the patent documentation in E – form) to be searched, the examiner shall first of all identify the International Patent Classification (IPC) symbol (abbreviated as the Classification symbol) of the application. For this purpose, the examiner shall, on the basis of correct understanding of the subject matter of the application, use his knowledge of classification to verify the IPC symbol assigned to it by the classification department. If the IPC symbol is found not accurate, it shall be handled according to Section 3. 1, Chapter 8 of this Part.

### **5. 3 Determine the Technical Field of Search**

The examiner shall usually carry out the search in the technical field to which the subject matter of the application belongs. When necessary, the scope of the search shall be extended to the analogous technical fields. The technical field to which the subject matter of the application belongs is determined by the contents of the claims, especially the specific function and the use, as well as the corresponding specific embodiments which are clearly indicated. The International Patent Classification symbol which indicates the information of the invention assigned by the examiner is the technical field to which the subject matter of the application belongs. As to the analogous technical field, it is determined by the essential function or the use that the subject matter of the application as revealed in the application documents has to possess, rather than the title of the subject matter of the application, or the specific function expressly indicated in the application documents. For example, a tea – mixer and a concrete – mixer are in the analogous fields, because mixing is the essential function of both of them. Similarly, a brick cutting machine and a biscuit cutting machine also are in the analogous fields. Another example, a cable clamp having certain structural characteristics is defined in an independent claim of an applica-

tion. If no relevant document can be found in the technical field to which the cable clamp belongs, the search shall be extended to the technical fields of pipe clamp and similar clamps. These clamps possess the similar essential function with the cable clamp, it is quite possible for them to have the structural characteristics as defined in that independent claim. In other words, when an extended search is made, the search shall cover all the documents that may contain all or certain corresponding features of the subject matter of the application.

### 5.3.1 Use of Computer Searchable Database

The keyword, the title of the invention, the name of the inventor, etc. may be used by the examiner in the computer search of the computer searchable database to determine the technical fields to be searched. Among them, search by keyword is the most important way to help determine the technical fields of the search.

On the basis of the correct understanding of the subject matter of the application and after choosing one or more "keywords", the computer search in the computer searchable database using these "keywords" may help determine the IPC Group or Sub – class to be searched with regard to the subject matter of application. Using the same method, the IPC Group or Sub – class of the other subject matter of application mentioned above can be determined also.

### 5.3.2 Use of International Patent Classification

If, through the use of the computer searchable database, no exact information on the technical fields to be searched can be found, the examiner may determine the technical fields of the search by consulting the International Patent Classification in the following steps:

(1) consult the "Contents of the Section" at the beginning of each Section of the IPC, and choose all the possible Sub – section and Class according to the headings.

(2) consult the headings of the selected Sub – Section and Class, and choose the closest Sub – class which may most possibly cover the contents of the subject matter of the search.

In the above two steps, the examiner shall pay attention to the notes or references of the headings of the Sub – section and /or Class, which may have influence on the contents of the

Sub – class, with indication to the differences between the Sub – classes, and probably the illustration of the location of the expected subject matter. Moreover, the examiner shall note that if there is a functional classification location that is similar to the function of the subject matter of the search, there are possibly one or more application classification locations that are related to the subject matter of the search. When no specific location of the subject matter of the search could be found, the classification of the remaining locations, of which the heading of the Class or Group are “other XX”, “XX not listed in Group XX”, may be considered as the technical fields of the search.

(3) refer to the “Sub – class Index” at the beginning of the Sub – class, consult the complete heading, notes and reference of the Group, and choose the Group which is most suitable for covering the subject matter of the search.

(4) consult all of the Sub – groups with one dot under the selected Group, and choose the most suitable one for covering the subject matter of the search. If the Sub – group has notes and references, these notes and references may give information of the other Sub – groups to be taken into consideration so as to find out one or more classification locations which may be more suitable for the subject matter of the search.

(5) choose a Sub – group with more than one dot which can cover the subject matter of the search.

Through the above – mentioned five steps, the Sub – group which is most suitable for the covering of the subject matter of the search can be determined. This Sub – group and all its lower Sub – groups in which the subject matter of the search are not obviously excluded are the technical fields of the search. If there is any note of priority with the selected Sub – group, such Sub – group and all its lower Sub – groups in which the subject matter of the search are not obviously excluded shall also be deemed as the technical fields of the search. Furthermore, from the immediate higher level of the Sub – group through to the Group to which the selected Sub – group belongs are the technical fields of the search as well, because there include documents relating to the subject matter of the search in an even broad scope. If the selected Sub – group is in a Sub – group according to the “last location rule”, besides the selected Sub – group and its lower Sub – group in which the subject matter of the search are not obviously excluded, the search shall be performed in the rel-



evant Sub – groups which have the same number of dots as the selected Sub – group, and those under them which are not obviously excluded as the subject matter of the search. Moreover, the search shall be performed in the various relevant Sub – groups at the immediate higher level of the selected Sub – group through to the Group. For example, 8/20 is a Sub – group with 3 – dots under C08G8/00. It is a selected Sub – group according to the “last location rule”, under which there is a 4 – dots Sub – group—8/22. Under 8/20, there is 3 – dots Sub – groups—8/24, which is the relevant Sub – groups with the same number of dots as 8/20. Above the 3 – dots Sub – group, there are relevant 2 – dots Sub – group 8/08 and 1 – dot Sub – group 8/04. Therefore, the examiner shall perform the search first in Sub – group 8/20, then the search shall be carried out in Sub – groups 8/22, 8/24, 8/08, 8/04 through to the Group 8/00 successively.

(6) consider other possible Sub – groups under the same Sub – class and the other Sub – classes which are selected by way of Step (2).

## **6. Search of Application for a Patent for Invention**

### **6.1 Essentials of Search**

When conducting the search, the examiner shall direct his attention primarily to the novelty and at the same time pay attention to any prior art likely to have a bearing on the inventiveness, and select out the two or more reference documents which may destroy the inventiveness of the subject matter of the application when they are combined together. The examiner shall also pay attention to any documents that may be of importance for other reasons, such as documents which may contribute to a better understanding of the subject matter of the application; or documents which are most suitable for illustrating the subject matter of the application and are possible to become most relevant with the prior art for the examiner to ask the applicant to make amendments of the preamble portion of the independent claim and the relevant part of the description.

In the process of the search, the examiner shall pay attention to all of the contents of the patent documents of the prior art, especially the contents of the description (and its drawings) and shall not pay attention to the claims only. The examiner should compare the contents of the claims of the application to be

searched with the contents as disclosed in the relevant patent documents in the prior art.

## **6. 2 Order of Search**

### **6. 2. 1 Search of Technical Fields to Which the Invention Belongs**

The technical fields to which the invention belongs are the major technical fields of the subject matter of the application. There is the greatest possibility to find the most relevant documents if search is conducted in these fields. Therefore, the examiner shall begin the search carefully and in an all round way with the patent documents in these fields. For example, if the IPC symbol indicating the information of the invention is xxx7/16... (7/12 having priority), then the search shall be directed to 7/16 first and then to 7/12; After that, the examiner shall search the various Sub – groups under 7/16 and 7/12, in which the subject matter of the search are not obviously excluded. Finally, the examiner shall search the Sub – group at the immediate higher level up to Group which cover the subject matter of application. If there are more than one IPC symbol indicating the information of the application, the examiner shall search the patent documents of the technical fields defined by the other IPC symbols in the same way.

As to the other subject matter of the application to which the search should be directed, the search shall be carried out in a similar way in the technical fields to which it belongs and in the relevant technical fields.

### **6. 2. 2 Search of Technical Fields Having Analogous Function**

Based on the search results obtained by carrying out the search according to what is described in Section 6. 2. 1, the examiner shall consider whether it is necessary to extend the search to the analogous technical fields. If it is, the search shall be carried out in these technical fields which have analogous function in the way as described in Section 6. 2. 1.

### **6. 2. 3 Search of Technical Fields After Re – Determination**

If no reference documents are found after search has been carried out according to what is described in Sections 6. 2. 1 and 6. 2. 2, it is possible that the technical fields have not been correctly determined. Then, the examiner has to re – determine the

technical fields and carry out the search in those fields.

In carrying out the search as described in Sections 6.2.1, 6.2.2 and 6.2.3, the chronological order of the search, i.e. the order of the publication date of the materials to be searched, should be in general, from near to far as compared with the filing date of the application.

#### **6.2.4 Search of Other Materials**

Where necessary, the examiner shall carry out search in the non – patent literature for search ( see Section 2.2 of this Chapter).

Besides, the examiner may consult the documents cited in the reference documents obtained in the above – mentioned Sections 6.2.1 – 6.2.3, and the relevant documents listed as a “reference cited” of the publication description of patent applications or patent description obtained from the search.

### **6.3 Concrete Steps**

#### **6.3.1 Search by Hand**

The examiner may consult the patent documents in the following steps when search is conducted by hand:

Step one: quickly skim through the abstracts and the drawings on the first page of and the contents of the independent claims of the patent documents of the search files for examination in the technical fields of the search; the abstracts of classified patent documents of Japan, Russia (including the former Soviet Union), the Federal Republic of Germany, UK, France, Switzerland and so on; titles of the classified Chinese and foreign periodicals and theses; and pick up the documents which may be relevant to the subject matter of the application after preliminary judgment. If the drawings of the application to be searched have various detailed structures, the examiner may compare the drawings of the application with those of the documents in the search file for examination one by one, and select those with the same or similar structural features as those in the application.

Step two: carefully consult the abstracts, drawings, claims, and the documents corresponding to the abstracts and titles selected in Step one, and further choose the reference document which is most relevant to the application.

Step three: carefully consult, analyze and study the description of the documents selected in Step two, and then determine the reference documents which should be cited in the search report and the text of an Office Action.

### 6.3.2 Search by Computer

Where the search is to be carried out by a computer, the examiner should give special attention to choose appropriate search formulas in order to improve the hit rate and to avoid the omission of relevant documents. The major search formulae include the following: combination of classification symbol and keyword; combination of keyword and keyword; combination of classification symbol and classification symbol, etc. The examiner may apply these search methods in a flexible way according to the actual situation. Methods and steps which are most frequently adopted include: to determine the relevant fields of search in accordance with the principles described in Section 5.3 of this Chapter, then use keywords which may reflect the inventive concept to make detailed search in these fields so as to find out the most relevant documents in the prior art. The Following is a brief explanation of the general procedures of search by machine.

For example, the subject matter of an application relates to a theft – proof unit for clothes for sale in the department store, which consists of the components buttoned from both sides of the clothes. One of the components has a needle – shaped structure and the other component has the structure to grip the needle. The needle – like component may damage the small container of the grip component if they are not separated by a special tool, and the liquid will flow out from the container to stain the clothes.

In order to carry out the search directed to the said application, the examiner should firstly determine the classification symbol that relates to this subject matter, that is, to determine the relevant technical fields for search. The subject matter of the said application relates to the theft – proof unit of the clothes. To that end, the two keywords which reflect the subject matter such as theft – proof and clothes are adopted and the following relevant classification symbols are found: E05B69/00, E05B73/00, G08B15/02, G08B13/00, G09F3/03, A44B9/18. There is no need to consider the classification symbols that obviously have

no relevance with the subject matter of the application. But the classification symbols which cover theft – proof unit of the clothes shall have relevance with the fields of search. Then, in the fields covered by these related classification symbols, the keywords which further reflect the inventive concept of the subject matter of the application, such as liquid, shall be adopted to carry out further search, then some relevant prior art documents relating to the theft – proof clothes which contain liquid may be obtained by the examiner. If the documents thus found is not too numerous, the examiner may consult the documents one by one to find out the prior art documents most relevant to the subject matter of the application. It should be noted that the above – mentioned keywords include their synonyms or superior or inferior words so as not to omit any relevant documents.

#### **6. 4 Search of Conflicting Application**

##### **6. 4. 1 Basic Principles**

The search for any conflicting application should be carried out as perfectly as possible before issuing the notification to grant the right of patent, that is, the examiner should search all the patent applications by the others filed before the date of filing of the application under consideration and published after the date of filing of the application concerned.

##### **6. 4. 2 Search Directed to the Application Which Has Been Published after the Expiration of Eighteen Months from the Date of Filing and Entered into Substantive Examination Procedure**

Usually, an application for a patent for invention should be published after the expiration of eighteen months from its date of filing and entered into substantive examination procedure. In this situation, the search made before the issuance of the first Office Action should cover the search for conflicting application.

##### **6. 4. 3 Search Directed to the Application Which Is Published Earlier and Entered into the Substantive Examination Procedures**

Where an application for a patent for invention is published earlier and entered into the substantive examination procedure,

the examiner may preliminarily carry out the search for conflicting application before the issuance of the first Office Action. If it is within eighteen months from the date of filing for the date of the conclusion of the examination of that application, the examiner should carry out supplementary search step by step depending on the introduction of the conflicting applications into the patent documents for search. If the said conclusion date is on or after the date of expiration of eighteen months from the date of filing, the examiner should make complete search for conflicting application before the conclusion of the examination, because all of the conflicting applications have been published by then.

#### **7. Search for Preventing the Patent Right from Being Granted Repeatedly**

##### **Rule 13. 1**

In order to prevent repeatedly granting the patent right, the search shall be conducted as completely as possible before issuing the notification to grant the patent right, that is, applications or the patent documents relating to the same invention – creation submitted by the same applicant in the Chinese patent documents should be found out. see the provisions of Section 6, Chapter 3 of this Part for the judgment of the identical invention – creation.

#### **8. Termination of Search**

##### **8. 1 Scope of Search**

Theoretically, a perfect search should be comprehensive and complete. However, the search should be limited by consideration for reasonableness of cost. The examiner should, at any time, determine whether the search should be stopped according to the quantity and quality of the selected reference documents. The factors for consideration are the balance of time, energy and cost spent on the search and the expected results.

##### **8. 2 Several Circumstances of Termination of Search**

The examiner may terminate search when one of the following circumstances occurs during search:

(1) A reference document closely related to all of the subject matters of the application has been found, so that the examiner thinks that the document has clearly disclosed all of the technical features of all the subject matters of the application or the contents disclosed by the document may enable a person skilled in the relevant field of technology to obtain all of the tech-

nical solutions described in the claims, that is, the novelty or inventiveness of all of the subject matters of the application have been prejudiced by that reference document alone, and that document constitutes a document at X level or E level provided by the search report;

(2) Two or more reference documents closely related to all of the subject matters of the application have been found, so that the examiner thinks that the combination of the contents of the documents may enable a person skilled in the relevant field of the technology to obtain all of the technical solutions of the claims without creative work, that is, the inventiveness of all of the subject matters of the application has been prejudiced by the combination of these reference documents, and these documents constitute a documents at Y level provided by the search report;

(3) According to his/her knowledge and working experience, the examiner thinks that it is impossible to discover closely related reference documents, or the time, energy and cost spent on the work is not commensurate with the expected results, it is therefore not worth continuing the search;

(4) Closely related reference document(s) mentioned in aforesaid (1) or (2) (usually they are documents at X or Y level provided by the search report) has been found from the materials provided by the public or from the foreign search materials or foreign examination results provided by the applicant.

## **9. Searches under Special Circumstances**

### **9.1 Search Directed to the Subject Matter of an Application Which Relates to More than One Technical Field**

Where the subject matter of an application relates to different technical fields, besides making search in the technical field in which he/she is responsible for performing examination, the examiner should, depending on the situation, consult with the examiners in the other technical fields to decide how to make further search.

### **9.2 Search Directed to an Application Which Lacks Unity of Invention**

#### **9.2.1 Search Directed to an Application Which Obviously Lacks Unity of Invention**

Where it can be determined that the subject matters of an application lack unity after the examiner analyzes and studies the claims and description (and its drawings), one of following measures may be taken:

(1) Perform search after the applicant makes necessary amendments to eliminate the defect of lack of unity;

(2) Where all of the technical solutions described in two or more independent claims, between which unity is not present, fall into the technical field that examiner is responsible for performing examination and the search fields of them are very close or even extensively overlap each other, the examiner may make search for them together under the circumstance that it takes little or no additional search effort. As a result, the examiner may indicate the defect of the lack of unity of invention and evaluate these independent claims when drafting the Office Action. In this way, the procedure of examination has been accelerated by reducing one Office Action. If one or more independent claims of the application are found to lack novelty or inventiveness after search, the applicant may delete these claims rather than make divisional applications after receiving the Office Action. Unnecessary work will be avoided by doing so. Moreover, the materials further indicates that unity is not present between the subject matters of the application may be found through such search.

#### **9.2.2 Search Directed to an Application Which Does Not Obviously Lack Unity of Invention**

The application that does not obviously lack unity of invention refers to those to which whether the unity is present can be determined only after search has been completed. The examiner should perform search for such an application in the following way:

(1) When making search for the first independent claim, if the examiner find this claim lack of novelty or inventiveness after search, which causes that unity is not present between the other independent claims, the examiner may not make search for the other independent claims;

(2) Where the inventive concept of two or more inter-parallel independent claims of an application are very close, and none of them needs to be searched in another technical field, the examiner may make search for all of the subject matters of the application, because it will not greatly increase the work-



load;

(3) When making search directed to an independent claim, if the examiner find the claim lack of novelty or inventiveness, which causes that unity is not present between its inter – parallel dependent claims, the examiner may consult the method described in the provisions of Section 9.2.1, 9.2.2(1) or 9.2.2(2) to handle it.

### **9.3 Search under Other Circumstances**

Where part of the subject matters of an application falls into the situation described in Section 10 of this Chapter, the examiner should make search directed to the subject matters that are not in these situations. Where the defect of lack of unity exists between the subject matters that are not in these situations, the search should be made in accordance with the provisions of Section 9.2 of this Chapter.

### **10. Subject Matters Excluded from the Search**

It is not necessary for the examiner to make search if all of the subject matters of an application are under one of the following circumstances;

- (1) Fall into the scope of subject matters which are not to be granted according to Article 5 or 25 of the Patent Law;
- (2) Do not possess a practical applicability;
- (3) Not in conformity with the requirements of Rule 2.1 of the Regulations;
- (4) The description and claims have not made a clear and complete explanation of the subject matters of the application so that a person skilled in the relevant field of technology cannot carry it out.

### **11. Supplementary Search**

During the course of the substantive examination procedure, in order to obtain more suitable reference documents, the examiner may make supplementary search under any of the following circumstances;

- (1) The applicant has amended the claim, but the earlier search did not cover the scope claimed by the amended claim;
- (2) The clarification of the applicant makes the earlier search incomplete;
- (3) There is a mistake in the earlier search made before the issuance of the first Office Action or the search is incomplete;

(4) The change of the Office Action makes the search incomplete or inaccurate so that it is necessary to increase or change the extent of search.

During the interlocutory examination and the continuation of examination after the reexamination, if the situation described in (1) or (2) occurs, the supplementary search should be made.

Moreover, as to the document of the international patent application which is designated China and may constitute interference conflicting application in accordance with Section 4.2(2) of this Chapter, the supplementary search shall be made to see whether it has entered national phase of China before the notification to grant the patent right to the application under consideration.

## 12. Search Report

The search report is used to record the result of the search, especially the document which constitutes the relevant existing technology. The search report should adopt the form prescribed by the Patent Office, and it should clearly record the field of search and/or database and keyword, the reference document found by search and the relevant level in which the reference document relates to the subject matter of the application. The examiner should completely fill in all other items as the Search Report Form required.

The search report should adopt one of the following symbols in order to reflect the relationships between a reference document and the claim:

X: the document that will independently prejudice the novelty or inventiveness of the claim;

Y: the document, combined with other documents at the same level cited in the search report, that will prejudice the inventiveness of the claim;

A: the document define the general state of the art, i. e. the document which discloses part of the technical features of the claim or relevant prior art;

R: the patent or patent application document that is filed by the same applicant for the same invention – creation and published on or after the date of filing of the application being examined, or the patent application document that is submitted to the Patent Office by the others on the same date of filing of the application being examined for the same invention – creation;

P: the intermediate document, that is the documents pub-

lished on dates falling between the date of filing of the application being examined and the date of priority claimed, or the documents that will cause to verify the priority of the application;

E; the conflicting application document that may, by alone, prejudice the novelty of the invention claimed by the application being examined.

Among the above – mentioned documents, symbol X, Y and A indicate a correlation between the contents of the reference document and the claim of the application. R and E indicate a chronological relation between the reference document and the application, and the correlation of their contents. Symbol P, which is a symbol made under the circumstance that the priority of the application is not verified, represents the chronological relation between the reference document and the application. Symbol X, Y, E or A, which represents the degree of the correlation of the contents of the documents, should follow the symbol P.

Where a claim includes several parallel technical solutions and the degree of correlation between a reference document and these technical solutions are different, the examiner should use the symbol which represents the highest degree of correlation for the reference document.

### **13. Search of a Patent for Utility Model**

In accordance with the provisions of Article 57.2 of the Patent Law, in the case of an infringement dispute relating to a patent for utility model, the people's court or the local administrative authority for intellectual property affairs may ask the patentee to furnish a search report made by the State Intellectual Property Office.

In accordance with the provisions of Rule 55.1 of the Implementing Regulations, after the announcement of the decision to grant a patent for utility model, the patentee of the said patent for utility model may request to make a utility model search report.

Following are provisions for other aspects of a search of a patent for utility model.

#### **13.1 Acceptance and Commencement of Search**

The patentee should submit a request for search for patent for utility model, the patent description (or indicate the patent number) and the patent certificate in two copies to the State In-

Rule 55.2

tellectual Property Office. The legal status of the patent for utility model shall be indicated in the Request attached by the corresponding certified document. Each Request should be limited to one patent for utility model. The text of the patent requested for search should be the same as the document of the patent for utility model when the patent right was announced as granted or when the patent right was upheld valid after the examination for invalidation. Where there are more than one patentee, the request should be made by all the patentees or by the representative appointed by all the patentees. If the request is not in conformity with the above – mentioned requirements, the State Intellectual Property Office may not accept it.

The request for search for patent for utility model may be submitted either by the patentee or by the patent agency appointed by the patentee. If the patentee has appointed a patent agency to handle all of the matters of a patent for utility model at the time of the application of that patent for utility model was filed, and now the patentee wishes to process the request for search either by itself/himself or by another patent agency, the appointment of the original patent agency should be terminated.

#### Rule 55.3

After receiving the request for search for patent for utility model, the State Intellectual Property Office should begin an formal examination of the request. Where the request does not comply with the above provisions, the State Intellectual Property Office should invite the person who made the request to amend the request within a specific time limit. If that person does not make rectification within the time limit, the request shall be deemed not to have been submitted.

### 13.2 Process of Search

The search report of a patent for utility model should be made by the department of the substantive examination that is responsible for the technical field to which that patent for utility model belongs or another department designated by the State Intellectual Property Office. The department that accepts such request should send the request and other documents promptly to the department responsible for performing the search. After receiving the request, the department responsible for searching should appoint a relevant examiner to perform the search in accordance with this Chapter.

Search should be directed to all the claims of the patent for

utility model.

Where the subject matters claimed by the patent for utility model fall into the scope described in Section 10 of this Chapter, the examiner should not conduct search.

Where unity is not present among the subject matters claimed in the patent for utility model, the examiner should invite the person who requested for search to pay an additional search fee. If no additional search fee has been paid, the examiner should perform search directed to the subject matter claiming in Claim 1 of the patent for utility model, and the subject matter of other claim(s) between which unity is present with Claim 1. The examiner should not carry out search directed to the subject matter(s) claimed in other claim(s) between which unity is not present with Claim 1.

### 13. 3 Search Report of a Patent for Utility Model

#### Rule 56

The result of the search of utility model shall be recorded in the search report. The search report consists of two parts: the form indicating the relationship between the reference document and each claim, and the brief explanation as to whether each claim is in conformity with the requirements of the provisions of Article 22 of the Patent Law concerning novelty or inventiveness.

See the explanation of the search report provided by the State Intellectual Property Office for the requirements of completing the search report. see Section 12 of this Chapter for the requirements for completing the items in search report which are the same as those in the search report for a patent for invention.

The examiner should evaluate each claim for which the search has been made in the brief explanation. In the case of multiple dependent claims, the examiner should respectively evaluate each technical solution that referred to in the dependent claims. If the claim has parallel selective solutions, the examiner should evaluate each solution.

If no reference document which may prejudice the novelty or inventiveness of the claim(s) is found, the examiner should provide a clear conclusion that the claim is in conformity with the provisions of Article 22 of the Patent Law. If the claim is not in conformity with the provisions of Article 22 of the Patent Law with respect to novelty or inventiveness, the examiner should cite the reference document, indicate the relevant reason and attach a copy of the cited document. See Section 5, Chapter 4 of this

Part for the judgment of inventiveness of the patent for utility model.

Where the subject matter of the patent for utility model falls into one of the situation as described in Section 10 of this Chapter under which no search is necessary, or the search is limited due to the defect of lack of unity, the examiner should provide the relevant reason and necessary analysis in the search report.

The search report should be made by the examiner carrying out the search, verified by the head of the division of examination in which the said examiner works or the examiner designated by him, and signed with seal by both the said examiner and the person who is in charge of the verification.

#### **13. 4 Correction of the Search Report of a Patent for Utility Model**

Where the department which is responsible for search finds that there are some mistakes in the search report for the patent for utility model, the department may correct the mistakes on its own initiative, and send the corrected search report to the person who made the request to replace the earlier report.

## Chapter 8

### Procedures for Examination as to Substance

#### 1. Introduction

The examination as to substance in this Chapter refers to the examination as to substance to a Chinese application for a patent for invention. As for the examination as to substance to an international application at the Chinese national phase, where there are stipulations in Chapter 2, Part III of these Guidelines—"Examination as to Substance of International Applications after Entering the National Phase", the examination shall be conducted in accordance with those stipulations. Where there is no relevant stipulations, the provisions of this Chapter shall apply.

Under the provisions of Article 35 of the Patent Law, the Patent Office shall conduct the examination as to substance to an application for a patent for invention.

The purpose of the examination as to substance is to judge whether patent right shall be granted to an application for a patent for invention, especially whether it is in conformity with the requirements of "novelty, inventiveness and practical applicability" as set out in the relevant Articles of the Patent Law.

In accordance with the provisions of Article 35.1 of the Patent Law, the procedures of examination as to substance usually shall be started upon the request of the applicant. However, in accordance with Article 35.2 of the Patent Law, such examination as to substance may be started by the Patent Office on its own initiative.

In accordance with the provisions of Article 39 of the Patent Law, where it is found after examination as to substance that there is no cause for rejection of the application for a patent for invention, the Patent Office shall make a decision to grant the patent right for invention.

In accordance with the provisions of Article 38 of the Patent Law, in the course of examination as to substance, where, after the applicant has made the observations or amendments, the Patent Office finds that the application for a patent for invention is still not in conformity with the provisions of the Patent Law, i. e. it falls into the situations described in Rule 53 of the Implementing Regulations of the Patent Law, the application shall be rejected.

In accordance with Article 32 of the Patent Law, an applicant may withdraw its/his application for a patent at any time be-

fore the patent right is granted. Furthermore, in Articles 36. 2 and 37 of the Patent Law and Rule 42. 2 of the Implementing Regulations of the Patent Law, circumstances are described where an application for a patent shall be deemed to have been withdrawn in the procedures of examination as to substance.

This Chapter mainly concerns the procedures for the examination as to substance and the basic principles thereof, verification of application documents and preparation of examination as to substance, examination as to substance (including composition and requirements of the first Office Action, and continuation of examination, etc. ), response and amendments, decision of rejection and notification to grant patent right, termination, suspension and restoration of the procedures for examination as to substance, Interlocutory Examination and the continuation of examination after reexamination, etc. .

## **2. Procedures of Examination as to Substance and Basic Principles thereof**

### **2. 1 Outline of Procedures of Examination as to Substance**

The procedures for examination as to substance start when the file of the application is received by the Department of Examination as to Substance from the File Procedure Administration Department and terminate at the time when the notification to grant patent right, or that the patent application has been deemed to have been withdrawn is sent, or the decision to reject an application has been made and entered into force or that the application has been withdrawn by the applicant.

Circumstances that may occur in the course of the examination as to substance are as follows:

Art. 37

(1) Where the examiner, after he/she has made the examination as to substance of the application for a patent for invention, finds that the application is not in conformity with the provisions of the Patent Law and its Implementing Regulations, he/she shall notify the applicant and request it/him to submit, within a specified time limit, its/his observations or, if necessary, to amend the application. The Office Action (including notification to make divisional application) sent by the examiner and the response made by the applicant may be repeated for several times until the patent right is granted to the application or the application is rejected or withdrawn or deemed to have been withdrawn.

Art. 39

(2) Where it is found, after examination as to substance, that there is no cause for rejection of an application for a patent



for invention, or the defect has been overcome after the observations or amendments have been made by the applicant, the notification to grant patent right shall be issued.

Art. 38

(3) Where, after the applicant has made the observations or amendments, the examiner finds that the defects described in the provisions of Rule 53 of the Implementing Regulations of the Patent Law, which has been pointed out in the Office Action still exist in the application, the application shall be rejected.

Art. 37

Art. 36. 2

Rule 42. 2

(4) Where, without any justified reason, no response has been made to the Office Action, the notification to make divisional application or the notification to submit information, the Patent Office shall send a notification that the application is deemed to have been withdrawn.

Furthermore, where necessary, the examiner may have interview, telephone discussion or on – spot investigation in the course of examination as to substance according to the provisions of these Guidelines.

## **2.2 Basic Principles in Procedures of Examination as to Substance**

### **(1) Principle of Examination Under Request**

Subject to other provisions of the Patent Law and its Implementing Regulations, the procedure of examination as to substance shall be started upon the request of the applicant. The examiner shall perform the examination on the basis of the application documents (including those submitted when the application was filed, when amendment has been made according to the law or when response to the Office Action was made) duly submitted by the applicant according to the Law.

### **(2) Principle of Hearing**

In the course of examination as to substance, at least one opportunity of providing observations and/or amending application documents against the reason and evidence of rejection shall be given to the applicant before the decision of rejection is made. The reason for rejection and the evidence on which it relies shall be notified to the applicant before the examiner makes a decision of rejection.

### **(3) Principle of Economy in Procedures**

In the course of the examination as to substance of an application for a patent for invention, the examiner shall make the procedures as brief as possible. In other words, the examiner

shall try his/her best to close the case as early as possible. To reach this aim, the examiner shall indicate all the defects of the application which are not in conformity with the Patent Law and its Implementing Regulations in the first Office Action and invite the applicant to make response for all the issues within the prescribed time limit, unless he is sure that the application is not possible to be granted patent right. The correspondence between the examiner and the applicant shall be reduced to the least to economize on procedures.

However, the examiner shall not neglect the principle of examination under request and the principle of hearing for the reason of economizing on procedures.

### **3. Verification of Application Documents and Preparation of Examination as to Substance**

#### **3.1 Verification and Check of IPC Symbol of Application**

After receiving an application, the examiner shall, no matter whether the examination will be conducted in the near future, firstly verify and check the IPC Symbol of the application.

When the application is found beyond his/her responsibility, the examiner shall timely treat it in accordance with the rules of coordination of classification of the Patent Office so as not to delay the examination.

Where the examiner finds that although the classification Symbol is not precise, it still belongs to his/her responsibility, he/she shall correct it on his/her own initiative.

If the examiner thinks that mark X shall be used as there is no suitable classification position, he/she shall consult with the person responsible for making decision regarding classification in the Division. If that person agrees to adopt mark X, it is necessary to consult with the classification department. When there is consensus of opinion, the classification department shall, together with the person responsible for making decision regarding classification in the Division, draft a "Report of Suggestion to Use Mark X".

#### **3.2 Verification of Application File**

For the application files within his/her responsibility according to classification, or for the applications allocated to him/her, the examiner shall timely check them, no matter whether they are to be examined in the near future.

**3. 2. 1 Check of Grounds for the Start of Procedures**

The examiner shall check the following:

Art. 35

Rule 50

(1) Whether a Request for the examination as to substance is included in the application file and whether it was submitted within three years from the date of filing. Where the Patent Office, on its own initiative, determines to proceed to examine the application of a patent for invention as to its substance, whether there is a notification with the signature of the Commissioner and the record indicating that the applicant has been notified.

Rule 90. 1 (2)

Rule 93

(2) Whether a receipt of the substantive examination fee is included in the application file.

**3. 2. 2 Check of Application Documents**

Art. 26. 1

Rule 51. 1

The examiner shall check whether the documents for examination as to substance (initial application documents and the published documents; the amended documents shall be included if the applicant has, on his/her own initiative or upon the request of the Patent Office in the course of preliminary examination, made any amendment of the documents) are complete.

**3. 2. 3 Check of Material Related to Priority**

Art. 30

Where the applicant claims the right of foreign priority, the examiner shall check whether there is a declaration of priority and a copy of the patent application documents certified by the competent authority of the foreign country in which the application was first filed in the file. Where the applicant claims the right of domestic priority, the examiner shall verify whether there are a declaration of priority and a copy of patent application documents which were first filed in China in the file.

Rule 90. 1 (4)

Rule 92. 2

Where the applicant claims priority, the examiner shall verify whether the receipt of the fee for claiming priority is included.

**3. 2. 4 Check of Other Relevant Documents**

Art. 36. 2

Rule 49

For an invention which is the subject matter of a patent application that has already been filed in a foreign country, the examiner shall check whether any document concerning any search made for the purpose of examining that application or concerning the results of any examination made in that country submitted by the applicant is included in the file.

### **3. 2. 5 Handling of Application File Where There Is Defect**

Where the examiner finds any ground, document or material mentioned in the above – mentioned Sections 3. 2. 1 to 3. 2. 3 missing in an application file, or any documents not in conformity with the requirements of the Patent Law and its Implementing Regulations, he/she shall return the application to the File Procedure Administration Department and state the reason thereof. When the examiner finds that the materials mentioned in the above – mentioned 3. 2. 4 missing in an application file and he/she is sure that the applicant has obtained such materials, he/she may fill in a Notification to Submit Materials and invite the applicant to submit the relevant information within the specified time limit. If the applicant fails to do so without any justified reason, the application shall be deemed to have been withdrawn.

Art. 36. 2

Besides, before the examination as to substance is conducted, it is preferable for the examiner to have a rough reading of the application documents to see if it is necessary to invite the applicant to submit any relevant reference materials. If it is, the examiner may fill in a notification to notify the applicant to submit such materials within two months specified in the notification. To finish this work in advance may accelerate the procedure of examination.

### **3. 3 Establishment of Individual Examination File**

After checking the application file, the examiner shall establish an individual examination file to record the important information of the application examined by him/her and add the relevant information in the course of examination, so as to have the information of the examination proceeding and the basic state of each application in hand at any time.

### **3. 4 Order of Examination**

#### **3. 4. 1 General Principles**

Except for the special circumstances described in Section 3. 4. 2 of this Chapter, the examination shall be performed according to the order of receipt for all the applications for patent for invention that are received. The examination shall not be handled in the way of examining the easier applications first and then the more difficult ones, let alone to shelve the difficult applications to the effect of not making examination to them at all.

However, applications for patent belonging to the same class received successively may be handled together.

When the applicant responds to the first Office Action, the examiner shall continue the examination in the order of the responses that are received first.

### 3. 4. 2 Special Treatment

There may be special treatment in the following circumstances:

(1) For applications having great significance to the interest of the State or the public interest, upon the request of the applicant or the competent authorities concerned and with the approval of the Commissioner of the Patent Office, the examination may be conducted first and may be handled with priority in the later proceedings.

Art. 35. 2

(2) For patent applications of which the examination as to substance is started on the initiative of the Patent Office, the examination may be conducted with priority.

(3) For divisional applications of which the original date of filing are retained, examination may be conducted together with the original application.

## 4. Examination as to Substance

### 4. 1 Text of Examination

Usually, the text of examination used by the examiner for the first time is the initial documents submitted by the applicant according to the Patent Law and its Implementing Regulations or the documents amended upon the request of the preliminary examination department of the Patent Office.

Rule 51. 1

Where the applicant has made the amendments to the application for a patent for invention on its/his own initiative upon request for the examination as to its substance or within three months after the receipt of the notification of the Patent Office concerning the start of examination as to substance, the amended application documents submitted by the applicant shall be used as the text of examination.

Where the applicant has more than one time made amendments to the application documents on its/his own initiative within the above – mentioned time limits, the application documents submitted at the latest shall be used as the text of examination.

Generally, the amendment of the application documents made by the applicant on its/his own initiative at other times

shall not be taken into consideration. The amended application documents submitted by the applicant shall not be used as the text of examination. The examiner shall state the reasons thereof in the Office Action.

Where, though the amendments made by the applicant is not in conformity with the provisions of Rule 51 of the Implementing Regulations of the Patent Law, if after reading it, the examiner thinks that the amended documents have eliminated the defects existed in the initial application documents and is in conformity with the requirements of the provisions of Article 33 of the Patent Law, and taking the amended text as the basis of examination can help economize examination procedures, the amendments may be considered to have been made with the agreement of the examiner and to be equivalent to amendments made in accordance with the requirement of the notification. Therefore, such documents may be used as the text of examination (Refer to Section 5.2 of this Chapter).

#### Rule 51. 1

For the above – mentioned amended application documents that could be accepted, it shall be examined first whether such amendments are in conformity with the requirements of the provisions of Article 33 of the Patent Law. The contents disclosed in the initial description and claims submitted by the applicant on the date of filing shall be the basis of judging whether the amendment to the application documents for a patent made by the applicant is in conformity with the provisions of Article 33 of the Patent Law (Refer to the relevant provisions of Section 5.2 of this Chapter for how to determine whether the amendment to the application documents made by the applicant is in conformity with the provisions of Article 33 of the Patent Law). However, application documents in foreign languages submitted by the applicant to the Patent Office and the contents disclosed in the priority documents shall not be taken as the basis to determine whether the amendment to the application documents meets with the requirements of Article 33 of the Patent Law.

For the above – mentioned amended application documents that could be accepted, they shall be used to form the text of examination in one of the following circumstances, even though there exists amendments that are not in conformity with Article 33 of the Patent Law:

- (1) There is no amendment to claims;
- (2) The amendment to all or part of the claims does not go

beyond the scope of the disclosure contained in the initial description and claims.

When pointing out other defects existing in the application, the examiner shall, in the Office Action, indicate that there is the defect of amendment not in conformity with the provisions of Article 33 of the Patent Law.

Where the amendment of the whole of the claims in the amended application documents has gone beyond the scope of the initial description and claims, the examiner shall issue an Office Action to notify the applicant that the amendment is not in conformity with the provisions of Article 33 of the Patent Law. Under such circumstances, in order to be beneficial to speeding up the examination procedure, the application documents before the amendment may be used to conduct the examination. The examiner shall, in the said Office Action, point out the defects of the application documents which are not in conformity with the Patent Law and its Implementing Regulations for the reference of the applicant to further amend the application documents.

#### **4. 2 Reading of Application Documents and Understanding of Invention**

After the examination as to substance is started, the examiner shall read the application documents carefully first, and try to understand the invention accurately. Emphasis shall be on the understanding of the technical problem which the invention intends to resolve, the technical solution for resolving the said technical problem, and all the essential technical features of the technical solution shall be figured out clearly, especially those which are different from that of the background art. Furthermore, the examiner shall try to understand the technical effect produced by the said technical solution. Necessary notes may be taken when reading and figuring out the invention so as to facilitate further examination.

#### **4. 3 Issuance of Office Action without Search**

Where all the subject matters of an application for a patent for invention obviously fall into the circumstances described in Section 10, Chapter 7 of this Part, the examiner may issue the first Office Action without making any search.

It should be noted that, in cases where only some, and not all, of the subject matters of an application belong to the above

– mentioned circumstances, the first Office Action shall be issued after the search and examination have been conducted to the subject matters which do not belong to the said circumstances.

#### 4.4 Handling of Application Lacking Unity of Invention

The defect of lacking unity of invention is sometimes obvious for an application for patent, and sometimes it can only be determined after the search and examination have been conducted. The defect of lacking unity of invention may exist either between the inter – parallel independent claims or between the inter – parallel dependent claims by reason of the independent claim referred to by them respectively does not possess novelty or inventiveness.

Art. 31.1

Rule 35

Rule 42.2

The examiner may handle the application lacking unity of invention by using one of following methods:

(1) To invite the applicant to make amendments before search

If the examiner, at the time of reading the application documents, can immediately come to the conclusion that the subject matter of the application obviously lacks unity of invention, the search may be deferred (refer to provisions of Section 9.2.1 (1), Chapter 7 of this Part). A notification of dividing an application may be issued, in which the applicant is invited to make amendments to the application within the specified time limit of two months.

(2) To invite the applicant to make amendments after search

If the lacking unity of invention for the subject matters of an application can be decided only after search, the examiner may, according to circumstances, decide either to put off further search and examination, or to continue further search and examination (refer to Section 9.2.2, Chapter 7).

Where after search and examination, it is believed that the first independent claim or its dependent claim has prospect of being granted patent right, the examiner may put off the search and examination for the other independent claim and indicate clearly in the first Office Action that patent right may be granted to the first independent claim or its dependent claim, and invite the applicant to amend or delete the other claims which lack unity of invention in order to eliminate the defect of the application



for lack of unity of invention.

If after search and examination, it is believed that the first independent claim or its dependent claim does not have prospect of being granted patent right, the examiner may continue to conduct search and examination to other independent claim, make comments in the first Office Action on the claim to which search has been conducted, and at the same time point out the defect of the application, i. e. lacking unity of invention. The examiner may also put off the search and examination to other independent claim and only indicate in the first Office Action the defect of the application for a patent, i. e. lack of unity of invention (refer to Section 9.2.2(1) or (2), Chapter 7 of this Part).

If according to the requirements of the first Office Action, the applicant has made amendments which are in conformity with the provisions of Section 5.2 of this Chapter to the application, and there is no longer the defect of lacking unity of invention in the claims, the examiner shall continue the examination to the claims.

For situations where there is defect of lack of unity of invention between the inter – parallel dependent claims by reason of the independent claim to which they refer respectively does not possess novelty or inventiveness, the above – mentioned provisions (1) or (2) shall apply *mutatis mutandis*.

It should be noted that, although sometimes there is no unity of invention between the subject matters of the application, especially when the lack of unity of invention between the inter – parallel dependent claims results from the fact that the corresponding independent claim does not possess novelty or inventiveness, the relevant fields of search of them are very close and even overlap sometimes. Therefore, the examiner may search and examine these claims together and indicate in the Office Action the defects in these claims that are not in conformity with the other provisions of the Patent Law and its Implementing Regulations, and at the same time, the defect of lacking unity of invention in the application, so as to be to shorten the procedures of examination (refer to provisions of Section 9.2.1(2), Chapter 7 of this Part).

No matter the application is under situations (1) or (2) as described above, the applicant shall, within the specified time limit, amend its/his initial application, such as to restrict the initial claims to eliminate the defect of lack of unity of invention. If

Art. 38  
Rule 53

no response has been made by the applicant within the time limit, the application shall be deemed to have been withdrawn.

Where the applicant has different opinion in its/his response to the Office Action of the examiner on the application not in conformity with the requirement of unity of invention, and the examiner, after consideration, thinks the opinion of the applicant tenable, or the defect of lack of unity of invention eliminated after the amendment of the claims by the applicant, the examination of the application shall be continued. Where the opposite opinion is untenable or the defect of lack of unity of invention has not been eliminated, the examiner may reject the application according to provisions of Rule 53.3 of the Implementing Regulations of the Patent Law and Article 38 of the Patent Law.

#### **4.5 Searching**

For how to determine the technical field of search and how to proceed the search, please refer to Chapter 7 of this Part.

#### **4.6 Verification of Right of Priority**

##### **4.6.1 Circumstances Where Verification of Priority Is Needed**

Whether it is necessary to verify the right of priority shall be decided by the examiner after searching. Where the date of publication of all the reference documents is earlier than the priority date, no verification of priority right is necessary. Such verification is needed only when one of the following events occurs:

(1) The disclosure of the reference documents is identical with or closely related to the subject matter of the application, and the date of the publication of the reference documents is between the date of filing and the priority date. That is, the reference document constitutes a document of level PX or PY;

(2) The disclosure of the application filed by any other person before the Patent Office is identical with all the subject matters of the application, or is identical with some of the subject matters of the application. Moreover, the date of filing of the former application is between the date of filing and the priority date of the latter, and the date of publication of the former is on or later than the date of filing of the latter. That is, the application filed by the any other person before the Patent Office constitutes the document of level PE;

(3) The disclosure of the application filed by any other per-

son before the Patent Office is identical with all the subject matters of the application, or is identical with some of the subject matters of the application. Moreover, the priority date of the former application is between the date of filing of the latter and the priority date of the latter, and the date of publication of the former is on or later than the date of filing of the latter. That is, the application filed by the any other person before the Patent Office constitutes the document of level PE.

As for circumstances described in item (3), the verification of right of priority of the application under examination shall be conducted first. If its claim of right of priority is invalid, the claim of right of priority of the application filed by the any other person used as the reference document shall be also verified.

#### **4. 6. 2 General Principle on Verification of Priority**

Generally speaking, verification of right of priority refers to the verification of whether the right of priority claimed by the applicant is valid according to the provisions of Article 29 of the Patent Law. To this end, the examiner shall, on the basis of the examination performed by the preliminary examination department (see the provisions of Section 3. 2, Chapter 1 of Part I of these Guidelines), verify the following:

(1) Whether the earlier application, which is used as the basis of the right of priority, involves the same subject matter as that of the later application for which the priority is claimed;

(2) Whether this earlier application is the first application in which the same subject matter is described;

(3) Whether the date of filing of the later application is within twelve months from the date of filing of the earlier application.

The verification mentioned in Item (1) is to judge whether the technical solutions contained in the claims of the later application are clearly described in the documents (description and claims) of the said earlier application. For this purpose, the examiner shall analyze and study the earlier application in its entirety. If the technical solution described in the claim of the later application is clearly included in the documents (not including the abstract) of the earlier application, it shall be assured that the earlier application has the same subject matter as the later application. The examiner cannot refuse to accept the claim of priority right based on the view that such technical solution is not disclosed in the claims of the earlier application.

By the phrase "describe clearly", it does not mean the identical way of illustration. It shall be sufficient if the technical solution described in the claims of the application has been substantially set forth. However, if in case where one or more technical features of the technical solutions are just generally or ambiguously described in the earlier application, or where there is only a hint in the earlier application, the detailed description of such technical features is described in the application claiming for priority right, and a person skilled in the relevant field of the technology cannot directly and unambiguously derive it from the earlier application, then the earlier application cannot serve as the basis of the application claiming for right of priority.

Under certain circumstances, the content described in Item (2) shall be checked. For example, the right of priority for an application A is claimed on the basis of another earlier application B of the applicant. In the course of searching for application A, the examiner finds one more patent application document or patent document C filed between the date of filing and the priority date of the application A by the same applicant. The subject matter of application A has been disclosed in documents C and the date of filing incorporating documents C is earlier than the right of priority of application A, i. e. earlier than the date of filing of application B. Thus, it may be assured that the earlier application B is not the first application of that applicant which discloses the identical subject matter as that of the application A. As a result, application A can't claim the date of filing of the earlier application B as its date of priority.

#### 4. 6. 2. 1 Partial Priority

When improvement or perfection is made to the invention of the earlier application, the applicant may introduce into the later application the technical solution which is not included in the earlier application. Under such circumstances, in verifying the right of priority, the examiner shall not come to the conclusion that the claim of right of priority is not valid because new contents are added into the later application. The priority right shall be granted to the identical subject matter clearly described in the earlier application, i. e. partial priority shall be granted. Speaking in detail, for the claims of the later application, its claim of right of the priority date of an earlier application is valid when the technical solution has been clearly disclosed in the earlier application;

however, its claim of priority date of an earlier application in which the technical solution has not been disclosed is not valid and the later application shall be deemed to be put forward on the date of filing of the later application. So far as the whole application is concerned, this is called partial priority, i. e. part of the subject matters of the application has valid right of priority. In other words, the technical solution defined by part of the claims has valid right of priority.

#### **4. 6. 2. 2 Multiple Priorities**

##### **Rule 33. 1**

Where multiple right of priority is claimed by the applicant for one invention which is in conformity with the requirement of unity of invention, the examiner shall check whether the various technical solutions included in the claims of the application have been clearly disclosed respectively in the foreign or domestic applications for patent serving as the basis of the priority. Moreover, it is also necessary for the examiner to verify whether all the dates of filing of the earlier applications are within the time limit of the priority period of the later application. If these two requirements are satisfied, the claim of multiple right of priority may be valid. The various claims in which the various technical solutions are disclosed will possess different dates of priority. If some of the claims do not satisfy the above – mentioned requirements, but other claims do, the claim to the right of priority which is not in conformity with the requirements shall not be valid, while the claim to the right of priority which is in conformity with the requirements shall be valid.

Where different technical features are disclosed respectively in different foreign or domestic patent applications which serve as the basis of right of priority and the claims of the later application are the combination of these features, the claim for multiple right of priority is not valid.

#### **4. 7 Comprehensive Examination**

So far as procedures are concerned, reasons of economy dictate that the examiner makes a comprehensive examination of the application for a patent, i. e. to examine whether the application is in conformity with all the provisions of the Patent Law and its Implementing Regulations relating to the formality and substance of the application before the first Office Action is issued.

Rule 20. 1  
Rule 21. 2  
Art. 31

The emphasis of the examination shall be whether there is any situation described in Rule 53 of the Implementing Regulations in the description and the whole of the claims. First of all, it shall examine whether the subject matter of the application is in conformity with the provisions of Rule 2. 1 of the Implementing Regulations; whether it falls into the scope of the provisions of Article 5 or 25 of the Patent Law according to which no patent right shall be granted for the application; whether it possesses the practical applicability required in Article 22. 4 of the Patent Law; and whether the description has sufficiently set forth the subject matter of the application for which protection is sought, which is required by the provisions of Article 26. 3 of the Patent Law. Then, examine whether the technical solution defined by the claims possesses novelty and inventiveness required in the provisions of Article 22. 2 and 22. 3 of the Patent Law; whether the claims define clearly and concisely the extent of the protection sought for; whether a complete technical solution to resolve the technical problem has been disclosed in the independent claim. In the course of the said examination, the examination shall be carried out to decide whether there is the defect of lack of unity of invention in the claims; whether the amendments of the application are in conformity with the requirements of the provisions of Article 33 of the Patent Law and Rule 51 of the Implementing Regulations of the Patent Law; whether the amendments of the divisional application are in conformity with the provisions of Rule 43. 1 of the Implementing Regulations of the Patent Law and whether the claims are supported by the description.

Art. 26. 4

Where no situations described in Rule 53 of the Implementing Regulation of the Patent Law exist; or although there is substantial defect as described in Rule 53 of the Implementing Regulations of the Patent Law in the application, the application still has prospect of being granted patent right after some amendments, for the sake of economy in the procedures, the examination of whether all the other provisions of the Patent Law and its Implementing Regulations are complied with shall be conducted by the examiner as well.

Rule 18  
Rule 19  
Rules 22 – 24

For examiners who have already clearly understood the subject matter of the application for which protection is sought as well as its contributions to the prior art after search, the main job at this stage is to make a positive or negative judgment to the above – mentioned focal points of examination, based on the re-

sults of the search.

#### 4. 7. 1 Examination of Claims

In accordance with the provisions of Article 26. 4 of the Patent Law, the claims shall be supported by the description and shall state the extent of the patent protection asked for. In accordance with the provisions of Article 56. 1 of the Patent Law, the extent of protection of the patent right shall be determined by the terms of the claims. To this end, the carrying out of the examination as to substance shall be focused on the claims, especially on the independent claims.

After it is determined that the subject matter of the application is in conformity with the provisions of Rule 2. 1 of the Implementing Regulations of the Patent Law, does not fall into the scope of Articles 5 and 25 of the Patent Law, possesses the practical applicability provided in Article 22. 4 of the Patent Law, and the subject matter of the application for which protection is sought has been sufficiently disclosed in the description, the following examination shall be conducted as to the claims.

Art. 22. 2 –3

(1) To examine whether the independent claim possesses novelty and inventiveness in accordance with the provisions of Chapter 3 and Chapter 4 of this Part.

Where, the independent claim is believed not possessing novelty and inventiveness after examination, further examination shall be carried out to see whether the dependent claims possess novelty and inventiveness. If it is found after examination that none of the independent claims and dependent claims possesses novelty or inventiveness, it isn't necessary to continue the examination for claims.

If it is found after examination that the independent claim possesses novelty and inventiveness, or although the independent claim doesn't possess novelty or inventiveness, the dependent claim does, then the application has the prospect of being granted patent right, the examiner shall, according to the principle of economizing in procedure, carry out the examination of (2) to (8) in the following to the claims.

Art. 26. 4

(2) The examiner shall examine whether all the claims are supported by the description (and its drawings), and whether there are any inconsistent points between them. (see Section 4. 7. 2(2) of this Chapter).

Rule 20. 1

(3) To examine whether the claims define clearly and con-

cisely the matter for which protection is sought in terms of the technical features.

Rule 21. 2 (4) To examine whether the independent claim indicates a complete technical solution to resolve the technical problem the invention aims to settle. The crux of determining whether the technical solution is complete lies in checking whether all the essential technical features for resolving the said technical problem have been disclosed in the independent claim.

Rule 21. 1 (5) To examine whether the dependent claims are in conformity with the provisions of Rules 21. 3 and 23 of the Implementing Regulations of the Patent Law.

Rule 23 Rule 22. 3 (6) To examine whether one invention has one independent claim only and whether it precedes all the dependent claims relating to the same invention.

Rule 4. 1 (7) To examine whether the standard scientific and technical terms used in the claims (scientific and technological terms) are in conformity with the provisions of Rule 4. 1 of the Implementing Regulations of the Patent Law and consistent with those used in the description.

Rule 20. 3 Rule 13. 1 (8) If the reference document for the same invention – creation submitted by the same applicant before the date of filing or submitted by any other person on the date of filing has been found through search, double patenting of identical claims shall be avoided. see Section 6, Chapter 3 of this Part for the details concerning handling of identical invention – creation.

It should be noted that as for some applications, the examiner cannot examine the novelty and inventiveness of their subject matter firstly due to problems mentioned in (2) to (4) above, the examination on these problems shall be conducted prior to the examination on their novelty and inventiveness.

#### 4. 7. 2 Examination of Description and Abstract

Art. 26. 3 – 4 The description (and its appended drawings) shall set forth the invention in a manner sufficiently clear and complete so as to enable a person skilled in the relevant field of technology to carry it out. In the meanwhile, it, as the basis of the claims, shall be used to interpret the claims when determine the extent of the protection of the patent right.

Art. 56. 1 The examiner shall conduct the following for the examination of description and its drawings:

Art. 26. 3 (1) Whether the description (and its drawings) has clearly



and completely disclosed the invention and enabled a person skilled in the relevant field of technology to carry it out; whether the technical solution disclosed in the description is able to resolve the technical problem of the invention and achieve the expected advantageous effects. (see Section 2.1, Chapter 2 of this Part);

Art. 26.4 (2) Whether the extent of protection defined by the technical solutions of various claims is supported by the description and whether the technical solution contained in the part of contents of the invention of the description is consistent with that defined by the independent claim;

Rule 18 (3) Whether the relevant contents mentioned in Rule 18 of the Implementing Regulations of the Patent Law are included in the description; and whether the said contents are written in the required manner and order, and that standard terms are used and is in clear wording (see Section 2.2, Chapter 2 of this Part).

If the drafting of the description in a different manner or order can result in a more economical presentation and a better understanding by others due to the nature of the invention, the description may be written not in accordance with what is described in Rule 18 of the Implementing Regulations of the Patent Law.

Where one or more nucleotide or amino acid sequence is included in the application for a patent for invention, it shall examine whether there is a sequence list which is in conformity with the requirements contained in the description.

Rule 19 As for the application having drawings appended, it shall examine whether the drawings are in conformity with the requirements of Rule 19 of the Implementing Regulations of the Patent Law (see Section 2.3, Chapter 2 of this Part).

For applications of which drawings are not necessary, the description may not contain the contents as provided for in Rule 18.1(4) of the Implementing Regulations of the Patent Law.

Rule 4.1 Moreover, the examiner shall check whether the scientific and technological terms used in the description are the standard ones; and whether for some names of a foreigner or a foreign place, as well as for some scientific and technological terms, when no standard Chinese translations are available, the original language is provided.

Rule 24 The examiner shall attach importance to the examination of

the abstract. In addition to the formal requirements, the following four aspects shall be examined also ( see Section 2. 4, Chapter 2 of this Part ) :

(1) The abstract shall, in accordance with the provisions of Rule 24 of the Implementing Regulations of the Patent Law, indicate the title of the invention and the technical field to which it pertains, and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the technical solution to resolve the problem, the principal use of the invention;

(2) Where there are drawings appended to the description, a drawing which best characterizes the principal technical feature of the technical solution of the invention shall be provided in the abstract;

(3) A reproduction of the drawing of the abstract with a linear reduction in size to 4cm x 6cm shall still enable all details to be clearly distinguished;

(4) The whole text of the abstract shall contain not more than 300 Chinese characters.

If, after the examination performed in accordance with Section 4.7.1(1) of this Chapter, the examiner believes that all the claims do not possess novelty or inventiveness, then, attention shall be paid to whether there is any other technical solution included in the description which belongs to the single general inventive concept with the original independent claim and possesses novelty and inventiveness, so as to determine whether the application belongs to situation (3) or (4) as provided in Section 4.10.2.2 of this Chapter.

#### **4.8 Non – Comprehensive Examination**

For the sake of economize in procedure, the comprehensive examination shall be performed usually for an application for a patent for invention in accordance with Section 4.7 of this Chapter.

However, where there exists a serious defect of being not in conformity with the provisions of Patent Law and its Implementing Regulations in the application documents, i. e. when circumstances mentioned in Rule 53 of the Implementing Regulations of the Patent Law occur, and when it is impossible to grant patent right to the said application, the examiner may not conduct the comprehensive examination. He just need to indicate the

substantial defects which lead to the conclusion of examination in the Office Action and there is no sense in pointing out the less important substantial defect and/or formal defect in the application at this time.

#### **4. 9 Handling of Public Opinion**

##### **Rule 48**

In the course of examination as to substance, the observations submitted by anyone to the Patent Office on an application for a patent for invention not in conformity with the provisions of the Patent Law shall be included in the application file for consideration of the examiner. It's not necessary for the examiner to consider the observations submitted after the issuance of the notification to grant the patent right. The handling of the observation submitted by the public is not to be notified to the public concerned.

#### **4. 10 First Office Action**

##### **4. 10. 1 General Requirement**

After the examination as to substance for an application, the observations and the tendentious conclusion of the examination shall be notified to the applicant in the form of Office Actions.

The examiner shall describe in detail the observations according to the Patent Law and its Implementing Regulations in the text of the Office Action. The observations shall be clear, detailed enough to enable the applicant to understand the problem of its/his application clearly.

Under any circumstances, the observations shall be accompanied with reasons thereof, the conclusions shall be clear, and the relevant provisions of the Patent Law and its Implementing Regulations shall be cited. But there shall be no words with personal feelings. In order to enable the applicant to make the amendment in conformity with the requirements as soon as possible, where it is necessary, the examiner may provide a proposed sample of amendment as the reference of the applicant. If the applicant accepts the proposed amendment, he/she shall formally submit a revised document. The proposed amendment in the Office Action cannot be used as the text of the document for further examination.

In order to accelerate the examination, the Office Actions shall be as few as possible. Therefore, the comprehensive ob-

servation of the examiner, either on substantive or formality matters, shall be described in the first Office Action unless the application under examination has no prospect of being granted patent right due to serious substantive defects (as described in Section 4.3 or 4.8 of this Chapter) or the examiner intends to postpone the examination because the lack of unity of invention in the application. Where in the Office Action, the observation of the examiner is based on certain parts of the reference document, the specific paragraph of the reference document or the numbering of the drawings, as well as the reference signs of the parts and elements in the drawing shall be indicated.

#### 4.10.2 Composition and Requirements

The first Office Action shall consist of the special – purpose form and the text of the Office Action. Where reference documents are cited in the Office Action, the copy of the reference documents shall be included according to circumstances.

##### 4.10.2.1 Special – Purpose Form

The examiner shall fill in all the items of the special – purpose form, and shall carefully check and fill in the text on which the examination is based. If there are two or more interested parties, all the parties or their representatives shall be indicated.

The examiner shall fill in the items of cited reference documents in the form according to the following:

(1) Where the reference documents are patent documents (refer to patent description or published description of unexamined patent application), the country code, document number and document classification provided by the “Information Search International Cooperation Committee of the Patent Offices with Examination System of the Paris Union” (ICIREPAT) shall be indicated. Moreover, the date of publication of those documents shall be indicated. With regards to the conflicting applications, the date of filing shall also be indicated.

For example:

Title of Document	Date of Publication
CN – 1161293A	1997.10.8
US – 4243128A	1981.1.6
JP – 昭 59 – 144825(A)	1984.8.20

(2) Where the reference documents are articles in the periodicals, it shall be indicated the title of the article, the name of

the author, the name and number of the volume of the periodical, the starting and ending page numbers of the relevant article and the date of publication, etc. .

For example:

“Laser 2 – Corrdinate Measuring Instrument”, Laser 2 – Coordinate Measuring Instrument Development Group of China Academy of Measuring Sciences, “ Journal of Metrology”, Vol. 1, No. 2, Page 84 ~85, April of 1980.

(3) Where the reference documents are books, it shall be indicated the title of the book, the name of the author, the starting – ending page numbers of the relevant part, the name of the publishing house and the date of publication.

For example:

“Gas Discharge”, Yang Jinji, Page 258 ~ 260, published on October of 1983 by the Publishing House of Sciences.

#### 4. 10. 2. 2 Text of Office Action

The text of the Office Action may be drafted in the following ways according to circumstances and the result of the search of the application:

(1) Where the application belongs to one of the circumstances provided in Sections 4.3 of this Chapter under which the Office Action may be issued without search, only main problem and its reason shall be indicated in the text of the Office Action, and it isn't necessary to mention any other defect. At last, it shall be indicated that according to item X of Rule 53 of the Implementing Regulations, the application shall be rejected.

(2) Where, although the patent right may be granted to an application, there are still some minor defects, in order to accelerate the examination, the examiner may provide specific opinion of amendment in the Office Action, or directly make some suggestive amendments in the copy of the application documents which are used as the appendix of the Office Action, and have stated the reasons thereof. Then it shall point out that if the applicant agrees with the suggestions of the examiner, he/she shall formally submit the amended document or the replacement sheet of the amendment.

(3) Where although the patent right may be granted to an application, there are some serious defects which involve both the claims and the description, the examiner shall describe his/her observations in the order of the importance of the related is-

sues. Usually, the observations on the independent claims shall be described at first; secondly the observations concerning dependent claims; then the observations on the description (and its drawings) and the abstract. The observations on the description may be written in the order provided in Rule 18 of the Implementing Regulations of the Patent Law.

Where the independent claim has to be amended, the applicant shall be usually invited to make corresponding amendments on the relevant part of the description. Moreover, if the examiner finds, through search, that some documents are even more related to the invention than the reference documents cited by the applicant in the description, the applicant shall be invited to make corresponding amendments in the Background Art and other relevant part of the description in the text of the Office Action.

Rule 22. 1

As for the improvement invention, if the examiner finds, through search, that a reference document is considered most related to the application, while the original reference document, which is used as the basis of delimiting the claim, is obvious not suitable, the applicant shall be invited to delimit the independent claim again. Under such circumstances, the specific position of the corresponding technical feature in the most related reference document shall be indicated in the text of the Office Action. It shall also describe in detail in the Office Action how to delimit the independent claims by the newly cited reference document. It shall be invited to make corresponding amendments to the description. For example, to make objective comments on the contents disclosed in the said reference document in the background art of the description.

Rule 18. 1(2)

Where the technical problem which the invention intends to resolve has not been clearly indicated in the description, or only a general description has been made, but the examiner may understand that problem by studying the complete contents of the description and can proceed search and examination as to substance based on this understanding, the examiner shall, at the beginning of the text of the Office Action, indicate the technical problem which he/she believes the invention intends to resolve according to his/her understanding.

(4) Where it is impossible to grant patent right to an application because it does not possess novelty or inventiveness, the examiner shall provide his/her objection in the text of the Office

Action under each claim on the novelty and inventiveness, first on the independent claim, and then on the dependent claims one by one. However, if there are too many claims or the reason of objection is the same, the dependent claims can be evaluated in group. It shall be pointed out in the end that even in the description, there is no substantial content to be granted patent right.

Under such circumstances, it isn't necessary for the examiner to point out the minor defect or formal defect in the text of the Office Action. It is also not necessary to invite the applicant to make any amendment.

For how to make observations of examination and state the reasons thereof on the contents of the claims and the description according to the provisions of Article 22 of the Patent Law on novelty and inventiveness, please refer to the relevant contents in Chapter 3 and Chapter 4 of this Part.

Rule 42. 2

Rule 42. 1

Rule 43

(5) Where the application belongs to those lacking unity of invention as described in Section 4.4(1) of this Chapter, the examiner may invite the applicant to amend the application documents and clearly let the applicant know that the examination shall be continued only after the defect of lacking in unity of invention is eliminated. Where the application belongs to those described in Section 4.4(2) of this Chapter, at the time of providing specific observations of the examination, the examiner shall, in the text of the Office Action, point out that the several inventions included in the application are not in conformity with the provisions of Article 31.1 of the Patent Law concerning requirement of unity of invention. If, after search, it is found that the lack of novelty or inventiveness of the independent claim has led to the lack of unity of invention of the application for patent for invention, the examiner may, according to the situation, decide whether to further the examination (see Section 4.4 of this Chapter for the details).

#### 4. 10. 2. 3 Duplicate of Reference Documents

For the reference documents cited in the Office Action, a copy of the documents shall be included in the application file. If the cited reference document is too long, only the content relating to the text of the Office Action shall be copied. Besides, there shall be clear marks on the copy of the reference documents to indicate the source and the date of publication. Where

the cited reference documents come from periodicals or books, it is more important to have such clear marks.

Art. 37

#### **4. 10. 3 Time Limit of Response**

The examiner shall specify the time limit for the applicant to submit the response in the Office Action. The time limit shall be decided by the examiner after taking the relevant factors of the application into consideration, including the quantity and nature of the observations, the workload and the degree of complexity of the possible amendments and so on. The specified time limit for answering the first Office Action is usually four months.

#### **4. 10. 4 Signature**

The Office Action shall be sealed by the examiner who is responsible for the examination of the application. Where the Office Action is drafted by a trainee examiner, the seals of both the trainee and his/her instructor shall be affixed.

#### **4. 11 Continuation of Examination**

After the response of the first Office Action has been submitted by the applicant, the examiner shall continue the examination of that application and carefully consider the observations and/or amendments made by the applicant. The same standard of examination shall be applied by the examiner at the various stages of the examination.

Before continuing the examination, the examiner shall carefully verify the information in the response, such as the application number, the name of the applicant, the name of the agent, and the title of the invention etc. to avoid mistakes.

If the examiner has conducted comprehensive examination before the issuance of the first Office Action, the attention at the stage of continuation of the examination shall be focused on the response of the applicant to each observation mentioned in the text of the Office Action, especially on the reasons and evidences submitted by the applicant when he/she has objections against the whole or part of the comments of the examiner. Where the applicant submits a revised description and/or revised claims simultaneously, the examiner shall, according to the provisions of Article 33 of the Patent Law and Rule 51.3 of the Implementing Regulations of the Patent Law, examine respectively whether the amendments go beyond the scope of the



initial description and claims, and whether the amendments have been made based on the requirements of the Office Action ( see Section 5.2 of this Chapter). Where the amendments are in conformity with the said requirements, it shall go a step further to examine whether the revised application has overcome the defect indicated in the Office Action, whether there are new defects not in conformity with the provisions of the Patent Law and its Implementing Regulations coming out, and, what is even more important is whether the newly revised independent claim is in conformity with the requirements of Article 22 of the Patent Law so as to determine whether patent right could be granted to the revised application.

For the amendments made by the applicant, the examiner shall examine them very carefully to prevent the introduction of new contents by the applicant in an ingenious and imperceptible way.

#### 4.11.1 Handling of Application after Continuation of Examination

After the continuation of the examination is carried out, the examiner may handle the application in the following ways according to the circumstances:

(1) Where the applicant has made serious amendments according to the observations of the examiner, eliminated the defect which may lead to the rejection of the application so that patent right might be granted to the revised application, if there are still some defects in the application, the examiner shall invite the applicant again to remove these defects. Where necessary, the examiner may accelerate the examination by holding an interview with the applicant ( see Section 4.12 of this Chapter). If possible, the examiner may have discussion with the applicant about a specific issue by telephone in the way as described in Section 4.13 of this Chapter. However, no matter in what form the amendment is made, the final basis for examination should be the written amendments formally submitted by the applicant except the examiner makes amendments to the obvious mistakes on his/her own initiative ( see Sections 5.2.4.2 and 6.2.2 of this Chapter).

Art. 38

(2) If, after the applicant has made the observation or amendment, the examiner finds that the problem indicated in the original Office Action which belongs to cases under Rule 53 of the Implementing Regulations of the Patent Law still exists, he

Art. 39

may make the decision of rejecting the application.

(3) Where, after the applicant has made the amendment or observations, the application is in conformity with the requirements of the Patent Law and its Implementing Regulations, the examiner shall issue a notification to grant the patent for invention.

#### **4. 11. 2 Supplementary Search**

In the course of the continuation of examination (including the post – reexamination examination), where necessary, the examiner shall proceed to supplementary search. For example, if after reviewing the response of the applicant, the examiner realizes that his original understanding of the invention is not accurate, which could have led to the incomprehensiveness of the search, or if the amendments submitted by the applicant require for further search, or where an international application document designating China as described in Section 4.2(2), Chapter 7 of this Part which may constitute a conflicting document has been found in the first search (see Section 11, Chapter 7 of this Part), and it is necessary to conduct supplementary search to decide whether the application may enter into the national phase of China.

#### **4. 11. 3 Second Office Action**

##### **4. 11. 3. 1 Circumstances to Issue Second Office Action**

The examiner shall issue the second Office Action under one of the following circumstances;

(1) Where some reference documents which are more relevant to the application are found by the examiner, and it is necessary to re – evaluate the claims;

(2) Where the examiner has not made observations on one or more claims in the earlier examination, and it is found through the continuation of the examination that there are among them cases which are not in conformity with the requirements of the Patent Law and its Implementing Regulations;

(3) The examiner believes it necessary to give new observations after the applicant submits observations and/or amendments;

(4) If, though patent right may be granted to an application after its amendment, there still exist defects which are not in

conformity with the provisions of the Patent Law and its Implementing Regulations. And these defects may be defects that emerge after the amendments, defects that are newly found by the examiner, or defects that have been indicated to the applicant by the examiner but have not been completely eliminated;

(5) Where though the examiner intends to reject an application, he failed to indicate clearly in the earlier Office Action the reason and evidence of the rejection.

#### **4. 11. 3. 2 Contents and Requirements of the Text of Second Office Action**

The drafting of the text of the first Office Action applies also to that of the second Office Action.

Where the applicant submits a revised text in response to the Office Action, the examiner shall express his/her opinion on the revised text, and indicate the problem existing in the newly revised claims and description.

Where, in the response, if the applicant just puts forward its/his observations and has made no amendment to the application documents, the examiner usually may insist on his/her previous observations in the text of the second Office Action. However, if the applicant puts forward sufficient reason or where certain circumstances provided in Section 4. 11. 3. 1 of this Chapter occur, the examiner shall take into consideration of the drafting of new observations.

In order to accelerate the examination, where it is possible, the conclusion of the examination of the application shall be indicated clearly in the second Office Action. The specified time limit of the response to the second Office Action is usually two months.

#### **4. 12 Interview**

Under some circumstances, such as the circumstances described in Section 4. 11. 1(1) of this Chapter, the examiner may invite the applicant to have an interview so as to accelerate the examination procedure. The applicant may also request for an interview. In this situation, if the examiner believes the holding of an interview beneficial, he/she shall agree to have the interview; otherwise, the examiner may refuse the request for interview.

#### **4. 12. 1 Conditions of Holding Interview**

The conditions for the holding of interview are as follows:

- (1) The examiner has issued the first Office Action; and
- (2) At the time of or after submitting the response to the Office Action, the applicant files a request for interview; or when the examiner thinks it necessary, the applicant is invited for an interview.

No matter invited by the examiner or requested by the applicant, each interview shall be fixed in advance by issuing a "Notification of Interview" or by appointment of phone call. The duplicate of the "Notification of Interview" or the "Record of the Telephone Conversation Concerning Appointment of an Interview" shall be included in the application file. It shall be indicated clearly in the said Notification or the Record the contents, time and place of the interview confirmed by the examiner. If new document is to be put forward in the interview by the examiner or the applicant, it shall be submitted to the other party before the interview.

The time of the interview shall not be changed at will once it is fixed. If it has to be changed, the other party shall be notified in advance. If, without any justified reason, the applicant fails to show up in the interview, the examiner may refuse to fix new interview and decide that the examination shall be continued in written form.

#### **4. 12. 2 Venue of Interview and Participants**

The interview shall be held in the place designated by the Patent Office. With regard to the application, the examiner shall not interview the applicant in any other place.

The interview shall be presided over by the examiner responsible for the examination of the application under examination. Where it is necessary, other experienced examiners may be invited to provide assistance. Where an interview is presided over by a trainee examiner, his/her instructor examiner shall be present at the spot.

Where an agent is appointed by the applicant, the agent shall be present at the interview and shall produce his/her certificate of agent. Where there is any change of agent, the power of attorney of the applicant shall be produced. Where an agent is appointed by the applicant, the applicant may participate in the interview together with his/her agent.

Where no agent is appointed by the applicant, the applicant shall be present in the interview. Where the applicant is an entity, the person appointed by the entity shall be present in the interview. The said person shall produce their identifications and the letter of introduction issued by the entity.

The rules mentioned above shall apply also to co – applicants. Each entity or individual of the co – applicants shall be present in the interview unless they have stated otherwise before the interview or have appointed their agents.

Where necessary and when designated or entrusted by the applicant, the inventor may join the interview together with the agent; or where no agent is appointed by the applicant, the inventor may participate the interview on behalf of the applicant. The above – mentioned rule apply also to the co – inventors.

The total number of the applicant or agent present in the interview shall be usually no more than two. Where a patent application is owned by two or more entities or individuals and where no agent is appointed, the number of the participants in the interview may be decided according to the number of the co – applicants.

#### 4. 12. 3 Record of Interview

When an interview is over, the examiner shall fill in the “Record of Interview”. The special – purpose form formulated by the Patent Office shall be used. The record shall be in duplicate and signed by the examiner and the applicant (or its/his agent) present in the interview; One copy shall be given to the applicant and the other shall be kept in the application file.

Usually, issues discussed in the interview and the conclusion or contents of the amendments that have been agreed shall be indicated in the “Record of Interview”. However, if many issues have been discussed in the interview, and issues relating to novelty, inventiveness or whether the amendment has introduced new contents and so on are involved, the examiner shall keep a note of the discussion and the consensus reached as detailed as possible.

The “Record of Interview” shall not replace the formal response to the Office Action and the amendment of the applicant. Even though consensus on how to make the amendment has been reached by both parties in the interview, the applicant still has to submit the formal amended document and the examiner

can't make any amendment on the applicant's behalf.

Where no consensus on the amendment of the application documents is reached in the interview, the examination shall be continued in written form.

When the interview is over and the applicant is required to re – submit the amendments or written observations, if the watch on the initial specified time limit still exists, the time limit may not need to change because of the interview, or the time limit may extend one month depending upon the situation. If the watch on the initial specified time limit exists no more, the examiner shall specify another time limit for submitting the amendments or observations in the “Record of Interview”. The amendments or observations submitted this time shall be deemed as the response to the Office Action. If the applicant fails to make response at the expiration of the time limit, the application shall be deemed to have been withdrawn.

If the new document submitted by the applicant in the interview is not received in advance but the examiner, the examiner may decide to suspend the interview.

#### 4. 13 Communication by Telephone

Communication by telephone shall apply only to minor issues or non – misleading issues. The examiner shall make a record of the discussion and keep it in the application file. For the amendments agreed by the examiner in the telephone conversation, the applicant shall usually re – submit the revised documents in written form. The examiner shall make conclusion according to the written amendment. Where the contents of the amendments agreed by the examiner in the telephone conversation fall into the scope as described in Sections 5. 2. 4. 2 and 6. 2. 2 of this Chapter, the examiner may correct the obvious mistakes *ex officio*.

#### 4. 14 Taking of Evidence and On – Spot Investigation

Generally speaking, since the main responsibility of the examiner is to point out to the applicant the various aspects of the application which are not in conformity with the Patent law and its Implementing Regulations, it is not necessary for the examiner to request the applicant to provide evidence in the course of examination as to substance. If the applicant does not agree with the opinions of the examiner, the applicant may decide whether it is

necessary to provide evidence to support its/his application. If the applicant decides to provide evidence, he shall be given an appropriate opportunity to exhibit any evidence which may be related to the application, unless the examiner believes there is no good in doing so.

The evidence provided by the applicant may be either a written document or a model. For example, the applicant may provide information concerning merits of the technology of the invention to support the inventiveness of the application. For another example, the applicant may make a demonstration of the model to prove the practical applicability of the application and so on.

Where an application involves problems that can be resolved only by an on – spot investigation of the examiner, a request shall be made by the applicant. The on – spot investigation of the examiner shall be carried out only when the request is approved by the Director General of the relevant department of examination as to substance. All the costs of the investigation shall be borne by the Patent Office.

## **5. Response and Amendment**

### **5.1 Response**

Art. 37

The applicant shall respond to the Office Action issued by the Patent Office within the specified time limit.

The response of the applicant may include the observations only, the further revised application documents ( replacement sheet and/or rectification) may be also included.

Rule 7.3

The applicant may request the Patent Office to extend the specified time limit. However, the request for extension shall be submitted before the expiration of the initial time limit. See the relevant contents of Chapter 7 of Part V of these Guidelines.

#### **5.1.1 Form of Response**

Art. 37

Rule 3

Rule 118.1

The applicant shall respond to the Office Action within the specified time limit in the form of observations or rectification as required by the Patent Office ( see Section4, Chapter 1 of Part V of these Guidelines). The correspondence of the applicant to ask for opinions of the examiner shall not be deemed as the response.

The applicant shall submit its/his response to the Receiving Section of the Patent Office. The response addressed directly to the examiner shall have no legal effect.

### 5. 1. 2 Signature of Response

#### Rule 118. 1

Where no patent agency is appointed, the observations or amendments submitted by the applicant shall be signed or sealed by the applicant. Where the applicant is an entity, an official seal shall be affixed. Where there are two or more applicants, the observations or amendments may be signed or sealed by their representative.

Where a patent agency is appointed by the applicant, the response shall be sealed by such agency, and signed or sealed by the patent agent designated in the Power of Attorney. Where there is a change in patent agent, the response shall be signed or sealed by the patent agent after the change has taken place.

Where no patent agency is appointed by the applicant, if the response is not signed or sealed by the applicant (where there are two or more applicants, it shall be signed or sealed by all the applicants, or at least by their representative), the examiner shall return the response to the department responsible for preliminary examination.

Where a patent agency is appointed by the applicant, if the seal of the agency and signature or seal of the patent agent are not affixed in the response, or if the response is made by the applicant itself/himself, the examiner shall return the response to the department responsible for preliminary examination.

#### Rule 118. 2

Where there is a change in the applicant or the appointed patent agent, the examiner shall check whether a corresponding "Statement for Change in the Bibliographic Data" has been submitted. If such Declaration has not been submitted, the examiner shall return the response to the department responsible for preliminary examination.

### 5. 2 Amendment

In accordance with Rule 51. 1 of the Implementing Regulations of the Patent Law, when a request for examination as to substance is made, and when, within the time limit of three months after the receipt of the notification of the Patent Office on the entry into examination as to substance of the application, the applicant may amend the application for a patent for invention on its/ his own initiative.

In accordance with Rule 51. 3 of the Implementing Regulations of the Patent Law, where the applicant amends the application after receiving the Office Action of the Patent Office, the



amendment shall be made according to what is required by the Office Action, i. e. amendment shall be made to the defects as indicated in the Office Action.

In accordance with the provisions of Article 33 of the Patent Law, an applicant may amend its/his application for a patent, but the amendment to the application for a patent for invention or utility model may not go beyond the scope of the disclosure contained in the initial description and claims.

#### 5. 2. 1 Requirement of Amendment

Rule 51 of the Implementing Regulations of the Patent Law sets forth the time and manner for making amendment, whereas Article 33 of the Patent Law clarifies the contents and extent of the amendment. These are the requirements for the amendment *per se*, which have to be satisfied.

In the course of examination as to substance, in order to make the application meet the requirements of the Patent Law and its Implementing Regulations, the amendment of the application documents may take place quite a few times. When examining the amendment, the examiner shall assure not only the time and manner of amendment be in conformity with Rule 51 of the Implementing Regulations of the Patent Law, but also requirements of Article 33 of the Patent Law are strictly abided by, i. e. where the applicant amends the application documents either on its/his own initiative or according to the requirements of the Office Action, the amendment may not go beyond the scope disclosed in the initial description and claims.

If the contents and extent of the amendment are not in conformity with the provisions of Article 33 of the Patent Law, the amendment shall not be rejected.

If the time or manner of the amendment is not in conformity with Rule 51 of the Implementing Regulations of the Patent Law, the text of amendment shall generally be unacceptable.

However, where the time and manner of the amendment are not in conformity with the requirements of Rule 51 of the Implementing Regulations of the Patent Law, but the content and extent of which are in conformity with the provisions of Article 33 of the Patent Law, the amendment may be deemed as being agreed upon by the examiner, equivalent to amendments made according to the requirements of the Office Action and the application documents amended this way may be acceptable, pro-

vided that the defects existed in the initial application documents are eliminated in the amended documents and there is prospect for the application to be granted patent right. By doing so, it is beneficial to the shortening of the procedure of examination. Nevertheless, under the following circumstances, even though the content of the amendment does not go beyond the extent disclosed in the initial description and claims, the amendment shall not be deemed as being agreed upon by the examiner.

(1) The deletion of some of the technical features of the claim, which leads to the broadening of the extent of protection claimed in the claims.

For example, the applicant has, on its/his own initiative, deleted from the independent claim a technical feature, or a relevant technical term, or a technical feature which is used to define the specific application scope, even though the contents of the amendment do not go beyond the extent disclosed in the initial description and claims, such amendment cannot be allowed since it may lead to the broadening of the extent of protection claimed in the claims.

(2) The change of some of the technical features of the claim, which leads to the broadening of the extent of protection claimed in the claims.

For example, the applicant has, on its/his own initiative, replaced the technical feature "coil spring" by "elastic part". Although the technical feature of "elastic part" has been disclosed in the initial description, since such change would broaden the extent of protection, it is not allowable.

Another example, in the Examples 1 – 4 of Section 5.2.3.2(1) of this Chapter, although the contents of the said four changes are disclosed in the initial description, since such change may lead to the broadening of the extent of protection, it is not allowable.

(3) Make the technical content which is only disclosed in the description and lacks unity of invention with the initial subject matter applied for protection as the subject matter of the revised claim.

**Art. 31. 1**

For example, the applicant has disclosed not only the new handle but also other parts in the description of an application for a patent for invention concerning the new handle of the bicycle, such as saddle of the bicycle. It is found that the new handle defined by the claims does not possess novelty after examination

as to substance. Then the applicant, on its/his own initiative, makes the saddle the subject matter of the claims. As the revised subject matter has no relations with the initial subject matter applied for protection, and there is no unity of invention between the two, such change is not allowable.

In situations where the revised text of the application is not acceptable, it shall be handled as follows:

(1) Where the amended text is the latest one submitted by the applicant before the start of the examination as to substance, it shall be handled according to Section 4.1 of this Chapter.

(2) Where the amended text is submitted by the applicant in the response to the Office Action, a "Notification of the Text of Amendment not Acceptable" shall be issued. The reason of not acceptable shall be provided and a time limit fixed for the applicant to submit an amendment which shall be in conformity with Rule 51.3 of the Implementing Regulations of the Patent Law. In the meanwhile, it shall be indicated that if the text of amendment submitted by the applicant is still not in conformity with Rule 51.3 of the said Implementing Regulations when the prescribed time is due, it shall be deemed as no response having been provided to the Notification, and the application shall be deemed to have been withdrawn in accordance with the provisions of Article 37 of the Patent Law.

It should be noted that, if according to the examiner, in the response to the Office Action submitted by the applicant, part of the contents of the revised text are made according to the requirements of the Office Action and part of it not, he may conduct a examination of the text first and issue an Office Action depending on the situation. The examiner may, at the time of stating the other opinions of examination, invite the applicant to eliminate the revised contents which is not in conformity with the requirement of the last Office Action within the prescribed time limit, otherwise the said revised text shall not be acceptable. It shall be indicated in the Office Action that when the prescribed time limit is due, if the said content has not been deleted from the re-submitted text of amendment or if there are other content which are not in conformity with Rule 51.3 of the Implementing Regulations of the Patent Law in the re-submitted text of amendment, it shall be deemed as no response having been made to the Notification, and the application shall be deemed to have been withdrawn in accordance with the provisions of Article

37 of the Patent Law.

### 5. 2. 2 Allowableness of Amendments

Herein, the term "allowability of amendment" mainly refers to the amendment which is in conformity with the provisions of Article 33 of the Patent Law.

#### 5. 2. 2. 1 Amendment of Claims

The amendment of the claims mainly involves the change in the scope of protection of the independent claim made through the addition to or change in the technical features of the independent claim, or the change in the type or title of the subject matter of the independent claim and its corresponding technical features; the addition to or deletion of one or more claims; the amendment of the independent claim to re - delimit it from its most related prior art; the amendment of the reference portion of the dependent claim, to change the relation of reference, or to amend the characterizing portion of the dependent claim to clearly define the extent of protection claimed by the said dependent claim. For all the above - mentioned amendments, provided that the technical solution of the revised claim has been clearly disclosed in the initial description and claims, the amendments shall be allowable.

Allowable amendments to the claims include the following:

(1) The addition of technical features into the independent claim to further define the independent claim to eliminate the defects of the initial independent claim which include the initial independent claim not having novelty or inventiveness, lacking essential technical feature for resolving the technical problem, having not clearly defined the invention, or being not supported by the description etc. . Provided that the technical solution of the independent claim into which technical features are introduced has been clearly disclosed in the initial description and/or claims, the amendment shall be allowable.

(2) Changing the technical features of the independent claim to eliminate the defect of the initial independent claim such as not clearly describing the extent of protection, not being supported by the description, or not possessing novelty or inventiveness. So long as the changed technical solution of the independent claim is clearly disclosed in the initial description and/or claims, such amendment shall be allowable.

Art. 22

Art. 26. 4

Rule 21. 2

Rule 20. 1

Rule 20. 1

Rule 21. 2

Art. 26. 4

Art. 22

As for the amendment of the range of numerical values of the claim which contains the technical feature defined by such range, it is allowable only when the two extreme values of the revised range of numerical values are really disclosed in the initial description and/or claims. For example, the range of temperature in the technical solution of the claim is  $20^{\circ}\text{C} \sim 90^{\circ}\text{C}$ . The differences of the technical contents between the reference documents and this technical solution are that the corresponding range of temperature disclosed in the reference documents is  $0^{\circ}\text{C} \sim 100^{\circ}\text{C}$ , and a specific numerical value of  $40^{\circ}\text{C}$  is disclosed in the reference documents. Therefore, the examiner shall indicate in the Office Action that the said claim does not possess novelty. If the specific numerical values of  $40^{\circ}\text{C}$ ,  $60^{\circ}\text{C}$  and  $90^{\circ}\text{C}$  in the range of  $20^{\circ}\text{C} \sim 90^{\circ}\text{C}$  are mentioned in the description or claims of the application for a patent for invention, it is allowable to change the range of temperature in the claim to  $60^{\circ}\text{C} \sim 80^{\circ}\text{C}$  or  $60^{\circ}\text{C} \sim 90^{\circ}\text{C}$  by the applicant.

Where no other median of the initial range of the numerical value of certain technical feature is disclosed in the initial description and/or claims, and considering that some contents of the application have been disclosed in the reference documents or when a certain part of the initial range of numerical value of the technical feature is exploited, the invention cannot be carried out, and the application for an invention will possess novelty and inventiveness if the above - mentioned part is deleted, the mode of specific "disclaimer" could be adopted to exclude the said part from a claim which has comparatively broader range of numerical value, so that when viewed as a whole, the said claim covers a definite scope of protection with the portion clearly excluded. For example, a range of numerical value of technical solution for which protection is applied is  $X_1 = 600 \sim 10000$ , the difference between the technical contents disclosed in the reference documents and the said technical solution is that the range of numerical value disclosed in the reference documents is  $X_2 = 240 \sim 1500$ . As  $X_1$  and  $X_2$  are overlapped in part, the claim does not possess novelty. If, however, the mode of specific "disclaimer" is adopted to amend  $X_1$ , excluding the portion where  $X_1$  and  $X_2$  are overlapped, i. e.  $600 \sim 1500$ , then the range of numerical value of the technical solution sought for protection may be changed, i. e. change  $X_1 > 1500$  to  $X_1 = 10000$ . However, as the numerical value 1500 has not really been disclosed

*in the initial description and claims, it is not allowed to change  $X_1 = 600 \sim 10000$  to  $X_1 = 1500 \sim 10000$ .*

Art. 22. 2 – 3  
Rule 20. 1

(3) Changing the type and title of the subject matter and the corresponding technical features of the independent claim to eliminate the defects of the initial independent claim such as the type being wrong or not possessing novelty or inventiveness. If the technical solution of the revised independent claim is clearly disclosed in the initial description, such amendment shall be allowable.

Art. 31  
Art. 26. 4  
Rule 22. 3  
Rule 20. 1

(4) The deletion of one or more claims to eliminate the defects of having no unity of invention between the first independent claim and the parallel independent claims, the claims being not concise as two claims have identical extent of protection, or the claims being not supported by the description. As such amendment does not go beyond the scope disclosed in the initial claims and description, it is allowable.

Rule 22. 1

(5) Delimiting correctly the independent claim from the most related prior art. As such amendment does not go beyond the scope disclosed in the initial claims and description, it is allowable.

Rule 23. 1 – 2

(6) Amending the reference portion of the dependent claim to correct the mistake of reference so as to accurately mirror the mode of exploitation or embodiment disclosed in the initial description. As such amendment does not go beyond the scope disclosed in the initial claims and description, it is allowable.

Rule 21. 3  
Rule 23. 1

(7) Amending the characterizing portion of the dependent claim to clearly define the extent of protection claimed by the said dependent claim so as to accurately mirror the mode of exploitation or embodiment disclosed in the initial description. As such amendment does not go beyond the scope disclosed in the initial claims and description, it is allowable.

Above is the explanation to the several allowable amendments to claims. Such amendments are allowable as they are in conformity with the provisions of Article 33 of the Patent Law. However, whether the claims which are amended according to what is described above comply with the other requirements of the Patent Law and its Implementing Regulations remain to be further examined by the examiner. For the amendments made in response to the Office Action, the examiner shall check whether the revised claims have overcome the defects indicated in the Office Action, whether new defects come into being because of

the amendments. For amendments made on the applicant's own initiative, the examiner shall decide whether in the revised claims, there exist any other defects which are not in conformity with the requirements of the Patent Law and its Implementing Regulations.

#### 5. 2. 2. 2 Amendment of Description

There are two kinds of amendment so far as description is concerned; amendment to the defect of the description *per se* which is not in conformity with the requirements of the Patent Law and its Implementing Regulations; and the amendments made to adapt to the revised claims. If the two kinds of amendments do not go beyond the scope disclosed in the initial description and claims, they are generally allowable.

#### Rule 18

The allowable amendments to the description include the following:

(1) Amendment of the title of the invention to enable it accurately and concisely represent the subject matter of the invention for which protection is sought. Where the types of the independent claims cover product, process and use, the subject matter of all of them shall be represented in the title of the invention. The title of the invention shall be as brief as possible and it is better not to exceed 25 Chinese characters.

(2) Amendment of the technical field of the invention which is the technical field accorded under the International Patent Classification (IPC). In order to enable the public and the examiner to clearly understand the invention and the relevant prior art, the applicant is allowed to amend the technical field of the invention to make it relating to the corresponding field which is defined in the lowest classification position of the IPC.

(3) Amendment of the background art to enable it in conformity with the subject matter of the invention for which protection is sought. Where the independent claim is drafted according to the provisions of Rule 22 of the Implementing Regulations, the relevant contents of the prior art described in the preamble portion of the independent claim shall be contained in the background art of the description, and the documents representing the background art shall be cited. If, through search, the examiner finds any reference documents which are even more related to the subject matter of the invention for which protection is sought than the prior art cited in the initial description by the ap-

plicant, the applicant shall be allowed to amend the description by adding in the contents of these documents and the references to them. At the same time, the contents relating to the description of the unrelated prior art shall be deleted. It should be noted that such amendment, in fact, has introduced the contents in the description which are not contained in the initial claims and description of the invention. However, since the amendment relates just to the background art and does not involve the invention *per se*, and the contents added are prior art already known to the public before the date of filing, it is allowable according to the international practice.

(4) Amendment of the contents of the invention which relates to the technical problem intended to be resolved by the invention to make the invention more in consistency with the subject matter of the invention for which protection is sought, i. e. representing the technical problem to be resolved by the technical solution of the invention with reference to the most relevant prior art. Of course, the amended contents shall be already contained in the original description or can be directly deduced from the contents described in the original description

Art. 26. 3 - 4  
Rule 4. 1

(5) Amendment of the contents relating to the technical solution of the invention to make it adapted to the subject matter of the independent claim for which protection is sought. Where amendments have been made to the independent claim which is in conformity with the requirements of the Patent Law and its Implementing Regulations, related amendments may be made in this Part. Where there is no amendment of the independent claim, such changes as the polishing of the language, the standardization of the words and the use of unified technical terms could be made provided that the initial technical solution is not changed.

(6) Amendment of contents relating to the advantageous effects of the invention. Such amendment is allowable only in cases when certain technical features are clearly disclosed in the initial application but their advantageous effects are not mentioned unambiguously. However, the person skilled in the relevant field of technology may directly deduce such results from the initial application without any difficulty.

(7) Amendment of the caption of the drawings. If though there are drawings, there are no captions for the drawings, it is allowable to add the captions. Where the caption of the drawing



is not clearly, proper amendment according to the context may be allowed.

(8) Amendment of the best mode or embodiment. Such amendment is limited only to the addition of the specific source of the certain contents of the initial mode or embodiment and supplement the known standard measuring method of the disclosed data representing the advantageous effects of the invention (including the standard equipment and/or appliance in use). If it is found through search that part of the initial subject matter of the invention for which protection is sought has become part of the prior art, the applicant shall delete such part or clearly indicate that the said part falls into the scope of prior art.

**Rule 19**

(9) Amendment of the drawings. This refers to the deletion of the unnecessary words and explanatory notes in the drawings, which may be then added into the text of the description; the amendment of the reference signs of the drawings to make it consistent with those in the text part of the description; in order to make the structure of certain parts of the drawing sufficiently clear, though the text is clear, the addition of the enlarged drawings of the said certain parts is allowable; amendment of the Arabic numbering of the drawings to make each drawing have a number.

**Rule 24**

(10) Amendment of the abstract to make it indicate the title of the invention, the technical field to which the invention pertains, the technical problems to be resolved, the essential contents of the technical solution by which the said technical problem will be resolved and the principal uses; deletion of the commercial advertising; substitution of the drawing of the abstract to make it best characterize the technical features of the invention.

(11) Amendment of the obvious mistakes which can be discerned by the person skilled in the relevant field of technology, i. e. grammar mistakes, clerical mistakes, or typing mistakes. The amendment of such mistakes shall be considered the only correct solution deduced by the above – mentioned person from the whole and the context of the text of the description.

**5. 2. 3 Non – Allowableness of Amendments**

**Art. 33**

As a matter of principle, any amendment to the description (and its drawings) and the claims which is not in conformity with the provisions of Article 33 of the Patent Law is not allowable.

To make it more clear, if additions, changes and/or dele-

tions have been made to part of the contents of the application, and the information as seen by a person skilled in the relevant field of technology after such amendment is different from those disclosed in the initial application and such information cannot be directly or undoubtedly deduced from the initial disclosure, such amendment shall not be allowable.

Here, the contents of the application refer to contents disclosed in the initial description (and its drawings) and claims, not including any contents of the priority documents.

#### **5. 2. 3. 1 Non – Allowableness of Additions**

The following addition of contents are not allowable;

(1) Introduction of technical features which cannot be directly and definitely confirmed from the initial description (and its drawings) and/or claims into the claims and/or description;

(2) Addition of information which can be neither directly and definitely deduced from the initial description (and its drawings) and/or claims nor obtained according to the general knowledge of the person skilled in the relevant field of technology, to make the disclosed invention clear or the claims complete;

(3) The contents added are the technical features related to the parameter of size by measuring the drawings;

(4) Introduction of additional composition which has not been referred to in the initial application documents, which leads to special results which do not exist in the initial application;

(5) Supplement of useful effects which cannot be directly deduced from the initial application by the person skilled in the relevant field of technology;

(6) Supplement of experimental data to illustrate the advantageous effects of the invention, and supplement of method of exploitation or embodiment to prove that the invention is workable in the scope of protection claimed in the claims (Such supplementary information may be included in the application file for the reference of the examiner when he/she proceeds to the examination of novelty, inventiveness or practical applicability);

(7) Supplement of the drawings that are not referred to in the initial application is generally not allowable. However, the supplement of drawings of the background art, or the replacement of the drawings of the technology in the public domain contained in the initial drawings by the ones mostly related to the pri-

or art is allowable.

### 5. 2. 3. 2 Non – Allowableness of Changes

Changes that are not allowable refer to the following:

(1) The change of the technical features of the claims, which has gone beyond the scope of the contents disclosed in the initial claims and description.

Example 1:

A kind of phonograph record case with the opening at one side is defined by the initial claims. A view of a case with opening at one side and the other three sides been glued is given in the drawings. If the applicant amends the claims as “a case with openings at least at one side”, while it has never been mentioned in any part of the description “there may be openings at more than one side”, such amendment has gone beyond the scope of contents disclosed in the initial claims and description.

Example 2:

What is claimed for protection in the initial claims is the composition of rubber. It cannot be replaced by the composition of elastic material, unless it is clearly indicated in the initial description.

Example 3:

A kind of brake of bicycle is defined in the initial claims, the applicant amends it as a kind of brake of vehicle. This technical solution cannot be directly deduced from the initial claims and description. Such amendment has also gone beyond the scope of contents disclosed in the initial claims and description.

Example 4:

What is disclosed in the initial claim is a specific detailed technical feature; it has been amended to a more broad general expression which cannot be directly deduced from the initial application documents. For example, to replace the component or part which has specific structure feature by “functional term + means” which cannot be directly deduced from the initial application documents. Such amendment has gone beyond the contents disclosed in the initial claims and description.

(2) New contents introduced by changing unclear contents into clear and concrete contents.

For example, there is an application for a patent for invention relating to polymer compound. It is just indicated in the initial application documents that the polymerization process is car-

ried out at “higher temperature”. When the applicant got to know that it is indicated in a reference document cited by the examiner that the same process is carried out at the temperature of 40°C, he/she changed the “higher temperature” to “higher than 40°C”. Although “higher than 40°C” falls into the scope of “higher temperature”, the person skilled in the relevant field of technology is unable to draw that “higher temperature” refers to “higher than 40°C” from the initial application documents. Therefore, such amendment has added new contents.

(3) Several separate features of the initial application are combined as a new feature while the interrelations of these separate features are not disclosed in the initial application.

(4) Certain feature disclosed in the description is changed which makes the changed technical contents completely different from that of the contents disclosed in the initial application or go beyond the contents disclosed in the initial description and claims.

For example, several embodiments with different layer – structure are disclosed in the description of an application for a patent for invention relating to multi – layer laminated board. Among them, one structure is to have an outer layer of polytene. If the applicant makes the amendment of replacing the polytene layer with polypropylene, as the laminated board after the amendment is totally different from the one in the initial disclosure, it is not allowable.

One more example, the contents of “upholder such as coil spring” is disclosed in the initial description, after the amendment, the description is replaced by “elastic upholder”, which leads to the result of a specific holding method by the coil spring being replaced by all the possible elastic holding methods. It makes the technical contents go beyond what is disclosed in the initial description.

### 5. 2. 3. 3 Non – Allowableness of Deletions

The circumstances of deletions that are not allowable refer to the following:

(1) To delete the technical features from the independent claim which are clearly defined as the essential technical features in the initial application, i. e. to delete the technical features which are described as the essential technical features throughout the initial application; or to delete a technical term

from the claims which is related to the technical solution disclosed in the description; or to delete from the claim the technical feature which is affirmed clearly in the description as relating to the specific application scope.

For example, the change of “a side wall with rib” into “a sidewall”. Another example, it is described in the initial claims that “apply to the sealing of rotation axis of the pump...”. While it is described in the amended claim that the “sealing of rotation axis”. Such amendments are not allowable because the basis of the change can not be found from the initial description.

(2) The deletion of some contents from the application makes the amended description goes beyond the scope of the initial description and claims.

For example, several embodiments with different layer – structures are described in the description of an application for a patent for invention relating to multi – layer laminated board. Among them, one structure is to have an outer layer of polytene. If the applicant makes amendment to the description to delete this layer of polytene, since the laminated board after the amendment is completely different from the one in the initial disclosure, it is not allowable.

#### 5.2.4 Form of Amendment

##### 5.2.4.1 Submission of Replacement Sheet

In accordance with the provisions of Rule 52 of the Implementing Regulations of the Patent Law, when an amendment to the description or the claims is made, a replacement sheet in special – purpose form shall be submitted, unless the amendment concerns only the alteration, insertion or deletion of a few words. There are two ways for the submission of the replacement sheet:

(1) Submission of the retyped replacement sheet and the table of comparison of the amendments.

This applies to the description and/or claims with many amendments, and all the amended drawings. At the time when the applicant submits the replacement sheet, he/she shall submit a table of comparison between the amendments made and the initial documents.

(2) Submission of the retyped replacement sheet and the page of comparison of the amendments which is made on the

duplicate of the original page.

This applies to the description and/or claims with few changes. At the time when the applicant submits the retyped replacement sheet, he/she shall submit the page of comparison of the amendments made on the duplicate of the original page, which may enable the examiner to find out the contents of the change more easily.

The replacement sheet submitted by the applicant shall be in duplicate.

#### **5. 2. 4. 2 Amendment of Examiner**

Rule 52

Rule 51. 4

Usually, the amendment to the application shall be under the request of the applicant in the form of formal document. Alteration, insertion or deletion may be made by the examiner on his/her own initiative for the few words or marks, as well as for the obvious mistakes which he/she finds in the title of the invention or the abstract ( see Sections 5. 2. 2. 2 ( 11 ) and 6. 2. 2 of this Chapter ), and the applicant shall be notified. The examiner shall use pen, signature pen or ball – pen, rather than pencil, to make clear and distinct amendments.

#### **6. Decision of Rejection and Notification of Grant of Patent Right**

Art. 38

Art. 39

Rule 57

The examiner shall finish the examination as to substance of an application within the shortest possible time. Usually, the examiner may make the decision to reject an application or issue the notification of grant of patent right after one or two Office Actions. Once the said decision or notification is issued, any observations, response or amendment of the applicant shall be no more considered except for letters requesting for the rectification of mistakes in the patent documents which are due to the errors of the Patent Office or of wrongly written or mispronounced characters.

#### **6. 1 Decision of Rejection**

##### **6. 1. 1 Conditions of Rejection of Application**

Art. 38

Rule 53

Before making the decision to reject an application, the examiner shall notify the applicant the facts, grounds, evidences, and legal bases confirmed by him after the examination as to substance which belong to one of the circumstances where an application for a patent for invention shall be rejected as specified in Rule 53 of the Implementing Regulations of the Pa-

tent Law, and provide at least one opportunity for the applicant to make observations and/or amendments. If the applicant, within the specified time limit, has neither submitted any new convinced reasons and/or evidences, nor made any amendments to the application documents which are in conformity with the Patent Law and its Implementing Regulations, or if there still exist in the amended application documents defects of reasons and evidences notified already to the applicant and which are sufficient for the application to be rejected, the examiner shall make a decision to reject the application.

#### 6. 1. 2 Circumstances of Rejection

Various circumstances are provided for in Rule 53 of the Implementing Regulations of the Patent Law where an application for a patent for invention shall be rejected. For any application for a patent for invention, if, after the examination as to substance, or after observations and/or amendments to the application documents have been made by the applicant, one of the following circumstances still exists, it shall be rejected:

Rule 53(2)  
Art. 5  
Art. 25

(1) The subject matter of the application for a patent for invention is contrary to the laws of the State or social morality or is detrimental to public interest; or it is one of the objects mentioned in Article 25 of the Patent Law for which no patent right may be granted;

Rule 53(2)  
Art. 22  
Rule 53(3)  
Art. 26. 3 - 4

(2) The invention in the application does not possess novelty, inventiveness or practical applicability;

(3) The application for a patent for invention has not fully disclosed the subject matter for which protection is sought; or the claim is not supported by the description;

Rule 53(3)  
Art. 31. 1

(4) The application is not in conformity with the requirement of unity of invention as provided by the Patent Law;

Rule 53(2)  
Art. 9  
Rule 13. 1

(5) the invention applying for patent may not be granted patent right under the principle of "first to file"; or the application is not in conformity with the provisions of "one patent for one invention - creation";

Rule 53(1)  
Rule 2. 1

(6) The application for a patent for invention is not a new technical solution relating to a product, a process or improvement thereof;

Rule 53(2)  
Rule 20. 1  
Rule 21. 2

(7) The claims are not clear and concise; or the independent claim lacks essential technical features for resolving the technical problem;

Rule 53(4)  
Rule 43. 1  
Art. 33

(8) The amendment to the application or the divisional application goes beyond the scope of disclosure contained in the initial description and the claims.

### **6. 1. 3 Formation of Decision of Rejection**

The decision of rejection consists of the following two parts.

#### **(1) Special – purpose form**

Each item of the special – purpose form shall be filled in according to the requirements; where there are two or more interested parties, all the names or titles of the parties shall be included ( see Section 1. 2. 1 (1), Chapter 6 of Part V of these Guidelines).

#### **(2) Text of decision of rejection**

The text of decision of rejection includes cause of action, reason of rejection and decision. The three parts shall be drafted according to the requirements of Section 6. 1. 4 of this Chapter.

### **6. 1. 4 Drafting of Text of Decision of Rejection**

#### **6. 1. 4. 1 Cause of Action**

In the part of the cause of action, the process of examination of the application shall be briefly stated, including especially the information relating to the decision of rejection, i. e. the various Office Actions ( including the relevant evidence) and the summaries of the responses of the applicant, defects of the application which are the causes of the rejection, and the text of the application on which the rejection is based.

#### **6. 1. 4. 2 Reasons of Rejection**

The examiner shall expound explicitly the facts, reasons and legal basis of the decision of rejection in the part of reasons of rejection, and special attention shall be paid to the following.

(1) Applying correctly the provisions of the law. Where different Articles of the Patent Law or Rules of the Implementing Regulations of the Patent Law may be applied, the most suitable, leading Articles and Rules shall be cited to form the legal basis of the rejection.

(2) Convincing facts and reasons shall be taken to form the basis of rejection, and the applicant shall be given one opportunity to provide observations and amendments to these facts and reasons. Newly cited reference documents and other documents



cannot be used to form the basis of rejection.

(3) For applications not in conformity with the provisions of Article 22 of the Patent Law and to which patent right cannot be granted even after the amendment, analysis shall be made to each of the claims. The reasons of rejection shall be sufficient and convincing, rigorous in logic and appropriate in wording. The examiner shall not make a conclusion by citing only the relevant Articles and/or Rules of the Law and Regulations. Where necessary, brief comments of the examiner shall be made in this part on the arguments of the applicant.

#### 6. 1. 4. 3 Decision

In this part of decision, the examiner shall indicate the situations to which the reasons of rejection refer and which are described in Rule 53 of the Implementing Regulations of the Patent Law. The examiner shall also make the conclusion of rejection of the application by relying on the relevant provisions of Article 38 of the Patent Law.

### 6. 2 Notification of Grant of Patent Right

#### 6. 2. 1 Conditions for Issuing Notification of Grant of Patent Right

Art. 39  
Rule 54. 1

Where it is found after examination as to substance that there is no cause for the rejection of the application for a patent for invention, the Patent Office shall make a decision to grant the patent right. Before the decision to grant the patent right is made, a notification to grant the patent right for invention shall be issued. The text to which the right is granted must be the final text confirmed by the applicant in written form.

#### 6. 2. 2 Work Involved for Issuing Notification of Grant of Patent Right

Rule 54. 1

The examiner is allowed to make the following amendments or rectifications to the text to which patent right shall be granted *ex officio* before the notification of grant of patent right is issued (see Section 5. 2. 4. 2 of this Chapter).

(1) the description; amendment of the inappropriate title of the invention and/or technical fields to which the invention pertain; rectification of wrongly written or mispronounced characters, errors in symbols, marks etc.; amendment of the terms that are obviously non – standard; addition of the missing titles of

the various part of the description; and the deletion of the unnecessary explanatory notes in the drawings.

(2) the claims; rectification of wrongly written or misspelled characters, rectification of errors in punctuation mark or in the reference sign of the drawings; the enclosing of the drawing reference sign with brackets etc. . However, any amendment which may lead to the change of the scope of protection shall not be made by the examiner.

(3) the abstract; rectify the inappropriate contents and obvious mistakes in the abstract.

The above – mentioned amendments or rectifications made by the examiner shall be notified to the applicant.

The following work shall also be conducted by the examiner; fill in the IPC Symbol of the patent identified by himself/herself on the cover of the file and submit the file to the person who is responsible for classification of the Division for verification; put the text to which the patent right is going to be granted in the gazette pouch; fill in the prescribed items on the punch and affix his/her seal to it ; fill in the Notification to Grant Patent Right ( special – purpose form ) in duplicate ; after affixing seal to them, put one in the file and put the other in the inner cover of the application file; sort out a complete set of the file and fill in on the front and the back cover of the file the record of handing – over of the file at the time of granting the patent right and the record of outgoing documents. Where the title of the invention has been amended by the applicant, or after verification the IPC Symbol has been rectified, it is also necessary to fill in “Notification of Change in Bibliographic Data” in duplicate: one is bound before the front page of the first binding strip of the file, and the other is put in the folder of the inner cover.

## **7. Termination, Suspension and Restoration of Procedures of Examination as to Substance**

### **7.1 Termination of Procedures**

The procedures of the examination as to substance shall be terminated if the examiner makes a decision of rejection and the decision has entered into force, or the Notification to Grant Patent Right has been issued, or the applicant withdraws the application on its/his own initiative, or the application is deemed to have been withdrawn.

As for the rejected or granted application, the examiner shall indicate “rejection” or “grant” under the item of examina

tion as to substance on the cover of the file, and affix seal to it.

The examiner shall establish a personal file for each application for further consultation or for statistics purposes ( see Section 3.3 of this Chapter ).

### **7.2 Suspension of Procedures**

#### **Rule 86. 1**

The procedures of examination as to substance may be suspended upon the request of the interested party of a dispute concerning the right to apply for a patent in accordance with Rule 86. 1 of the Implementing Regulations of the Patent Law. Once the examiner receives the notification of suspending the procedure and recalling of the file, he/she shall return the file to the file proceeding administration department within the prescribed time limit.

### **7.3 Restoration of Procedures**

When termination of the procedures of an application for a patent results from that the application is deemed to have been withdrawn because the time limit provided by the Patent law and its regulations or as prescribed by the Patent Office is not observed, for force majeure or for any justified reason, according to the provisions of Rule 7. 1 – 7. 2 of the Implementing Regulations of the Patent Law, the applicant may request the Patent Office to restore the procedures of examination as to substance.

#### **Rule 86. 3**

For the suspension of the procedures under the request of the interested party of a dispute concerning the right to apply for a patent, after the Patent Office receives the decision of settlement or judgment which has legal effect, the procedures shall be restored immediately if no change in the right holder is involved. Where there is change in the right holder, the procedures shall be restored after the procedures of amendment of bibliographic data have been gone through. Where the said dispute is not settled within one year from the date of the submission of the request for suspension of the procedures, and the person who requested for the suspension does not request for an extension of the time limit, the Patent Office may restore the procedures of examination as to substance on its own initiative.

After receiving the written notice to restore the examination procedures and the patent application file from the preliminary examination department, the examiner shall re – start the procedures of examination as to substance.

## 8. Interlocutory Examination and Continuation of Examination after Reexamination

### Rule 61

In accordance with Rule 61 of the Implementing Regulations of the Patent Law, the examiner shall perform Interlocutory Examination on the request for reexamination transferred by the Patent reexamination Board, and an Office Action shall be made usually within one month from the date of receiving the file. See Section 5, Chapter 2 of Part IV and Section 11, Chapter 7 of this Part of these Guidelines for the requirements of Interlocutory Examination.

### Rule 62. 2

After the Patent Reexamination Board makes a decision of withdrawing the decision of rejection of the Patent Office, the examiner shall continue the examination of the patent application. The requirements provided in this Chapter apply to the continuation of the examination. However, in the continuation examination, it is not necessary for the examiner to conduct examination on the facts and reasons which have been examined and confirmed by the Patent Reexamination Board, nor can he/she makes a decision of rejection again which is opposite to the decision of reexamination based on the same facts and reasons (see Section 10, Chapter 2 of Part IV of these Guidelines).

**Chapter 9****Issues Regarding Examination of Application for Patent for Invention Relating to Computer Program****1. Introduction**

In accordance with the provisions of Article 25.1(2) of the Patent Law, no patent right shall be granted for the rules and methods of mental activities, including mathematical methods and all non – technical solutions with features of abstract thinking, subjective thought or human sensation (refer to Section 3.2 of Chapter 1 of this Part).

In accordance with Rule 2.1 of the Implementing Regulations of the Patent Law, “invention” in the Patent Law means “any new technical solution relating to a product, a process or improvement thereof.” The application for a patent for invention relating to one or more computer programs shall be a type of new technical solution meeting the requirements of this Rule.

The computer program *per se* mentioned in this Chapter refers to the coded instruction sequence or signified instruction sequence which can be transformed automatically into a coded instruction sequence or signified statement sequence. Such a sequence can be executed by a device capable of information processing, such as a computer, to achieve certain results. The computer program *per se* includes both the source and object programs.

The invention relating to one or more computer programs mentioned in this Chapter refers to a solution which is fully or partially based on the process of a computer program to resolve the problem raised in an invention.

Art. 25.1(2)

**2. Examination of Application for Patent for Invention Relating to Computer Program**

Where an application for patent for invention relates merely to a computer program *per se*, or to a computer program recorded in the carrier (such as a tape, disc, CD – ROM, magnetic CD – ROM, ROM, PROM, VCD, DVD or any other computer – readable medium), for the said program *per se*, it falls into the scope of the rules and methods for mental activities regardless of what form it is in.

However, if an application for patent for invention relating to a computer program is to resolve a technical problem, capable

of producing technical effect and has made use of technical means, it shall not be denied patent protection merely because the invention which is the subject matter of the application relates to a computer program. For example, an application for patent for invention is to improve the internal performance of a known computer by inputting a computer program into the known computer to control its internal operation, or to use a computer program to control an industry process, measurement or test process, or to use a computer program to realize external data processing, so long as the subject matter of these inventions meet the above – mentioned requirements, they shall not be excluded from the scope of patentable invention. Where an application for patent for invention relating to a computer program is to resolve a technical problem, has made use of technical means, and can produce technical effect, the subject matter of the application falls within the scope of patentable invention.

## 2. 1 Application for Patent for Invention Relating to Computer Program Which Is Not to Be Granted Patent Right

Any application for patent for invention relating to computer program which falls within the provisions of Article 25. 1 (2) of the Patent Law is not an object which can be granted patent right. The Followings are some examples of objects for which no patent right shall be granted.

(1) The subject matter of an application for a patent for invention relates to a method to solve ratio of the circumference of a circle to its diameter by computer. According to this method, a square is first divided by evenly distributed “dots” which are sufficiently accurate; next an inner circle of the square is made; then, ratio of the circumference of a circle to its diameter is solved by a computer program. The computer program enables the computer to carry out a pulse counting of the “dots” which are evenly distributed throughout the said square, then calculate and obtain ratio of the circumference of a circle to its diameter according to the following formula:

$$\pi = \frac{\sum \text{count value of the "dots" in the circle}}{\sum \text{count value of the "dots" in the square}} \times 4$$

In the calculation, the closer the “dots” are located, the more accurate the ratio of the circumference of a circle to its diameter  $\pi$  value is.

The subject matter of this application for patent for invention

relates merely to a method or rule for purely mathematical calculation which has not solved any technical problem, the object of the processing and the result achieved are numerical values of non – technical nature; hence, this invention does not fall into the scope of patentable invention.

(2) The subject matter of an application for a patent for invention is the automatical measurement of the coefficient of kinetic friction by computer. The traditional method to measure the coefficient of kinetic friction is to draw the restiform body to be measured in a fixed speed by a device so as to obtain the position variables of the friction plate  $S_1$  and  $S_2$  respectively, and then to calculate the coefficient of kinetic friction of the restiform body by the following formula:

$$\mu = (\log S_2 - \log S_1) / e$$

This invention automatically performs data processing to  $S_1$  and  $S_2$  by computer and solves its coefficient of kinetic friction in the following order:

1. Solve the ratio of  $S_2$  and  $S_1$ , i. e. ,  $S_2/S_1$ ;
2. Solve the logarithm  $\log S_2/S_1$  of the ratio of  $S_2/S_1$ ;
3. Solve the ratio of  $\log S_2/S_1$  and  $e$ .

Although the subject matter of this invention is to solve a physical quantity, since no new technical feature has been added to the traditional method of measurement by this invention, it is, in fact, a algorithmic program and a pure mathematical method. Therefore, this invention does not fall into the scope of patentable invention.

(3) The subject matter of an application for a patent for invention is a method for introducing a new, intensified function to the users of an application program on the basis of the practical use of computer software. According to this method, sufficient function is first provided for the user when they study at the preliminary level. If the scheduled project has been completed, the new, intensified function will be provided to them.

The essence of the invention is that on the basis of the known function of the various applications of the said computer, the user of the said applications is given, taught, instructed or informed of the kind of new, intensified function to be started in a particular condition merely on the basis of the subjective understanding, judgment, thought or experience of the inventor. The invention adopts a non – technical programming method, is not to resolve any technical problem and has not achieved any tech-

nical results. As a result, this invention is not patentable.

(4) The subject matter of an application for patent for invention is a management system for an entity to award its employees. The invention consists of a known computer, a database and a computer program for managing the relevant information. According to this invention, the said known computer is controlled by the said computer program to process the information in the database to execute the task of awarding the employees.

Although this invention relates to a “management system”, the essence of this invention, not having any change in its hardware structure, is the computer program for managing the relevant information, i. e. a method for the management of bonus award. Having neither resolved a technical problem, nor produced any technical effect, the invention does not belong to the scope of patentable invention.

(5) The subject matter of an application for a patent for invention relates to a method for managing or controlling the process of a computer game machine, comprising the steps of inputting a game, determining whether the said game is a new one, calling in the data of the new game, clearing away the executed data of the said new game, tallying up, returning to the initial state and waiting for the input of a new game.

The essence of the subject matter of this application for the patent for invention is a management or control program operated on a known computer to manage or control the process of a plurality of games. This subject matter merely executes management or control of the process of the games. The invention does not resolve a technical problem, nor does it produce any technical effect; hence, it may not be granted patent protection.

(6) The title of the subject matter of an application for a patent for invention is a computer – readable storage medium for storing computer programs. However, there is no change in the physical feature of the computer – readable storage medium. The essence of the subject matter of the application is the computer program *per se* recorded in the computer – readable storage medium. Since no patent may be granted to computer programs, this invention is not an object under patent protection.



## **2. 2 Application for Patent for Invention Relating to Computer Program for Which Patent Right May Be Granted**

Any application for a patent for invention the subject matter of which relating to a computer program which is to resolve a technical problem, uses technical means, and can produce technical effects may be granted patent protection.

### **2. 2. 1 Application for Patent for Invention Relating to Computer Program for Controlling an Industrial Process**

An application for a patent for invention is to input a computer program into a known computer to form a computer – program – controlled device or manufacturing process, and taking the computer program and the hardware of the computer as a whole, the said known computer and the said computer program have formed the subject matter of a manufacturing device or manufacturing process for controlling the industrial process. Since the invention has resolved a technical problem and can produce technical effect, this application for patent for invention relating to computer program for controlling an industrial process is a patentable invention.

For example, an application for a patent for invention relates to a method for controlling a die forming process of rubber. It utilizes a computer program input into a known computer to control the said die forming process. The said computer program accurately controls, in real time, the time of vulcanization of the rubber manufacturing process. Use of such real – time control of the vulcanization time of the rubber can rectify the defects of over – vulcanization and under – vulcanization which often occur in the existing process, and the quality of the rubber product is greatly improved. Since this invention has resolved a technical problem, uses technical means and produced technical effect, the subject matter of the application is patentable .

### **2. 2. 2 Application for Patent for Invention Relating to Improvement of Performance of the Internal Operation of Computer**

The subject matter of an application for a patent for invention relates to a method for improving the performance of the internal operation of a known computer system by a computer program. Since this invention is intended to resolve a technical problem and has produced technical effect of improving the internal performance of a known computer system, the subject matter of the

application is patentable.

For example, the subject matter of an application for a patent for invention is to execute the virtual storage control of a computer by a computer program to expand the valid storage capacity of the computer. This program can greatly expand the valid storage capacity of the computer, increase the storage capacity of the computer and improve the operating speed and efficiency of the computer. Since the subject matter of this invention has resolved the technical problem of expanding the valid storage capacity of the computer and the invention has produced technical effect, the subject matter of the application is patentable.

#### **2.2.3 Application for Patent for Invention Relating to Computer Program for Controlling Measurement or Test Process**

If the subject matter of an application for a patent for invention is using a computer program to control and/or execute a measurement or test process, this invention is intended to resolve a technical problem and can produce technical effect, hence, the subject matter of the application for patent for invention is patentable.

For example, the subject matter of an application for a patent for invention relates to a device for measuring liquid viscosity. According to the invention, a computer program is used to automatically control the processes of sampling, viscosity calculating and sample – chamber cleaning. This invention intends to resolve a technical problem and with the adoption of the said computer program, it has achieved the technical effect of greatly improving the efficiency and accuracy of the measurement as compared with the prior art. Hence, the subject matter of the application for patent for invention is patentable.

#### **2.2.4 Application for Patent for Invention Relating to Computer Program for External Data Processing**

The subject matter of an application for a patent for invention is to process external data by operating a computer program in a known computer to resolve a specific technical problem. Since this invention intends to resolve a technical problem by technical means and can produce technical effect, it is a patentable invention.

For example, the subject matter of an application for a pa-

tent for invention relates to an image processing apparatus, comprising a known computer in which an image processing program is stored in the known memory. Under the control of this image processing program, the said computer processes the external input image data to improve the quality of the said image. The essence of this invention is to process the image data by a computer program in the known computer to improve the quality of the image. Improving the quality of the image is a technical problem which the application intends to resolve, and the improvement of the quality of the image is the technical effect that has been achieved. Therefore, this invention is a patentable invention.

Art. 25. 1(2)

**3. Application for Patent for Invention Relating to Methods of Encoding and Inputting Chinese Characters**

A method of encoding the Chinese characters is an information formation method. As far as the information formation method or the encoding method of the Chinese characters *per se* is concerned, just like the various formation method of the other information such as voice signal, language signal, visual display signal or traffic signal, it depends only on the subjective thought or artificial rules. Therefore, the encoding method of the Chinese characters is not a technical solution. The execution of this encoding method *per se* merely results in a symbol/alphanumeric string which is not a technical effect. Therefore, the application for the patent for invention of which the subject matter relates merely to a method for encoding the Chinese characters is not to be granted patent protection.

For example, the subject matter of an application for a patent for invention relates to a method for encoding the radicals of the Chinese characters. This encoding method is used to compile dictionaries and to search the Chinese characters with the said dictionaries. According to this method in the invention for encoding the Chinese characters, corresponding rules are artificially made for encoding the Chinese characters, and to select, designate and combine the code elements for encoding the Chinese characters, so as to form the code/alphanumeric strings to express the Chinese characters. And all these depend only on the knowledge and understanding of the inventor. As this invention does not intend to resolve a technical problem, it has not made use of any technical means and has not achieved any

technical effect, it is not a patentable invention.

However, if the method for encoding the Chinese characters is combined with a special keyboard so that it works as a method in a computer system for inputting the Chinese characters to process the Chinese characters or as a method of a computer to process the Chinese character information to enable the known computer system in which the Chinese characters could not be operated in the past to use the information in the form of the Chinese characters as the instruction to produce some new functions so that automatic control of the manufacturing process or office automation system can be achieved. In this way, the Chinese character computer input method or Chinese character computer information process may well be a patentable invention.

For such an application for a patent for invention relating to a method for inputting the Chinese characters to the computer, comprising the combination of the method of encoding the Chinese characters and the special keyboard used for this encoding method, it shall describe in the description and the claims the technical features of the Chinese character input method. When necessary, the technical features of the keyboard used for this method, including the definition of the various keys on the keyboard and the location of the each key on the keyboard shall also be illustrated.

For example, the subject matter of an application for a patent for invention relates to a method for inputting the Chinese characters on computer, comprising the steps of selecting a determined number of specific radicals from all the radicals of the Chinese characters as the code elements for the encoding, assigning the said encoding code elements to the corresponding keys of the said keyboard and inputting the Chinese characters according to the rules of inputting and encoding of the Chinese characters by using the specific keys on the keyboard.

This application for a patent for invention is a method for inputting the Chinese characters on computer comprising the combination of the method for encoding the Chinese characters and the special keyboard. This input method enables the known computer system which could not operate on the Chinese characters before to be able to do so, and adds a new processing function to the known computer. Since what the invention intends to resolve is a technical problem and can produce technical

effect, the subject matter of the application for patent for invention is patentable.

#### **4. Drafting of Description and Claim of Application for Patent for Invention Relating to Computer Program**

In principle, the requirements for the drafting of the description and the claims of an application for patent for invention relating to computer program are the same as those for drafting the description and the claims of applications for patent for invention in other technical fields. Following are the specific requirements for drafting the description and the claims of an application for patent for invention relating to computer program.

Art. 26. 3

##### **4. 1 Drafting of Description**

The description of an application for patent for invention relating to the computer program shall, in addition to outlining the technical solution of the invention as a whole, illustrate the concept of design, the technical features of the computer program concerned and the mode of exploitation to produce the technical effect in a clear and comprehensive way. In order to clearly and completely outline the main technical features of the computer program, the principal flow chart of the computer program shall be presented in the drawings of the description. An explanation of each step of the computer program shall be made in the description in natural language based on the said flow chart in chronological order. The disclosure of the main technical features of the computer program in the description shall enable a person skilled in the relevant field of technology to produce the computer program capable of producing the technical effect as described in the description on the basis of the disclosure of the flow chart and its explanation. In order to be sufficiently clear, where necessary, the applicant may briefly extract from the computer source program some important parts of it to serve as a reference in the customarily used, marked program language, but it is not necessary to provide the whole source program of the computer.

Art. 26. 4  
Rule 20. 1

##### **4. 2 Drafting of Claims**

The independent claim of the claims of an application for a patent for invention relating to computer program may be drafted as a claim for process or a claim for product, i. e. the apparatus for executing the process. No matter in which of the types it is

## Rule 21.2

drafted, the independent claim shall be supported by the description. It shall represent the technical solution in its entirety and outline the essential technical features for resolving the technical problem. It shall not only describe the functions of the computer program and the effects those functions can produce. 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 components and the connections among them shall be specified, and a detailed account shall also be given on the components of the computer program by which the various functions of the computer program have been performed, and on how these functions are performed.

As references, the following are examples of inventions relating to computer program drafted as process claim and apparatus claim respectively.

## Example 1:

The independent claim of an application for a patent for invention entitled "the cursor control of the characters on the CRT screen" may be drafted as follows:

"A method for controlling the characters on the CRT screen by a cursor, comprising:

- the inputting step for inputting information;

- the step of storing the starting position addresses of the horizontal movement and vertical movement of the cursor into a H/V starting point memory unit;

- the step of storing the designation addresses of the horizontal movement and vertical movement of the cursor into a H/V designation memory unit;

- the step of storing the horizontal and vertical addresses of the current position of the cursor into a cursor position memory unit;

it is characterized in that the method of cursor control also includes:

- the step of comparing the current horizontal and vertical addresses of the cursor stored in the said cursor position memory unit with the corresponding horizontal and vertical designation addresses stored in the H/V designation memory unit respectively;

- the step of transformation of the cursor position controlled by

the output signal from the said inputting keyboard and output signal of the said comparator, which may select the following performances;

- increment as a single character position to the horizontal and vertical addresses stored in the cursor position memory unit, or

- decrement as a single character position from the horizontal and vertical addresses stored in the cursor position memory unit, or

- set the horizontal and vertical starting position addresses stored in H/V starting position memory unit to cursor position memory unit;

- the step of cursor display which displays the current position of the cursor on the screen according to the memory state of the cursor position memory unit. ”

Example 2;

The claim of the said application for a patent for invention for a computer program is drafted as an apparatus claim.

“A cursor controller for CRT screen, comprising;

- an inputting unit for inputting information;

- the H/V starting point memory unit for storing the starting position addresses of the horizontal movement and vertical movement of the cursor;

- the H/V designation memory unit for storing the designation addresses of the horizontal movement and vertical movement of the cursor;

- a cursor position memory unit for storing the horizontal and vertical addresses of the current position of the cursor;

It is characterized in that the cursor controller also includes;

- a comparator for respectively comparing the current horizontal and vertical addresses of the cursor stored in the said cursor position memory unit with corresponding horizontal and vertical designation addresses stored in the H/V designation memory unit;

- a cursor position transformation unit controlled by the output signal from the said inputting keyboard and the signal from the comparator, which may select the following performances;

- increment as a single character position the horizontal and vertical addresses stored in the cursor position memory unit, or

- decrement as a single character position from the horizontal and vertical addresses stored in the cursor position memory u-

nit, or

set the horizontal and vertical starting position addresses stored in the H/V starting position memory unit to the cursor position memory unit;

a cursor display unit which displays the current position of the cursor on the screen according to the memory state of the cursor of the position memory unit. "

Example 3:

An application for a patent for invention for a "computer system suitable for sequence control and servo control" uses parallel processing to conduct sequence control and servo control by taking the instructions of opening, closing, and pausing as the parallel processing instructions between the first and second programs. The independent claim of this invention may be drafted as:

A process to conduct sequence control and servo control by taking the instructions of opening, closing, and pausing as the parallel processing instructions is characterized in adopting the following steps:

storing the sequence control program or servo control program which is going to execute the task into the program memory of the computer system;

starting the computer system, and the CPU fetching instructions, executing operation according to the program counter unit, and updating the program counter unit according to the executive instructions;

if the executing instructions are program instructions, the updating of the program counter unit is identical with that of the general computer;

if the executing instructions are opening instructions, the program counter unit is updated as the address of instructions following this opening instruction, i. e. the first address of the parallel processing program which is going to be opened so as to start the operation of the controlling of sub - process;

if the executing instructions are closing instructions, the program counter unit is updated by the address selected from the address list or the address of the instruction following this closing instruction, so that the program *per se* which issues the said instruction to close or another parallel program stops its operation and the other parallel programs start into operation at the same time;



if the executing instructions are pausing instructions, the program counter unit is updated by the address of the instruction following this pausing instruction so that the execution of the program shall be suspended for a certain period of time according to the requirements, and another parallel program is started simultaneously in the meantime.

## Chapter 10

### Several Provisions for the Examination of Applications for Patent for Invention in the Field of Chemistry

#### 1. Introduction

Many special issues exist in the examination of applications for the patent for invention in the field of chemistry. This Chapter is meant to set forth some provisions on how to handle issues which are particular to the examination of applications for the patent for invention in the field of chemistry according to the principles of the Patent Law and its Implementing Regulations. These provisions need to be constantly supplemented and revised in the examination practice in the years to come.

This Chapter consists of six sections concerning chemical applications for which no patent right shall be granted, claims of chemical invention, sufficient disclosure of chemical invention, novelty and inventiveness of chemical invention and unity of invention of chemical invention. Issues particular to the applications for invention relating to biotechnology will be dealt with in Section 7.

#### 2. Chemical Applications for Which No Patent Right Shall Be Granted

##### 2.1 Natural Substances

A substance, found from the nature and existing in its natural state, is merely an object of discovery in the sense of the "scientific discoveries" as provided in Article 25.1(1) of the Patent Law, and no patent right shall be granted for it. However, if a substance is isolated or extracted from the nature for the first time, of which the structure, the morphological or other physical/chemical parameters are unknown in the prior art and can be precisely characterized, and if it has value in industrial application, the substance *per se* and the process to obtain it may be granted patent right under the Patent Law.

##### 2.2 Recipes and Cooking Methods

As recipes belong to rules of mental activities (see Section 3.2, Chapter 1 of this Part) under Article 25.1(2) of the Patent Law, no patent right shall be granted to recipes.

For any cooking method having no industrial applicability, since it is not in conformity with the provisions of Article 22.4 of

the Patent Law; no patent right shall be granted to it.

## **2. 3 Medical Prescription**

Art. 22. 4

The prescriptions of a doctor refer to the prescriptions made by a doctor according to the concrete conditions of a particular patient. As the prescriptions of a doctor, the making up of a prescription by the doctor or the process of medicine dispensation merely according to the prescription of a doctor do not possess industrial applicability, they shall not be granted patent right.

## **2. 4 Medical – Use of Substance**

As the medical – use of a substance is a method for the diagnosis or treatment of diseases, it falls into the situations provided in Article 25. 1 (3) of the Patent Law; hence, it shall not be granted patent right. However, if it is used for the manufacturing of a medicament, it may be granted patent right under the Patent Law ( see Section 3. 5. 2 of this Chapter).

## **3. Claim of Chemical Invention**

### **3. 1 Claim of Compound**

The claim of a compound shall be characterized by the name of the compound or with the structural or molecular formula of the compound. The compound shall be named according to general nomenclature, rather than a trade name or code name. The structure of the compound shall be clear enough, and any ambiguous or vague wording is not permitted.

### **3. 2 Claim of Composition**

#### **3. 2. 1 Open – Ended Mode, Close – Ended Mode and Their Application Requirements**

In accordance with the provisions of Rule 22. 2 of the Implementing Regulations of the Patent Law, if it is not appropriate, according to the nature of the invention, to present the independent claim in the form of a preamble portion and characterizing portion, it may be presented in other form. Generally, the claim for composition is such an example.

The claim for a composition shall be characterized by the features of the composition, such as the components, or the components and the contents of the components. There are three modes of presentation for the claim of a composition: open

– ended, close – ended and semi – open – ended. The open – ended mode means that the composition does not exclude those components that are not mentioned in the claim. The close – ended mode means that any of the other components that are not mentioned in the claim shall be excluded. The semi – open – ended mode is somewhere between the two modes. The three modes of presentation are different in scope of protection sought. The commonly – used wording is as follows.

(1) Open – ended mode; wording such as “comprising”, “including”, “containing”, “essentially comprising”, “substantially comprising” etc. . All indicate that some other components which are not indicated in the claim may be further included in the composition, though the former may take quite a great proportion in content.

(2) Close – ended mode; wording such as “consisting of...”, “be composed of...”, “be balanced with...” etc. , all indicate that the composition claimed is composed of the indicated components only, without any other components to be included in. However, there could be impurities, and the impurities may take only normal proportion in content.

(3) Semi – open – ended mode; wording such as “substantially” is used together with the close – ended mode wording, e. g. “substantially consist of...” and “be substantially composed of...”. The scope of protection of the claims presented in this mode is between that of the open – ended mode and the close – ended mode. It makes the close – ended mode claim open only to the components that are not mentioned in the claims and these components may take any proportion in content on condition that they have no substantial effect on the basic feature(s) or the new feature(s) of the components already mentioned.

(4) When the word “mainly” is used together with the wording of the close – ended mode, i. e. “mainly consisting of...” and “be mainly composed of...”, it means that the claim is an open – ended mode.

It is to be noted that, when the open – ended mode or close – ended mode expressions are in use, they must be supported by the description. For example, the claim of a composition is  $A + B + C$ . If there is, in fact, no other component described in the description, it should not be presented in an open – ended mode.

It shall also be pointed out that if the independent claim of a composition is  $A + B + C$ , where there is another component  $D$  indicated in the claims following it, if the claim  $A + B + C$  is in open – ended mode, the claim involving component  $D$  shall be a dependent claim; if the claim  $A + B + C$  is in close – ended mode, the claim involving component  $D$  shall be an independent claim.

### 3. 2. 2 Definition of Component and Content in Claim of Composition

Rule 21. 2

(1) If the essential part or the inventive point lies in the components *per se*, the task of the invention is to select the components, and the content of the components can be determined by a person skilled in the art, it is permitted to define the component only in the independent claim. However, if the inventive point lies both in the components and relates to the content thereof, the task of the invention is not only to select the component, but also to determine the particular content of the said component. In that case, both the component and the content must be defined in the independent claim.

Rule 21. 2

(2) In certain technical fields, such as alloys, both the necessary component and the content thereof must be defined in the independent claim.

Rule 20. 1

(3) No ambiguous or vague words such as “about”, “or so”, “approximately” etc. shall be used to define the content of the component. Usually, such words shall be deleted whenever they appear. The content of the component may be indicated by “0 ~  $X$ ”, “ $< X$ ” or “less than  $X$ ”, etc.. Those indicated by “0 ~  $X$ ” are optional components. By “ $< X$ ” or “less than  $X$ ”, etc., “ $X = 0$ ” is also included. It shall not be allowed to use “ $> X$ ” to indicate the range of content.

Rule 20. 1

(4) The sum total of the content in percentage of each component of a composition shall be equal to 100% and the ranges of the contents of the components shall meet the following requirements:

The maximum value of the content of one component + minimum value of the content of all the other components  $\leq 100$

The minimum value of the content of one component + maximum value of the content of all the other components  $\geq 100$

Rule 20. 1

(5) Where it is difficult to indicate the particular relations among the components of a composition by words or by numeri-

cal value, the claim may be defined by a formula showing the characteristic relation or amount relation or by the use of a diagram. The specific meaning of the diagram shall be explained in the description.

## Rule 20. 1

(6) Qualitative verbal description instead of numeric quantitative expressions are acceptable if it is clear in meaning and known in the relevant field of technology, such as "the content is sufficient to make certain material moistened", "catalytic amount" etc. .

## Art. 26. 4

**3. 2. 3 Other Definition for Claim of Composition**

Generally, there are three types of composition claims: non – defining, function – defining and use – defining. For example:

(1) "An hydrogel composition comprising polyvinyl alcohol of molecular formula ( I ), saponifier and water" (the molecular formula ( I ) is omitted here);

(2) "A magnetic alloy comprising 10% ~60% by weight of A and 90% ~40% by weight of B" ;

(3) "A butene dehydrogenation catalyst comprising  $\text{Fe}_3\text{O}_4$  and  $\text{K}_2\text{O}$ ...".

Among the above, (1) is a non – defining type, (2) is a function – defining type and (3) a use – defining type.

If the invention has emphasis on the composition *per se* or if the said composition possesses two or more permanent functions or is applied in two or more application fields, the use of a non – defining claim is permitted. For example, according to the description, the hydrogel composition mentioned in (1) mentioned above possesses the property of formability, hygroscopicity, film – formability, adhesivity and high caloricity; hence, it can be used in many fields as a food additive, a gluing agent, an adhesive, a coating material, a microorganism culture medium or a heat insulation medium.

When the invention has emphasis on the application, it shall be drafted as use – defining, such as (3) mentioned above. A mere mentioning on the performance (as in (2) mentioned above) does not lead to limit the use. In certain fields, such as in alloys, the intrinsic property and/or use of the invented alloy must be specified. Most pharmaceutical claims shall be drafted in the form of the use – defining type.

### 3.3 Chemical Products Which Cannot Be Clearly Defined Merely by Features of Structure or Component

Here, the word chemical products include compounds and compositions.

#### Rule 20.1

(1) Circumstances where it is permitted to use physico – chemical parameter(s) to characterize the claim of a chemical product; the chemical product has unclear structure and cannot be precisely characterized merely by using its chemical name or chemical structure or composition. The said parameter(s) shall be the one(s) commonly used in the relevant field of technology and shall be clear enough. When a new parameter has to be used under some circumstances, it shall have the product defined by this parameter distinguished from the prior art.

(2) Circumstances where it is permitted to use process of preparation to characterize the claim of a chemical product; the claimed chemical product cannot be sufficiently defined by the features other than the method of preparation, and the relevant process of preparation adds new property to the chemical product and makes it capable of a particular use.

### 3.4 Claim of Chemical Process

The claim of the process invention in the field of chemistry, be it a process for preparing a substance or another process (e. g. process for the application, process method or treatment method of a substance. ), may be defined by the features of the process relating to procedure, substance and apparatus.

The process features relating to procedure include process steps (it may also be reaction steps) and process conditions, such as temperature, pressure, time, catalysts or other auxiliaries used in process steps;

The process features relating to substance include the chemical component, chemical – structural formula, physical/chemical property parameters of the raw material used in the process and the product;

The process features relating to apparatus include the type of the apparatus specially adapted in the said process and the feature or function of the apparatus related to the said process invention.

In the case of a specific process claim, one of the three types of technical features is selected depending on the subject matter claimed, the technical problem to be re – solved and the

inventive element of the process invention.

### 3.5 Use Claim

#### 3.5.1 Types of Use Claim

The invention relating to the use of a chemical substance is made on the basis of discovery of a new feature of the substance and the use of such feature. Regardless of a new or known substance, its feature is inherent in the substance *per se*. The essence of the use invention does not lie in the substance *per se*, but in the application of its feature. Hence, a use invention is an invention of process, and its claim a process claim.

If substance *B* is invented by making use of substance *A*, the application for a patent shall be based on substance *B per se*, and its claim is a product claim rather than use claim.

The examiner shall take notice of the wording to distinguish a use claim from a product claim. For example, "compound *X* for an insecticide" or "the use of compound *X* as an insecticide" is a wording used in use claim, which is of type of process claim, while the wording "an insecticide made of compound *X*" or "the insecticide containing compound *X*" is not a use claim, but a product claim.

It shall also be clarified that "the use of compound *X* as an insecticide" should not be construed as equivalent to "the compound *X* for an insecticide". As the latter is a product claim defining the use, it is not a use claim.

#### 3.5.2 Claim of Medical Use of Substance

An application for a patent relating to the medical use of a substance shall not be allowed if its claim is drafted in the wording "use of a medicament for the treatment of diseases", "use of a medicament for diagnosis of diseases" or "used as a medicament", because such claim is one for "method for the diagnosis or for the treatment of diseases" as referred to in Article 25.1(3) of the Patent Law. However, since a medicament and a method for the manufacture thereof are patentable according to the Patent Law, it shall not be contrary to Article 25.1(3) of the Patent Law if an application for a patent for the medical use of a substance adopts pharmaceutical claim or use claim in the form of method for preparing a pharmaceutical, such as "use of a medicament for the manufacturing of a medicament", "use of



a medicament for the manufacturing of a medicament for the treatment of a disease”.

The above – mentioned use claim in the form of method for manufacturing a medicament may be drafted as “use of compound X for manufacturing a medicament for the treatment of disease Y ” or the like.

Art. 26.3

#### 4. Sufficient Disclosure of Chemical Invention

##### 4.1 Disclosure of Chemical Product Invention

Here, the word “chemical product” includes compound and composition. Where the claimed invention is a chemical product itself, the description shall disclose the identification, preparation and use of the chemical product.

###### (1) Identification of a chemical product

Where the invention relates to a compound, the description shall indicate the chemical name and the structural formula (including various function groups, molecule steric – configuration and so on) or the molecular formula of the said compound. The explanation of the chemical structure shall be clear enough to enable a person skilled in the art to identify the compound. In order to clearly distinguish the compounds in the application from the compounds in the existing technology, the description shall disclose the chemical/physical property parameters (including the various qualitative and quantitative data and spectrum) relating to the technical problem which the invention is intended to resolve. Moreover, in the case of a polymeric compound, besides the name, the structural or molecular formula of its repeating units that are to be disclosed according to the same requirements as those of the above – mentioned compound, the description shall properly disclose its molecular weight and the distribution thereof, the arrangement state of its repeating units (such as homopolymeric, copolymeric, block – polymeric or graft – polymeric state), etc.. If the polymeric compound cannot be completely identified by these structural elements, the property parameters, such as crystallinity, density and second – order transition point, shall also be disclosed.

As for the invention of a composition, besides the components of the composition, the description shall disclose the chemical and/or physical state of each component, the range of selection of each component, the range of content of each component and its effect on the property of the composition.

(2) Preparation of chemical product

The description of a chemical product invention shall disclose at least one preparation method. The explanation of the preparation method shall disclose the raw material, procedures and conditions and the specifically used equipment in the method so as to make it possible for a person skilled in the art to carry it out. In the case of a compound invention, the example of its preparation is also required.

(3) Disclosure of the use and the technical effect of chemical product

In an application relating to a chemical product, the use and practical effect of the product shall be sufficiently disclosed. Even if the structure of the compound has been confirmed for the first time, at least one use of the compound shall be disclosed. If the structure of a new compound is similar to that of a known compound, the use and practical effect of the new compound shall be sufficiently disclosed. See the examples in Section 5.5 (3) of this Chapter for how to evaluate the structural similarity.

For a new pharmaceutical compound or pharmaceutical composition, its specific medical use, pharmaceutical effect, effective amount and the method of administration shall be disclosed. The qualitative or quantitative data of the laboratory test (including animal test) or clinical test shall be sufficiently provided for a person skilled in the art to be convinced that the technical solution of the invention resolves the technical problem and produces the effect as expected. The effective amount, method of use or method of preparation shall be disclosed to such an extent that a person skilled in the art can carry it out.

The method used to test the property data showing the effect of the invention shall be explained, and the method should be a method commonly used or is standard in the relevant field of technology. If it is a special method, the explanation of it shall be made to enable a person skilled in the art to carry it out.

#### 4.2 Disclosure of Chemical Process Invention

(1) For a chemical process invention, regardless of a process for preparing a substance or any other process, the substance of the raw material, the procedures and processing conditions adopted in the process shall be disclosed. Where necessary, the effect of the process on the property of the title

substance shall be disclosed, so as to enable a person skilled in the art, when carrying out the invention, to resolve the problem which the invention is intended to resolve according to the process disclosed in the description.

(2) For the substance of the raw material used in the process, not only the chemical components and property parameter(s) etc., but also its source, shall be disclosed to make it identifiable. For a new substance of raw material which cannot be obtained in the prior art, the process of its preparation shall be disclosed, otherwise the invention shall be regarded as contrary to the provision of Article 26.3 of the Patent Law. If the substance of the raw material is a natural substance, besides its origin, disclosure shall be made of its basic chemical components or the basic parameter(s) capable of identifying the said substance.

#### 4.3 Mode of Carrying Out Invention

(1) The number of embodiments needed in the description depends on the extent to which the technical features are generalized in the claim, namely, how the parallel elements and the range of selected values of data are generalized. 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 skilled in the art to understand how to carry out the invention and to assess the feasibility of the scope defined by the claims.

(2) It is not permissible for an applicant to introduce into the description any embodiment submitted after the date of filing. In particular, any content relating to the scope of protection is not permissible to be introduced into the claims. Any embodiments submitted after the date of filing only serves as reference for the examiner to assess the novelty, inventiveness and practical applicability.

### 5. Novelty and Inventiveness of Chemical Invention

#### Art. 22.2

#### 5.1 Novelty of Compound

This Section also applies to other substances.

(1) For a compound claimed for protection in an application for patent, if it has been referred to in a document of the prior art in a manner that a person skilled in the art can manufacture or separate it according to the teachings of the document, the

compound does not possess novelty. The word “refer to” mentioned above means: to clearly define or explain the component by i) the chemical name, ii) the molecular formula (or structural formula), iii) the physical/chemical parameter(s), and/or iv) the method of preparation (including the raw material of the said compound).

(2) For a compound, If only part of the content of i) – iv) mentioned above is disclosed in a document of the prior art and a person skilled in the art is unable to understand how to obtain the said compound from the said document or common general knowledge, the document can not be used to destroy the novelty of the said compound.

(3) If it is difficult to identify the name and the molecular formula of a compound, the physical/chemical parameter or any other parameter used to identify a compound disclosed in a document of the prior art may be used to destroy the novelty of the compound, provided that, guided by the document, a person skilled in the art may produce or separate the product.

(4) A general formula cannot destroy the novelty of a specific compound included in the general formula. However, the disclosure of a specific compound destroys the novelty of a claim for said general formula containing the said specific compound, but it does not affect the novelty of a compound other than the specific compounds contained in the said general formula. A series of specific compounds may destroy the novelty of the corresponding compounds in the series. The compounds in a range (such as  $C_{1-4}$ ) destroy the novelty of the specific compounds at the two ends of that range ( $C_1$  and  $C_4$ ). However, if the compound  $C_4$  has several isomers, the compounds  $C_{1-4}$  can not destroy the novelty of each single isomer.

(5) The existence of a natural substance *per se* does not destroy the novelty of the invented substance. A natural substance destroys the novelty of the said invented substance only when it is known in the prior art and is identical with the invented substance in structure and morphology or when it is equivalent directly to the invented substance.

#### Art. 22.2

#### 5.2 Relation Between Open or Close – Ended Mode of Composition Claim and Novelty

Suppose composition A of ( $a + b + c$ ) is disclosed in an earlier application or prior art, the subject matter of a later appli-

cation for a patent for invention relates to composition B of ( $A + B$ ), the two applications are intended to resolve the same technical problem. The claim for composition B possesses novelty if it is presented in a close – ended mode claim, i. e. it is described as “consisting of  $A + B$ ”. It does not possess novelty if it is presented in an open – ended mode claim as “containing  $A + B$ ”. If the exclusive method is used in the claim of composition B, i. e. , when it is indicated that “ $C$ ” is not contained, composition B possesses novelty.

Art. 22.2

### 5.3 Novelty of Chemical Product Characterized by Process or by Physical/Chemical Parameters

For the claim of a chemical product characterized by process, if compared with the prior art, the difference of the claim lies only in process of preparation, having neither parameters which may be used to prove its novelty, nor indications of any change in its function and/or nature resulting from the difference of the process, then the product claim characterized by the process does not possess novelty as required in Article 22.2 of the Patent Law.

For the claim for a chemical product characterized by physical/chemical parameter(s), if it is impossible to compare the product defined by the said parameter(s) with those in the prior art based on the parameter(s) provided and to determine the difference between the product defined by the said parameter(s) and those in the prior art, the product claim characterized by the said parameters does not possess novelty as required in Article 22.2 of the Patent Law.

Art. 22.2

### 5.4 Novelty of Use Invention of Known Substance

A known substance is not rendered novel merely because a new application thereof has been put forward. For example, if substance  $X$  is known as a detergent, then the substance  $X$  used as a plasticizer does not possess novelty. However, the known substance does not destroy the novelty of its new use if the new use *per se* is an invention. This is because such use invention is an invention of process of use, the contribution made by the inventor lies in how to use the substance rather than the substance *per se*. For example, the said substance  $X$  is originally used as a detergent. Then, someone discovered from research that it can be used as a plasticizer after adding to it cer-

tain additives. Then its preparation, the kind of additives selected and the proportion etc. are the technical features of the process of use. Under such circumstances, the examiner shall assess whether the process *per se* possesses novelty and inventiveness and shall not reject the use invention on the ground that substance X is known.

## Art. 22.3

## 5.5 Inventiveness of Compound

(1) When a compound is novel, not similar in structure to a known compound, and has certain use and effect, the examiner may deem it to possess inventiveness without requiring that it shall have an unexpected use and effect.

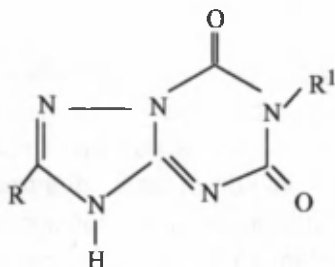
(2) For a compound that is similar in structure to a known compound, it must have unexpected use or effect for it to possess inventiveness. The said unexpected use or effect could be a use different from that of the known compound, the substantial progress or improvement of a known effect of a known compound, or a use or effect which is not clear in the general knowledge or cannot be deduced from the general knowledge.

(3) When whether two compounds are similar in structure has relation to do with the technical field of the compounds, the examiner shall apply different criteria to different technical fields. The following are some examples:

Example 1:

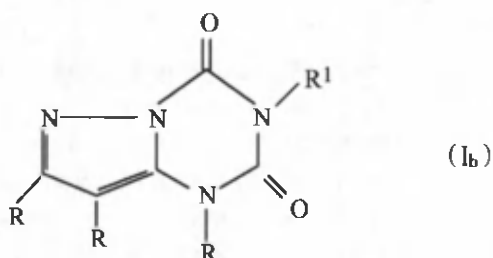
The compounds with similar structures must have the identical basic core structure or basic rings,

Prior art:



(L)

Application:



As the structure of (I<sub>b</sub>) is not similar to that of (I<sub>a</sub>), (I<sub>b</sub>) possesses inventiveness; and evidence is not necessary to show that (I<sub>b</sub>) has an unexpected use or effect compared with (I<sub>a</sub>).

Example 2:

Prior art:  $\text{H}_2\text{N}-\text{C}_6\text{H}_4-\text{SO}_2\text{NHR}^1$  (I<sub>a</sub>)

Application:  $\text{H}_2\text{N}-\text{C}_6\text{H}_4-\text{SO}_2-\text{NHCONHR}^1$  (I<sub>b</sub>)

Sulfonamide (I<sub>a</sub>) is an antibiotics, and sulfonylurea (I<sub>b</sub>) an antidiabetic. The two are similar in structure but different in pharmaceutical effect. The invention possesses inventiveness.

Example 3:

Prior art:  $\text{H}_2\text{N}-\text{C}_6\text{H}_4-\text{SO}_2\text{NHCONHR}^1$  (II<sub>a</sub>)

Application:  $\text{H}_3\text{C}-\text{C}_6\text{H}_4-\text{SO}_2\text{NHCONHR}^1$  (II<sub>b</sub>)

The structure of amino-sulfonylurea (II<sub>a</sub>) is similar to that of methyl-sulfonylurea (II<sub>b</sub>). Their difference lies in  $\text{NH}_2$  and  $\text{CH}_3$  only. Being short of unexpected effect, (II<sub>b</sub>) has no inventiveness.

(4) It should be noted that the inventiveness of a compound ought not be denied simply on the grounds of structural similarity. It is necessary to further explain that its use or effect can be expected or is predictable, or that a person skilled in the art is able to produce or use that compound without any inventive work.

(5) If the effect of a technical solution is caused by something known and inevitable, the technical solution does not possess inventiveness. For example, an insecticide A-R is in the prior art, wherein, R is  $\text{C}_{1-3}$  alkyl. It has been pointed out in the prior art that the effectiveness of insecticide is improved with the increase of the number of atom in the alkyl. If the insecticide in an application is A- $\text{C}_4\text{H}_9$ , the effectiveness has been obviously improved compared with the prior art. The application does not possess inventiveness because it has been pointed out in the

prior art that the improved effectiveness of the insecticide is inevitable.

**Art. 22.3****5.6 Inventiveness of Use Invention of Chemical Substance****(1) Inventiveness of use invention of a known substance**

The prerequisites for a use invention of a known substance to meet the requirements of inventiveness are:

- (i) A new property of the substance is found;
- (ii) The new use based on that property produces advantageous effect; and
- (iii) That new property cannot be derived or expected from the structure, composition, molecular weight or physical/chemical property of the substance in an obvious way.

**(2) Inventiveness of use invention of new substance**

A use invention of a new chemical substance is regarded as possessing inventiveness if the use described in the application has an advantageous effect and cannot be expected from the known substance having a similar structure or composition.

**5.7 Test of Comparison**

When assessing the effect of an invention, the applicant shall be required to submit a test of comparison according to the following circumstances.

(1) For a new compound, if the relevant property or function of a known compound structurally similar to it is not mentioned in the document of the prior art or only the completely different property or function of the compound structurally similar to it is mentioned (for example, the function of the new compound in the application is fire-retardant, but the function of the compound in the prior art which has a similar structure is plastification), it is not necessary to invite the applicant to submit a test of comparison. If same property or function is mentioned in the prior art and the examiner has doubts on the inventiveness of the invention, a test of comparison must be provided to prove the existence of a new unexpected effect. For example, where the range of a certain numerical value defined in the application is close to that in the prior art, a test of comparison must be submitted. The prior art used in the comparison must be the closest one.

(2) For a new compound, if it is mentioned in the document of the prior art that similar function resides in a structurally similar



compound (for example, the function of the new compound disclosed in the application is pain relief, but the function of the compound in the prior art which is similar in structure to that of the new compound is anesthesia), a test of comparison is necessary to prove the effect of the invention only when a person skilled in the art can expect that the known structurally similar compound in the prior art has the same function as that of the new compound (such as pain relief).

(3) It should be noted that it is usually difficult for an applicant to conduct a test of comparison for the reasons of economy and time. Therefore, the applicant shall not be required to conduct a test of comparison unless it is absolutely necessary, and shall be allowed by the examiner to prove the new unexpected effect with other evidence.

Art. 31.1

## 6. Unity of Chemical Invention

Rule 35

### 6.1 Unity of Invention of Markush Claims

#### 6.1.1 Basic Principle

Where the alternatives in a Markush claim are of a similar nature, the claim may be regarded as being in conformity with the requirements of unity of invention. Such an alternative is called Markush elements. The Markush elements may be either chemical or non-chemical. Where the Markush grouping is for alternatives of compounds, they shall be regarded as being of a similar nature and at the same time the Markush claim possesses unity of invention if they meet the following standards:

(1) All alternative compounds possess a common property or activity; and

(2) All alternative compounds possess a common structure, i. e., they share a common main structure unit; or under the circumstances that they do not have a common structure, all of the alternative compounds are regarded as belonging to the same class of chemical compounds in the relevant technology of the invention.

The term "share a common main structure unit" in (2) mentioned above refers to that the common structure unit occupies a large portion of their structures, and the structure of the main structure unit is definite; or, although it only takes a small portion of the structure, it constitutes the characterized feature compared with the prior art. This structural unit may be either a sin-

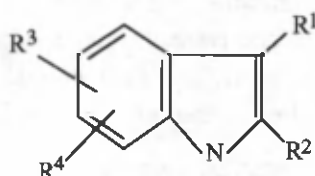
gle component or a combination of the individual components linked together.

The meaning of the term "regarded as belonging to the same class of chemical compounds" in (2) mentioned above is that same result could be expected after each Markush member is substituted one for the other.

### 6. 1. 2 Examples

Example 1:

Claim 1: The compounds of the general formula:

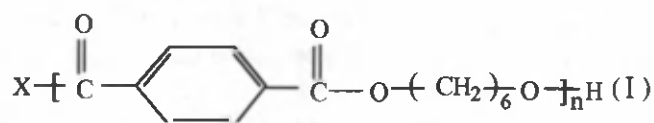


Wherein,  $R^1$  is selected from phenyl, pyridyl, thiazolyl, thioalkyl, alkoxyl and methyl;  $R^2 - R^4$  are methyl, tolyl or phenyl... the compounds are used as a pharmaceutical for increasing the oxygen-intaking capability of blood.

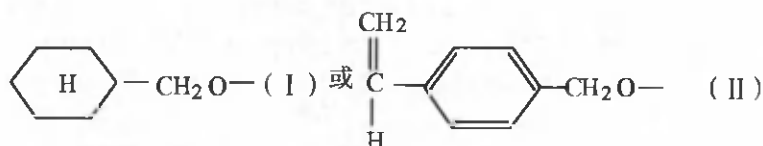
Explanation: In the general formula, indolyl is the main structure unit common to all the Markush compounds, and all the compounds have the same use. Therefore, this Markush claim possesses unity of invention.

Example 2:

Claim 1: The compounds of general formula:



Wherein,  $100 \geq n \geq 50$ , X is:

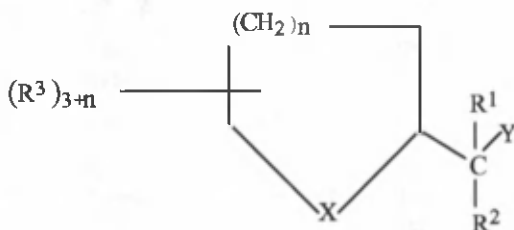


Explanation: It is indicated in the description that the compound is prepared via esterifying the terminal group of known polyhexamethylene terephthalate. It possesses anti-pyrolysis property when it is esterized into (I). However, when it is esterized into (II), it does not possess the anti-pyrolysis prop-

erty due to the existence of " $\text{CH}_2 = \text{CH} -$ ". Therefore, ( I ) and ( II ) have no common property and lack unity of invention.

Example 3:

Claim 1: A nematocide composition comprising a compound with the following general formula as an active component:



Wherein,  $n = 1, 2$  or  $3$ ;  $X = \text{O}, \text{S}$ ;  $\text{R}^3 = \text{H}, \text{C}_{1-6}\text{alkyl}$ ;  $\text{R}^1$  and  $\text{R}^2 = \text{H}, \text{halogen}, \text{C}^1 - \text{C}^3\text{alkyl}$ ;  $\text{Y} = \text{H}, \text{halogen}, \text{ammonium}; \dots$

Explanation: Although all the compounds in this formula have the same function of killing nematode, the structures of their main structure unit are not fixed, i. e., the main structure unit may be five -, six - or seven - member rings respectively, and they belong to heterocycles in two different classes; hence, this Markush claim does not possess unity of invention.

Example 4:

Claim 1: A herbicide composition including the mixture of compounds A and B in effective amount, a diluent or inert carrier, wherein, A is 2, 4 - dichlorophenoxyacetic acid and B is selected from the following compounds; cupric sulfate, sodium chloride, ammonium sulfamate, sodium trichloroacetate, dichloropropyl acid, 3 - amino - 2,5 - dichlorobenzoic acid, diphenamide, ioxynil, 2 - (1 - methyl - n - propyl) - 4,6 - dinitrophenol, dinitroaniline and triazine.

Explanation: Under such circumstances, the same result cannot be achieved after substituting the compounds of these Markush elements B for each other; hence, they cannot be regarded as compounds of the same class in the relevant technology of this invention, but compounds of the following different classes: (a) inorganic salt; cupric sulfate, sodium chloride, ammonium sulfamate; (b) organic salt or acid; sodium trichloroacetate, dichloropropyl acid, 3 - amino - 2, 5 - dichlorobenzoic acid; (c) amide; diphenamide; (d) nitrile; ioxynil; (e) phenol; 2 - (1 - methyl - n - propyl) - 4,6 - dinitrophenol; (f) amine; dinitroaniline; and (g) heterocycle; triazine. Ac-

cordingly, the inventions claimed in claim 1 do not possess unity of invention.

Example 5:

Claim 1: A hydrocarbon catalyst for gaseous oxidation comprises X or X + A.

Wherein,  $\text{RCH}_3$  is oxidized to  $\text{RCH}_2\text{OH}$  with X;  $\text{RCH}_3$  is oxidized to  $\text{RCOOH}$  with X + A. These two catalysts have the same component X and the same function—for oxidation of  $\text{RCH}_3$ . Although X + A makes the oxidation of  $\text{RCH}_3$  more sufficient, the function is the same, and they possess unity of invention.

## 6.2 Unity of Invention Between Intermediate Product and Final Product

### 6.2.1 Basic Principle

(1) An intermediate and a final product possess unity of invention if the following two conditions are met:

(i) The intermediate and the final product have the same basic structure unit, or their chemical structures are technologically closely interrelated, and the basic structure unit of the intermediate is incorporated into the final product;

(ii) The final product is prepared or separated directly from the intermediate.

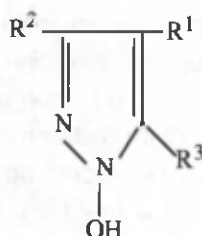
(2) For the different intermediates used in the several processes for the preparation of the same final product, if these different intermediates possess the same basic structure unit, they could be claimed for protection in one application.

(3) The different intermediates of different structural parts of the same final product shall not be claimed in the same application.

### 6.2.2 Examples

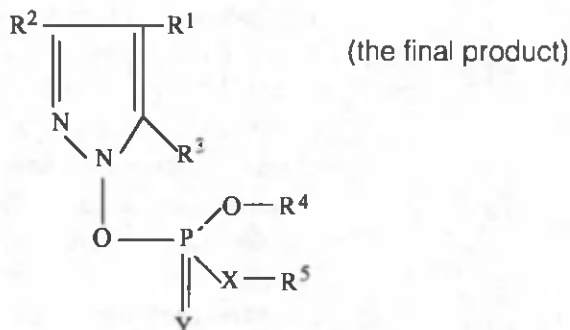
Example 1:

Claim 1:



(the intermediate)

Claim 2;



Explanation: The chemical structures of the intermediate and the final product mentioned above are technically closely related, the basic structure unit of the intermediate is incorporated into the final product, and the final product can be prepared directly from the intermediate; therefore, claim 1 and claim 2 possess unity of invention.

Example 2:

Claim 1: An amorphous polyisoprene (the intermediate)

Claim 2: A crystalline polyisoprene (the final product)

Explanation: In this example, the crystalline polyisoprene is obtained directly by way of stretching the amorphous polyisoprene. As their chemical structures are identical, they possess unity of invention.

## 7. Special Issues on Inventions Relating to Biotechnology

### 7. 1 Patentability of Biological Material *per se*

#### 7. 1. 1 Definition of Biological Material

"Biological material" in this Section refers to any material which has genetic information and is capable of self-replication or being replicated in biological system, including, among other things, gene, plasmid, micro-organism, and animal or plant cell lines.

#### 7. 1. 2 Whether Biological Material *per se* an Object of Patent Protection

Art. 25. 1(4)

##### 7. 1. 2. 1 Micro-Organism

Microorganism includes, among other things, bacterium, actinomycete, fungus, virus, protozoon and algae. It is stipula-

ted in Article 25.1(4) of the Chinese Patent Law that no patent right shall be granted for animal varieties and plant varieties. Because micro-organism is neither animal nor plant, it is not listed in Article 25.1(4) of the Patent Law. A micro-organism existing in the natural world without the involvement of any human technical treatment is, however, a scientific discovery and does not possess industrial applicability. Hence, It shall not be granted patent right. Micro-organism *per se* constitutes an object of patent protection only when it is isolated into pure culture and possesses particular industrial application.

**Art. 25.1(1)****7.1.2.2 Genes**

Gene is a DNA sequence that has a particular physiological function. No matter it is a gene or a DNA fragment, it is, in essence, a chemical substance, and the gene isolated or extracted from an organism is a natural substance.

As stated in Section 2.1 of this Chapter, to find, in the nature, a gene or its DNA fragment existing in its natural state is mere discovery. This falls into "scientific discoveries" as provided in Article 25.1 of the Patent Law and is not patentable. However, a gene or a DNA fragment *per se* and the process to obtain them are objects of patentable invention if a gene or a DNA fragment is isolated or extracted, for the first time, from the natural world, if its base sequence is unknown in the prior art, can be definitely characterized and has a value of industrial application.

Human genes originate from the human body. They are different from the other genes in that they carry with them the human genetic information. If the base sequence of a gene or DNA fragment isolated or extracted for the first time from the human body is unknown in the prior art, can be definitely characterized, and has a value of industrial application, the said human gene shall then be eligible for patent protection.

**Art. 25.1(4)****7.1.2.3 Transgenic Animal and Plant**

It is stipulated in Article 25.1(4) of the Patent Law that no patent right shall be granted to animal varieties and plant varieties.

Transgenic animal and plant are those obtained by biological method, such as DNA recombination technology of the genetic engineering. In accordance with the provision of Article

25.1(4) of the Patent Law, no patent right shall be granted to them.

Art. 5

#### **7.1.2.4 Biotechnological Inventions Excluded from Patent Protection**

For an invention relating to biotechnology, if the commercial development of which is contrary to the social morality or detrimental to public interests, it shall be regarded as an object as provided in Article 5 of the Patent Law and shall not be granted patent right.

Following inventions shall be regarded as non – patentable inventions as mentioned above:

(1) Processes for cloning human beings and the human beings thus cloned;

(2) Processes for modifying the germ line genetic identity of the human beings;

(3) Use of human embryos for industrial or commercial purposes;

(4) Processes for modifying the genetic identity of animals which are likely to cause pain to them without any substantial medical benefit to human beings or animals, and animals obtained from such processes.

Art. 22.4

#### **7.2 Repeatability of Inventions Relating to Biological Material**

In the field of micro – organism of biological material, since some inventions cannot be repeated, they do not possess industrial applicability, and shall not be granted patent right.

##### **7.2.1 Processes for Screening Particular Micro – Organisms from Natural Environment**

Under most circumstances, the process to screen a particular micro – organism from the natural environment is not repeatable because it is limited by the objective condition and is very random. For example, a particular micro – organism has been isolated and screened from the soil of X place, X County, X Province. The indeterminate geographic position, constant change of the natural and artificial environment and the contingency of the existence of such microorganism even in the same piece of soil may render it impossible to repeatedly screen out the micro – organism with the exact same biochemical hereditary feature in the same species of the same genus within the valid

term of twenty years of the patent right. Therefore, the process for screening a particular micro – organism from natural environment generally does not possess industrial applicability. Unless the applicant can provide sufficient evidence to prove the repeatability of the process, no patent right shall be granted to it.

#### **7. 2. 2 Processes for Producing New Micro – Organism through Artificial Mutagenesis by Physical /Chemical Process**

This type of process mainly depends on the random mutation of the microorganism occurring under the condition of mutagenesis. This mutation is in fact a change of one or more bases during DNA replication, and a bacterial strain with certain characteristics is then screened out. Because the base changes at random, even if the condition of mutagenesis has been clearly disclosed, it is difficult to achieve exactly the same result by repeating the condition of mutagenesis. Under most circumstances, such process does not comply with the provision of Article 22. 4 of the Patent Law. Unless the applicant provides sufficient evidence to prove that the micro – organism with desired characteristics can be definitely produced by mutagenesis under certain mutagenic condition, no patent right shall be granted for this type of processes.

#### **7. 3 Deposit of Biological Material**

(1) It is stipulated in Article 26. 3 of the Patent Law that the description shall set forth the invention or utility model in a manner sufficiently clear and complete so as to enable a person skilled in the art to carry it out. In other words, the description shall sufficiently disclose in writing the invention for which the patent protection is sought. In the particular field of biotechnology, because it is sometimes difficult to describe the specific feature of a living body in writing, the biological material itself cannot be made available even if there is such a description, a person skilled in the art may remain unable to carry out the invention. Thus, in order to meet the requirement as set forth in Article 26. 3 of the Patent Law, the biological material involved in the invention shall be deposited according to the requirement.

Where a biological material, which is involved in the application and indispensable for the invention to be completed, is not available to the public and has not been deposited according to Rule 25 of the Implementing Regulations of the Patent Law



by the applicant, or although it has been deposited according to the requirement, a receipt of deposit and the viability proof provided by the depositary institution has not been submitted at the time of filing, or, at the latest, within four months from the date of filing, the examiner shall reject the application for its non-compliance with the provisions of Article 26. 3 of the Patent Law.

Rule 25(3)

Where the application for a patent relates to a biological material which is not available to the public, it shall indicate, in the Request and the description, the taxonomic denomination of the biological material, the name and address of the depositary institution, the date on which the sample of the biological material is deposited and the accession number of the deposit. Where the biological material has been deposited with a depositary institution designated by the State Intellectual Property Office according to Rule 25 of the Implementing Regulations of the Patent Law, the date on which the sample of the biological material is deposited, the name and the abbreviation of the depositary institution and the accession number of the deposit shall be indicated when the biological material used in the invention is mentioned for the first time in the description. Moreover, such information shall be presented in the explanatory notes of the drawings in the description.

Rule 25

(2) "Not available to the public" mentioned in Rule 25 of the Implementing Regulations of the Patent Law refers to the biological material held by an individual or entity, deposited with a depositary institution not for the purpose of patent procedures and not released to the public; or the biological materials not available to the public before the date of filing (priority date), e. g., new micro-organisms created by means of screening, mutation, etc. which cannot be repeated. All those biological materials shall be deposited.

The following are the circumstances in which a biological material shall be regarded as available to the public and the deposit thereof is not required: the biological material commercially available to the public at home and abroad; biological materials deposited with a depositary institution recognized by the patent offices of various countries or by international patent organizations for the purposes of patent procedures, and have been published in the Patent Gazette or patents earlier than the priority date or filing date of the application filed in China; the biological material that must be used in a patent application is disclosed in

a non – patent documentation before the date of filing , with the source of the documentation indicated in the description , the public access to the biological material described , and the proof of guaranteeing the biological material accessible to the public for twenty years from the filing date provided by the holder of the biological material.

(3) For the biological materials deposited with the depositary institution designated by the State Intellectual Property Office , the institution shall confirm its viability. Where the biological material is confirmed dead , polluted , inactive , or variant , the applicant should deposit the biological material identical with that initially deposited together with the original sample , and notify the Patent Office. The latter deposit is then acknowledged as the continuation of the original deposit.

(4) The depositary institutions designated by the State Intellectual Property Office refer to the international depositary institutions for biological material samples acknowledged by the Budapest Treaty , including the Center for General Micro – organism of the Administration Committee of the China Micro – biological Culture Collection (CGMCC) based in Beijing and the China Center for Type Culture Collection (CCTCC) based in Wuhan.

#### 7. 4 Writing of Claim

##### 7. 4. 1 Description of Micro – Organism

Rule 20. 1

(1) A micro – organism involved in a claim shall be described according to the micro – biological taxonomic denomination. It shall be described by its Chinese denomination if it has a specific Chinese name , and its Latin scientific name be also provided in brackets where it is first mentioned. Where the micro – organism has been deposited with a depositary institution designated by the State Intellectual Property Office , the abbreviation of that institution and the access number shall also be indicated in the description of the micro – organism.

Art. 26. 4

(2) If neither a specific mutant strain , nor a corresponding mode for it to be carried out is mentioned in the description , any claim for that mutant strain and its derivative of a certain micro – organism shall not be permissible.

##### 7. 4. 2 Presentation of Vectors for Genetic Engineering

Art. 26. 4

Claims shall clearly define the vector to be used. If the vec-

Rule 20. 1           tor used is known, it shall be described in its known name, and the document having disclosed the vector shall be indicated in the description. If the vector used is new, it must be specifically described in the description, for example, by way of structural representation, explanation of the process for obtaining it or disclosure in any other manner which clearly defines the vector used.

#### **7. 4. 3 Presentation of DNA**

Rule 20. 1           The claims shall clearly define the DNA involved. It may be stated as follows:

- (1) provide directly the nucleotide sequence of the DNA;
- (2) where the nucleotide sequence of the DNA is unknown, the DNA can be defined with its preparation method and characteristics;
- (3) DNA known in the prior art may be presented by its known name, with the document disclosing the DNA with such name indicated in the description.

#### **7. 4. 4 Presentation of Protein**

Rule 20. 1           As protein is a substance composed of amino acids in a certain sequence, its structural form is basically the same as the DNA composed of the nucleotide in a certain sequence. For the definition of protein involved in claims, see Section 7. 4. 3 of this Chapter.

### **7. 5 Writing of Description**

#### **7. 5. 1 Disclosure of Micro – Organism**

Art. 26. 3  
Rule 25           (1) The deposited micro – organism shall be described by the strain denomination, the species denomination and genus denomination in accordance with micro – biological nomenclature. Where it is not identified with a species denomination, a genus denomination shall be provided. The Latin scientific denomination of a micro – organism involved in the invention shall be provided in brackets when it is referred to for the first time in the description. Where that micro – organism has been deposited with the depositary institution designated by the State Intellectual Property Office according to Rule 25 of the Implementing Regulations of the Patent Law, the date of deposit, the title and abbreviation of the depositary institution and the access number

of the deposit shall be indicated in the description according to paragraph 3 of Section 7.3(1) of this Chapter. In the other parts of the description, the micro – organism deposited may be represented by the abbreviation of the depositary institution and the access number of the micro – organism, such as staphylococcus Aureus CCTCC8605.

(2) Where the micro – organism used is a new species, its taxonomic characteristics shall be described in detail, and the reason to classify it as a new species shall be clarified, and the relevant document on which the classification is based should be indicated.

#### **7. 5. 2 Disclosure of Vector and DNA of Genetic Engineering**

Art. 26. 3

A clear and complete explanation of the vector and DNA involved shall be given in the description. For a known vector and DNA, the relevant document shall be indicated. The new vector and DNA shall be described in respect of its specific structure, sequence, preparation method or characteristics.

#### **7. 5. 3 Sufficient Disclosure of Inventions Relating to DNA Fragment, Gene, Peptide and Protein**

Art. 26. 3

As a general rule in chemistry, inventions relating to a DNA fragment, a gene, a peptide and a protein shall be sufficiently disclosed.

For any specific technical solution of an invention relating to a DNA fragment, a gene, a peptide and a protein has been presented, if no experimental evidence is provided and that the said technical solution can be established only when it is proved with the result of the experiment, the technical solution shall be deemed incapable of being carried out.

For any invention relating to a DNA fragment, a gene, a peptide and a protein, if the technical solution of the invention is for the purposes of a diagnosis or treatment of diseases, the laboratory test (including animal test) or clinical qualitative or quantitative data of test shall be sufficiently provided for a person skilled in the art to see that the expected purpose or effect of the technical solution of the invention can be achieved. The effective amount, method of use or preparation etc. shall be disclosed to such an extent that a person skilled in the art can carry out the invention. Otherwise, the said technical solution shall be deemed incapable of being carried out.

For any invention relating to a gene or a DNA fragment, only when the gene or the DNA fragment *per se* or the peptide and the protein expressed thereby has satisfied the requirements for disclosure mentioned above, the technical solution of the invention can be deemed capable of being carried out.

Art. 22.2-3

## **7.6 Examination of Novelty and Inventiveness of Inventions Concerning Biological Technology**

### **7.6.1 Inventiveness of Invention Concerning Micro – Organism**

#### **(1) Micro – organism *per se***

For a micro – organism, if its taxonomic characteristics are remarkably different from those of the known species (i.e., a new species), it possesses inventiveness. If for an invention of a micro – organism, though there is no substantial difference between the taxonomic characteristics of the micro – organism and those of the known species, so long as the micro – organism produces technical effects that cannot be expected by a person skilled in the art, it possesses inventiveness.

#### **(2) Invention relating to application in respect of micro – organism**

An invention relating to the application in respect of a micro – organism does not possess inventiveness if the micro – organism used in the invention is a known species of the same genus as another known micro – organism of the same use. However, if the invention using the micro – organism produces technical effects unexpected of the invention using the latter micro – organism, the invention using the former micro – organism possesses inventiveness.

An invention relating to the use of a micro – organism shall possess inventiveness if the micro – organism used in the invention is remarkably different from a known species with taxonomic characteristics (i.e. the micro – organism used in the invention is a new species), even if the use is the same.

### **7.6.2 Genetic Engineering**

#### **7.6.2.1 Novelty**

##### **(1) Genes**

If a protein *per se* possesses novelty, the invention of the gene encoding the protein also possesses novelty.

### (2) Recombinant protein

If a protein as an isolated and purified single substance is known, an invention concerning a recombinant protein defined by a different preparation process and having an identical amino acid sequence does not possess novelty.

### (3) Monoclonal antibody

If antigen A is novel, a monoclonal antibody of antigen A is considered novel. However, if a monoclonal antibody of a known antigen A' is known and if the antigen A involved in the invention has the same epitope as that of A', the monoclonal antibody of the known antigen A' binds to antigen A involved in the invention. In such a case, the invention of the monoclonal antibody of antigen A does not possess novelty.

## 7. 6. 2. 2 Inventiveness

### (1) Gene

Where a protein is known, but its amino acid sequence is not, an invention of a gene encoding the protein does not possess inventiveness if a person skilled in the art can readily determine the amino acid sequence at the time of filing. However, when the gene has a specific base sequence and has advantageous effects compared with other genes having a different base sequence encoding the said protein, which a person skilled in the art cannot expect, the invention of the said gene possesses inventiveness.

If the amino acid sequence of a protein is known, an invention of a gene encoding the protein does not possess inventiveness. However, if the gene has a particular base sequence and has advantageous effects compared with other genes having a different base sequence encoding the said protein, which a person skilled in the art cannot expect, the invention of the said gene possesses inventiveness.

If the claimed structural gene of an invention is the naturally obtainable mutant of a known structural gene and if the claimed gene is derived from the same species as the known structural gene and has the same properties and functions as the known structural gene, then the invention does not possess inventiveness.

### (2) Recombinant vector

If both a vector and an imbedded gene are known, an invention of a recombinant vector obtained by a combination of the

two usually does not possess inventiveness. However, if an invention of a recombinant vector with a specific combination of them can produce unexpected effect compared with the prior art, the invention possesses inventiveness.

**(3) Transformant**

If both a host gene and an imbedded gene are known, an invention of a transformant obtained by a combination of them generally does not possess inventiveness. However, if an invention of a transformant obtained from a combination of them can produce unexpected effect compared with the prior art, it possesses inventiveness.

**(4) Fused cell**

If parent cells are known, an invention of a fused cell produced by fusing the parent cells does not possess inventiveness. However, if the fused cell has an unexpected effect compared with the prior art, the invention of the fused cell possesses inventiveness.

**(5) Monoclonal antibody**

If an antigen is known and it's clearly known that the antigen has immunogenicity (for example, the said antigen clearly has immunogenicity because a polyclonal antibody of the antigen is known or the antigen is a polypeptide with a large molecular weight), the invention of a monoclonal antibody of the antigen does not possess inventiveness. However, if the invention is further defined by other features, and hence has an unexpected effect, the invention of that monoclonal antibody possesses inventiveness.

**7. 7 Requirements Concerning Submission of Computer – Readable Copy of Nucleotide or Amino Acid Sequence Listings**

**Rule 18. 4**

The applicant shall submit the nucleotide or amino acid sequence listings in computer – readable CD or floppy disc.

If the nucleotide or amino acid sequence listings recorded in computer – readable CD or floppy disc submitted by applicant is not consistent with that disclosed in writing in the description and claims, the sequence listings in writing shall prevail.





**Part III**  
**Examination of International**  
**Application Entering National Phase**

Part II  
Description of Instructional  
Application Entering National Phase

## **Chapter 1**

### **Preliminary Examination and Processing of International Application Entering National Phase**

#### **1. Introduction**

Any international application, filed in accordance with the Patent Cooperation Treaty (hereinafter referred to as PCT), desiring to obtain patent protection for invention or utility model in China and so indicated, shall, after going through the procedures in the international phase, proceed to the formalities before the Patent Office for entering the Chinese national phase (hereinafter referred to as the national phase) within the prescribed time limit as prescribed in Rule 101 of the Implementing Regulations and begin the procedures in the national phase. The procedures in the national phase comprise of the following: the procedure of preliminary examination as allowed under PCT, the procedure of national publication, the procedures of substantive examination, grant of patents or rejection of applications taking into account and making references to the results of the international search and the international preliminary examination, as well as all other possible follow-up procedures.

This Chapter deals with the examination to an international application for the entering of the national phase, preliminary examination of the international application in the national phase, and the processing of general matters of an international application in the national phase, etc.. In this Chapter only the explanations and provisions for special matters of the above-mentioned contents are provided. Issues which are the same to other national applications and for which there are no explanation or provision in this Chapter, shall be dealt with by making reference to the provisions in Chapter 1 of Part I and Part V respectively of these Guidelines.

The main tasks of the examination as referred to in this Chapter are the following:

(1) whether or not an international application declaring the entering of the national phase complies with the prescriptions as provided in Rules 100 and 102 of the Implementing Regulations; the procession of the applications which have no effect or the effect of which is ceased in China;

(2) whether or not the translation or documents of the original application of an international application filed at the time

when entering the national phase comply with the prescriptions as provided in Rules 102 and 103 of the Implementing Regulations of the Patent Law; whether or not the said translation and documents are in conformity with the formal requirements as provided in Rule 44 of the Implementing Regulations of the Patent Law, the procession of the applications which do not meet the said requirements;

(3) whether or not the translation of the documents which are amended in the international phase and submitted by the applicant is in conformity with the provisions as provided for in Rule 104 of the Implementing Regulations of the Patent Law, the procession of the applications which do not meet the said requirements;

(4) whether or not the other documents which are related to the application are submitted and are in conformity with the prescriptions as provided in Rules 105, 106, 107, 109 and 110 of the Implementing Regulations of the Patent Law as well as in Articles 18 and 19.1 of the Patent Law; the procession of the applications which have deficiencies.

Specific provisions relating to the processing of such general matters as national publication, receipt of documents and payment of fees, and the establishment of files for international applications are provided in this Chapter in accordance with Rules 111, 113 and 114 of the Implementing Regulations of the Patent Law.

## **2. Examination of the Effect of International Application**

### **2.1 Having No Effect in China**

Any international application which has been accorded a filing date must have gone through the examination conducted by the Receiving Office on whether or not it is in conformity with the provisions of Article 11 of the Treaty and has had an affirmative conclusion. Therefore, so long as an international application designates China, according to the provisions of Rule 100.1 of the Implementing Regulations of the Patent Law, the application shall be deemed as having the effect of a regular national application by the Patent Office and the international filing date accorded by the Receiving Office shall be deemed as the actual filing date in China. The examiner need not and shall not conduct examination again on whether or not it complies with the requirements for receipt of an application as set down in the Patent Law and its Implementing Regulations. Nevertheless, the examiner

shall examine whether or not the international application declaring the entering of the national phase has designated China. The examiner shall, based on the copy of the international application (i. e. , international publication Pamphlet) sent by the International Bureau, confirm that there is the designation of China and that the designation of China is on the front page of the Pamphlet.

The designation of China in an international application shall contain the indication of the kind of protection. The kind of protection sought at the time of entering the national phase shall be the same as that indicated on the front page of the Pamphlet.

Where there is no record of the designation of China in the said Pamphlet of the international application declaring the entering of the national phase, or where the kind of protection recorded in the said Pamphlet regarding the designation of China is inconsistent with the kind of protection indicated in the written statement of the applicant concerning the entry of Chinese national phase( hereinafter referred to as the entering statement), the formalities for entering the national phase shall not be processed for reasons of the fact that the international application has no effect in China or that it has no effect in China in respect to the kind of protection indicated in the entering statement, and the applicant shall be so indicated.

## **2. 2 Loss of Effect in China**

### **2. 2. 1 Loss of Effect Notified by the International Bureau**

PCT Art. 24(1)(i)

PCT Art. 24(1)(ii)

For an international application declaring the entering of the Chinese national phase, if, during the international phase, the "Notification of Withdrawal of International Application" (PCT/IB/307) or "Notification that International Application Considered to be Withdrawn" (PCT/IB/325) has been sent by the International Bureau to the Patent Office as a Designated Office, or where the "Notification of Withdrawal of Designation" (PCT/IB/307) of China of the international application or notification of designation of China "Considered to be Withdrawn" (PCT/IB/324) of the international application has been transferred to the Patent Office as a Designated Office by the International Bureau, and where the effect or the effect in China of the said international application is ceased in accordance with the provisions of Rule 100. 2 of the Implementing Regulations, the applicant shall be notified that the

formalities for entering the Chinese national phase of that international application are not acceptable due to the cease of effect.

### **2. 2. 2 Formalities for Delays in Meeting the Time Limit for Entering National Phase**

PCT Art. 24 ( 1 )  
( iii )

Where an applicant for an international application fails to go through the formalities for entering the national phase ( hereinafter referred to as the entering formalities ) within the time limit as provided in Rule 101. 2 of the Implementing Regulations; or where, though the entering formalities have been performed, there exists such defects as prescribed in Rule 102. 1 of the Implementing Regulations; or where, although the entering formalities have been performed within the time limit as prescribed in Rule 101. 2 of the Implementing Regulations, the surcharge for late entry, at the expiration of the time limit, has not been paid in accordance with the provisions of Rule 101. 2 of the Implementing Regulations, the effect of the said international application ceases in China. The examiner shall notify the applicant that the formalities for entering the Chinese national phase are not acceptable due to the cease of effect.

Where an applicant, before the expiration of the time limit as prescribed in Rule 101. 1 or 101. 2 of the Implementing Regulations of the Patent Law, has gone through part of the entering formalities or where the applicant, after the expiration of the time limit provided in Rule 101. 1 of the Implementing Regulations of the Patent Law and before the expiration of the time limit provided in Rule 101. 2 of the Implementing Regulations of the Patent Law, has completed the entering formalities but has not paid the surcharge for late entry, and at the time when the examiner conducts the examination, the said time limit is not yet expired, the examiner shall notify the applicant that the entering formalities are not acceptable due to defects in the formalities, but the effect of the international application in China does not cease. If the applicant, before the expiration of the prescribed time limit, goes through the entering formalities again and the defects are corrected, the said international application shall remain valid in China.

If, due to delay in meeting the time limit as prescribed in Rule 101. 2 of the Implementing Regulations of the Patent Law, the effect of an international application ceases, and the applicant has submitted a request of restoration of right in accord-

ance with Rule 7.2 of the Implementing Regulations of the Patent Law, the examiner shall notify the applicant that the request is not acceptable according to Rule 102.2 of the Implementing regulations of the Patent Law. If the applicant indicates that the delay in meeting the time limit is caused by force majeure, the examiner shall proceed in accordance with Rule 7.1 of the Implementing Regulations of the Patent Law.

### **2.2.3 Election**

Where an international application elects China before the expiration of the time limit as set forth in the PCT and its Implementing Regulations and if the election still remains valid at the time when the international application enters the national phase, the time limit for going through the formalities for entering the national phase shall be thirty months from the date of priority.

As to whether or not China is elected, it depends on the "Notification of Election" (PCT/IB/331) sent by the International Bureau. As to whether or not China is elected within the prescribed time limit, it depends on the mark made by the International Bureau in the said Notification.

If, after transmitting the "Notification of Election", the International Bureau transmits again the "Notification of Withdrawal of Demand or Elections" (PCT/IB/339) or the "Notification that Demand is Considered not to Have Been Submitted or Made" (PCT/IB/350), and the above notification involves the withdrawal of election or the election deemed not have been made, the election of China is invalid if there is "CN" in the indicated countries.

### **2.3 Notification of National Application Number**

Any international application, which has been confirmed its effect in China after examination and has gone through the entering formalities according to the provisions, shall be allowed to continue its examination and approval procedures in the Patent Office. The Patent Office shall accord to it a national application number, and the notification of national application number shall be issued. In the follow-up examination and approval procedures, the national application number shall be indicated when the formalities are performed by the applicant or the notifications are issued by the examiner.

### 3. Examination of the Documents Submitted at the Time of Entering the National Phase

Rule 101.1(1)  
Rule 103.1  
(3) – (4)

#### 3.1 Written Statement on the Entry of the National Phase (PCT/CN/501)

Rule 100.1

##### 3.1.1 International Filing Date

The international filing date is accorded by the Receiving Office in the international phase. If the international filing date is amended for any reason in the international phase, the amended date shall be regarded as the right one. The international filing date indicated in the entering statement shall be the same as the one written on the front page of the Pamphlet. Where the inconsistency appears, the examiner shall correct it *ex officio* according to the date as recorded in the Pamphlet and notify the applicant accordingly.

The international filing date is deemed as the actual filing date in China.

##### 3.1.2 Kind of Protection

Rule 13.1 of the Implementing Regulations stipulates that "For any identical invention – creation, only one patent right shall be granted". Therefore, when an international application designates China, it shall indicate either "patent for invention" or "patent for utility model" for type of protection, which means the applicant can only choose one from the two. In this respect, it is not permitted to use such words as "invention and utility model" (allowable in some countries). Thus, in respect of China, the kind of protection for an international application has already mentioned when it is filed. The information is carried on the front page of the Pamphlet under "Designated State" transferred by the International Bureau.

As change of kind of protection after the filing of the application is not mentioned under the Patent Law, re-select of the kind of protection is not allowed when an international application enters the national phase. The applicant can only fill in the kind of protection indicated in the original Request of International Application (PCT/RO/101) in the entering statement. In short, the indication of the kind of protection shall be the same as what is recorded in the Pamphlet. Where there is any inconsistency, the examiner shall regard it as a written mistake, correct it *ex officio*



in accordance with what is recorded in the Pamphlet, and notify the applicant accordingly. If the applicant does not agree with what has been corrected, the examiner shall handle the matter in accordance with Paragraph 3, Section 2.1 of this Chapter.

### **3.1.3 Title of Invention**

Except for those few which are decided by the examiner of the International Search Authority, the title of the invention shall be based on the record of the original request of the international application. Where the Request uses languages other than Chinese, in addition to the translation should be exact in expressing the meaning of the title of the invention, it shall be as brief as possible. Where there are no unnecessary words in the translation, the limit of the number of words regarding the title of invention provided in Chapter 1 of Part I of these Guidelines shall not apply.

Where the title of the invention indicated on the front page of the Pamphlet is not what is recorded in the original Request of the international application, but decided by the examiner of the International Search Authority, the title of the invention in the entering statement shall be the translation of the title of the invention decided by the examiner of the International Search Authority.

Where amendments to the title of invention is requested at the time of entering the national phase, it shall be submitted in the form of amendment to application documents. It is not allowed to fill in directly, in the entering statement, the amended title of invention. The national publication does not publish the amended title of invention.

### **3.1.4 Applicant**

#### **3.1.4.1 Determination of Information on Applicant**

Except for changes recorded by the International Bureau in the international phase, the applicant entering the national phase shall be the one indicated in the Request of international application. According to the provisions of the Treaty, where more than one country has been designated in the international application and when there are more than one applicant, different applicants may be indicated for different designated countries. Applicants to be mentioned in the entering statement shall be the applicants for China. Where foreign languages are used in the international

publication, the name or title of the applicant and the address shall be translated into Chinese in an accurate way. The translation of the title of the legal person shall be as standard as possible. The examiner shall check carefully the contents indicated in the entering statement with those that are recorded on the front page of the Pamphlet. If there is any inconsistency, the applicant shall be notified to correct it or to go through necessary formalities.

Where, in the international phase, "Notification of the Recording of a Change" (PCT/IB/306) has been transferred to the Patent Office as the Designated Office by the International Bureau to inform the amendments of applicants or amendments concerning the name or title or address of the applicant, the changes shall be known as being reported to the Patent Office and the amended information shall be filled in directly in the entering statement. The examiner shall read carefully the notification of the International Bureau and check carefully the relevant contents indicated in the entering statement with the amendments recorded in the Pamphlet and the Notification. If there is any inconsistency, the applicant shall be notified to correct it or to go through the necessary formalities.

If the applicant is dead and is recorded by the International Bureau, its name shall not appear in the entering statement at the time of entering the national phase.

According to the provisions of the Patent Cooperation Treaty, the Receiving Office, based on the law of the country, shall check and determine whether the information provided by the applicant concerning its or his nationality or residence is true or not. The information after the examination of the Receiving Office shall be indicated on the front page of the Pamphlet published by the International Bureau. Generally speaking, the examiner of the Patent Office as a Designated Office shall not have question about it any more.

#### **3. 1. 4. 2 Qualification of Applicant**

According to Chapter 1, Part I of these Guidelines, where the applicant is a foreigner (natural person or legal person), the provisions of Article 18 of the Patent Law shall apply to examine whether the applicant is entitled to file an application. Where an international application has only one applicant, the applicant is usually a national or resident of a member state of PCT, or, at

least, a national or resident of a member state of the Paris Convention. Therefore, there is no need to examine whether or not the applicant meets the requirement of Article 18 of the Patent Law. As according to the Treaty, where there are two or more applicants, an international application could be filed when at least one of them is a national or resident of a member state of PCT, it is possible that when the international application is filed, the applicant for China is a national or resident of a non – member state of PCT. Besides, as the Treaty has requirements only for the country to which the applicant filing the international application belongs, and does not have any requirements for the country to which the assignee belongs when there is any change in the applicant, it is possible that the country to which the applicant or some of the applicants belong is not a member state of PCT at the time of entering the Chinese national phase. Under such circumstances, the examination shall be conducted in accordance with the relevant contents in Section 2.1.3.2, Chapter 1 of Part I of these Guidelines. If, after examination, it is determined that all the applicants do not meet the requirements as provided in Article 18 of the Patent Law, the application shall be rejected. If only some of the applicants do not meet the requirements as provided in Article 18 of the Patent Law, such applicants shall be notified to go through the formalities for amendments, the applicants who are not entitled to file the application shall be deleted from the application. Where the applicant refuses to make necessary amendments, the application shall be rejected.

### **3.1.4.3 Translation of the Name of Applicant**

In the international phase, It is stipulated that when the applicant is a natural person, the family name shall be indicate before the given name(s). In the entering statement, the translation of the name of the applicant shall be written in a way that is consistent with the customary practice of the country to which he/she belongs.

Where the applicant believes that the translation of his name in the entering statement is not correct, he may amend it on his own initiative before the completion of the preparatory work of the national publication. If, after examination, the examiner believes that the amended translation of the name is consistent with the name in the original, the amendment shall be accepted, and the

amended translation of the name shall be used in the national publication. If, after the national publication, the applicant requests for amendment of the translation of the name, he shall file an amendment to correct the mistake of the translation and pay the corresponding fee. If, after examination, the examiner believes that the amended translation of the name is consistent with the name in the original, the amended translation of the name shall be used in the later notifications and announcement for grant of patent right.

### **3. 1. 5 Inventor**

#### **3. 1. 5. 1 Determination of Information on Inventor**

Except for the changes that have been recorded by the International Bureau in the international phase, the inventor at the time of entering the national phase shall be the one indicated in the Request of the international application. According to the Patent Cooperation Treaty, where an international application designates more than one country and when there are more than one inventor, different inventors may be indicated for different designated country when necessary. Under such circumstances, the inventor to be indicated in the entering statement shall be the inventor for China. Where the international publication is in languages other than Chinese, the name of the inventor shall be translated into Chinese in an accurate way. The examiner shall check carefully the name of the inventor indicated in the entering statement with what is recorded on the front page of the Pamphlet. If any inconsistency occurs, the applicant shall be notified to correct it or to go through the necessary formalities. Where there is no translation of the name of the inventor in the entering statement, the applicant shall be notified to submit a replacement sheet of the entering statement having on it the translation of the name of the inventor indicated within the prescribed time limit in time.

Where, in the international phase, the "Notification of the Recording of a Change" (PCT/IB/306) has been transferred to the Patent Office as the Designated Office by the International Bureau to inform the amendment of the inventor or the amendment concerning the name of the inventor, the amendment shall be regarded as known to the Office, the amended information shall be filled in the entering statement directly. The examiner

shall read carefully the notification of the International Bureau and check the relevant contents indicated in the entering statement with the amendments recorded in the Pamphlet and the Notification. If any inconsistency occurs, the applicant shall be notified to correct it or to go through the necessary formalities.

Where the inventor for China is dead and is recorded by the International Bureau, its name as the inventor shall still be indicated in the entering statement.

Rule 105.1(1)

**3.1.5.2 No Inventor Mentioned in the International Application**

According to the Patent Cooperation Treaty, if the national laws of all the designated countries of an international application do not require to furnish the name of the inventor at the time of filing a national application, the information of the inventor may be not required in the Request of the international application. In accordance with the provisions of the Implementing Regulations of the Chinese Patent Law, lack of name of inventor in the Request is not a condition for refusing to accept the application, but a defect that can be amended in the later stages.

If the name of the inventor is not mentioned in the Pamphlet of an international application, the name of the inventor shall be added in the entering statement at the time of entering the national phase. If the examiner finds that the name of the inventor is still missing in the entering statement, the applicant shall be notified to furnish a replacement sheet of the entering statement having the name of the inventor indicated within the prescribed time limit. There is no examination to the inventorship of the inventor.

**3.1.5.3 Translation of the Name of Inventor**

In the international phase, the family name of the inventor shall be indicated before the given name(s). The translation of the name of the inventor in the entering statement shall be based on the customary practice of the country to which he/she belongs.

Where the applicant believes that the translation of the name of the inventor in the entering statement is not accurate, it/he may amend it on its/his own initiative before the completion of the preparatory work of the national publication. If, after examination, the examiner believes that the amended translation is consistent with the name in the original, the amendment shall be

accepted and the amended translation of the name shall be used in the national publication. Where there is amendment of the translation of the name of the inventor after the national publication, it shall be filed in the form of correcting mistakes of the translation and pay the corresponding fee. If, after examination, it is believed that the amended translation is consistent with the name in the original, the amended translation shall be used in the announcement for grant of patent right.

### 3. 1. 6 Basis of Examination

In the international phase of an application, the applicant may make amendments to the claims in accordance with Article 19 of the Treaty after receiving the international search report. Such amendments shall be submitted to the International Bureau within the prescribed time limit. During the course of the international preliminary examination, the applicant may also amend the description, drawings and claims in accordance with Article 34 of the Treaty. Such amendment shall be submitted to the International Preliminary Examination Authority. The above procedures are referred to as amendments in the international phase. Rule 109 of the Implementing Regulations of the Chinese Patent Law stipulates that the applicant may amend the description, drawings and claims after going through the entering formalities within the prescribed time limit, which are referred to as amendments in the national phase. Thus, for an international application entering the national phase, in addition to the original application documents, it may contain one or more amended texts. The applicant shall indicate, for the examiners of the Patent Office, the text which shall serve as the basis for examination as to substance, i. e., make a statement concerning the basis for examination. If no amendments have been made both in the international phase and after entering the national phase, the basis for examination shall be the original application. Where there have been amendments either in the international phase or after entering the national phase and the amendments have been indicated in the statement concerning the basis for examination, the text to be used for examination shall be the original application having the corresponding part replaced by the amended documents. Where amendments have been made in the international phase but not indicated in the statement concerning the basis for examination, the amendments shall be regarded as being aban-

done and shall not be taken into consideration in the examination. The statement concerning the basis for examination shall contain indications of the prescribed items in the written entering statement at the time of entering the national phase, indication of the translation amended in the international phase but separately submitted after entering the national phase or indications of amendments made in the national phase in the prescribed form (PCT/CN/521). The latter is a complement and an amendment to the former.

The amendments made under Article 19 of the Treaty in the international phase, referred to in the statement concerning the basis for examination, shall have expression in the Pamphlet. The corresponding contents of the amendments made in accordance with Article 34 of the Treaty shall be attached to the International Preliminary Examination Report. Where it is found that the amendments made in the international phase referred to in the statement concerning the basis for examination do not exist, the examiner shall notify the applicant to amend the relevant contents in respect of basis for examination in the entering statement.

Where amendments of the international application documents have been referred to in the statement concerning basis for examination, the said amended documents or the translation of the amended documents shall be submitted at the same time. If the corresponding documents are not submitted, the examiner shall notify the applicant to submit them within the prescribed time limit. If the documents are still not submitted at the expiration of the time limit, the amendments indicated in the statement shall not be taken into consideration.

### **3. 1. 7 Examination of Other Contents in the Written Statement**

For the contents in the written statement, see Section 5.2.1 of this Chapter for examination on claim to right of priority; see Section 5.4.1 of this Chapter for examination on the indications concerning the deposit of biological materials; see Section 5.3 of this Chapter for examination on non – prejudicial disclosures.

### **3. 2 Translation and Drawings of the Original Application**

In accordance with the provisions of Rule 101.1(3) of the Implementing Regulations of the Chinese Patent Law, where an international application is filed in a language other than Chi-

nese, the Chinese translation of the description, the claims, the text matter of the drawings and the abstract of the original international application shall be submitted at the time of entering the Chinese national phase.

In accordance with the provisions of Rule 101.1(4) of the Implementing Regulations of the Chinese Patent Law, where an international application contains drawings, a copy of the drawings shall be submitted at the time of entering the Chinese national phase.

### 3.2.1 Translation of Description

The Chinese translation of the description shall be consistent with the contents of the description in the Pamphlet transferred by the International Bureau. The translation shall be complete and authentic to the original. The applicant shall not add any content of the amendment in the translation of the original.

The contents in the Pamphlet based on the replace sheet or amendment sheet shall be regarded as the content of the original application. For contents filed as part of the description of an international application, and which has been declared "not to be taken into consideration" after the examination of the Receiving Office and has been indicated as such in the Pamphlet, similar indications shall be made in Chinese in the translation. For example, where references to drawings are made in the description while actually no drawings are furnished in the application.

Where the description (including the drawings) contain contents that are contrary to social morality or public order, or contain other belittling statement which, after the examination of the International Bureau, have been deleted from the international publication, the said contents shall not be added into the translation of the original application again. If such contents appear in the translation again, the applicant shall be notified to correct the mistakes in the translation. Where such contents are not deleted in the international publication and are contained in the translation, provisions of Section 4.1, Chapter 1 of Part I of these Guidelines shall apply.

Where, in the international phase, the description of an international application contains nucleotides or amino acid sequence listings and is furnished as a separate part of the description, its translation shall be furnished also as a separate part and the pages shall be numbered separately. Where the



- PCT Rule 49.5 (a<sup>bis</sup>) text matter of the sequence listing have been included in the main part of the description, no translation of these text matter is needed for such sequence listing.
- PCT Rule 5.2(b)

It is unnecessary to translate the program language of the computer cited in the description. It is sufficient if the translation of the name of the editor and title of the document in the cited reference materials are in consistency with the requirements for national publication in a proper way.

### 3.2.2 Translation of the Claims

The translation of the claims shall be consistent with the content of the claims of the original application recorded in the Pamphlet. If it is found that the translation is obviously inconsistent with the original application, such as having additions or omissions of the claims, the examiner shall notify the applicant to correct the mistakes in the translation.

### 3.2.3 Drawings

In accordance with the provisions of Rule 101.1(4) of the Implementing Regulations of the Chinese Patent Law, where an international application contains drawings, regardless whether or not there are any text matter in the drawings, a copy of the drawings shall be submitted. This provision is made for international applications filed in a language other than Chinese.

Where there is text matter in the drawings and the international publication is made in a language other than Chinese, the text matter shall be translated into Chinese. A new copy of the drawings shall be furnished with translation marked in proper place instead of the original language. Even if the content of the text matter in the drawings does not comply with the provisions of Rule 19 of the Implementing Regulations of the Patent Law, it shall be translated according to the original application. The new drawings shall be identical with the drawings in the Pamphlet and shall meet the format requirements of these Guidelines for drawings.

It is not necessary to translate the word "Fig." in the drawings into Chinese. The same is for the program languages of a computer appeared in the drawings and certain text matter for screen images.

Where the translation of the text matter in the drawings is not furnished or the furnished translation is not complete, the appli-

cant shall be notified to go through the formalities to correct the mistakes in the translation.

Where the copy of the drawings is not submitted, the applicant shall be notified to provide it within the prescribed time limit.

### **3. 2. 4 Translation of Abstract , Drawing of Abstract**

The translation of the abstract shall be consistent with the content of the abstract on the front page of the Pamphlet. Where the examiner of the International Search Authority has amended the abstract submitted by the applicant, the translation of the amended abstract shall be submitted. Where the International Search Report is contained in the Pamphlet A3 of re – publication rather than in the Pamphlet A2 of the first publication, and the content of the abstract on the front page of Pamphlet A3 is different from that of the Pamphlet A2, the translation shall be made on the basis of the content of the abstract in the Pamphlet A3.

The translation shall be as brief as possible on condition that the content of the original application is not changed. So long as there is no unnecessary words or sentences, the examiner shall not request the applicant to delete or delete *ex officio* the translation based on the limit to the number of words in the abstract as provided for in Rule 24.2 of the Implementing Regulations of the Patent Law.

Where the translation of the abstract is not submitted at the time of entering the national phase, the examiner shall notify the applicant to supplement it.

The drawing of the abstract shall be consistent with the drawing selected for the international publication. Where the search report is not contained in the first publication, and the drawing of the abstract in Pamphlet A2 of the first publication is different from that in Pamphlet A3 of the re – publication, the drawing of the abstract for re – publication shall prevail, because it is decided according to the suggestions of the examiner of International Search Authority. Where the drawing of abstract is not submitted at the time of entering the national phase or the drawing of abstract submitted is inconsistent with what is in the Pamphlet, the examiner shall notify the applicant to rectify it.

### **3.3 International Application of International Publication in Chinese**

Rule 101.1(3)

Rule 101.1(4)

For an international application of which the international publication is in Chinese, at the time of entering the national phase, it is necessary to submit only the written entering statement, a copy of the abstract and the drawing of the abstract (where there is a drawing of abstract) of the original application. It is not necessary to submit the copies of the description, claims and drawings.

### **3.4 Entering the National Phase before Expiration of Time Limit**

Rule 108

Since, according to Article 23(1) of the Treaty, "No Designated Office shall process or examine the international application prior the expiration of the applicable time limit under Article 22", the applicable time limit is thirty months from the date of priority. And Article 23(2) of the Treaty also provides that "Notwithstanding the provisions of paragraph (1), any Designated Office may, on the express request of the applicant, process or examine an international application at any time". For the Elected Office, corresponding stipulations are provided in Article 40 of the Treaty.

#### **3.4.1 Early Processing**

According to Rule 108 of the Implementing Regulations of the Patent Law, if the Patent Office is requested to handle and examine an international application before the expiration of thirty months from the date of priority, the applicant, in addition to go through the formalities provided in Rule 101 of the Implementing Regulations, shall have to handle the following:

(1) Submit an express request in accordance with Article 23(2) of the Treaty which shall contain the citation referred to in Article 23(2) of the Treaty and shall indicate his consent of having the national publication first before the international publication when necessary.

(2) Where the International Bureau has not transferred the international application to the Patent Office, to submit the confirmed copy of the international application to the Patent Office, the said copy is a copy of the "home copy" certified by the Receiving Office or the "record copy" certified by the International Bureau.

Where an international application meets the above - men-

tioned requirements, the examiner shall immediately proceed to handle and examine it.

### **3. 4. 2 Suspension**

Where an international application has gone through the formalities for entering the national phase before the expiration of thirty months from the date of priority but has not gone through the necessary formalities provided in Rule 108 of the Implementing Regulations of the Patent Law, in accordance with the provisions of the Treaty, the Patent Office shall suspend to process and examine the international application. The examiner shall check the documents with the list of documents and notify the applicant the decision of "suspension". The process and examination will be restarted until the time limit expires.

### **3. 5 Date of Entering the National Phase**

The date of entering the national phase refers to the date of going through all the entering formalities provided in Rule 101 of the Implementing Regulations of the Patent Office. Where all the formalities are completed within one day, that date shall be the date of entering the national phase. Where the formalities are completed on different dates, the latest day for completing all the formalities shall be the date of entering the national phase.

Where the documents and payment of fees are submitted by fax and it has been indicated that the fees shall be deducted from the account, the date of the arrival of the fax shall be the date of completing the formalities for entering the national phase.

Where the documents and payment of fees are submitted by mail and it has been indicated that the fees shall be deducted from the account, the date when the mail arrives shall be the date of entering the national phase. Where there is delay in mail as indicated in Rule 113.2 of the Implementing Regulations, and after being proved as such, the date of expiration of the time limit shall be the date of completing the formalities for entering the national phase.

Rule 104

## **4. Examination of Translation of Amended Documents in the International Phase**

PCT Art.19

### **4. 1 Translation of Claims Amended According to Article 19 of PCT**

Where according to the statement of the applicant the claims amended in accordance with Article 19 of the Treaty shall be served as the basis for examination, and the international publication of the amendment is in a language other than Chinese, the applicant shall submit its translation at the time of entering the national phase, and at the latest before the complete of the technical preparation of the national publication. In accordance with the provisions of Rule 104 of the Implementing Regulations of the Patent Law, the amended part of the translation submitted after the said period shall not be taken into consideration. The examiner shall issue a notification of non – consideration of the amendment. Where an international application contains the statement of amendment according to Article 19(1) of the Treaty and a request is submitted asking the examiner to take into consideration the said statement, the applicant shall submit the translation of the statement at the same time when the translation of the amended claims is furnished.

The translation of the amended claims (including amendment, addition or deletion of claim) shall be consistent with the content of the corresponding part published in the Pamphlet. For amendments which were submitted in the international phase but were refused by the International Bureau for not being in conformity with the provisions of Rule 46 of the Regulations of the Treaty, they shall not be submitted as amendment under Article 19 of the Treaty at the time of entering the national phase.

The translation of the amendment shall be written on an amendment sheet that can be replaced by the corresponding part of the translation of the original application. The words "Claims (amended according to Article 19 of PCT)" shall be indicated on the top of the first page of the translation of the amended claims. For the translation of the amended documents which are submitted after the entering of the national phase, Form PCT/CN/521 shall be attached. The applicant shall indicate in the Form that it/he intends to use the amended contents as the basis for examination.

The translation of the claims amended according to Article 19 of the Treaty shall be published together with the translation of claims of the original application. The translation of the amended claims shall meet the requirements concerning the form and format of publication as provided in these Guidelines.

Where the translation of the amended documents fails to

meet the above – mentioned requirements, the examiner shall notify the applicant to make necessary rectifications. If the applicant fails to submit the rectifications, the examiner shall issue a notification of non – consideration of the amendment.

Where the claims amended according to Article 19 of the Treaty is also used as the basis for international preliminary examination, and the applicant has submitted it as the translation of the annexes of the international preliminary examination report at the time of entering the national phase, the said translation shall not be published in the national publication.

#### PCT Art. 34

#### 4. 2 Translation of the Amendment According to Article 34 of PCT

Where according to the statement of the applicant, the amendments made in accordance with Article 34 of the Treaty shall be served as the basis for examination, and the amendment is made in a language other than Chinese, the translation of the annexes of the international preliminary examination report shall be submitted at the time of entering the national phase, and at latest before the complete of the technical preparation of the national publication. The amend part of the translation submitted after the said period shall not be taken into consideration. The examiner shall issue a notification of non – consideration of the amendment.

The content of the translation of the amended part shall be consistent with the content of the amendment sheet attached to the international preliminary examination report transferred by the International Bureau. For amendments made in accordance with Article 34 of the Treaty in the international phase but failed to be accepted by the examiner, and have thus not been transferred as the annexes of the international preliminary examination report, the applicant shall not submit such content to the Patent Office at the time of entering the national phase as amendments made according to Article 34 of the Treaty.

The translation of the amendment shall be written on an amendment sheet that can be replaced by the corresponding part of the page of the translation of the original application. If as the result of the amendment, there is addition of the content, one or more pages may be inserted after that page. The pages shall be numbered as "Xa" and "Xb" or "X – 1" and "X – 2". If as the result of the amendment, there is deletion of the whole page, indication shall be made in the explanation of the amendment.

Where one of the items is deleted from the claims, the original numbering may stay, with the word "deletion" indicated. The amended claims could also be re-numbered in a continuous way, with explanation attached to illustrate it. A page of brief explanation of the amendment shall be attached in front of the translation of the amendment. On top of that page, there shall indicate the words "translation of annexes of international preliminary examination report". Explanation of the amendments shall indicate only the parts where the amendments are involved.

For the translation of the annexes of the international preliminary examination report submitted after entering the national phase, it shall be submitted with Form PCT/CN/521 attached. The applicant shall indicate in the Form that he intends to use the amended contents as the basis for examination.

Where the translation of the amended documents fails to meet the above-mentioned formal requirements, the examiner shall notify the applicant to make necessary rectifications. If rectifications are not submitted when the time is due, the examiner shall issue a notification of non-consideration of the amendment.

The translation of the annexes of the international preliminary examination report shall not be published in the national publication.

## **5. Examination of Other Documents**

### **5.1 Appointment and Power of Attorney**

#### **5.1.1 Appointment**

Art. 19.1

For a foreign applicant who has no habitual residence or business office in Mainland China, he shall, at the time of entering the national phase, appoint a patent agency designated by the State Intellectual Property Office to handle the relevant matters. If no patent agency is appointed or if the appointed patent agency is not a designated patent agency, the examiner shall handle the matter according to the relevant provisions of Section 3.1.1.1, Chapter 1 of Part I of these Guidelines.

For an applicant who has habitual residence or business office in Mainland China, it/he is not obliged to appoint a patent agent.

#### **5.1.2 Power of Attorney**

Rule 16.3

In addition to the requirements for power of attorney as pro-

vided in Section 3. 1. 1. 2, Chapter 1 of these Guidelines, there shall be contents concerning the matters to be handled in the designated or elected country in the power of attorney of an international application submitted at the time of entering the national phase under the Item of scope of appointment. The power of attorney shall indicate the international application number, the name or title of the applicant (i.e. consignor) both in the original and its translation. Except in cases where there are amendments, the original name or title of the applicant shall be in the language of the published Pamphlet and be identical with what is on the front page of the Pamphlet; Where there have been amendments in the international phase, the amendments shall be identical with the rectified amendments recorded in Form PCT/IB/306. The translation of the name/title shall be identical with what is recorded in the entering statement (PCT/CN/501).

If at the same time when the international application enters the national phase, the formalities for change of applicant has gone through, the applicant may submit only the power of attorney signed by the changed applicant.

Where for an international application no power of attorney is submitted at the time of entering the national phase, or if the submitted power of attorney has some defects, the examiner shall notify the applicant to make rectifications. If rectifications are not made at the expiration of the time limit, the application shall be considered to have been withdrawn.

## 5. 2 Claiming Priority

### 5. 2. 1 Declaration of Priority

It is stipulated in Rule 107. 1 of the Implementing Regulations of the Patent Law that "where the applicant claims one or multiple priorities in the international phase and such claims remain valid at the time when the application enters the Chinese national phase, the applicant shall be deemed to have submitted the written declaration in accordance with the provision of Article 30 of the Patent Law. "

For an valid priority claim, the applicant shall indicate in the entering statement accurately the date of filing, the application number and the name of the country or international organization with which the earlier application was filed. Except for cases



mentioned in the next paragraph, the indicated information shall be consistent with what is recorded on the front page of the Pamphlet. Where any inconsistency is found in the entering statement, the examiner shall correct it *ex officio* according to what is recorded in the Pamphlet, and notify the applicant promptly.

The priority claim referred to in the "Notification of withdrawal of priority claim" (PCT/IB/317) and "Notification that Priority Claim Deemed not to Have Been Made" (PCT/IB/318) transferred by the International Bureau to the Patent Office as Designated Office or Elected Office shall be regarded as having lost its effect and shall not be included in the entering statement. If the priority claim as referred in the above mentioned notifications are still contained in the entering statement, the examiner shall delete it *ex officio*, and shall notify the applicant accordingly.

In the international phase the Receiving Office has already conducted examination on the validity of the priority claim, i. e., whether or not the earlier application, which is the basis of the priority, has been filed in a member State of the Paris Convention or the World Trade Organization (WTO), whether or not the applicant is a national or resident of a member State of the Paris Convention and whether or not the filing date of the earlier application is within twelve months before the international filing date. And even if priority claim deemed not to have been made is declared for failing to meet the above - mentioned requirements, the Patent Office as Designated Office or Elected Office shall not raise any question about it. It is not necessary for the examiner to examine them.

If in the international phase, the applicant fails to provide the application number of the earlier application, he shall indicate the application number in the entering statement. If the application number is still not provided at the time of entering the national phase, the priority claim shall be considered not to have been made.

In accordance with the provisions of Rule 107.2 of the Implementing Regulations of the Patent Law, where there is clerical mistake somewhere in the written declaration of priority claim submitted in the international phase, the applicant may file a request for correction at the time of going through the entering formalities and shall pay the fee for correcting the priority claim. Such request for correction shall be submitted in the written

form, and shall fill in the amended priority claims in the entering statement. At the time when the request for correction is submitted, a copy of the earlier application shall be attached to serve as the basis of correction. Where the copy of the earlier application is transferred by fax according to the provisions of Section 7.1.2 of this Chapter, the applicant shall submit the original document within the prescribed time limit. The examiner shall check carefully the copy of the earlier application and the matters contained in the declaration of priority claim. If it is confirmed that the mistake in the declaration of priority claim is out of negligence in writing, the applicant may be allowed to make corrections. The request for corrections submitted after entering the national phase shall not be taken into consideration.

No new priority claims shall be allowed to submit after entering the national phase.

#### **5.2.2 Submission of Priority Documents**

##### **Rule 107.3**

In accordance with the provisions of Rule 17 of the Treaty Regulations, where the applicant has complied with the requirements of submitting the documents of priority to the Receiving Office or requesting the Receiving Office to provide a copy of the documents of priority, the Patent Office as the Designated Office shall not request the applicant itself/himself to submit the copy of the documents of priority. The International Bureau shall be requested to provide the said copy by the Patent Office. The examiner of the Patent Office shall check the international search report in the Pamphlet of the international application. If there are documents marked with "PX" or "PY" under the item of relevant documents in international search report, the examiner shall send a Notification of PCT/CN/512 to the International Bureau asking the International Bureau to transfer the copy of documents of priority of the application. If documents marked with "PX" or "PY" are not found by the examiner of the International Search Authority, but are found by the examiner who is responsible for the substantive examination in the process of supplementary search in the patent office, the said Request shall still be submitted through the examiner of preliminary examination to the International Bureau.

Where the Patent Office is notified by the International Bureau that the applicant has not submitted the documents of priority according to the provisions in the international phase, the

examiner shall notify the applicant to submit them within the prescribed time limit. If such documents are not submitted at the expiration of the time limit, the corresponding priority claim shall be considered not to have been made.

### **5. 2. 3 Examination of Priority Documents**

Where the copy of documents of priority are provided by the International Bureau or where the applicant has supplemented the documents of priority, the examiner shall conduct examination to the documents of priority.

#### **5. 2. 3. 1 Inconsistently with Declaration of Priority**

The examiner shall examine the each item contained in the declaration of priority based on the documents of priority. If any of the content is inconsistent with what is recorded in the documents of priority, the examiner shall issue a notification of the priority claim being considered not to have been made.

#### **5. 2. 3. 2 Submission of Proof of Priority**

Rule 105. 1(3)

The examiner shall check whether or not the applicant of the later international application has right to claim the right of priority of the earlier application indicated in the application at the filing date. Where the earlier application is not filed with the Patent Office, the applicant shall be considered to have right to claim the right of priority if one of the following requirements has been met:

(1) The applicant of the later application and applicant of the earlier application are the same person.

(2) The applicant of the later application is one of the applicants of the earlier application.

(3) The applicant of the later application has right to priority as the result of assignment by or as gift of the applicant of the earlier application or because of the jointly signed agreement or transfer of right in other form.

For cases under item (3), unless the applicant has made a declaration to priority in the international phase and the declaration meets with the requirements, the applicant shall submit the relevant proof of documents. The proof of documents shall be signed by the assignor and the date of the signature shall be earlier than the international filing date, or the effective date of the assignment indicated in the proof documents shall be earlier

than the international filing date.

The proof of documents shall be the original documents or the certified copy of the original documents.

If through examination, the applicant of an international application is found not in conformity with the requirements mentioned in (1) or (2), the examiner shall check whether or not a declaration to priority of the earlier application made by the applicant is included in the Pamphlet. If there is such a declaration, and the examiner believes it true and credible, the applicant shall not be asked to submit the proof of documents. If there is no such declaration or if the declaration fails to meet the requirements, the examiner shall send a notification to the applicant asking him to submit the proof of documents referred to in Item (3). If no such documents are submitted at the expiration of the time limit, the applicant shall be considered not to have the right to claim priority.

If the applicant of an international application has no right to claim priority, the examiner shall issue a notification of priority being considered not to have been claimed.

#### **5. 2. 4 Restoration of Right to Priority**

Rule 107. 4

Where circumstance under Rule 26. 2<sup>bia</sup> of the Treaty Regulations have occurred to an international application in the international phase, and the International Bureau or the Receiving Office has declared the priority claim considered not to have been made, the applicant may, at the time of going through the formalities for entering the national phase, request for restoration of priority right and pay the restoration fee provided that the information concerning the priority being considered not have been made has been published together with the international application.

The request for restoration raised after the entering of the national phase shall not be taken into consideration.

#### **5. 2. 5 The Earlier Application Filed in China**

Rule 33

Where the earlier application is a national application filed with China or an international application designating China, of which the priority has been claimed by an international application, the requirements to be satisfied in the preliminary examination of the priority of the said international application shall be, besides the provisions of Section 5. 2. 3. 2 of this Chapter, the

same as the other international applications.

If the earlier application was filed with China, the applicant of the later application claiming the priority right shall be the same person as the earlier application, or the person to whom all the applicants of the earlier application have assigned the right of priority. If these requirements are not satisfied, the priority shall be considered not to have been claimed.

Where the earlier application was filed with China, the entering of the Chinese national phase of the international application claiming the priority of the earlier application shall be considered as claiming domestic priority. If at the time of filing, an international application claims the priority of an earlier application, and the subject matter of the earlier application falls under one of the situations listed in Rule 33.2(1), (2), (3) of the Implementing Regulations of the Patent Law, the examiner shall issue a notification of priority considered not to have been claimed. Due to special proceedings for the international applications, the examiner for preliminary examination shall not handle the earlier application which is the basis of priority claim according to the provisions of Rule 33.3 of the Implementing Regulations of the Patent Law. Similarly, the examiner of the preliminary examination shall not handle the grant of patent to the earlier application after the international application is filed, though it may lead to double patenting of both the earlier application and the later application. All these issues shall be left for the procedures of the substantive examination to handle.

### **5.3 Non – Prejudicial Disclosure or Exceptions to Lack of Novelty**

In accordance with the provisions of Rule 105.1(4) of the Implementing Regulations of the Patent Law, if the invention – creation involved in an international application falls under one of the situations indicated in Article 24(1) or (2) of the Patent Law, and if a declaration of non – prejudicial disclosure has been made at the time of the international application is filed, the applicant shall indicate it in the entering statement, and submit the relevant documents of proof as prescribed in Rule 31.2 of the Implementing Regulations of the Patent Law within two months from the date of going through the entering formalities.

Where the applicant indicates in the entering statement that statement of non – prejudicial disclosure has been made at the time of filing the international application, the examiner shall

check whether or not there is corresponding record on the front page of the Pamphlet. The content of the record shall include the date and place of the disclosure, kind of disclosure and the name of the exhibition or meeting in respect of the non – prejudicial disclosure. The examiner shall check also whether or not the exhibition indicated in the statement falls under Article 24(1) of the Patent Law, and whether or not the indicated academic meeting or technological meeting falls under Rule 31.1 of the Implementing Regulations of the Patent Law. Where what the applicant indicates in the entering statement cannot be found in the record of the Pamphlet, or where the statement of non – prejudicial disclosure does not satisfy the requirements specified in the Patent Law and its Implementing Regulations, the request for grace period of non – prejudicial disclosure shall be considered not have been made. The examiner shall notify the applicant promptly. If the entering statement does not contain what is recorded in the Pamphlet, the applicant may rectify it within two months from the date of entering the national phase.

Because of the special procedures for the international application, the time limit for submitting the proof documents is two months from the date of going through the entering formalities. For requirements for proof documents, provisions in Section 3.3.2, Chapter 1 of part I of these Guidelines shall apply.

#### **5. 4 Reference and Proof of Deposit of Sample of Biological Material**

##### **5. 4. 1 Indication in the Entering Statement**

In accordance with the provisions of Rule 106.1 of the Implementing Regulations of the Patent Law, where reference has been made for the deposit of the biological material sample according to the provisions of the Treaty, the applicant shall indicate it in the entering statement. The indication shall include the kind of documents in which deposit details are recorded, and, where it is necessary, the location of the relevant content in the documents.

Where the deposit details are included in the description in a way other than the forms, the page number and number of lines of the translation of the description covering the indicated contents shall be indicated in the entering statement under the specified items. The examiner shall check the corresponding content

of the translation. Where the the deposit details are indicated in the Form PCT/RO/134 or other separate paper sheet, such Form or sheet shall be included in the Pamphlet. Where the examiner finds, after verification, there is no relevant deposit details in the corresponding location of the translation indicated in the entering statement, or where Form PCT/RO/134 or other sheet indicated in the entering statement is not included in the Pamphlet, the reference to the said deposited biological materials shall be considered not to have been made.

**Rule 106.2**

Where reference concerning deposited biological materials has been made in the international phase according to the provisions of the Treaty, but is not indicated or is not clearly indicated in the entering statement, the applicant may rectify it within four months from the date of going through the entering formalities on its/his own initiative. If no rectification is made at the expiration of the time limit, the examiner shall notify the applicant that the reference to the said deposited biological materials shall be considered not to have been made.

**5. 4. 2 Reference to Deposit of Biological Materials**

In accordance with the provisions of Rule 106 of the Implementing Regulations of the Patent Law, where the applicant has made reference to the deposited biological materials according to the provisions of the Treaty, the requirements in Rule 25(3) of the Implementing Regulations of the Patent Law shall be deemed as having been satisfied. According to the provisions of the Treaty Regulations, the reference to the deposit of biological materials shall include: the title and address of the depositary institution, the date on which the sample of the biological material is deposited, the accession number of the deposit provided by the depositary institution. So long as the reference reaches the International Bureau before the technical preparation of the international publication is completed by the International Bureau, the Patent office as the Designated Office shall consider the reference being timely submitted. To this end, where the reference to the deposit of the biological material sample is included in the Pamphlet as part of the description or in the form of separate paper sheets, and if the content of the reference include the above – mentioned information, the examiner shall regard the reference as meeting the requirements. Where the applicant makes no reference to the deposit of the biological material sample in

**PCT Rule****13<sup>bis</sup>. 3(a)****13<sup>bis</sup>. 4(a)**

the international phase, but covers the deposit of biological material sample in the entering statement, the examiner shall notify the applicant that the biological material sample shall be deemed not to have been deposited.

For cases where the certificates of the deposit of the biological material sample is submitted by the applicant on the filing date and if it is included as part of the international application in the Pamphlet by the International Bureau, when request is made by the applicant to make rectifications to the missing part of the reference to the deposit of the biological material sample, the examiner may allow the applicant to make supplement or correction based on the certificate of the deposit in the Pamphlet.

Where it is found that the reference to the deposit of the sample of the biological material is not in conformity with the details recorded in the certificate of deposit, and if it can be assured that the inconsistency is caused by the clerical error in the reference, the examiner shall notify the applicant to make rectification within the prescribed time limit. The applicant shall submit the replacement sheet of the corrected reference. Where no rectification is made at the expiration of the time limit, the sample of the biological material shall be deemed not to have been deposited.

Where the reference to the deposit of the biological material sample is submitted in the form of Form PCT/RO/134 or in the form of separate paper sheets other than reference, it shall be translated into Chinese as part of the international application at the time of entering the national phase. Where no translation into Chinese is submitted, the examiner shall notify the applicant to supplement it. Where no rectification is made at the expiration of the time limit, the reference to the deposited biological materials shall be deemed not to have been made and the applicant shall be notified that the said sample of the biological materials is considered not to have been deposited.

#### **5. 4. 3 Certificate of Deposit of Biological Material Sample**

##### **Rule 106. 3**

Because of the special procedures of the international application, the time limit for submitting the certificates of the deposit and the viability of the biological material is four months from the date of going through the formalities for entering the national phase. For the examination of the content of the certificates of the deposit and the viability of the biological materials, provi-



sions in Section 2.6.2.2, Chapter 1 of Part I of these Guidelines shall apply.

### **5.5 Amendment to the Application Documents after Entering the National Phase**

#### **Rule 109**

*For an international application pursuing a patent for utility model, the applicant may file a request to amend the description, the drawings and the claims within one month from the date of going through the entering formalities. For an international application pursuing a patent for invention, the applicant may request to amend the application documents on its or his own initiative according to Rule 51.1 of the Implementing regulations of the Patent Law.*

At the time of an international application entering the national phase, where the applicant indicates clearly that the amendments made under Article 28 or 41 of the Treaty shall form the basis of examination, the amendments may be submitted at the same time when the translation of the original application is submitted.

The detailed explanation of the amendments shall be attached when the amendments are submitted. The explanation may be in the form of a table of comparisons on the content before and after the amendment or the marked notes of amendments on the copy of the original. Where the amendments are submitted at the time of entering the national phase, notes of "amendment made according to Article 28 (or 41) of the Treaty" shall be marked on top of the explanation of the amendments. Where the amendments are submitted after entering the national phase, in addition to the explanation of the amendments, a Form of PCT/CN/521 shall be attached to indicate the content of the amendment shall be used as the basis of the examination.

The content of amendment shall be submitted in the form of replacement sheets. The content of the replacement sheets shall be corresponding with the content of the replaced sheets and shall be consistent with the context in meaning.

Where more than one amendments have been made for the content of the same part, the later explanation of amendments and replacement sheets of amendment shall be based on the last amendments.

### 5.6 Amendment of Error in Translation

#### PCT Art. 11(3)

In accordance with the provisions of the Treaty, an international application shall have the effect of a regular national application in each designated country from the international filing date. Thus, the international application transferred by the International Bureau to the Patent Office as the Designated Office is the text which has the legal effect. Where error is found in the translation submitted at the time of entering the national phase based on the said text, and if the requirements provided in Rule 110 of the Implementing Regulations of the Patent Law are met, correction of error in the translation may be allowed. For the time limit under Rule 110. 1(1) of the Implementing Regulations of the Patent Law, provisions of Section 6.1 of this Chapter shall apply.

Error in translation refers to cases where the translation is not complete and faithful compared with the original text transferred by the International Bureau. Such error may be caused by mistake of the translator, clerical mistake or mistake in the selection of the text.

Where the applicant has gone through the formalities for amending the errors in the translation before the completion of the preparatory work of national publication, the Patent Office shall publish the corrected documents.

When correcting error in the translation, in addition to submitting the replacement sheet, the applicant shall file a written request for correcting error in the translation and pay the prescribed fee for the amendment of translation.

The corrected sheet of the translation and the corresponding sheet of the originally submitted translation shall be able to replace each other, i. e., the content of the amendments shall be consistent with the context in meaning.

Where it is found in the preliminary examination proceedings that the translation is obviously inconsistent with the original, such as the number of the claims is inconsistent with that of the claims in the original, or if the text matter of the drawings is not translated, the examiner shall notify the applicant to make amendments. If inconsistency exists only in the nonverbal part, such as in mathematical or chemical formulae and so on, it shall not be handled as an error in the translation. The applicant shall be invited to make amendments only.

**5. 7 Request for Examination as to Substance**

For an international application which enters the national phase and designates China for a patent for invention, the request for examination as to substance shall be submitted within three years from the date of priority, and the fee for substantive examination shall be paid. The examiner shall conduct the examination in accordance with 3. 4, Chapter 1 of Part I of these Guidelines.

**5. 8 Change in Bibliographic Data****5. 8. 1 Change Recorded by the International Bureau****5. 8. 1. 1 Effect of Notification of the International Bureau**

If, upon the request of the applicant or the Receiving Office, amendments of the applicant or its/his name (title), residence, nationality or address in the request are amended, or the amendment of the inventor or his/her name in the request are recorded and notified to the Designated Office in a written form (Form PCT/IB/306) by the International Bureau in the international phase, so long as the Patent Office has received the written notification of the amendment from the International Bureau, the applicant shall be considered to have reported the amendment of bibliographic data to the Patent Office. This means it/he shall not be required to submit a request for the amendment of the bibliographic date and pay the handling fee for the change. At the time when the international application enters the national phase, the amended bibliographic data shall be used directly.

**5. 8. 1. 2 Supplement of Proof Documents**

Rule 105. 1(2)

Where amendment is made under the item of "applicant" (entity only) as indicated in the "Notification of the Recording of a Change" (PCT/IB/306) transferred by the International Bureau, the applicant shall, at the time of entering the national phase, in accordance with Rule 105. 1(2) of the Implementing Regulations of the Patent Law, submit the contract of assignment or gift of the right to apply for a patent, the document of proof on the merge of the company provided by the administrative authority of industry and commerce, or other proof documents relating to transfer of right. The proof documents may be the original copy or the copy of it certified by the notary public organ. The

examiner shall examine the validity of the proof documents. Where the proof documents are not provided, the examiner shall notify the applicant to supplement it. If no documents are supplemented at the expiration of the time limit, the application shall be deemed to have been withdrawn.

Where, in the "Notification of the Recording of a Change " (PCT/IB/306) as transferred by the International Bureau, the amendment refers to the assignment of the right to apply for a patent by a Chinese entity or individual to a foreigner, in addition to asking the applicant to submit the agreement of assignment as necessary, the examiner shall check, in accordance with Article 10.2 of the Patent Law, whether or not the assignment has been approved by the competent authorities under the State Council. Without the approval, the assignment is not valid.

Where, in the "Notification of the Recording of a Change " (PCT/IB/306) as transferred by the International Bureau, the amendment refers to the change in name or title, address of the applicant, or the name of the inventor, no proof documents are necessary. The amendment shall be deemed to have taken effect.

#### **5. 8. 2 Change in the Bibliographic Data in the National Phase**

The request for change in the bibliographic data furnished at the time of entering the national phase or after entering the national phase shall be dealt with according to Section 3. 7. 2, Chapter 1 of Part I of these Guidelines.

In addition to the evidence documents of the several kinds of changes concerning the bibliographic data as indicated in Section 3. 7. 2. 3, Chapter 1 of Part I of these Guidelines, under the following two circumstances, the notarized statement of the person concerned (applicant or inventor) may be used as the evidence documents for request for amendment.

(1) Where the applicant states that the wrong name or title of the applicant or the wrong name of the inventor is indicated at the time of filing the international application, and request is filed to correct the error after the entering of the national phase.

(2) Where the applicant states that different title or name of the applicant or inventor of an international application is used for different countries (not just the language difference) and intends to use a title or name different from what is recorded in the international publication, and has filed the request for amendment in

China. For example, a Chinese American uses the name of xxx· Tom in the U. S. A. and has filed the international application in this name, but requests to use xxx as his name at the time of entering the Chinese national phase.

## **5. 9 Request for Review**

### **5. 9. 1 Submission of Request for Review**

PCT Art. 25

According to the provisions of the Treaty, the circumstances under which submission of request for review to the Patent Office as Designated Office by the applicant may be allowed are as follows:

(1) Where the Receiving Office has refused to accord an international filing date or has declared that the international application is considered withdrawn;

(2) The Receiving Office has declared that the designation of China is considered withdrawn;

(3) The International Bureau has declared the application considered withdrawn because it has not received the registered copy of the international application within the prescribed time limit.

Rule 115

PCT Rule 51

The request for review shall be submitted to the Patent Office within two months from the date of receiving the notification of the decision. In the request, the reason for the request for review shall be indicated and the copy of the decision which is the subject for review shall be attached. Upon the request of the applicant, the copy of the relevant documents of the file shall be transferred by the International Bureau to the Patent Office later.

### **5. 9. 2 Other Formalities**

At the time of submitting the request for review according to Section 5. 9. 1, the applicant shall go through the entering formalities prescribed in Rule 101 of the Implementing Regulations of the Patent Law to the Patent Office. It/He shall indicate in the entering statement the fact that the request for review has been submitted.

### **5. 9. 3 Review and Follow – Up Processing**

Where the examiner believes the request for review is submitted in accordance with the provisions of the Treaty and its Implementing Regulations, and the entering formalities have been

performed in accordance with the prescriptions, he shall conduct a review to whether or not the decision made by the International Bureau or Receiving Office is correct.

Where the examiner believes the decision made by the said International Authority is correct and the effect of the said international application in China has ceased, the provisions in Section 2.2.1 of this Chapter shall apply.

Where the examiner believes the decision made by the International Authority is incorrect, he shall confirm that the international application have effect in China, and continue the procession and examination of it in the national phase. For the international application of which the international filing date has not been accorded by the Receiving Office, the examiner shall notify the applicant that the application is deemed to be filed to the Patent Office on the date on which the international filing date shall be accorded.

Where the international application has not been published in the international publication because of interruption of the proceedings in the international phase, the examiner, at the time of conducting the examination prescribed in this Chapter, shall use the copy of the registered copy of the documents in the files transferred by the International Bureau instead of the Pamphlet mentioned in these Guidelines.

## **5. 10 Rectification of Errors Made by the International Authority**

### **5. 10. 1 Statement on Rectification of Errors Made by the International Authority**

Where, in the processing of the international application, as the result of the error of the Receiving Office, the International Preliminary Examination Authority or the International Bureau, a wrong notification was issued, the record in the Pamphlet was wrong, there is omission in issuing a notification or omission in making a record, and the examiner has made the decision of "Effect of the International Application Ceases", "Amendment of Formal Defects", or "Right of Priority Deemed not to Have Been Made", etc. after the entering of the national phase, the applicant may request for rectification of errors made by the International Authority within six months from the date of the issuance of the corresponding notification by the examiner. The request may be submitted in the form of "statement of observation".

### 5. 10. 2 Appendix

At the time of submitting the statement of observation requesting the rectification of error made by the International Authority, a copy of the corresponding document showing that the International Bureau has rectified or has agreed to rectify the said error shall be supplied as the appendix, such as the rectified copy of the Pamphlet, or the rectification sheet of the "Notification of the Recording of a Change" (PCT/IB/306), the rectification sheet of the "Notification of Election" (PCT/IB/331), etc. . The request for rectification without the said appendix shall not be acceptable.

### 5. 10. 3 Processing after Rectification

Where it is confirmed after examination or contact with the International Bureau that it is indeed an error made by the international authority and has been rectified by the International Bureau, the rectified conclusion shall be the one to be acknowledged. Where the decision of "Effect of the International Application Ceases" has been made out of error, the Patent Office shall accept a second time the translation and the fees that have been returned to the applicant, and the date of the first going through of the entering formalities shall be regarded as the date of entering the national phase. The confirmation of the date shall be determined by the mark made by the Patent Office in the returned documents and the receipt of payment. Where during the process waiting for the International Authority to rectify the error, the time limit for going through the certain formalities has expired, and the said formalities can not be performed in time so long as the error is not rectified (such as the submission of the request for examination as to substance, the submission of the certificate of the deposit and the viability of the biological material, the submission of the proof of non – prejudicial disclosure, etc. ), the applicant shall, at the time of re – submitting the translation and the payment of the application fee, complete the various formalities that have been delayed. The examiner shall consider such formalities being performed within the prescribed time limit.

For conclusions made out of error leading to the loss of right on the part of the applicant, the corresponding rights shall be restored after the International Bureau notifies that the error has been rectified.

## 6. National Publication

National publication applies only to the international application for patent for invention designating China.

In accordance with the provisions of Rule 111.1 of the Implementing Regulations of the Patent Law, with regard to any international application for a patent for invention, if after the preliminary examination, the Patent Office considers it in compliance with the provisions of the Patent Law and its Implementing Regulations, it shall be published in the Patent Gazette; where the international application is filed in a language other than Chinese, the Chinese translation of the international application shall be published.

Although the international publication of most of the international applications has been completed by the International Bureau at the expiration of eighteen months from the date of priority before the entering of the national phase, it is stipulated in the Treaty that where the language used in the international publication is different from the language used for publication in the designated country according to the law of the country, so far as the protection of right is concerned, the designated country may provide that the effect of the publication begins after the translation using the latter language is published according to the law of that country. It is clearly indicated in Rule 111.2 of the Implementing Regulations of the Patent Law that for the international application filed in a language other than Chinese, the right for provisional protection as provided for in Article 13 of the Patent Law shall begin after the national publication.

Another purpose of the national publication is to notify the public the information on the entering into the Chinese national phase of the application.

### 6.1 Time of Publication

As except for the situations described in 3.4 of this Chapter, most international applications enter the national phase at the expiration of eighteen months from date of priority, therefore, the provisions of Article 34 of the Patent Law are not applicable to them. If, after the preliminary examination to the international application which has entered the national phase, the Patent Office believes that all the requirements are met, the preparatory work for national publication shall begin in time. The time for the Patent Office to finish the preparatory work of national publication



shall not be earlier than three months from the date of entering the national phase of the international application.

## **6. 2 Form of Publication**

### **6. 2. 1 International Publication in a Language Other than Chinese**

The national publication shall be in the form of both the publication in the Patent Gazette for Invention and the publication of the Description of the Unexamined Application for Patent for Invention.

### **6. 2. 2 International Publication in Chinese**

The national publication shall be in the form of publication in the Patent Gazette for Invention.

## **6. 3 Content of Publication**

### **6. 3. 1 Content of National Publication in Patent Gazette for Invention**

The national publication of the international application is an independent part in the Patent Gazette, separating from the publication of the national application. The national publication of the international application consists of bibliographic data, abstract and drawing of the abstract (when necessary). The bibliographic data contains: the IPC symbol, application number, publication number, filing date, international filing number, international publication number, international date of publication, priority matter, matters of patent agent, matters of applicant, matters of inventor, and title of the invention, etc..

The index of the Patent Gazette for Invention is compiled in the prescribed order in which the published international application and the published national application are combined.

### **6. 3. 2 Content of Published Description of International Application**

The content of the published description of an international application consists of the front page, the translation of the original description and claims, translation of the abstract, as well as the drawings and the translation of the text matter of the drawings. Where necessary, it may contain a sequence listing of the nucleotide or amino acid, the translation of Form PCT/RO/134

where details of the deposit of the biological material sample are recorded, the translation of the claims amended according to Article 19 of the Treaty and the translation of the statement of the amendment. The translation of the amended claims shall follow the translation of the original ones. The content on the front page shall be the same as the published content of the same application in the Patent Gazette for Invention which is published at the same time.

## **7. Place and Form of Submission of Documents and Date of Submission**

### **7.1 Submission of Documents at the Time of Entering the National Phase**

#### **7.1.1 Place of Submission**

The translation or documents provided in Rule 101 of the Regulations of the Patent Law and the other documents furnished with them shall be submitted or transferred to the International Application Division of the Patent Office (PCT Divisions). In sending the mail, the words "PCT Division, Patent Office under the State Intellectual Property Office" shall be indicated. For documents which are submitted, transferred or mailed to the other departments of the State Intellectual Property Office or the Patent Office, the date of arrival shall be the date when the documents are transferred to the PCT Division of the Patent office.

#### **7.1.2 Form of Submission**

Rule 113.3

The above – mentioned translation and other documents may be submitted by personal delivery, by mail, or by way of facsimile machines. Where the words in the documents transferred by the facsimile machines are illegible, or where there is omission of page, the said documents or part of the documents shall be considered as not having been received. The original of the documents transferred by way of facsimile machines shall be submitted or mailed to PCT Division of the Patent Office within fourteen days from the date of the transmission by fax.

#### **7.1.3 Determination of Date of Submission**

Rule 113.1

The translation and documents prescribed in Rule 101 of the Implementing Regulations, no matter they are submitted by personal delivery, by mail or by the way of facsimile machines, the date of arrival at the PCT Division shall be regarded as the date

of submission of the documents.

**Rule 113.2**

Where the documents are transferred by mail and there is delay in the mailing, so long as the interested party can provide the evidence to prove that the documents have been mailed five days prior to the expiration of the time limit, although the documents arrive actually after the expiration of the time limit, the delay in arrival shall be excused. The examiner shall regard the date of expiration of the time limit as the date of submission. For the delay in mailing the documents, if the postmark of the place where the documents are sent is clear enough, the postmark can be used as an evidence.

## **7.2 Submission of Documents after the Entering of National Phase**

### **7.2.1 Place of Submission**

During the period of after the entering of the national phase and before receiving the Notification on International Application Having Passed the Preliminary Examination, various documents shall be submitted to the PCT Division of the Patent Office. After receiving the Notification, various documents shall be submitted to the Receiving Division of the Patent Office.

### **7.2.2 Form of Submission**

The documents may be submitted by personal delivery or by mail, but shall not be transferred by facsimile machines.

### **7.2.3 Determination of Date of Submission**

Provisions in Rule 5 of the Implementing Regulations shall apply, i. e., where the documents are submitted by mail, the date of mailing indicated by the postmark on the envelope shall be deemed as the date of submission.

## **8. Special Rules for Payment of Fees**

### **8.1 Filing Fee, Printing Fee for Publishing the Application, Additional Fee for Filing Application, and Surcharge for the Late Entry**

The filing fee, printing fee for publishing the application, and surcharge for the late entry shall be paid within the prescribed time limit stipulated in Rule 101 of the Implementing Regulations. The date of payment shall be the date on which the

Payment Division of the Patent Office receives it. Where fees are paid by deduction from the account, the date on which the bill of the payment arrives at the Patent Office shall be the date of payment.

Where the additional fee for filing the application is not paid or is not paid in full by the applicant at the time of entering the national phase, the examiner shall notify the applicant to pay the said fee within the prescribed time limit. If the fee is not paid or not paid in full within the time limit, the application shall be deemed to be withdrawn.

## **8. 2 Reduction and Exemption of Fees**

### **8. 2. 1 Exemption of Filing Fee**

The filing fee and the additional fee for filing the application of an international application filed with the Patent office as receiving office shall be exempted at the time of entering the national phase.

### **8. 2. 2 Reduction and Exemption of the Fee for Examination as to Substance**

Where an international application enters the national phase and submits the request for substantive examination, and if the international search report of the international application is made by the Patent Office as the International Search Authority, it only needs to pay 50% of the substantive examination fee.

Where an international application enters the national phase and submits the request for substantive examination, and if the international search report and international preliminary examination report of the international application are made by the Patent Office, the substantive examination fee shall be exempted.

Where an international application enters the national phase and submits the request for substantive examination, and if the international search report of the international application is made by one of three International Searching Authorities: the European Patent Office, Japanese Patent Office and Swedish Patent Office, it only needs to pay 80% of the substantive examination fee.

### **8. 2. 3 Reduction of Maintenance Fee and Annual Fee**

Where the applicant of an international application has difficulty to pay the maintenance fee or the annual fee, it/he may submit a request for reduction or postponement of the payment in accordance with the measures for the reduction and postponement of payment stipulated by the Patent Office.

### **8.3 Other Special Fees**

In addition to the fees indicated in Section 1, Chapter 2 of Part V of these Guidelines and the surcharge for the late entry indicated in Section 8.1 of this Chapter, there are three kinds of special fees in the proceedings of the national phase for an international application:

(1) handling fee for amendment of errors in the translation, this fee shall be paid at the time of submitting the request for amendment of errors in the translation;

(2) fees for amendment of claim for priority, this fee shall be paid at the time of submitting the request for amendment of claim for priority;

(3) restoration fee for unity of invention, this fee shall be paid within the time limit prescribed in the Notification concerning the Payment of Restoration fee for the Unity of invention sent by the examiner (see Section 5.5, Chapter 2 of this Part for details of restoration fee for unity of invention).

## **9. Files**

### **9.1 Formation of National Application Number**

A national application number shall be issued to an international application at the time of entering the national phase, and it shall be stuck on the cover of the file as a sign. The national application number of an international application consists of nine numbers. The first two numbers represent the year in which the application is filed, it is followed by a number which indicates the kind of protection pursued by the international application, the next five numbers represent the order of the application entering the national phase, and the last number is used for verification purposes of the computer. This last number is separated from the other numbers by a dot. Where an international application designates a patent for invention in China, the third number shall be "8" ; and where an international application designates a patent for utility model in China, the third number shall be "9" . Take 98801234.X as an example. According to the formation of this national application number, it applies to an interna-

tional application filed in or after 1998.

The formation of the national application number of an international application filed from 1994 to 1997 is a little different. It uses the first two numbers to indicate the year of the filing, the third number indicates the kind of protection ("1" represents invention and "2" represents utility model), the fourth number indicates the identity of international application ("9" or "8"), the following four numbers indicate the order of entering the national phase, and the last number is used for verification purposes of the computer. This number is separated from the other numbers by a dot. Number 97191234.X is an example for this.

## 9.2 Content of the Documents in the File

The differences between the content of the documents in the file of an international application and that in a national application are as follows:

(1) The entering statement is on the first page of the file (PCT/CN/501);

(2) It is followed by the originally filed international application, i.e., the Pamphlet published by the International Bureau. Where the international search report is not included at the time of the first publication of the International Bureau, i.e., when code name "A2" appears on the front page of the Pamphlet, there should be second publication of documents with "A3" as the code name. For purposes of publication of the claims amended under Article 19 of the Treaty, third publication of the documents is also possible;

(3) Documents in the third part of the file consist of various notifications and papers reflecting the examination proceedings in the international phase which are sent to the Patent Office by the International Bureau. These documents include "Notification of Election" (Form PCT/CN/331), "International Preliminary Examination Report" (Form PCT/CN/409); "Notification of the Recording of a Change" (Form PCT/CN/306);

(4) Documents in the fourth part of the file consist of the abstract or translation of abstract, drawing of abstract, translation of claims, translation of description, drawings and translation of the text matter in the drawings, sequence listing of nucleotide and amino acid of the international application submitted by the applicant at the time of going through the formalities for entering the national phase; when necessary, it may also

contain the translation of the amendment of the application documents submitted by the applicant in the international phase or the amendment of application document submitted by the applicant at the time of entering the national phase.

(5) What is different from the national application is that there is no Notification of Acceptance in the file. And on the second binding strip of the file, there is the "Notification of National Application Number".

If part of the documents mentioned in the proceeding (2), (3) and (4) are received after going through the entering formalities, they shall be bound on the second binding strip.

Other content shall be the same as what is indicated in Section 1, Chapter 4 of Part V of these Guidelines.

### 9. 3 Inspection of Files

Rule 111. 3

For the inspection of the files, the provisions of Section 4, Chapter 4 of Part V of these Guidelines may apply.

Art. 21. 2

The publication referred to in the said provisions indicates the national publication of an international application after the entering of the national phase. This means the Patent Office shall bear the responsibility of keeping the application confidential before the national publication.

## **Chapter 2**

### **Examination as to Substance of International Application after Entering the National Phase**

#### **1. Introduction**

The examination as to substance of an international application after the entering of the national phase in this Chapter refers to the examination as to substance of an international application pursuing for patent protection for invention which has entered the national phase in accordance with the Implementing Regulations of the Patent Law. The international application entering the national phase may be either an international application which has not gone through the international preliminary examination under Article 22 of the Treaty or an international application which has gone through the international preliminary examination under Article 39 of the Treaty.

#### **2. Principles of Examination as to Substance**

##### **2.1 Basic Principles of Examination as to Substance**

In accordance with the provisions of Article 27 (1) of the Patent Cooperation Treaty, no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided in this Treaty and its Regulations. It is further stipulated in paragraph (5) of the same Article that nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires. In particular, any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any contracting State is free to apply, when determining the novelty and inventiveness of an invention claimed in an international application, the criteria of its national law in respect of prior art and other conditions of patentability not constituting requirements as to the form and contents of applications.

On the basis of the above stipulations of the Treaty, the examination of the international application which has entered national phase shall be conducted according to the following principles:

- (1) For the form and contents of the application, the exami-



nation shall be conducted, in principle, according to the Patent Law and its Implementing Regulations. Where there is conflict between the Patent Law and its Implementing Regulations and the Treaty and its Implementing Regulations, the provisions of the latter shall prevail.

(2) For substantive requirements for granting of patent right, the examination shall be conducted according to the relevant provisions of the Patent Law, the Implementing Regulations of the Patent Law and these Guidelines for Examination.

## **2.2 Articles or Rules Having Relevance on Substantial Requirements for Grant of Patent Right**

Article 5 of the Patent Law: subject matter contrary to the laws of the State, social morality or public interest;

Article 9 of the Patent Law: principle of first-to-file;

Article 22 of the Patent Law: novelty, inventiveness and practical applicability;

Article 25 of the Patent Law: subject matter excluded from patentability;

Article 26.3-4 of the Patent Law: sufficient disclosure of invention, claims shall be supported by the description;

Article 29 of the Patent Law: the right of priority;

Article 31 of the Patent Law and Rule 35 of the Implementing Regulations: unity of invention;

Article 33 of the Patent Law: amendment shall not go beyond the scope of the disclosure of the initial description and claims;

Rule 2.1 of the Implementing Regulations: definition of invention;

Rule 13 of the Implementing Regulations: avoidance of double patenting;

Rule 20.1 of the Implementing Regulations: claims shall be clear and concise;

Rule 21.2 of the Implementing Regulations: an independent claim shall contain all the essential technical features.

## **3. Determination of Text Forming Basis of Examination as to Substance**

### **3.1 Request of Applicant**

At the time of entering the national phase, the applicant of an international application shall indicate, in the Written Entering Statement, the text which it/he intends to be used for the purpo-

ses of examination as to substance by the Patent Office.

The examination as to substance in the national phase shall be performed, upon the request of the applicant, on the basis of the text indicated in the Written Entering Statement and the other texts submitted in a later stage which meet the relevant requirements.

### 3. 2 Text Forming Basis of Examination as to Substance

The texts which may be used to form the basis of examination as to substance include:

(1) Where the international publication of an international application is in Chinese, the international application as originally filed; Where the international publication of an international application is in a foreign language, the translation of the international application as originally filed;

(2) Where the international publication of an international application is in Chinese, the claims as amended and submitted according to Article 19 of the Treaty; Where the international publication of an international application is in a foreign language, the translation of the claims as amended and submitted according to Article 19 of the Treaty;

(3) Where the international publication of an international application is in Chinese, the claims, description and drawings as amended and submitted according to Article 34 of the Treaty; Where the international publication of an international application is in a foreign language, the translation of the claims, description and drawings as amended and submitted according to Article 34 of the Treaty;

(4) the claims, description and drawings as amended and submitted according to Article 28 and Article 41 of the Treaty.

Although all the above – mentioned documents may be used to form the basis of the examination as to substance, where more than one amended documents have been submitted by the applicant in respect to the same document of the application (such as description or claims), and if these amended documents are submitted on the same date, the document indicated in Item 6 (that is “the applicant requests the Patent Office to conduct examination on the basis of the following documents”) of the Written Entering Statement (Form PCT/CN/501) shall prevail; where these amended documents are not submitted on the same date, the documents submitted in a later date shall pre-

vail.

Where, at the time of entering the national phase, the amended document made in the international phase is not indicated as the basis of the examination or where the Chinese translation of the documents is not submitted according to the requirements, it shall not be used as the basis of examination as to substance.

**Rule 109.2**

Furthermore, after an international application has entered the national phase and at the time when a request for examination as to substance is made, or within three months from the receipt of the notification of the Patent Office on the entry into examination as to substance, the applicant may amend the application documents according to Rule 51.1 of the Implementing Regulations of the Patent Law.

Refer to Section 4.1, Chapter 8 of Part II of these Guidelines for the determination of the text to be used as the basis of the relevant examination.

**3.3 Legal Effect of Documents of International Application as Originally Filed**

Where the international publication of an international application is in a language other than Chinese, the examination as to substance shall be conducted according to its Chinese translation. The examiner, generally speaking, need not check the original. Nevertheless, the documents of the international application as filed originally shall have legal effect and form the legal basis for any amendment to the application documents.

For an international application, the original description and claims indicated in Article 33 of the Patent Law refer to the description, claims and drawings of the international application as originally filed.

**3.4 Examination of the Amended Text**

The amended documents of an international application submitted by the applicant under the provisions of the Treaty as well as at the time when a Request for examination as to substance is made after the entering of national phase of an international application or within three months from the date of receiving the notification of the Patent Office on the entry into the examination as to substance shall meet the requirements of Article 33 of the Patent Law.

The amended documents requested to be used as the basis of the examination as to substance as mentioned above shall form the basis of the examination as to substance only when they meet the requirements of Article 33 of the Patent Law.

In the course of examination as to substance, if a new amended application documents is submitted by the applicant according to the provisions, the text submitted by it/him at an earlier date shall not be taken into consideration.

#### **4. Search in Examination as to Substance**

##### **4.1 General Principles**

Generally, a comprehensive search shall be conducted when an international application enters examination as to substance in the national phase. For requirements concerning the search, please refer to Chapter 7, Part II of these Guidelines.

##### **4.2 Principle of Practicing Economy**

Though, from the principle of practicing economy, the examiner shall make use of the information provided in the international search report as much as possible, attention needs to be paid to whether the text which the applicant requests to be used as the basis of examination as to substance has made any amendment to the text which form the basis of the international search report.

If, compared with the text which the applicant requests to be used as the basis of examination as to substance, there are amendments to the text which form the basis of the international search report so far the subject matter is concerned, instead of just simply using the international search report in the examination, the examiner shall re-consider the results of the search and conduct supplementary search when necessary.

Where the reference documents listed in the international search report are sufficient to destroy the novelty or inventiveness of a patent application, it isn't necessary to conduct further search in respect of the patent application.

It is to be noted that the meaning of category P and category E of the reference documents listed in the international search report are different from those in the search report made in the procedures of examination as to substance in the Chinese national phase. In the international search report, "P" represents documents published prior to the international filing date but later than the priority date as claimed; "E" represents an earlier appli-

cation or patent which is published on or later than the international filing date.

## **5. Contents of Examination as to Substance and Requirements of Examination**

This Section focuses mainly on the differences of the examination as to substance between an international application which has entered the national phase and a non – international application. For the identical points, relevant sections are listed for reference.

### **5.1 Role of International Preliminary Examination Report**

The international preliminary examination of an international application is to formulate a preliminary and non – binding opinion in accordance with Article 33 of the Treaty on the question whether the claimed invention appears to be novel, to possess inventiveness (to be non – obvious) and practical applicability. Article 33 (2) – (4) of the Treaty sets specific criteria for requirements of novelty, inventiveness and practical applicability. At the same time, Article 33 (5) of the Treaty indicates clearly that the criteria described in Article 33 (2) – (4) merely serve the purposes of international preliminary examination. Any Contracting State may apply additional or different criteria in deciding whether, in that State, the claimed invention is patentable or not.

Based on the above – mentioned principles of the Treaty, the examination as to substance to an international application which has entered the national phase shall be conducted independently according to the Patent Law and its Implementing Regulations.

From the principle of economy, for an international application which is attached with the international preliminary examination report, the examiner shall make reference to the opinions provided in the report. However, attention needs to be paid to whether the text which the applicant requests to be used as the basis of examination has made any amendment to the text which form the basis of the international preliminary examination report. If, compared with the text which the applicant requests to be used as the basis of examination, there are amendments to the text which form the basis of the international preliminary examination report so far the subject matter is concerned, the examiner usually doesn't need make reference to the judgment made in

the international preliminary report on whether the invention meets the criteria of novelty, inventiveness, practical applicability as well as the other requirements for granting of patent right.

It is to be emphasized that the examiner shall not simply take the instructive opinion provided in the international preliminary report as the concluding opinion for the examination as to substance in the national phase. He shall pay attention to whether other prior art documents which have not been listed in the international search report are cited in the international preliminary examination report.

For the examination as to substance of an international application which has entered the national phase, the examiner shall make independent judgment on whether the patent application is in conformity with the substantial requirements of the Patent Law and its Implementing Regulations.

#### **5.2 Examination on Whether Subject Matter of an Application Falling within the Scope of Objects to Which Patents May Be Granted**

At the time of performing the examination as to substance of an international application which has entered the national phase, the examiner shall first examine whether the subject matter of the application falls into the scope of Article 5 and Article 25 of the Patent Law. In case where the subject matter of an international application (such as tool for gambling or method of nuclear transformation) does not belong to the contents excluded in Rule 39 of the Regulations under the Treaty, but fall into the scope as provided in Article 5 and Article 25 of the Patent Law under which no patent right shall be granted, the application shall not be granted patent right.

Please refer to the provisions of Chapter 1 of Part II of these Guidelines for requirements of examination on this matter.

#### **5.3 Examination on Right of Priority**

Where reference documents indicated as category PX or PY have been listed in the international search report, the examiner shall check the priority right of the international application. Where the priority right of the international application can not be established, the applicant shall be notified accordingly. In such cases, the reference documents which are indicated with letters of PX or PY shall be used as the prior art to evaluate the novelty

and inventiveness of the international application when the examination on novelty and inventiveness of the international application is performed. Where the right of priority can be established, a check shall be conducted to reference documents indicated with letters PX. Where the reference document indicated with letters PX is a Chinese patent application (or patent) or an international application designating China, and its filing date is earlier than the priority date of the international application, the examiner, at the time of performing examination of novelty, shall determine whether the reference documents constitute conflicting application.

Where reference documents indicated as category EX are listed in the international search report, and if the reference document is a Chinese patent application (or patent) or an international application designating China, and its filing date is between the filing date and priority date of the international application, the right of priority of such international application shall also need to be checked. Where the right of priority cannot be established, at the time of performing examination of novelty to the international application, the examiner shall determine whether the reference documents constitute conflicting application.

Where, after conducting search in the course of examination as to substance of an international application after its entering the national phase, reference documents are found which were published between the filing date and the priority date of the international application and are relevant to its novelty or inventiveness, or where earlier applications or patents filed by other person with the Patent Office are found which were relevant to novelty and were published between the filing date and priority date of the international application, the examiner shall request the International Bureau to provide the copy of the text of priority, and shall check the right of priority of the international application.

#### **5. 4 Examination on Novelty and Inventiveness**

Where there are published documents and non-written disclosure which have been listed in the international preliminary examination report but are not taken into consideration in the opinion of the international preliminary examination, they shall be examined when novelty and inventiveness of the invention are being judged in the examination as to substance after the entering of the national phase.

The non – written disclosure listed in international preliminary examination report refers to the disclosure to the public by means of oral disclosure, use, exhibition or other non – written means which occurred before the filing date or the valid priority date of the international application, and the date of such non – written disclosure is indicated in written disclosures which have been made available to the public on a date which is the same as, or later than, the filing date or the valid priority date of the international application. Such non – written disclosure does not constitute prior art at the phase of international preliminary examination. Nevertheless, the international preliminary examination report has reminded the designated State to pay attention to these non – written disclosure.

The certain published documents listed in the international preliminary examination report refer to the applications or patents which were filed before the filing date or the valid priority date of the international application but published on or later than such date, or the published documents of a patent application claiming the priority of an earlier application which was filed before the said date. Such published applications or patents do not constitute prior art at the phase of international preliminary examination. Nevertheless, the international preliminary examination report has reminded the designated State to pay attention to such non – written disclosure.

For the examination of novelty and inventiveness of the international application, the provisions of Chapter 3 and Chapter 4 of Part II of these Guidelines shall apply respectively.

### 5.5 Examination of Unity of Invention

The examiner shall pay attention to whether, in the application documents submitted and requested to be used as the basis of the examination by the applicant, there are multiple inventions which lack unity of invention.

For multiple inventions lacking unity of invention, the following shall be checked.

(1) Whether the multiple inventions lacking unity of invention contain any invention which has not gone through the international search or international preliminary examination only because the applicant fails to pay the additional search or examination fee at the request of the examiner.

(2) Whether the reason leads to lacking unity of invention for



a multiple invention is caused by the fact that the translation of the invention submitted after the entering of the national phase contain any contents which were already abandoned by the applicant due to failure to pay the additional search or examination fee in the international phase ( such as the contents abandoned by the applicant in the international phase in order to set limits to certain claims) .

(3) For situations indicated in (1) or (2), whether the decision of lacking unity of invention made by the International Bureau is correct.

**Rule 112.2**

If, after examination, it is confirmed that the decision made by the International Bureau is correct, the examiner shall notify the applicant to pay the restoration fee for unity of invention within two months, so that the above - mentioned contents may be included as a valid part of the international application. Where the fees are paid by the applicant according to the prescriptions, those parts which have not gone through search and examination shall be regarded as valid parts of the international application. For problems concerning unity of invention occurred after the restoration, they shall be dealt with according to Chapter 6 of Part II of these Guidelines. Where the applicant fails to pay the restoration fee of unity of invention within two months, the applicant shall be notified that the above - mentioned contents which have not gone through the international search and international preliminary examination shall be deemed to have been withdrawn and shall not form the basis of examination.

Where, it is held after examination that according to the application documents submitted by the applicant and requested to be used as the basis of examination, there is no problem of unity of invention, and is inconsistent with the decision of the International Bureau, an examination shall be conducted on all of the subject matters seeking protection.

For circumstances where, during the search and examination in the international phase, the International Bureau has not raised the issue of unity of invention, but there is in fact defects in the application regarding lacking of unity of invention, the provisions in Chapter 6 of Part II of these Guidelines shall apply.

**5.6 Examination of Double Patenting**

**Rule 13.1**

Where an international application designating China claims the priority right of an earlier application filed in China or an earli-

er international application which has designed China and entered China's national phase, two patent applications regarding the same invention might enter the proceedings of examination as to substance. In order to avoid double patenting out of this, provisions in Section 6, Chapter 3 of Part II of these Guidelines shall apply to the handling of these two patent applications.

#### 6. Correction of Mistake in Translation

##### Rule 110

Where the applicant finds, by him or itself, there are mistakes in the Chinese translation of the description, the claims or the text matter of the drawings as filed, it/he may request to correct the translation within the following time limit:

(1) before the completion of technical preparations for national publication by the Patent Office;

(2) within three months from the date of receipt of the notification of the Patent Office on the entering into substantive examination phase of an application of patent for invention.

Where the applicant intends to correct the mistakes in the translation, it/he shall file a written request for correction and submit a replacement sheet of the translation. When such circumstances occur, the examiner shall check whether it is a mistake of translation. If not, the request for correction shall be rejected. If it is a translation mistake, the correctness of the correction of the translation shall be verified. Where it is confirmed that the correction is in conformity with the provisions of Article 33 of the Patent Law, further examination based on the amended text may be performed. Where the amended translation is still inconsistent with the original, the examiner shall notify the applicant accordingly and an examination shall be conducted to the amended text on whether it is in conformity with Article 33 of the Patent Law.

For defects due to translation mistakes which are found by the examiner in the course of examination as to substance, and which did not exist in the original text of the international application or in the original text which was amended in the international phase, but exist in the translation, the defects shall be indicated in the Office Action. The applicant shall, at the time of making response to the Office Action, file a written request for correction of mistakes in the translation and submit the replacement sheet of the translation. At this time, it is necessary to check only whether the amended translation is correct and whether the amendment is in conformity with Article 33 of the Patent Law.

**Part IV**  
**Examination of Requests for**  
**Reexamination and Invalidity**

Part IV  
Examination of Requests for  
Registration and Validation

**Chapter 1****General Principles****1. Introduction**

This Chapter relates mainly to the establishment, the tasks, and the composition of the Patent Reexamination Board, the principles of the examination of requests for reexamination and invalidation, the collegiate system of examination, the challenge system, the decision of examination, the evidence and the determination of evidence and the determination of non – publication disclosure, etc. . The aforesaid contents apply to the examination of the requests for reexamination and invalidation.

**2. Establishment of Patent Reexamination Board**

In accordance with the provisions of Article 41. 1 of the Patent Law, the State Intellectual Property Office shall establish the Patent Reexamination Board.

**3. Tasks of Patent Reexamination Board**

In accordance with the provisions of Articles 41, 45 and 46 of the Patent Law, the Patent Reexamination Board performs examination of and makes decisions regarding the requests for reexamination and for invalidation of the patent right.

**3. 1 Examination of Requests for Reexamination**

In accordance with the provisions of Article 41. 1 of the Patent Law, cases of request for reexamination by the Patent Reexamination Board are those made for reexamination out of dissatisfaction with the decision of rejection by the Patent Office, including cases involving reexamination of the rejected applications in the preliminary and substantive examination.

**3. 1. 1 Reexamination of Decision of Rejection of Preliminary Examination**

Rule 44

The Patent Reexamination Board examines the requests for reexamination made out of dissatisfaction with the decision of rejection of the patent application made by the Patent Office in accordance with the provisions of Rule 44 of the Implementing Regulations of the Patent Law.

**3. 1. 2 Reexamination of Decision of Rejection of Substantive Ex-**

**amination**

Art. 38  
Rule 53

The Patent Reexamination Board examines requests for reexamination made out of dissatisfaction with the decision of rejection of the application by the Patent Office in accordance with Article 38 of the Patent Law and Rule 53 of the Implementing Regulations of the Patent Law.

**3. 2 Examination of Requests for Invalidation of Patent Right**

In accordance with Articles 45 and 46. 1 of the Patent Law, the Patent Reexamination Board examines the request for invalidation of patent right.

**3. 3 Appearance in Court**

Where an party concerned is not satisfied with the decision made by the Patent Reexamination Board and institutes legal proceedings in the people's court according to law, the Patent Reexamination Board may appear in court.

**4. Composition of Patent Reexamination Board**

Rule 58

The Patent Reexamination Board is composed of a Director General, Deputy Directors General, members of the Reexamination Board, and concurrent members, examiners and concurrent examiners of reexamination. The Commissioner of the State Intellectual Property Office shall concurrently hold the position of the Director General of the Patent Reexamination Board. The Deputy Directors General, members and concurrent members of the Patent Reexamination Board shall be appointed by the Commissioner among experienced experts in technology and law from the Office. The examiners and concurrent examiners of reexamination are selected by the Commissioner among the experienced examiners and staff of the legal affairs from the Office.

**5. Principles of Examination**

The principles generally applied in the various procedures for the examination of request for reexamination ( hereinafter referred to as reexamination procedures) and in the various procedures for the examination of request for invalidation ( hereinafter referred to as invalidation procedure) are as follows: principle of legality, principle of fair enforcement of law, principle of petition, principle of conducting investigation *ex officio*, principle of hearing, and principle of publicity.

**5. 1 Principle of Legality**

Art. 21. 1

The Patent Reexamination Board shall perform its administration in accordance with the law. The examination procedures and the examination decisions of both the cases of request for reexamination (( hereinafter referred to as the reexamination cases) and the cases of request for invalidation (( hereinafter referred to as the invalidation cases) shall be in conformity with the relevant provisions of the applicable laws, rules and regulations.

**5. 2 Principle of Fair Enforcement of Law**

Art. 21. 1

The Patent Reexamination Board shall act in line with the principles of objectivity, impartiality, correctness and timeliness, on the basis of the facts and in compliance with the law; perform its functions of examination independently without personal consideration; make impartial decisions on the basis of comprehensive, objective and rational analysis and judgment.

**5. 3 Principle of Petition**

Rule 63

Rule 71

The reexamination procedures and the invalidation procedure shall be initiated at the request of the party concerned. If the petitioner withdraws its/his request before the Patent Reexamination Board makes a decision concerning reexamination or examination of invalidation, the examination procedures it or he has initiated shall be terminated. However, if the withdrawal is made when the conclusion of examination decision has been announced or the decision has been issued in writing, the effectiveness of the examination decision shall not be affected.

**5. 4 Principle of Conducting Investigations *Ex Officio***

The Patent Reexamination Board may conduct investigation *ex officio* of the cases under its examination.

**5. 5 Principle of Hearing**

Before any examination decision is made, the party concerned to whom the decision may be unfavorable shall be given a chance to make observations regarding the grounds, evidence, and the ascertained facts adopted in the examination decision, that is, the party concerned to whom the examination decision is unfavorable shall have been informed of the grounds, evidence, and the ascertained facts adopted in the examination decision in the process of notification, document communication

or oral procedure.

If there is a change in patent applicant or patentee according to the effective judgment or settlement decision made by the People's Court or a local Intellectual Property Office (or corresponding functional department) before the examination decision is made, the party concerned, after the change, shall be given a chance to make its or his observations.

#### **5. 6 Principle of Publicity**

Except the cases that need to be kept secret according to the laws and regulations of the State (including cases in which patent applicants request for reexamination out of dissatisfaction with the rejection made during the preliminary examination), the oral procedure of all the other cases shall be held publicly, and the examination decisions published and distributed to the public.

#### **6. Examination by Collegiate Panel**

Cases that are collegially examined by the Patent Reexamination Board shall be examined by a collegiate panel consisting of three or five members, including a panel leader, one chief examiner and one or three participating examiners.

##### **6. 1 Setting – Up of Collegiate Panel**

The Patent Reexamination Board shall determine and change the members of the collegiate panel to attend to cases of reexamination and invalidation in accordance with the prescribed procedures in the light of division of specialty, amount of cases, and the circumstances of the examination staff engaged in the same patent application or in the prior patent procedures.

The heads of the appealing divisions of the Patent Reexamination Board and members of the Reexamination Board shall be qualified of right to serve as the panel leader; others shall be qualified to serve as the panel leader with the approval of the Director General or Deputy Directors General of the Board.

The members of the Reexamination Board, reexamination examiners, concurrent committee members of the Patent Reexamination Board concurrent examiners of reexamination may serve as chief examiners or participating examiners of the panel.

Examiners invited from the examination departments may serve as participating examiners of the panel for specific cases.



After the Patent Reexamination Board makes the examination decision to uphold the validity of a patent right or declare a patent right partially invalid, if the same petitioner raises another request for invalidation of the patent right to which the said examination decision relates on different grounds or on the basis of different evidence, the chief examiner who has made the initial examination decision shall not participate in the examination of the invalidation case.

For cases to be reexamined after the initial examination decision is cancelled by the effective judgments of the People's Court, the panel – members shall be re – determined, and the chief examiner who has made the initial examination decision shall not participate in the new round reexamination.

#### **6.2 Provisions Concerning the Setting – Up of Five – Member Collegiate Panel**

For the following cases, a five – member collegiate panel shall be set up:

- (1) cases of great influence in China or abroad;
- (2) cases involving important knotty legal issues ; and
- (3) cases involving great economic interests.

Decisions on the necessity to set up a five – member collegiate panel shall be made by the Director General or by the Deputy Directors General upon joint consideration or examined and approved by the Director or Deputy Directors General upon report by the head of the relevant division or panel – members in accordance with the stipulated procedures.

For cases examined by a five – member panel, if no oral hearing has been conducted before the setting – up of such a panel, a hearing shall be conducted.

#### **6.3 Division of Responsibility of Panel Members**

The panel leader presides over the comprehensive examination of the reexamination or invalidation procedure; presides over oral procedure; presides over panel meetings and the voting thereof; makes decisions on whether the examination decision of the collegiate panel should be reported to the Director General or the Deputy Directors General for examination and approval.

The chief examiner is responsible for conducting comprehensive and detailed examination of cases and taking care of the file; preparing notifications and examination decisions; taking

charge of routine contacts between the panel and the parties concerned; and preparing texts of announcement to be published when the conclusion of the examination for the request for invalidation is to declare the patent right partially invalid.

The participating examiner shall participate the examination and assist the panel leader and the chief examiner.

#### **6. 4 Formation of the Conclusion of Panel Examination**

The collegiate panel makes examination decisions by votes by the rule of majority on whether the evidence involved in the examination of reexamination or invalidation is to be adopted, whether the facts could be affirmed or whether the legal grounds are tenable.

#### **7. Examination by Sole Examiner**

Simple cases may be independently examined by a sole examiner.

#### **8. Challenge System**

##### **Rule 38**

Where a panel member of a reexamination or invalidation case belongs to one of the situations as prescribed in Rule 38 of the Implementing Regulations of the Patent Law, the panel member shall be excluded from performing his/her function on his/her own initiative. If such a panel member who should have been excluded from performing his/her function on his/her own initiative has not been excluded, the party concerned has the right to request him/her to be excluded.

Where the party concerned requests a panel member to be excluded, the request shall be filed in writing, the grounds shall be stated, with relevant evidence attached if necessary.

For any request for exclusion raised by an party concerned, the Patent Reexamination Board shall make a decision in writing and notify the person who raised the request.

#### **9. Decision of Examination**

##### **9. 1 Examination and Approval of Examination Decision**

The panel shall be fully responsible for the identification of facts, the application of the law and the regulations, the format and wording of the conclusion as well as the documents of the examination decision.

In the following cases, the examination decision made by the panel shall be reviewed and approved by the Director General or Deputy Directors General of the Board:

- (1) cases examined by the five – member panel;
- (2) cases in which the panel members are divided in their votes; or
- (3) cases in which the decisions are re – made after the initial examination decisions of the Patent Reexamination Board were cancelled by an effective judgment of the Court.

Where the Director General or Deputy Director General of the Patent Reexamination Board responsible for examining and approving the panel decision does not agree with the decision, he/she may instruct the panel to discuss the matter again and make a conclusion. In cases where no unanimous consensus can be reached between the panel and the Director General or the Deputy Directors General after the panel discusses the matter again, if the Director General or at least two Deputy Directors General think it necessary to consider the matter in a broader circle, a meeting shall be held in which at least two thirds of the Director General, Deputy Directors General and the members of Patent Reexamination Board shall participate to discuss the matter. The panel and the Director General or Deputy Directors General responsible for the examination and approval shall handle the matter according to the opinion of the majority, that is, the opinion of over a half of the participants.

In some important knotty cases, a meeting of Director General, Deputy Directors General, all the members and examiners of the Patent Reexamination Board shall be held with the approval of the Director General to discuss the matter involved and make a decision.

The person who is in charge of the examination and approval of a case shall be responsible for the examination and approval regarding the application of relevant laws and regulations and the conclusion of the examination decision.

## 9.2 Composition of Examination Decision

The examination decision includes the following components.

- (1) Bibliographic data of the examination decision

The bibliographic data of the examination decision on the request for reexamination shall include the number and the date of

the decision, the title of the invention – creation, the IPC Symbol, the petitioner for reexamination, the application number, the date of filing, the date of publication (if the application for a patent for invention has been published) and the name of the members of the Collegiate Panel.

The bibliographic data of the examination decision on the request for invalidation shall include the number and the date of the decision, the title of the invention – creation, the IPC symbol, the petitioner for the invalidation, the name or title of the patentee, the patent number, the date of filing, the date of announcement of the grant of the patent right and name of the members of the collegiate panel.

#### (2) Legal bases

Legal bases of the examination decision shall refer to the Articles and Rules of the relevant laws and regulations to which the grounds of the examination decisions relate.

#### (3) Main points of the decision

The main points of the decision are essential summaries and core expositions of the grounds on which the text of the decision is based. It is the criteria for the judgement of the issues in dispute or for the difficult points of the case. The main points of the decision shall further explain the Articles and Rules of the Patent Law and its Implementing Regulations that are referred to, and shall, as much as possible, draw instructive conclusions according to the specific circumstances of the case.

The main points of the decision shall meet the following formal requirements:

- ( i ) the wording shall be simple and concise ;
- ( ii ) the statements shall be logical, accurate, well organized, well grounded and consistent with the conclusion of the decision;
- ( iii ) the conclusion shall not be drawn by simply reciting the relevant Articles of the Patent Law or the Rules of its Implementing Regulations, nor a brief summery of the cause of action and a conclusion thereof; it is allowable to extract from the text of the decision the key sentences which fulfill the said requirements.

#### (4) Cause of action

The following shall be presented in chronological order in the part of cause of action: submission of request for reexamination or invalidation, grounds, evidence, acceptance of the request for reexamination or invalidation, delivery and transfer of

documents, examination process and principal disputes. The information of this part shall be objective, true to the fact and consistent with the corresponding records of the case. It shall reflect the examination process and the main arguments of the case in a correct and brief way.

The part of cause of action shall outline and summarize the statements of both parties in brief and concise language, clearly and accurately represent the views of both parties, and shall specify all the reasons and evidence of the party to whom the decision of conclusion may be unfavorable.

An examination decision of reexamination of an application for patent for invention or utility model or that of examination of invalidation of the patent right shall indicate clearly the contents of the independent claims and that of the dependent claims to which the examination decision is directed.

#### (5) Grounds of decision

In this part of the decision, it shall be explained in detail the stipulations of the laws and regulations and the facts on which the examination decision is based, as well as the applicability of the Articles to the case. The explanation of this part shall be detailed to the extent that the conclusion of the examination can be drawn on the basis of the stipulations and facts mentioned in this part. A detailed analysis should be made on all the grounds, evidence and principal opinions of the party to whom the conclusion of the decision may be unfavorable, and reasons shall be stated on why its/his grounds are untenable and opinions could not be adopted.

As for the examination decision relating to the assessment of the identicalness or similarity of designs, the main contents of the design to which the decision relates shall be first presented in writing in an objective manner.

#### (6) Conclusion

In this part, the detailed conclusion of the examination shall be stated. Clear and specific instructions to the initiation, time limit and accepting entity of the follow – up procedures shall also be given.

#### (7) Drawings

For the examination decision in which the assessment of identicalness or similarity of designs is involved, the picture or the photograph of the design may be used as the drawing of the examination decision when necessary.

### **9.3 Publication of Examination Decision**

All the texts of the examination decisions made by the Patent Reexamination Board on requests for reexamination and invalidation shall be published except for those in which non – published patent applications are involved. For all the examination decisions which are to be published, if an party concerned is not satisfied with the decision and has instituted legal proceedings in the court and if the court has accepted the case, the examination decision and the judgment of the court shall be published together after the judgment of the court takes legal effect.

## **10. Rectification and Correction**

### **10.1 Rectification Relating to Acceptance**

Where a request for reexamination or invalidation was not, but should have been, accepted; or was, but should not have been, accepted, it shall be rectified upon the approval of the Director General or Deputy Director General, and the party concerned shall be notified accordingly.

### **10.2 Rectification of Notification**

Where the Patent Reexamination Board finds that there are errors in the various notifications and that the errors should be corrected, rectifications shall be made upon the approval of the Director General or Deputy Director General and the party concerned shall be notified accordingly.

### **10.3 Rectification of Examination Decision**

Where there are obvious clerical errors in the examination decision on request for reexamination or invalidation and need to be rectified after they are found out, rectification shall be made upon the approval of the Director General or Deputy Director General, and the party concerned shall be notified in the form of Notification which is attached with replacement sheets.

### **10.4 Rectification of Requests Deemed to Have Been Withdrawn**

For any request for reexamination or invalidation which has already been deemed to have been withdrawn, it shall be corrected once it is found that it should not be thus treated and that the correction is approved by the Director General or Deputy Director General. The reexamination or invalidation procedure shall be continued, and the party concerned shall be notified accordingly.

### **10. 5 Rectification of Other Decision**

For all the other decisions which are made by the Patent Re-examination Board and need to be corrected, the rectification shall be made upon the approval of the Director General or Deputy Director General.

### **10. 6 Rejection of Request**

For any request for reexamination or invalidation that is accepted, if considered not in conformity with the requirements after examination, a decision of rejection of the request for reexamination or invalidation shall be made after being approved by the Director General or Deputy Director General of the Reexamination Board.

## **11. Evidence, Determination of Evidence and Burden of Producing Evidence**

### **11. 1 Evidence**

Evidence includes documentary evidence, material evidence, audiovisual material, testimony of witness, statement of the party concerned, conclusion of appraisal and record of on-site investigation and examination. Furthermore, evidence is divided into direct evidence and indirect evidence. The direct evidence refers to evidence that can be used independently and directly to prove the facts that need to be proved. The indirect evidence refers to evidence that can not be used independently and directly to prove the said facts, but need to be used in combination with other evidence to prove the facts that need to be proved.

### **11. 2 Determination of Evidence**

The evidence can be used only after it is investigated and verified. The panel shall comprehensively and objectively examine and verify the evidence according to the written statement made by the party concerned in respect of the evidence and its/his oral statement provided in the oral procedure. The panel shall also examine and verify the evidence according to the written statement in respect of the evidence and oral statement made by the adversary party during the cross-examination of the oral procedure in a comprehensive and objective way. The truthfulness and reliability of the evidence can be examined from the two aspects of the source of the evidence and the content of the evidence. When the truthfulness and reliability of the evi-

dence is examined from the angle of the source of the evidence, it shall be mainly focused on whether, during the course of its formation, there are any factors that may affect the truthfulness and reliability of the evidence and whether, with regard to the provider of the evidence, there are any factors that may affect the truthfulness and reliability of the evidence. When the truthfulness and reliability of the evidence is examined from the angle of the content of the evidence, it shall be mainly focused on whether the facts revealed by the evidence are reasonable and free of inconsistency.

The following rules shall be followed when using indirect evidence to prove the facts:

- (1) the evidences *per se* must be true and reliable;
- (2) there is no inconsistency among the indirect evidences used for the determination of the facts;
- (3) the indirect evidences must be of itself a complete system of proofs;
- (4) the conclusion drawn from the system of proofs comprising indirect evidences must be unique.

Any written testimony can be used only after the cross – examination and the cross – confirmation with other evidences. The oral evidence of a person incapable of expressing his/her will correctly cannot be used as the basis for the determination of the facts.

For audiovisual materials, the statement of the party concerned, documentary and material evidence under objection or query, they shall be examined in combination with the other evidences of the case so as to determine whether they may be used as the basis for the determination of the facts.

Legal acts, legal facts and legal instruments that have been notarized by the legal procedures may be used as the basis for the determination of the facts, on condition that there is no evidence to overturn the notary attestation. The party concerned may submit such proofs as the notary certificate from the notary office to prove the legal act, legal facts, and legal instruments that are notarized by the notary office. Nevertheless, any notary certificate of such office which goes beyond its scope of notarization cannot be used as the basis for the determination of the facts.

The evidence materials obtained by illegal means shall not be used as evidence.



### **11. 3 Burden of Producing Evidence**

The party concerned shall be under the burden of producing evidence for its/his allegation. Where it is necessary to present evidence, the party concerned shall provide evidence sufficient to support its/his allegation. For the same facts, the party concerned who raised the allegation shall generally put to the proof first. Where the facts proved by the evidence can be confirmed after cross – examination, the burden of producing evidence shall be transferred to its/his adversary. If no evidence which is sufficient to overturn the said proof of the facts could be put forward by the parties concerned of the adversary, the facts may be confirmed. If the parties concerned of the adversary has put forward evidence sufficient to overturn the facts, the burden of producing evidence goes back to the party who raises the allegation. Where any party who is under the burden of producing evidence cannot provide sufficient evidence, it/he shall bear the legal consequences of not tenable of its/his allegation or tenability of the allegation of the adversary.

### **12. Determination of Disclosure**

Disclosure in the sense of the Patent Law includes disclosure by means of publication ( i. e. disclosure by publication) and disclosure by means of non – publication.

#### **12. 1 Disclosure by Means of Publication**

Disclosure by means of publication means that a technology (or design) is openly published in publications. For disclosure by means of publication, please refer to the relevant provisions of Chapter 3, Part II of these Guidelines.

#### **12. 2 Determination of Disclosure by Means of Non – Publication**

Disclosure by means of non – publication means that a technology (or design) is disclosed by means other than publication, that is, disclosure by use, oral disclosure and disclosure by carriers other than publication.

##### **12. 2. 1 Learner of the Technology (or Design) and Disseminator of Technology (or Design)**

A learner of a technology (or design) ( hereinafter referred to as the learner) refers to one who, before the date of filing (or the priority date where priority is claimed, the same below) of a

patent or a patent application, obtains the knowledge of a technology (or design) from another person or at another person's place and is capable of disseminating the technology (or design) which he has obtained.

The another person referred to above is the disseminator of the technology (or design) (hereinafter referred to as the disseminator). The disseminator can be both an inventor (or designer) or a learner.

#### **12. 2. 2 Obligation of Confidentiality of the Learner**

Where there is an agreement on confidentiality between the learner and the disseminator or where there are applicable stipulations on confidentiality or where there is evidence proving that the disseminator has required the learner to keep a technology (or design) confidential before the disseminator disseminates the same to the learner, it should be established that the learner has the obligation to keep confidential the technology (or design) which he has learned from the disseminator.

Where there is no agreement on confidentiality between the learner and the disseminator, and if there are no applicable stipulations about confidentiality, nor there are evidences showing that the disseminator has required the learner to keep the technology (or design) confidential before he had disseminated the same to the learner, then it shall make a judgment of whether the learner is bound by the obligation of confidentiality based on their business relations, ascertainable facts, evidences and the principle of bona fide.

#### **12. 2. 3 Principle of Determination**

The key to determine whether a technology (or design) is disclosed is to determine whether any one in the public may have access to the technology (or design) if he/she so wishes.

#### **12. 2. 4 Criteria of Determination**

Where there is evidence showing that the inventor (or designer) or the learner has disseminated the technology (or design) to the public by non – publication means, and if, as a result, any person in the public who wants to know the technology (or design) may have access to it, it shall be established that the technology (or design) is disclosed.

If, though the learner is not under obligation with regard to

the disseminator to keep confidential the technology or design he/she has learned, it cannot be proved that the means or method of obtaining the technology (or design) can make anyone in the public have access to the technology or design if he/she so wishes, it shall not be established that the technology (or design) is disclosed because there is the learner who knows about the technology (or design).

If, though the learner is under obligation with regard to the disseminator to keep confidential the technology (or design) which he/she has learned, there is evidence showing that he/she in fact had not fulfilled his/her obligation of confidentiality before the date of filing and has disseminated the technology (or design) to the public by non – publication means, it shall be established that the technology (or design) is disclosed.

If the learner is under obligation with regard to the disseminator to keep confidential the technology (or design) that he/she has learned and if there is no evidence showing that he/she in fact had failed in fulfilling his/her obligation, it shall not be established that the technology (or design) is disclosed because there is the learner who knows about the technology (or design).

#### 12. 2. 5 Disclosure by Use

The disclosure by use includes making known to the public the contents of the technology (or design) by way of manufacture, use, sale, importation, exchange, gift – presenting, demonstration, and exhibition etc. . The contents of the technology (or design) is made available to the public through disclosure by use, the public may have access to it as long as they want to. It does not matter whether any person in the public actually knows about it.

For instance, there is a sales invoice which can prove that Entity A ( the disseminator) has sold a type of a product to Entity B ( the learner) before the date of filing, and Entity B is not obliged with regard to Entity A to keep it confidential. Entity B has obtained this product by the legal means of purchase. Under such circumstances, the technical features of the product are accessible to the public because any person who buys the product can learn about not only its external technical features, but also its internal technical features by disassembling or destroying it, except for those features which cannot be learned due to the

technical limitation, including the limited means of analysis available at the time. Therefore, a technical solution comprising technical features which is available to the public due to the act of selling shall be established as being disclosed by use.

If the technical contents are used in a confidential way, it shall not be regarded as being available to the public, and should not be established that the said technical contents is made public by the use. For instance, the trial use of a new weapon or outfit by the soldiers in the army, or the experiment on a new technical method carried out by a confidential factory are uses of confidential nature, as both the soldiers in the army and the employees of the factory (the learners) are bound by stipulations on confidentiality, their learning and use of the technology does not constitute the disclosure of the technology.

#### **12. 2. 6 Oral Disclosure**

The means of oral disclosure include such means as conversation, report, lecture, speech, radio and television broadcasts and sound – reproduction equipment, through which the technical contents are communicated to the public. The technical contents communicated to the public by way of all these means is thus disclosed orally, the public may know about them as long as they wish. It doesn't matter whether any person of the public has actually obtained it.

If someone (the disseminator) requires a listener (learner) to keep confidential the technical contents before he/she tells him about it, the listener is then obliged to keep the technical contents confidential and no one in the public can know anything about it. Unless there is the evidence showing that the listener in fact fails to fulfill his/its obligation to confidentiality and that the technical contents are disclosed, the fact that the said listener has learned about the technology is not enough to establish that the technical contents are disclosed.

#### **12. 2. 7 Disclosure by Carriers Other than Publication**

Disclosure by carriers other than publication refers to the disclosure in which the technology (or design) is disclosed by various carriers that are not publications in the sense of the Patent Law, such as disclosure of technology (or design) on printing materials.

For instance, a piece of paper on which technical contents

are contained is given by someone (the disseminator) to another person (the learner). If there is evidence showing that there exists special business relations between the two, and, according to the precedents and the previous experiences, the learner knows that he/she is obliged to keep the said technical contents confidential, then the fact that the learner knows about the technical contents is not enough to establish that the said technology is disclosed.

#### **12. 2. 8 Disclosure by Use or Oral Disclosure as Recorded in Writing or in Other Forms**

For disclosure by use or oral disclosure which happens before the date of filing and is recorded in writing or in other forms on or after the date of filing, if the said contents have already been recorded before the happening of the dispute over the right to apply for patent or patent right to which the reexamination or invalidation case relates and if there is neither evidence showing that the contents recorded in writing or in other forms are different from those of the technical contents (or design) which are disclosed by use or by oral disclosure, nor is there evidence showing that the contents recorded in writing or in other forms are not true, then the said contents recorded in writing or in other forms shall be regarded as the true record of the said disclosure by use or by oral disclosure.

#### **13. Stipulations Concerning Examination Procedures after the Examination Decision Being Cancelled by Effective Court Judgment**

(1) After the examination decision on the request for reexamination is cancelled by effective judgment of the People's Court, the Patent Reexamination Board shall re – make the examination decision.

Where the examination decision on the request for invalidation is cancelled by effective judgment of the People's Court and if the judgement does not indicate whether the patent right is valid, the Patent Reexamination Board shall re – make the examination decision.

(2) Where the examination decision is cancelled on the grounds that the main evidence is insufficient or the application of the laws and regulations is incorrect, no decision that is identical with the initial one shall be made for the same reasons and based on the same evidences.

(3) Where the examination decision is cancelled for violation of the statutory procedures, the Patent Reexamination Board shall rectify the procedural errors and, on the basis of the rectification, re – make the examination decision in accordance with the judgment of the People's Court.

#### **14. Stipulations Concerning Translation of Evidence in Foreign Language**

##### **Rule 4**

Where evidence in a foreign language is submitted by the party concerned, the Chinese translation of the part to be used shall be submitted at the same time when the evidence in the foreign language is submitted. If the party concerned who submits the evidence in a foreign language fails to submit the Chinese translation, the evidence in the foreign language shall be deemed not to have been submitted. Where the party concerned of the adversary has objection to a specific content of the translation, the Chinese translation of the corresponding part to which the objection relates shall be submitted. Where necessary, an entity which is acceptable by both parties can be entrusted to translate the whole of the text, a part of the text which is to be used or the part of the text to which the objection relates. Where the parties cannot reach an agreement on whom to entrust in respect of the translation, the Patent Reexamination Board may entrust a professional translation entity to translate the whole of the text, a part of the text which is to be used or the part of the text to which the objection relates. Each party shall bear 50% of the translation fee. The party refusing to pay the translation fee shall be regarded as having no objection to the correctness of the translation submitted by its adversary.

#### **15. Stipulations Concerning Invitation of Relevant Organizations or Experts to Provide Consultation or Make Appraisal**

When necessary, the Patent Reexamination Board may invite relevant organizations or experts to provide consultation on the contents or issues involved in a case, and entrust the relevant organizations to conduct appraisal. The necessary cost shall be borne by the Patent Reexamination Board or the party concerned depending on the specific circumstances of the case.

#### **16. Treatment of Sample Submitted by Party Concerned**

At the time of submitting a sample in the procedure of reex-

amination and invalidation, the party concerned has the right to request in writing that the sample be taken back by it/him when the case is closed. For such a request, the panel shall decide the timing for the sample to be taken back based on the actual needs of the examination and the follow-up procedures. When the party concerned is allowed to take back the sample, the Patent Reexamination Board shall notify it/him accordingly, and the party concerned shall take back the sample within three months from the date of receipt of the notification. If the sample is not taken back within the time limit or where no request is made for the taking back of the sample at the time of submitting the sample, the Patent Reexamination Board shall have right to dispose of it.

## **Chapter 2**

### **Examination of Request for Reexamination**

#### **1. Introduction**

This Chapter relates mainly to the principles of examination, formality examination, interlocutory examination, collegiate examination and decision of reexamination with regard to the examination of request for reexamination.

#### **2. Legal Basis**

This Chapter is formulated in accordance with the provisions of Article 41 of the Patent Law and Rules 59 to 63 of the Implementing Regulations of the Patent Law.

#### **3. Principles of Examination**

Being part of the procedures of patent examination and approval, the principles to be observed in the examination procedures shall also apply to the reexamination procedure. Apart from the principles as provided for in the General Provisions, the collegiate panel shall observe the principle of non – missing of examination step and the principle of procedure – saving .

##### **3. 1 Principle of Non – Missing of Examination Step**

Any examination not performed at the preceding level shall normally not be performed at the subsequent level so as to free the parties from missing any examination step.

##### **3. 2 Procedure – Saving Principle**

The procedure shall be performed without repetition, and shall be as prompt, time – saving and cost – effective as possible.

#### **4. Formality Examination of Request for Reexamination**

##### **4. 1 Contents of Formality Examination**

The applicant who is not satisfied with the decision on rejection by the Patent Office may file a request in writing for reexamination with the Patent Reexamination Board.

After the Patent Reexamination Board receives the request for reexamination, it shall first perform the formality examination. The contents of formality examination are as follows:

- (1) whether the request for reexamination is one made out



Art. 41. 1

of dissatisfaction with the decision on rejection by the Patent Office as provided for in Article 41. 1 of the Patent Law;

(2) whether the person requesting for reexamination is the applicant of the rejected application; where the applicants of the rejected application are co – applicants, whether the persons requesting for reexamination are all the co – applicants;

(3) whether the time limit of filing the request for reexamination is in conformity with the provision of Article 41. 1 of the Patent Law; where the time limit is not in conformity with the provisions in the presence of the request for restoration of right, whether the request is in conformity with the provision concerning the request for right restoration of Rules 7 and 93 of the Implementing Regulations of the Patent Law;

(4) whether the person requesting for reexamination has paid the reexamination fee according to the provisions of Rules 90, 91 and 93 of the Implementing Regulations of the Patent Law; where the said fee has not been paid or has not been paid in full within the prescribed time limit; in the presence of the request for restoration of right, whether that request is in conformity with the provisions concerning request for right restoration of Rules 7 and 93 of the Implementing Regulations of the Patent Law;

Rule 59. 2

(5) whether the request for reexamination is in the form of the prescribed standard format;

Rule 16. 3

(6) where the person requesting for reexamination has appointed a patent agency to handle the reexamination request, whether the power of attorney has been submitted and whether the scope of power has been indicated.

#### 4. 2 Handling of Formality Examination

(1) The request for reexamination shall not be accepted if it is one that has been filed out of dissatisfaction with the decision by or notification from the Patent Office, rather than one filed out of dissatisfaction with the decision on rejection by the Patent Office as stipulated in the provision of Article 41. 1 of the Patent Law.

Art. 41. 1

(2) The request for reexamination shall not be accepted if the person requesting for reexamination is not the applicant of the rejected application. Where the applicants of the rejected application are co – applicants, but the persons who request for the reexamination do not include all of the applicants, the situa-

tion shall be rectified. If no rectification has been made when time is due, the request for reexamination shall be deemed not to have been made.

(3) The request for reexamination shall not be accepted if the time limit for filing the same is not in conformity with the provision of Article 41. 1 of the Patent Law.

Where the request for restoration of right is filed after the decision on non – acceptance is made, if the request for restoration is in conformity with the provisions concerning restoration of right of Rules 7 and 93 of the Implementing Regulations of the Patent Law, the right may be restored, and the request for reexamination shall be accepted. Otherwise, the right cannot be restored.

Where the time limit for filing the request for reexamination is not in conformity with the provision of Article 41. 1 of the Patent Law, but the request for restoration of right is filed before the decision on non – acceptance is made, then the two requests may be handled together. If the request for restoration is in conformity with the provisions concerning the restoration of right of Rules 7 and 93 of the Implementing Regulations of the Patent Law, the request for reexamination shall be accepted. Otherwise, the request for reexamination shall not be accepted.

Rule 90  
Rule 91

(4) If the person requesting for reexamination files the request for reexamination within three months from the date of receipt of the decision on rejection, but has not paid, or not paid in full, the reexamination fee within the time limit, the request for reexamination shall be deemed not to have been filed.

Where the request for restoration of right is filed after the decision on deeming the request for reexamination not to have been filed is made, if the request is in conformity with the provisions concerning restoration of right of Rules 7 and 93 of the Implementing Regulations of the Patent Law, the right may be restored, and the request for reexamination shall be accepted. Otherwise, the right shall not be restored.

Where the reexamination fee is paid in full after three months from the date of receipt of the decision on rejection and where the request for restoration of right is filed before the decision is made, the two requests may be handled together. If the request for restoration of right is in conformity with the provisions concerning restoration of right of Rules 7 and 93 of the Implementing Regulations of the Patent Law, the request for reexamination shall be accepted. Otherwise, the request for reexamination

shall be deemed not to have been filed.

**Rule 59. 2**

(5) Where the request for reexamination is not in the form of the prescribed standard format, the Patent Reexamination Board shall invite the person requesting for reexamination to rectify it within the prescribed time limit. If no rectification has been made after the expiration of the time limit or though rectification has been made within the prescribed time limit, if the same defects remain after the rectification has been submitted for two times, the request for reexamination shall be deemed not to have been filed.

**Rule 16. 3**

(6) Where the person requesting for reexamination has appointed a patent agency to handle the reexamination request, but has not submitted the power of attorney or has not indicated the scope of power, the situation shall be rectified. If no rectification has been made when the time is due, the appointment shall be deemed not to have been made.

Where the request for reexamination is not in conformity with the provisions of the Patent Law and its Implementing Regulations after the formality examination and rectification is required, the Patent Reexamination Board shall issue the "Notification on Rectification" and invite the person requesting for reexamination to make the rectification within one month from the date of receipt of the Notification.

Where the request for reexamination is deemed not to have been filed or has not been accepted, the Patent Reexamination Board shall issue the "Notification on Deeming the Request for Reexamination Not to Have Been Filed" or the "Notification of Non - acceptance of Request for Reexamination", and notify the person requesting for reexamination accordingly.

Where the request for reexamination meets the requirements of the relevant provisions of the Patent Law and its Implementing Regulations after the formality examination, the Patent Reexamination Board shall issue the "Notification of Acceptance of Request for Reexamination", and notify the person requesting for reexamination accordingly.

## **5. Interlocutory Examination**

In accordance with the provisions of Rule 61 of the Regulations, the Patent Reexamination Board shall transfer for interlocutory examination of the request for reexamination made out of dissatisfied with the decision on rejection by the Patent Office which has passed the formality examination including the att-

ched certifying documents and amended application documents to the examination department which made the decision on rejection together with the original application file. The examination department shall provide an Office Action of Interlocutory Examination. Except in special situations, the interlocutory examination shall be completed within one months from the date of receipt of the file.

There are three types of office actions of the interlocutory examination:

(1) The examination department agrees to withdraw the initial rejection decision because the evidence of the request for re-examination is sufficient and the grounds tenable;

(2) The examination department agrees to withdraw the original rejection decision on the grounds of rectification in the amended text submitted by the person requesting for reexamination of the defects in the text of the original application document; and

(3) The examination department upholds the original decision on rejection since the observations and amended text of the application document submitted by the person requesting for re-examination are not enough for it to withdraw the rejection decision.

As for the Office Action of the Interlocutory examination, the examination department that makes the initial examination shall pay special attention to the following points:

(1) The examination department that makes the initial examination shall specify the type of its office action. The grounds for upholding the initial decision of rejection shall be presented in detail. Where the ground is the same as that of the initial decision of rejection, it is not necessary to repeat it, and a brief explanation shall suffice. Where, after conducting another search for the amended claims and using newly found reference documents, the examination department which conducted the initial examination maintains the initial rejection decision, the examination department shall make a detailed explanation of its maintenance on the basis of the new reference documents (in combination with the initial reference documents if necessary).

(2) Where the examination department that made the initial examination believes that the amendment to the rejected patent application submitted by the person who requests for reexamination is not in conformity with the provisions of Rule 60.1 of the

Implementing Regulations of the Patent Law or Article 33 of the Patent Law, the examination department shall indicate this in the Office Action of Interlocutory Examination.

(3) Where the office action of the examination department that made the initial examination falls into (1) or (2) hereina-bove, the Patent Reexamination Board shall no longer conduct collegiate examination. It shall make the reexamination decision on the basis of the interlocutory examination conclusion, notify the person who requests for reexamination, and let the initial examination department proceeds with examination and approval proceedings. The examination department that made the initial examination shall not directly perform the proceedings of examination and approval without the reexamination decision made by the Patent Reexamination Board.

(4) The examination department that made the initial examination shall not raise new grounds for or evidence of the rejection in the Office Action of Interlocutory Examination on the request for reexamination of the application on which the rejection decision is based and to which no amendment has been made.

## **6. Collegiate Examination of Request for Reexamination**

### **6.1 Examination of Grounds and Evidence**

In the reexamination procedures, the examination shall generally focus on the grounds and evidence on which the decision of rejection is based. If necessary, the examination may be performed on the grounds and evidence that should have been examined before the decision of rejection is made. Examination of the said grounds and evidence that should have been examined before the decision of rejection is made does not violate the "principle of non -missing examination step".

When conducting examination to cases of reexamination on decision of rejection made in the substantive examination, the panel may determine in the following order whether the grounds set forth below belong to those that should have been examined at a preceding examination level:

(1) whether the patent application is in conformity with the provisions of Articles 5 and 25 of the Patent Law or Rule 2.1 of the Implementing Regulations of the Patent Law;

(2) whether the amendments to the patent application documents is in conformity with the provision of Article 33 of the Patent Law or whether the divisional application is in conformity with the provisions of Rule 43.1 of the Implementing Regulations of

the Patent Law;

(3) whether the patent application is in conformity with the provisions of Article 22. 4, 26. 3 or 31. 1 of the Patent Law;

(4) whether the patent application is in conformity with the provisions of Article 26. 4 of the Patent Law and Rules 20. 1 or 21. 2 of the Implementing Regulations of the Patent Law;

(5) whether the patent application is in conformity with the provisions of Articles 22. 2 and 9 of the Patent Law or Rule 13. 1 of the Implementing Regulations of the Patent Law; and

(6) whether the patent application is in conformity with the provisions of Article 22. 3 of the Patent Law.

When necessary, such general knowledge as technical dictionary, technical manual, text book, etc. which have fallen into public domain in the technical field, may be introduced into the examination as evidence by the panel.

#### 6. 2 Notification of Reexamination

##### Rule 62

The collegiate panel shall issue a "Notification of Reexamination" notifying the person who requests for reexamination in one of the following circumstances:

(1) the reexamination decision will uphold the decision of rejection;

(2) the original decision of rejection may be withdrawn only when the person who requests for reexamination makes amendments to the application documents according to the relevant provisions of the Patent Law and its Implementing Regulations;

(3) the person who requests for reexamination is required to present further evidence or comment on relevant issues;

(4) it is necessary to present new reasons or evidence that have not been mentioned in the decision of rejection.

The person who requests for reexamination shall respond within one month from the date of receipt of the Notification of Reexamination. If no response is made when the time is due, the requests for reexamination shall be deemed to have been withdrawn.

#### 7. Types of Reexamination Decisions

There are three types of reexamination decisions:

(1) the grounds for request for reexamination is untenable, the request is rejected and the initial decision of rejection upheld;

(2) the grounds for request for reexamination is tenable and

the initial decision of rejection revoked; and

(3) the initial decision of rejection is revoked based on the new text after defects as indicated in the initial decision of rejection was removed after amendments having been made to the patent application documents by the person who requests for re-examination,

The (2) as mentioned above includes the following circumstances:

(i) the laws and regulations applied in the decision of rejection are not correct;

(ii) the grounds for rejection are not supported by the necessary evidence;

(iii) the examination has violated the set legal procedures. For example, the decision of rejection is based on the application text which has been abandoned by the applicant or on the technical solution for which protection has not been claimed; the applicant has not been given a chance in the proceedings of examination to make an observations on the grounds, evidence or affirmed facts adopted in the decision of rejection; or no evaluation is given in the decision of rejection on the evidence submitted by the applicant which has relevance with the reason of the rejection etc.. All the above might influence the impartiality of the examination;

(iv) any other circumstances where grounds of rejection are not tenable.

#### **8. Delivery of Reexamination Decision**

In accordance with Article 41. 1 of the Patent Law, the Patent Reexamination Board shall deliver the examination decision in respect of the request for reexamination to the person who requests for the reexamination.

#### **9. Binding of Reexamination Decision on Examination Department Making Initial Examination**

Where the reexamination decision revokes the decision made by the examination department that made the initial examination, the said examination department shall carry out the reexamination decision and no decision contrary to the reexamination decision shall be made based on the same reason and evidence.

### 10. Termination of Reexamination and Continuation of Examination and Approval

Rule 62. 1

Rule 63

The procedure of reexamination shall terminate if the request for reexamination is deemed to have been withdrawn for failure of making a response when the time is due. The procedure of reexamination shall terminate if the person who requests for reexamination withdraws its/his request for reexamination before a reexamination decision is made.

Where the person who requests for reexamination is not satisfied with the reexamination decision of Section 7 (1) as mentioned above, it/he may institute legal proceedings in the people's court according to Article 41.2 of the Patent Law within three months from the date of receipt of the reexamination decision. The Patent Reexamination Board shall appear before court. Where no legal proceedings are instituted in the court within the specified time limit, the reexamination decision shall take effect and the reexamination procedures terminate. For reexamination decision of Section 7 (2) or (3) as mentioned above, after they are made, the reexamination procedures shall terminate. The Patent Reexamination Board shall return the relevant application file to the examination department that made the initial examination. The examination department shall continue the procedures of examination and approval according to the reexamination decision.



### Chapter 3

#### Examination of Request for Invalidation

##### 1. Introduction

This Chapter mainly relates to the principles of examination, formality examination, collegiate examination and decision of examination in respect of the examination of request for invalidation.

##### 2. Legal Basis

This Chapter is formulated in accordance with the provisions of Articles 45, 46, and 47 of the Patent Law and Rules 64 – 71 of the Implementing Regulations of the Patent Law.

##### 3. Principles of Examination

The proceedings of request for invalidation is to be initiated after the announcement of grant of patent right and involves the parties concerned (except in the situation in which the patentee requests for partial invalidation of its/his patent right). Excerpt for the general principles, with respect to the proceedings of invalidation, the panel shall in addition comply with the following principles: principle of petition, principle of conducting investigation *ex officio*, principle of *non bis in idem*, principle of disposition by parties concerned, doctrine of consolidated examination and principle of confidentiality.

###### 3.1 Principle of Petition

In the proceedings of invalidation, the collegiate panel usually performs examination only to the scope and grounds of the request for invalidation and the evidence submitted by the parties concerned.

Where the person requesting for invalidation makes the request based on the grounds as provided in Rule 64.2 of the Implementing Regulations of the Patent Law, the relevant Items, Sections and Articles of the Patent Law and its Implementing Regulations shall be indicated as independent grounds. In general, the Patent Reexamination Board shall perform the examination only to the grounds raised. The Patent Reexamination Board is not obliged to undertake a comprehensive examination on the validity of the patent.

Where more than one reference document are submitted by

the person requesting for invalidation, it/he shall indicate clearly which is the one that is the closest to the patent against which the invalidation is requested, and also the way by which the comparison is made, i. e., whether it is the result of individual comparison or combination comparison. If it is by way of combination comparison, and if there exists two or more ways of combination, then the specific way of combination shall be indicated. For different independent claims, the corresponding closest prior art documents may be indicated respectively. The panel shall take into consideration of the ways of comparison and combination and the closest reference documents indicated by the person who requests for invalidation.

**Rule 66**

New grounds for invalidation that are submitted by the person who requests for invalidation after one month from the date of submitting the request for invalidation and which need to be supported by new evidence and new evidence which is used to support the specific facts which fail to be supplied with the burden of proof within one month from the date of submitting the request for invalidation may be disregarded by the panel.

In the process of consolidated examination, upon the request of the person who requests for invalidation, the panel may examine the combination of the evidence submitted by different persons who request for invalidation or the evidence for different requests for invalidation submitted by the same person in respect of the same patent right.

In the proceedings of invalidation, the party concerned does not need to provide evidence for the allegations or facts acknowledged by the adversary.

Unless the allegations and facts are obviously untenable, there exists contradictions or disputes over the ownership of patent right, the panel may affirm the allegation and facts that have been explicitly acknowledged by both parties.

Unless the evidence is obviously untrue or there exists contradiction or dispute over the ownership of patent right, the panel may adopt the evidence that is acceptable to both parties without further investigation and verification.

**Rule 65.3**

Where a request for invalidation of a patent for design is filed on the grounds that the patent for design is in conflict with the prior legitimate right of any other person, the person who requests for invalidation is obliged to submit the decision of settlement or judgement of the court which has come into effect and

which can prove that the patent right for design is in conflict with such prior right as trademark right or copyright.

### 3. 2 Principle of Conducting Investigation *Ex Officio*

When necessary, the panel may, *ex officio*, request the party concerned to supplement evidence in respect of the facts alleged by it/him within the prescribed time limit.

When necessary, such general knowledge as technical dictionary, technical manual, textbooks, etc. which have fallen into public domain in the technical field may be introduced into the examination as evidence by the panel.

The Patent Reexamination Board may itself investigate relevant facts or verify relevant evidence, or entrust a local administrative authority for intellectual property affairs (or any corresponding functional organs), or other relevant entities to do so. The necessary costs shall be borne by either the Patent Reexamination Board or the party concerned.

When necessary, especially when a meaningful examination conclusion can not be drawn from the grounds as submitted by the person in its/his request for invalidation due to the mission of some of the defects which exist in the patent right by the person requesting for invalidation, the panel may perform examination *ex officio* on the grounds which have been missed by the said person.

### 3. 3 Principle of *Non Bis in Idem*

Rule 65. 2

Any patent right which is covered in a closed invalidation case, if requested for invalidation on the same grounds and evidence, shall not be allowable.

For any request for invalidation that is raised at a second time, if the grounds and the evidence of which were not taken into consideration in the prior examination decision due to limit of time etc., shall not belong to cases that are not allowable as mentioned above.

### 3. 4 Principle of Disposition by Parties Concerned

For the grounds or evidence of a request for invalidation which have been abandoned by the person who raised the request, if no other party raises them again, the panel usually shall not make any further investigation and verification.

The party concerned has right to compromise with its/his

adversary party after the proceedings of invalidation starts by itself. In case where both the person requesting for invalidation and the patentee have expressed their willingness to compromise to the panel, a certain period of time may be given to the parties by the panel for them to negotiate, and shall suspend to make the examination decision until it is requested for decision by anyone of the parties or until the time limit as prescribed by it is due.

In the proceedings of invalidation, if, regarding the request for invalidation raised by the person requesting for invalidation, the patentee narrows the extent of protection of the patent right on its/his own initiative, it shall be deemed that the patentee has recognized that the extent of protection claimed in the patent which is larger than the corrected one does not conform to the relevant provisions of the Patent Law and its Implementing Regulations from the very beginning, and agrees with the request for invalidation of the claim as raised by the requesting party. The requesting party shall then be exempted of its/his burden of proof on the request for invalidation of the claim.

In the proceedings of invalidation, if the patentee declares that it/he abandons the claim for a dependant claim, it shall be deemed that the patentee has recognized that the claim does not conform to the relevant provisions of the Patent Law and its Implementing Regulations from the very beginning, and agrees with the request for invalidation raised by the requesting party regarding the claim. The requesting party shall then be exempted of its/his burden of proof on the request for invalidation of the claim.

### **3. 5 Principle of Consolidated Examination**

If more than one request for invalidation have been put forward in respect of one patent right, the requests shall be handled together as much as possible. All the persons requesting for invalidation shall be the parties concerned.

### **3. 6 Principle of Confidentiality**

Before the examination decision is made, any member of the panel shall not explicitly or implicitly reveal, without permission, to any side of the parties, the opinion of himself/herself on the case, or that of any other Panel member, the Director General or Deputy Director General responsible for the examination

and approval of the case.

In order to ensure the impartial enforcement of the law and for the purposes of confidentiality, the members of the panel in general shall not meet with anyone of the parties concerned.

#### 4. Formality Examination of Request for Invalidation

##### 4.1 Contents of Formality Examination

Art. 45

Rule 64. 2

Except for the patentee, any entity or individual may make a request for invalidation to the Patent Reexamination Board, so long as it/he considers that the grant of the patent right is not in conformity with the relevant provisions of the Patent Law and its Implementing Regulations as set forth in Rule 64. 2 of the Implementing Regulations of the Patent Law.

The patentee, based on the evidence of public publications, may request for partial invalidation of its/his patent right.

After receiving the request for invalidation, the Patent Reexamination Board shall perform the formality examination first of all and the contents of the formality examination are the following:

Art. 45

(1) whether the request for invalidation is directed to a patent the grant of which has been published;

(2) whether the patent right under request for invalidation has been declared invalid by an effective examination decision on a request for invalidation;

(3) where the person who requests for invalidation is the patentee, whether it/he is requesting the whole of its/his patent right invalid, whether the evidence submitted by it/him belongs to public publications; and if the patent right is under joint ownership whether the persons requesting for invalidation include all the co - patentees;

Rule 65. 4

(4) whether the Form of request for Invalidation complies with the prescribed standard format;

Rule 64. 1

Rule 65. 1

(5) where there are evidences submitted, whether the request for invalidation has indicated in detail the grounds for invalidation by making reference to all the evidences as submitted, and whether the corresponding evidence for each ground has been indicated;

Rule 64. 2

Rule 65. 1

(6) whether the grounds of request for invalidation belong to those as provided in Rule 64. 2 of the Implementing Regulations of the Patent Law;

Rule 65. 2

(7) with regard to the same patent right, whether the grounds and evidence of a subsequent request for invalidation are the same as those which form the basis of the examination

decision made for an earlier request for invalidation;

Rule 65. 3

(8) where a request for invalidation of a patent for design is made on the ground that the patent for design is in conflict with a prior legitimate right of another person, whether the effective decision of settlement or verdict of the court which proves such conflict of right has been submitted;

(9) whether the person requesting for invalidation has paid the fee for such request in accordance with the provisions of Rules 90, 91 and 97 of the Implementing Regulations of the Patent Law;

Rule 16. 3

(10) where the person requesting for invalidation has appointed a patent agency to handle the matter of request for invalidation, whether the power of attorney has been submitted and the scope of the power entrusted indicated; whether the person requesting for invalidation and the patentee have appointed the same patent agency; whether the same party concerned has appointed more than one patent agency; where more than one entity or individual have jointly made a request for invalidation but have not appointed the same agency, whether the request for invalidation and other documents have been signed by all the entities and individuals.

#### 4. 2 Handling of Formality Examination

Art. 45

(1) A request for invalidation shall not be allowable if it is not directed to a granted patent;

The person making the request may file a request for invalidation on a patent right that has been terminated or abandoned;

(2) A request for invalidation shall not be allowable if the patent right under the request for invalidation has been declared invalid in whole by an effective examination decision of request for invalidation made by the Patent Reexamination Board;

After the examination decision of partial invalidation of the patent right has taken effect, the person requesting for invalidation may file a request for invalidation on the claim(s) that is (are) held valid by the decision;

(3) A request for invalidation of its/his own patent right filed by the patentee shall not be allowable if the whole of the patent right is requested for invalidation, or if the evidence submitted by it/him does not belong to the scope of public publications, or where the patent right is under joint ownership, not all of the co - patentees have joined in filing the request for invalidation;

- Rule 65. 4 (4) Where the Form of the request for invalidation does not comply with the prescribed standard format, the Patent Reexamination Board shall invite the person requesting for invalidation to rectify it within the prescribed time limit. If no rectification has been made within the prescribed time limit or though rectification has been submitted within the prescribed time limit, if the same defects remain after the rectification has been submitted for two times, the request for invalidation shall be deemed not to have been submitted;
- Rule 64. 1 (5) For a request for invalidation which is accompanied with  
Rule 65. 1 evidences, such request shall not be allowable if it fails to indicate in detail the grounds for invalidation by making reference to all the evidences as submitted, or if the corresponding evidence for each ground is not indicated;
- Rule 64. 2 (6) A request for invalidation shall not be allowable if the  
Rule 65. 1 grounds for the request do not belong to those as provided for in Rule 64. 2 of the Implementing Regulations of the Patent Law;
- Rule 65. 2 (7) A request for invalidation shall not be allowable if its grounds and evidence for invalidation are the same as those that are indicated in an effective examination decision of the Patent Reexamination Board on a request for invalidation of patent right;
- Rule 65. 3 (8) For a request for invalidation of a patent for design based on the grounds that the patent for design is in conflict with the prior legitimate right of another person, it shall not be allowable if no effective decision of settlement or verdict of the court capable of proving such conflict of rights has been submitted;
- Rule 90 (9) A request for invalidation shall be deemed not to have  
Rule 91 been submitted if the person requesting for invalidation does not  
Rule 97 pay, or does not pay in full, the fees for the request for invalidation within one month from the date on which the request is filed;
- Rule 16. 3 (10) Where a patent agency is appointed by the person requesting for invalidation, and if the power of attorney is not submitted to the Patent Reexamination Board or if the scope of the power as entrusted is not indicated in the power of attorney, the Patent Reexamination Board shall notify the person to make rectifications within seven days from the date on which it/he is informed of it. If the rectification is not made within the time limit, the appointment shall be deemed not to have been made. Where the person requesting for invalidation and the patentee have appointed the same patent agency, the Patent Reexamina-

tion Board shall notify both parties, and the parties shall change the entrustment within seven days from the date on which they are informed of it. If no change of entrustment is made within the time limit, the appointment made by the party who has a later date of appointment shall be deemed not having been made. Where the appointment is made by the parties on the same date, the appointment shall be deemed not been made by both parties.

Where more than one patent agencies are appointed by a party concerned, the said party shall indicate in writing one of the agencies as the liaison person. If none of the patent agencies is indicated as the liaison person, the patent agency which is entrusted first shall be regarded as the liaison person by the Patent Reexamination Board. Where two or more patent agencies are entrusted first and no such indication is made for liaison person, the Patent Reexamination Board shall regard the agency which is named first as the liaison person. Where no order can be said for the names of the patent agencies (appointment is made individually), the Patent Reexamination Board shall notify the said party to make the indication within seven days from the date on which it is informed of it. If no indication is made within the time limit, the appointment shall be deemed not to have been made.

Where any person requesting for invalidation of a patent is obliged to appoint a foreign – related patent agency under Article 19, paragraph one of the Patent Law, and if the power of attorney submitted by him/her does not meet with the requirements, the Patent Reexamination Board shall invite it or him to make rectification within the prescribed time limit. If no rectification is made within the time limit, the request for invalidation shall be deemed to be withdrawn; if the rectified document submitted within the time limit still does not meet with the requirements, the request for invalidation shall be rejected.

Where an agency is appointed for the whole term of the patent by a party concerned, the appointed agency shall exercise the power of attorney on behalf of the said party in respect of all the cases (including those that are put on file after the appointment) regarding the same patent right. Where an agency is appointed on a case – for – case basis by the party concerned, the appointed agency shall exercise the power of attorney on behalf



of the said party in the specified cases.

Where a citizen is appointed as agent by a party concerned, the provisions relating to the appointment of agencies shall be applied *mutatis mutandis*.

Where the request for invalidation does not comply with the provisions of the Patent Law and its Implementing Regulations after the formality examination and needs to be rectified, the Patent Reexamination Board shall issue the "Notification of Rectification" to notify the person requesting for reexamination to make the rectification.

Where the request for invalidation is deemed not to have been submitted or is not allowable, the Patent Reexamination Board shall issue the "Notification of Request for Invalidation Being Deemed Not to Have Been Submitted" or "Notification of Request for Reexamination Being not Allowable" to notify the person who requests for invalidation.

#### Rule 67.1

Where, after the formality examination, it is found that the request for invalidation meet with the relevant provisions of the Patent Law and its Implementing Regulations, the Patent Reexamination Board shall send the "Notification of Allowance of Request for Invalidation" to both the person who requests for invalidation and the patentee. Moreover, the Patent Reexamination Board shall transfer copies of the request for invalidation and relevant documents to the patentee, requesting it/him to make response within one month from the date of receipt of the Notification. Where the patentee has appointed an agency for the whole term of the patent, copies of the request and the relevant documents shall be transferred to the said agency.

For any request for invalidation that has been accepted involving a patent infringement case, the Patent Reexamination Board may, upon the request of a people's court, a local intellectual property administrative authority (or a corresponding competent authority) or the party concerned, issue the "Notification of Examination Status of Request for Invalidation" to the people's court, the local intellectual property administrative authority (or the corresponding competent authority) that is trying or handling the said patent infringement case.

### 5. Collegiate Examination of Request for Invalidation

#### 5.1 Delivery of Documents

#### Rule 67

The Patent Reexamination Board shall, depending on the needs of the examination, transfer the relevant documents to the

parties concerned. Where it is necessary to prescribe a time limit for making the response, the time limit shall be one month. If the party fails to make a response within the time limit, the said party shall be deemed to have had the knowledge of the grounds, facts and evidence contained in the transferred documents, and have no objections to them.

The observations and the attachments submitted by the parties concerned shall be made in duplicate.

### 5. 2 Methods of Examination

#### Rule 69

In the proceedings of invalidation, the examination shall be performed in the following manner depending on the circumstances.

(1) If the Patent Reexamination Board has transferred the invalidation request documents to the person against whom the request for invalidation is made, then, at the expiration of the prescribed time limit for making a response, no matter whether the said person against whom the request for invalidation is made has made an observations or not, so long as no oral procedure is requested by it/him, and the panel considers that the evidence submitted by the person requesting for invalidation sufficient, and the grounds set forth by it/him to invalidate the whole of the patent right tenable, it may make the examination decision to invalidate the patent right. Under such situation, if the requesting party requests the patent right invalid only in part, the panel may, based on the scope as mentioned, also make a decision declaring the patent right invalid in part directly. If the person against whom the request is made has submitted a response, its/his response shall be sent to the person requesting for invalidation together with the examination decision that has been made directly.

(2) If the Patent Reexamination Board has transferred the invalidation request documents to the person against whom the request for invalidation is made, then, at the expiration of the prescribed time limit for making a response, no matter whether the person against whom the request for invalidation is made has made an observations or not, so long as the panel finds, upon consideration, the scope of the request for invalidation as indicated by the person requesting for invalidation is tenable in part, and it is possible for it to make a decision declaring part invalidation of the patent right, the panel shall issue a notification of o-

ral hearings and close the case through the oral procedure. If the person against whom the request for invalidation is made has submitted a response, the response shall be sent to the person requesting for invalidation together with the notification of oral hearings.

(3) If the Patent Reexamination Board has transferred the invalidation request documents to the person against whom the request for invalidation is made, and the person has made the observations within the time limit, so long as the panel considers that the grounds in the observations submitted by it/him are correct, and it is possible for it to make a decision to uphold the patent right, it shall, depending on the specific situations of the case, perform the written examination by issuing either a notification of transfer of documents or notification of examination of request for invalidation; or a notification of oral hearings together with the notification of transfer of documents to close the case by oral procedure.

(4) If the Patent Reexamination Board has transferred the invalidation request documents to the person against whom the request for invalidation is made and the said person has not made observations within the prescribed time limit, so long as the panel considers that the evidence submitted by the person requesting for invalidation is insufficient and that the grounds for invalidating the patent right are not tenable, it shall make a examination decision to uphold the patent right. The panel may, depending on the specific situation of the case, perform the written examination by issuing either the notification of examination of request for invalidation or a notification of oral hearings to close the case by oral procedure.

If, after the issuance of the notification of oral hearings, the oral procedure is not held on time for reasons on the part of the parties concerned, the panel may make the examination decision directly.

### 5.3 Notification of Examination of Request for Invalidation

Under one of the following circumstances in the invalidation procedure, the panel may issue the "Notification of Examination of Request for Invalidation" to both parties concerned:

- (1) where the facts or evidence provided by the parties concerned are unclear or sceptical;
- (2) where the patentee has amended its/his claims on its/

his own initiative, but the amendment is not in conformity with the relevant provisions of the Patent Law and its Implementing Regulations;

(3) where grounds or evidence that have not been mentioned by the person requesting for invalidation needs to be added; or

(4) any other circumstances under which the issuance of "Notification of Examination of Request for Invalidation" is necessary.

For the party concerned which is directed so far as the content of the notification of examination is concerned, it shall make a response within one month from the date of receipt of the notification. If no response is made within the time limit, it shall be deemed to have knowledge of the grounds, facts and evidence contained in the notification and does not have objection on it.

#### Rule 68

#### 5. 4 Amendment of Patent Documents in Invalidation Procedure

The amendment to the documents of the patent for invention or utility model shall be limited to the claims only and shall follow the principles set forth below:

(1) The title of the subject matter of the initial claim shall not be changed;

(2) Compared with the claim of the granted patent, the amendment shall not extend the scope of protection of the initial patent;

(3) The amendment shall not go beyond the scope of the disclosure contained in the initial description and claims; and

(4) Addition of technical features that is not included in the claims of the granted patent is usually not allowed.

On condition that the above-mentioned principles for amendment are satisfied, the amendment of the claims shall limit usually to the deletion or combination of the claims and the deletion of the technical solution. The deletion of claim(s) refers to the deletion of one or certain claims from the claims, such as the independent claim or the dependent claim(s). The combination of claims refers to the combination of two/more dependent claims which do not depend on each other/one another, but both/all subordinate to the same independent claim in the announcement for granting the patent right. In such a case, the technical features of the combined claims are combined together to form a new claim which contains all the technical features of

the claims combined. Where no rectification is made to the independent claim, it is not allowed to make combination or amendment to its dependent claim(s). The deletion of the technical solution refers to the deletion of one or more technical solutions from the two or more parallel technical solutions that are included in the same claim. The above-mentioned amendments may be used separately or in combination.

After the expiration of the time limit prescribed by the Patent Reexamination Board in the transfer of the request for invalidation, the notification of new ground or new evidence documents or the notification of examination of invalidation in which new grounds or new evidence that have not been referred to by the requesting party are introduced, the patentee of patent for invention or utility model can amend the claim only by way of deletion.

Before the examination decision is made, the patentee may either delete the claim or delete the technical solution contained in the claim.

Where a claim is amended by way other than the deletion, the person requesting for invalidation shall be given an appropriate opportunity by the panel to present new grounds and evidence of and observations for the request of invalidation in respect of the amended claim.

The patentee for design shall not be allowed to amend its/his patent documents.

Rule 86

Rule 87

### 5. 5 Suspension of Invalidation Procedure

In the procedures for examination of invalidation, where there is dispute over the ownership of patent right, the Patent Reexamination Board shall temporarily suspend the examination of the invalidation request from the date of receipt of the written request for the suspension of the invalidation procedure coupled with a copy of notification of acceptance of lawsuit or settlement submitted by the relevant party concerned, or from the date of receipt of the ruling of the people's court concerning preservation of the patent right and its official letter to request the Patent Reexamination Board to assist in preserving the patent right. The Patent Reexamination Board shall resume the examination in one of the following circumstances.

(1) The person requesting for the suspension requests for resumption of the examination;

(2) The examination has been suspended for over one year, and no request for extension attached with a proof showing that the case concerning the ownership of the patent right has not been closed is received from the person requesting for suspension;

(3) Receipt of the proof of the people's court that has taken measures to preserve the patent right to cancel the preservation of the patent right;

(4) At the expiration of the time limit of preservation, no notification to continue the preservation of the patent right is received from the people's court which has taken measures to preserve the patent right; or

(5) Receipt of a copy of the effective ruling or the decision of settlement from the people's court or a local administrative authority for intellectual property affairs (or a corresponding functional organ) and the patentee has been changed when necessary.

#### **6. Types of Examination Decisions on Request for Invalidation**

There are three types of examination decisions with regard to a request for invalidation:

- (1) decision on declaring invalidation of patent right;
- (2) decision on declaring part invalidation of patent right ;
- (3) decision on maintenance of validity of patent right.

To declare a patent right invalid includes declaring the patent right invalid in whole and declaring the patent right invalid in part. For the effects of declaring a patent right invalid, see Article 47.1 -3 of the Patent Law.

Where in the procedures of request for invalidation, if the grounds for the request for invalidation and the evidence thereof submitted by the person requesting for invalidation lead only to part of the claims of a patent for invention or utility model untenable, or though they may lead to all of the claims of a patent for invention or utility model invalid, they can not lead to all of the new claim(s) formed by way of amendments other than deletion, it shall declare such untenable claims invalid and maintain the other claims valid. For any patent for design which consists of several sets of products having independent use value, if the grounds of the request for invalidation and the evidence thereof lead only to part of the products which are components of the patent for design not in conformity with the relevant provisions of the Patent Law, it shall declare the said part of

products of patent for design invalid and maintain the validity of patent for design for other parts of the products which are also components of the patent for design. This decision of examination is a decision of examination declaring partial invalidation of patent right.

The provisions of Article 47 of the Patent Law apply also to invalidation of patent right in part. When invalidation of patent right in part is declared, the invalidated part of the claims shall be deemed not to have existed from the beginning, and the part of the claims that are kept valid (including the amended claims) shall be deemed to have being existed from the very beginning at the same time. This means that, like the decision to declare the whole of the patent right invalid, the decision to declare the part invalidation of patent right also possesses the effect of *ex post facto*.

#### **7. Delivery, Registration and Announcement of the Examination Decision on Request for Invalidation**

##### **7. 1 Delivery of Decision**

According to the provision of Article 46. 1 of the Patent Law, the Patent Reexamination Board shall deliver to both parties the examination decision on the request for invalidation.

For the request for invalidation that involves infringement dispute, where the relevant people's court or local administrative authority for intellectual property affairs (or a corresponding functional organ) had been notified before the examination of request for invalidation started, the Patent Reexamination Board shall, after making the decision, deliver to them the examination decision and the "Notification of Closing of Invalidation Examination".

##### **7. 2 Registration and Announcement of the Decision**

According to the provisions of Article 46. 1 of the Patent Law, after the decision made by the Patent Reexamination Board declaring the patent right invalid (wholly and in part) takes effect, it shall be registered and announced by the State Intellectual Property Office.

#### **8. Termination of Invalidation Procedure**

Where the person requesting for invalidation withdraws its/his request before the Patent Reexamination Board makes an examination decision on it, the procedures of invalidation shall ter-

minate.

Rule 69.3

Where the person requesting for invalidation fails to make a response to the notification of oral procedure within the prescribed time limit and fails to take part in the oral procedure, and its/his request for invalidation is deemed to have been withdrawn, the procedures of invalidation shall terminate.

Before the decision of examination to declare the patent right invalid made by the Patent Reexamination Board takes effect, if another request for invalidation is raised with regard to the same patent right, the examination procedures of the said request for invalidation of the same patent right shall terminate until the said decision of examination to declare the patent right invalid has taken effect.

After the decision of examination made by the Patent Reexamination Board declaring the part invalidation of the patent right takes effect, the examination procedure of the other request for invalidation on the same patent right shall be carried out by focusing only on the claims which have not been declared invalid.

Art. 46.2

After the Patent Reexamination Board makes the decision of examination on the request for invalidation, if, within three months from the date of receipt of the decision, the party concerned to whom the decision is unfavorable has not instituted legal proceedings in the people's court, the decision of examination takes effect, and the said invalidation procedure is terminated.



**Chapter 4****Provisions Concerning Oral Procedure in Reexamination and Invalidation Procedures****1. Introduction**

This Chapter mainly relates to the contents of the determination, notification, performance, suspension, termination, record, auditor, and the rights and obligations of the interested parties of the oral procedure in the examination of request for reexamination and request for invalidation. The said oral procedure is a kind of formal administrative hearing.

**Rule 69. 1****2. Determination of Oral Procedure**

The party concerned may, in the procedures of invalidation, submit the request for oral procedure and explain the reasons thereof to the Board. The request shall be submitted in writing.

The interested parties may request for oral procedure in the following circumstances:

- (1) Where one of the parties requests for face – to – face cross – examination of evidence and debate with the opponent;
  - (2) Where it is necessary to state the facts before the collegiate panel;
  - (3) Where it is necessary to make a demonstration in kind;
- or
- (4) Where the testimony of the witness who has already provided the testimony is necessary.

Where the party concerned has requested for oral procedure in writing for the reasons mentioned above, the collegiate panel shall generally agree to carry out the oral procedure.

Where the collegiate panel finds such oral procedure necessary according to the case, it may decide *ex officio* to carry out the oral procedure. Where the oral procedure has been conducted in respect of the same case, when necessary, the Director General, Deputy Director General or the collegiate panel may decide to conduct the oral procedure again.

Upon the approval of the Director General or Deputy Director General, the Board may make a circuit of the oral procedure to settle the cases on the spot. The Patent Reexamination Board shall bear all the expenses and costs.

### 3. Notification of Oral Procedure

Rule 69. 2

Rule 69. 3

After it is decided to proceed to the oral procedure, the collegiate panel shall issue a "Notification of Oral Procedures" to the parties, informing them of the date, place and other matters about the oral procedure. Normally the time and place of the oral procedure shall not change once they are fixed. Where it is necessary to change the time or place in a special situation, the change shall be approved by the Director General or Deputy Director General. The parties shall submit the acknowledgment of receipt of the Notification to the Board within seven days from the date on which it is received. Where the person requesting for invalidation fails to submit the said acknowledgment of receipt within the specified time limit and is not present at the oral procedure, the request for invalidation shall be deemed to have been withdrawn. If the patentee does not participate in the hearing, the hearing shall be performed by default.

The said acknowledgement of receipt shall be signed or sealed by the interested parties. Where willingness to be present at the oral procedure is expressed, names of the persons to be present at the oral procedure shall be clearly indicated. Where the entrusting of a witness who has already provided his/her testimony to be present at the oral procedure is required, a statement to that effect shall be included in the acknowledgement of receipt, and the name of the witness, the entity where he/she works (or his/her profession) as well as the facts to be testified shall be indicated. Where there is no such statement in the acknowledgement of receipt, his/her presence as witnesses in the oral procedure shall not be allowed.

No more than four persons for each party concerned including its/his agent are allowed to be present at the oral procedure. Where less than four are indicated to participate in the oral procedures in the said acknowledgement of receipt, others may be designated to be present at the oral procedures before it starts. Where a party has more than one person present at the oral procedure, one of them shall be designated as the first speaker to make primary presentation.

Where the person concerned cannot participate in the oral procedure on the fixed date, the patent agent or any other person appointed by it/him may appear in the oral procedure on its/his behalf.

Where the person concerned has appointed a patent agen-

cy to handle the matters according to Article 19 of the Patent Law, then the agency shall appoint patent agent(s) to be present at the oral procedure.

#### **4. Preparation Before Oral Procedure**

Before the oral procedure takes place, the following shall be done by the collegiate panel:

(1) transmitting the relevant documents submitted by the party to its/his opponent;

(2) studying the file, understanding the details of the case and identifying the key points of the dispute and the main issues to be investigated and the points of debate;

(3) holding pre-hearing collegiate panel meeting to decide on the duties and powers of the collegiate panel members for the oral procedure, the order and contents of the investigation, the main issue to be ascertained, and the various situations likely to occur during the oral procedure and the plans to deal with them;

(4) making ready the necessary documents;

(5) announcing in writing the relevant information regarding the oral procedure two days before (with the exception of the un-disclosed patent application); and

(6) making preparations for other administrative matters for the oral procedures.

#### **5. Carrying Out of Oral Procedure**

The oral procedure shall be held on the scheduled date.

Except for the collegiate bench meeting and the voting of the collegiate panel, the oral procedures shall be conducted publicly (except for those which shall be kept confidential in accordance with the provisions of the laws and regulations).

Before the oral procedure starts, the identities of the persons to be present at the oral procedures shall be verified, and their qualifications to be present there ascertained.

The oral procedure shall be presided over by the head of the collegiate panel. After declaring the oral procedure open, the collegiate panel head shall make an introduction to the collegiate panel members; the parties concerned shall introduce their persons present at the oral procedures; the collegiate panel head shall ask whether the parties have objections to the qualifications of the persons of its/his opponent present at the oral procedure; the collegiate panel head shall read out the rights and obligations of both parties, inquire both parties whether they re-

quire the evasion of anybody who handles the case, whether they require the testimony of any witness or the demonstration of any physical evidence.

In the oral procedure where both parties are present, it will be asked whether the parties concerned are willing to make compromise. If both parties are willing to do so, it shall suspend the procedure. Where there is little difference between the two parties, the oral procedure may be suspended. If there is great difference between the parties and it is difficult for them to reach a reconciliation agreement in a short period of time or if one party insists on making no compromise, the oral procedure shall continue.

Before starting the investigation in the oral procedure, if necessary, the primary examiner shall give a brief account of the facts of the case. The investigation shall start after that. The person requesting for invalidation shall describe the scope and the grounds for the request, brief the relevant facts and evidences. Then, the person to whom the request is directed shall make a defense. After that, the collegiate panel shall verify the scope and the grounds for the request for invalidation and the evidences submitted by both parties. It shall then determine the scope of the oral procedure. Where a party presents new evidence in the oral procedure, the collegiate panel shall determine whether the evidence is admissible in accordance with the relevant provisions. If it is decided that the evidence is admissible, the opponent shall be given the right to make an oral defense right at the time or do so in writing afterwards as it is the first time for him/it to receive the evidence. Then, the person requesting for invalidation shall adduce evidence relating to the grounds for the request for invalidation and the facts and evidence on which the request is based. After that, the party to whom the request is directed shall make cross – examination of the evidence. If necessary, it may disprove the evidence for the opponent to cross – examine. Where, for the request for invalidation, there are more than one ground, fact or evidence to be proved, the parties may be required to adduce and cross – examine the evidences and facts one by one. In order that the facts of the case could be found out comprehensively and objectively in the course of investigation of the oral procedure, the collegiate panel may question the parties or witnesses about the relevant facts and evidence and require the parties or witnesses to make the

explanation. The questions shall be impartial, objective, specific and clear.

Following that, the debate of the oral procedure shall start. If for both parties all the evidences and facts of the case are beyond controversy, then the debate of the oral procedure shall be conducted directly on the basis of the evidences and facts that are confirmed by both parties. The parties shall make observations and debate on the facts verified by the evidence, the point of the controversy and the applicable laws and regulations. During the debate, the collegiate panel members may raise questions, but should neither make any tendentious statement nor argue with any of the parties. If, in the course of the debate of the oral procedure, any party presents again the facts or evidence which it/he submitted before but which have not been verified, the head of the collegiate panel may declare the suspension of the debate and resume the investigation of the oral procedure. The debate shall continue after the investigation is over.

After the parties have made their observations at the debate, the head of the collegiate panel shall announce the end of the debate and invite the parties to make their final statements. The person requesting for invalidation may insist on its/his request or withdraw the request. It/he may also abandon part of the grounds for request and the corresponding evidence or narrow the scope of the request for invalidation. The person to whom the request for invalidation is directed may insist on rejecting the request of invalidation or declare the narrowing of the scope of patent protection or abandon part of the claims. Then, the two parties may try the compromise again as they did at the start of the procedure. The head of the collegiate panel shall announce temporary adjournment and a collegiate panel meeting shall be held. Then, the oral procedure resumes, the head of the collegiate panel shall read out the conclusion of the oral procedure. The conclusion of the oral procedure may be either the conclusion of examination decision or any other conclusion, such as announcing that the facts of the case have been investigated and ascertained, and an examination decision may be made on the basis of the facts. Thus, the oral procedure comes to an end.

In the course of the oral procedure, if necessary, the collegiate panel may adjourn for collegiate panel meetings.

## **6. Suspension of Oral Procedure**

Under one of the following circumstances, the head of the collegiate panel may announce the suspension of the oral procedure and if necessary, shall fix the date for the resume of the oral procedure:

- (1) where the party concerned challenges the evasion of a person who handles the case;
- (2) where it is necessary for the parties to negotiate for compromise;
- (3) where there is need for further demonstration of the invention – creation; or
- (4) any other circumstances where the collegiate panel thinks it necessary.

## **7. Termination of Oral Procedure**

For cases where the facts are ascertained after investigation and an examination decision may be made without the verification or approval by the Director General or Deputy Director General, the collegiate panel may read out the conclusion of the examination decision on the spot.

If the collegiate panel intends to read out on the spot the conclusion of an examination decision of a case which has gone through the oral procedure but which needs the verification and approval of the Director General or Deputy Director General of the Board, the conclusion of the examination decision shall be announced after the approval.

If the collegiate panel does not intend to read out on the spot the conclusion of an examination decision, the head of the collegiate panel shall make a brief explanation.

For all the three above – mentioned circumstances, it shall be for the head of the collegiate panel to announce the termination of the oral procedure. The full text of the decision shall be delivered to the parties in writing within a certain period of time after that.

## **8. Absence of Party Concerned**

Where one of the parties fails to take part in the oral procedure, the collegiate panel shall conduct the oral procedure according to the prescribed procedures so long as the presence of one of the parties concerned at the oral procedure complies with the requirements.

### 9. Taking of Notes

In the oral procedure, the secretary or a collegiate panel member designated by the head of the collegiate panel shall take the minutes of the procedure. The person who takes the minutes shall note down the important items of the oral procedure in the "Record of Oral Procedure" (if one sheet is not enough, more sheets may be added). Apart from taking notes in writing, on condition that it is announced beforehand, the collegiate panel may use sound – recording equipment when necessary.

After taking minutes of the important items of the oral procedure or at the time when the oral procedure terminates, the collegiate panel shall ask the parties to read the minutes. For the errors or mistakes of the minutes, the parties concerned have right to ask them to be rectified. If the minutes is verified and proved to be correct, the minutes shall be signed by the parties and put into the file. Where any party refuses to sign, the head of the collegiate panel shall indicate it in the "Record of Oral Procedure".

The above – mentioned important items of the oral procedure include the following:

- (1) the claims abandoned by the parties concerned, the scope, grounds or evidence of the request for invalidation;
- (2) the important facts affirmed by both parties;
- (3) the request of the person requesting for invalidation for combination of the evidences of the different requests for invalidation; and
- (4) any other important items which needs to be noted down.

### 10. Auditor

Auditors are permitted in the oral procedure, but they shall have no right to speak. Without the prior approval, there shall be no photographing, no audio or video recording, and no transmission of relevant information to any party concerned or agent present in the oral procedure.

When necessary, the Board may require the auditors to go through the formalities for auditing.

### 11. Rights and Obligations of Parties Concerned

The head of the collegiate panel shall, at the beginning of the oral procedure, inform the parties of their rights and obliga-

tions in the oral procedure.

**(1) Rights of Party Concerned**

Any party concerned has the right to request the evasion of a member hearing the case, to make a compromise with its/his opponent; to invite a witness who has provided a testimony and has been indicated in the receipt of Notification of Oral Procedure to appear in the oral procedure to make the testimony and to request the demonstration of the material evidence. It/he also has the right to debate. The person requesting for invalidation has the right to withdraw the request, to abandon part of the grounds for and the relevant evidence of the request and to narrow down the scope of the request for invalidation. The person to whom the request for invalidation is directed has the right to narrow down the scope of patent protection, to abandon part of the claims and the relevant evidence it/he has submitted.

**(2) Obligations of Party Concerned**

Any party concerned shall voluntarily abide by the rules of the oral procedure, to maintain the order of the oral procedure and never make speech without the approval of the head of the collegiate panel. It/He shall not interrupt the speech of the other party. In the debate, facts shall be presented and things shall be reasoned out. The speech and debate shall be limited to the scope which is relevant to the examination of the case as designated by the collegiate panel. The parties concerned shall have the burden of proof for the allegation it/he has raised, and shall state the grounds when contradicting the allegation of its/his opponent. It is not allowed to withdraw before the oral procedure is over without justified reasons.

**12. Oral Procedure for Reexamination**

The oral procedure for reexamination is a procedure attended by only one party. It may be conducted with reference to the oral procedure for invalidation as mentioned above.



## **Chapter 5**

### **Judgment of Identicalness and Similarity of Design**

#### **1. Introduction**

This Chapter relates mainly to the objects of judgment, subjects of judgment, principles of judgment, methods of judgment and criteria of judgment in respect of the identicalness and similarity of designs.

#### **2. Legal Basis**

This Chapter is formulated in accordance with the provisions of Articles 9, 23 and 56. 2 of the Patent Law and Rules 2. 3 and 13. 1 of the Implementing Regulations of the Patent Law.

#### **3. Object of Judgment**

##### **3. 1 Definition of Objects of Judgment**

When the identicalness and similarity of designs are being judged, the objects of the comparison are called objects of judgment. The objects of judgment are further divided into later object and prior object. The later object refers to the design which has been granted patent right and against which a request for invalidation has been filed (referred to hereinafter as design of comparison). The prior object refers to a design which has been publicly published in the publications in China and abroad or publicly used in China before the date of filing of the object of comparison, or a patent for design which has been filed before the date of filing of the object of comparison and published on or after such date (referred to hereinafter as prior design).

##### **3. 2 Types of Object of Judgment**

The type of an object of judgment shall be determined by the picture and/or photograph of the design and the article incorporating the design. As for the design of comparison, it shall be determined by whether in the brief explanation there are such contents as "the claimed design contains color" (i. e. the color is defined), "the existence of boundless unit pattern of two – side continuation or four – side continuation in plane product" (being called the boundless design for short) and the like.

*There are six types of design of comparison.*

##### **(1) Design of comparison of shape**

The design of comparison of shape refers to the design of

the shape of a product that has neither pattern nor the defined color.

(2) Design of comparison of pattern

The design of comparison of pattern refers to the pattern design of a boundless plane product that doesn't have the defined color.

(3) Design of comparison of shape and pattern

The design of comparison of shape and pattern refers to the shape and pattern design of a product that doesn't have the defined color.

(4) Design of comparison of shape and color

The design of comparison of shape and color refers to the shape and color design of a product that has the defined color but without any pattern.

(5) Design of comparison of pattern and color

The design of comparison of pattern and color refers to the pattern and color design of a boundless plane product that has the defined color.

(6) Design of comparison of shape, pattern and color

The design of comparison of shape, pattern and color refers to the shape, pattern and color design of a product that has the defined color.

#### 4. Criteria for Subject of Judgment

When it is judged whether a design is identical with or similar to another design, the judgement shall be based on the normal level of knowledge and cognitive capability of a general consumer of the product incorporating the design under comparison.

Products incorporating different kinds of designs which are the objects of comparison have different consumer groups. A general consumer for a product incorporating a certain kind of design shall possess the following characteristics:

(1) having common knowledge on the designs of the products incorporating designs that are identical with or similar to those under comparison. For example, a general consumer for cars shall have common knowledge about cars sold in the market and the information disclosed in the general advertisements for cars in mass media.

(2) having certain degree of cognitive capability on the differences of products incorporating a design in shape, pattern and color, but will pay no notice to the minor changes in the

shape, pattern and color of the product.

### 5 Principles of Judgment

If, after viewing the design under comparison and the prior design as a whole, a general consumer will draw the conclusion that the differences between the two do not have obvious influence on the whole visual effect of the consumer, it can be said that the design under comparison is identical with or similar to the prior design. Otherwise, the two designs are neither identical nor similar.

If a general consumer is likely to mistake the design under comparison for the prior design, it is obvious that the differences between the two designs do not have obvious influence on the whole visual effect of the product.

However, in case when two designs are not likely to be mistaken by a general consumer, it does not mean that there could draw the conclusion that the differences between the two have obvious influence on the whole visual effect of the products.

To determine whether there exists obvious influence, the following shall be, generally speaking, taken into consideration as well:

(1) The parts which can be seen easily in use generally have more obvious influence on the whole visual effect than the parts which cannot be seen that easily. For example, the change in the inlet face panel of a ceiling ventilator has more obvious influence than the change in other parts generally. However, there could be an exception if there is evidence showing that a specific design for a part which cannot be easily seen produces a noticeable visual effect for a general consumer.

(2) Where the design of a certain part of a product is considered an usual selection for that part of this kind of product, the changes in other parts generally have more obvious influence on the whole visual effect. For example, where the periphery of the cross section of a profiled bar is normally rectangle, the changes in the cross section usually have more obvious effect.

(3) Where there is difference in size, if the difference leads only to the magnifying or reducing of the product as a whole, there is no obvious influence on the whole visual effect.

(4) For changes not affecting the design of a product or where the change only refers to changes in the material which belong to an usual choice for the product incorporating the de-

sigh, then there is no obvious influence on the whole visual effect. For example, for a kind of metal which has certain color, lustre and tactile impression, and a product made of plastic coping the color, lustre as well as tactile impression of the said metal, the change in the material usually does not have obvious influence on the whole visual effect.

(5) The function, internal structure and technical property of a product and the specific shape defined only by the function of the product do not usually have obvious influence on the whole visual effect. For example, on a switch face panel for power supply or on a socket face panel, the replacement of a certain function unit with another function unit which is in conformity with the national standard does not produce obvious influence on the whole visual effect.

## **6. Methods of Judgment**

### **6.1 Judgment of the Normal Consumer**

The patent examiner shall make the judgment from the perspective of the normal consumer. He shall not make the judgment from the perspective of professional designer or expert.

### **6.2 One – to – One Comparison**

In making the judgment of identicalness and similarity, only one piece of prior design is generally compared with the design of comparison. It is not allowed to take the combination of two or more prior designs to make the comparison.

If the design of a set of products contains designs for several products that can be used separately, comparison could be conducted between different prior designs and the each of the designs of the product in a separate way.

If the design of comparison is the design of a product comprising at least two components which are to be used only when they are assembled together, it may take the combination of the designs of the components that are used by the assembled set and the number of the design is the same as that of the components assembled together as one piece of the prior design to be compared with the design of comparison.

### **6.3 Direct Observation**

The judgment of identicalness and similarity of the designs shall be made by direct visual observation. The comparison

shall not be made by means of a magnifier or a microscope. The comparison shall not be made by chemical analysis or by other tools or means. The parts or elements that cannot be directly identified by eyes shall not form the basis of judgment. For example, if when viewed visually, the shape, pattern or color of certain textile products are identical or similar, but when viewed under a magnifier, their lines are quite different and their shape and pattern are very different as a result of that, then in such cases, these products shall be still regarded as identical or similar.

#### **6. 4 Isolated Comparison(deleted)**

#### **6. 5 Taking Appearance of Product as Object of Judgment Only**

The three elements of shape, pattern or color or their combination of a product are the objects of judgment of identicalness and similarity for a design. This means that only the appearance of the product shall be taken as the object of judgment. If the extent of protection of the design under comparison is defined only by part of its elements, the other elements will not be taken into consideration when it is compared with prior designs.

For a product which uses transparent material to form the appearance, if the shape, pattern and color inside the transparent part of the product could be seen through the eyes, they shall be regarded as a part of the design of the product.

For a plug – in unit and a product of plug – in component toy, as in the course of making the purchase and the plugging in, the normal consumer will be impressed by the various single plug – in unit and the appearance of the plug – in components, the appearance of the plug – in unit or the appearance of all single component of the plug – in units rather than the entire appearance of the plugged in components shall be regarded as the object of judgement for identicalness and similarity.

By the plug – in toy product here, it refers to a toy the unit of which may be connected to other units that are identical to it to form a specific shape or pattern. By the plug – in components toy product here, it refers to a toy the group of plug – in components of which is inseparable and may be connected into specific shape and pattern.

The design of the plug – in components toy product is one of the designs of a product, and the design of the product refers

to the design of the whole of the components; and the appearance of each component of the plug – in components is merely regarded as part of the design of the plug – in components.

#### **6. 6 Comprehensive Judgment**

For a general product, the judgment of identity or similarity of its designs shall be conducted in a comprehensive way. By comprehensive judgment, the conclusion of whether the design under comparison is identical with or similar to the prior design shall be made from viewing the whole of the design under comparison and not only from a specific or certain part of the design under comparison.

#### **6. 7 Judgment of Key Part**

##### **6. 7. 1 Definition of Key Part**

For some products, there exist certain parts which can attract the attention of the general consumer much more easily than the other parts. These parts are the so-called “key parts” of a product.

##### **6. 7. 2 Determination of Key Part**

The determination of “key part” is closely related to the factors of whether it can attract the attention of the general consumer. In determining the “key part”, the state of the use of the product, the usual design style of the prior products that belong to the same or similar class with the product incorporating the design under comparison and its influence on the whole visual effect may be taken into consideration. Generally, only those parts may be regarded as “key parts” of the judgement which, in the state of use, have obviously stronger influence on the whole visual effect than the other parts.

For example, for a product such as a fixed hanging mail box, which has a specific facet facing the user when in use, its parts which can be seen in use obviously have stronger influence on the whole visual effect than those parts of it which cannot be seen (such as the back of the fixed hanging mail box). Therefore, for this kind of products, the parts which can be seen in use may be regarded as key parts. The other parts, such as the back of a table or a chair, the back of a fixed hanging mail box, the back of a vehicle number plate, the back and the bottom of

a TV set and other audio and video home appliances, the back of a watch, the back of a carpet, the bottom of a bottle or a pot, the parts other than the inlet face panel of a ceiling toilet ventilator etc. usually do not attract the attention of a general consumer. These parts as they are shall not be regarded as "key parts" of the judgement.

### 6. 7. 3 Relationship Between Key Part and Similarity

If the appearance of the key part of the design of comparison is not similar to that of the corresponding part of the prior design, the design of comparison and the prior design are not similar.

## 7. Criteria of Judgment

### 7. 1 Judgment of Identicalness of Design

The identicalness of the design means that the design of comparison and the prior design belong to the designs of products of the same class, and the entire factors of design of the design of comparison are identical with the corresponding factors of design of the prior design. By factors of design, they refer to the shape, the pattern and the color.

The products of the same class refer to the products that have the same use. For example, although the internal structures of the mechanical watch and the electronic watch are different, they have the same use, and they are of the same class. It should be noted that as long as the products have the same use, no matter whether they have any other use of their own, they are products of the same class. Though in determining the class of the products, reference may be made to the name, Locarno classification and the shelves classification of products, the identicalness of the use of the product shall be taken as the criterion.

For products in different classes, even though the three factors of design are the same, they cannot be regarded as identical in design.

For designs of products of the same class, according to the specific type of the design of comparison, the identicalness of design happens in the following circumstances:

#### (1) Design of shape

Regardless of whether the prior design has its particular pattern or color, as long as the design of comparison is identical

with the prior design in shape, they are identical designs. If the shape of the design of comparison is not identical with that of the prior design, the two designs are not identical and the design of comparison and the prior design are different designs.

(2) Design of pattern

As long as the design of comparison is identical with the prior design in pattern, they are identical designs. If the pattern of the design of comparison is not identical with that of the prior design, the two designs are not identical and the design of comparison and the prior design are different designs.

(3) Design of shape and pattern

If the design of comparison is identical with the prior design in shape and pattern respectively, they are identical designs.

(4) Design of shape and color

If the design of comparison is identical with the prior design in shape and color respectively, they are the identical designs.

(5) Design of pattern and color

If the design of comparison is identical with the prior design in pattern and color respectively, they are identical designs.

(6) Design of shape, pattern and color

If the design of comparison is identical with the prior design in shape, pattern and color respectively, they are identical designs.

## 7.2 Judgment of Similarity of Design

### 7.2.1 Similarity of Design

Similarity of design exists only among products that belong to the same or similar class. Products of similar class refer to products that are similar in use. For example, the egg container and the lamp bulb container are products of similar class, because though they are different, they are similar in use.

#### 7.2.1.1 Similarity of Design for Products of Same Class

For designs of products of the same class, according to the specific type of the design of comparison, the similarity of design happens in the following circumstances:

(1) Design of shape

As long as the design of comparison is similar to the prior design in shape, the design of comparison is similar to the prior design.



(2) Design of pattern

As long as the design of comparison is similar to the prior design in pattern, the design of comparison is similar to the prior design.

(3) Design of shape and pattern

If the design of comparison is similar to the prior design in shape and pattern, the design of comparison is similar to the prior design.

(4) Design of shape and color

If the design of comparison is similar to the prior design in shape and color, the design of comparison is similar to the prior design.

(5) Design of pattern and color

If the design of comparison is similar to the prior design in pattern and color, the design of comparison is similar to the prior design.

(6) Design of shape, pattern and color

If the design of comparison is similar to the prior design in shape, pattern and color, the design of comparison is similar to the prior design.

**7. 2. 1. 2 Similarity of Design for Products of Similar Class**

For designs of products of similar class, according to the specific type of the design of comparison, the similarity of design happens in the following circumstances:

(1) Design of shape

If the design of comparison is identical with or similar to the prior design in shape, the design of comparison is similar to the prior design.

(2) Design of pattern

If the design of comparison is identical with or similar to the prior design in pattern, the design of comparison is similar to the prior design.

(3) Design of shape and pattern

If the design of comparison is identical with or similar to the prior design in shape and pattern, the design of comparison is similar to the prior design.

(4) Design of shape and color

If the design of comparison is identical with or similar to the prior design in shape and color, the design of comparison is similar to the prior design.

(5) Design of pattern and color

If the design of comparison is identical with or similar to the prior design in pattern and color, the design of comparison is similar to the prior design.

(6) Design of shape, pattern and color

If the design of comparison is identical with or similar to the prior design in shape, pattern and color, the design of comparison is similar to the prior design.

### 7. 2. 2 Dissimilarity of Design

For designs of products of which the class is neither identical nor similar, there is no need to carry out the comparison and judgment of the design of comparison and the prior design. It may directly come to the conclusion that the design of comparison is not similar to the prior design.

The Following are the circumstances in which the designs are not similar:

(1) where the products are identical or similar in class, but the design of comparison is not similar to the prior design;

(2) where the products are neither identical nor similar in class.

For example, towel and table cloth; vehicle and toy vehicle.

### 7. 3 Judgment of Similarity in Shape

#### 7. 3. 1 Geometry of Product

A circle is considerably different from a triangle or a quadrilateral, so they shall not be regarded as similar. For example, though the pattern and color are similar for a circular utensil and a triangular utensil, the designs shall not be regarded as similar.

#### 7. 3. 2 Product Having Varied Shapes

By a product having varied shapes, it refers to a product which may have varied shapes when in use and for sale. For such a product, when it is used as a prior design, all its varied designs may be objects of comparison for the design of comparison. For the design of comparison, its design of the state in use shall be taken to compare with the prior design. The identicalness and similarity of the product depend on the identicalness and similarity of the design of the product in the state of use. For example, if a piece of folding furniture in the state of use is simi-

lar to the prior design in shape, no matter in what state it is when folded, it shall be regarded as similar in shape.

### **7. 3. 3 Packing Box**

For such products as a packing box, its shape in use shall be taken to form the basis of judgment of similarity.

### **7. 4 Judgment of Similarity in Pattern**

Variation in pattern includes changes in such elements as subject matter, composition, way of expression and size of the pattern. Change in color may also result in a change of the pattern. When the subject matter is identical, but if the composition, way of expression and the size of the pattern are different, the pattern may not be similar and, hence, the designs may not be similar.

In the judgment of similarity, characters, including the title of the product on the outer appearance of a product is a kind of pattern, its decorative function as part of the pattern rather than the meaning of the characters shall be taken into consideration.

### **7. 5 Judgment of Similarity in Color**

The judgment of identicalness and similarity in color shall be made in a comprehensive way, taking the three properties of color i. e. the hues, purity and lightness into consideration and also the combination and arrangement of two or more colors. The hues of color include red, orange, yellow, green, greenish black, blue, purple and their combination. The purity means the degree of brilliance. The lightness refers to the degree of brightness.

The change in color for designs of single color shall be similar designs.

## **Chapter 6**

### **Other Provisions**

#### **1. Introduction**

This Chapter relates mainly to the specific provisions relating to the Articles and Rules of the Patent Law and its Implementing Regulations concerning the procedures of examination for requests for reexamination and invalidation, including the examination of inventiveness of the utility model and the examination performed in accordance with Rule 13.1 of the Implementing Regulations of the Patent Law.

#### **2. Examination of Inventiveness of Utility Model**

For the examination of inventiveness of utility model, reference may be made to the provisions concerning the principles of examination, criteria of examination, and the provisions on the judgment of inventiveness of different kinds of inventions relating to the inventiveness of invention set forth in Chapter 4, Part II of the Guidelines. However, because the criteria for inventiveness for invention and for utility model as stipulated in Article 22.3 of the Patent Law are different, and the definitions for invention and utility model as objects of protection are different according to Rule 2 of the Implementing Regulations of the Patent Law, some issues require special consideration in the examination of inventiveness of utility model.

##### **2.1 Technical Features Not to Be Considered in Examination of Inventiveness of Utility Model**

###### **Rule 2.2**

"Utility model" in the Patent Law means any new technical solution relating to the shape, the structure, or their combination, of a product, which is fit for practical use.

The shape, the structure and their combination of the product mentioned in the above clause refer to the macro – shape, macro – structure and their combination of the product. The micro – shape, micro – structure and their combination, such as the molecular structure of a compound, are not objects of protection for the utility model.

In the examination of inventiveness of the utility model, where the shape, the structure or their combination of the product is changed by any non – shape or non – structure technical feature of the technical solution, only the change in the shape,

the structure or their combination resulting from the said technical feature shall be considered. And the non – shape technical feature or non – structure technical feature *per se* shall not be taken into consideration. The technical feature of the technical solution that has made no contribution for the change of the shape, the structure or their combination of the product shall be deemed non – existent. For example:

(1) Material Feature

If compared with the corresponding feature of the most related prior art, the difference of the material feature of a technical solution lies in the material itself, which does not result in any change of the shape, the structure or their combination of the product, then, even if the effect of the technical solution incorporating the material feature is better than, or different from, that of the most related prior art due to the difference of the material, the material feature shall not be taken into consideration in the examination of inventiveness of the utility model.

(2) Methodological Feature

For utility model products, the methodological features may be divided into two types.

One is the type of methodological feature that does not have effect on the shape, the structure or their combination of the product. That is, the introduction of the methodological feature does not lead to any change in the shape, the structure or their combination of the product. This type of methodological features shall not be taken into consideration in the examination of the inventiveness of the utility model. "The insect – prevention treated timber" may be taken as an example. Since the insect – prevention treatment does not lead to any change in the macro – shape or the macro – structure of the timber, the methodological feature of "insect – prevention treatment" shall not be taken into consideration in the judgment of inventiveness of the technical solution incorporating the said feature.

The other is the type of methodological feature that has effect on the shape, the structure or their combination of the product. That is, the introduction of such a methodological feature leads to changes in the shape, the structure or their combination of the product. In the examination of inventiveness of the utility model, only the changes in the shape, the structure or their combination of the product shall be taken into consideration and not the methodological feature *per se*. For example, a tech-

nical solution comprises two structural components A and B made of the same material. The two components are "welded" into an inseparable body. "Welding" has changed the macro-structure of the product. In the examination of inventiveness of the technical solution, the components A and B shall be treated as a whole and the methodological feature of "welding" *per se* shall not be considered. If the corresponding component in the most related prior art is a whole structure but not "welded" together, the two components may be regarded as having no difference. If the corresponding component in the most related prior art is "connected by rib", consideration shall be given to the difference between the separable structural components connected by "rib" and that of the inseparable component which is "welded together".

## 2.2 Standards for Examination of Inventiveness of Utility Model

### Art. 22.3

For inventions, inventiveness means that, as compared with the technology existing before the date of filing, the invention has prominent substantive features and represents a notable progress; For utility models, inventiveness means that, as compared with the technology existing before the date of filing, the utility model has substantive features and represents progress. Therefore, in the examination of the request for invalidation of a patent for utility model, the standard of inventiveness for the utility model is lower than that for the invention.

For the same invention – creation, in judging whether there exists "technical inspiration" in the prior art, the answer is different according to whether it is an invention or a utility model. The difference is in the following two aspects.

#### (1) Field of prior art

For inventions, the technical field to be taken into consideration covers not only the technical field to which the invention belongs, but also the technical fields that are similar, close or related to the technical field to which the invention belongs, and as well as the other technical field in which a person skilled in the relevant field of technology is likely to look for technical means to resolve the technical problem the invention intends to.

For utility models, the technical field to be taken into consideration is generally focused on the technical field to which the utility model belongs, with consideration also to the other technical fields that are similar, close or related to it.

### **(2) Number of prior art**

For an application for patent for invention, two or more documents of prior art may be cited to evaluate its inventiveness. As for utility models, in normal situation, one or two documents of prior art may be cited to evaluate its inventiveness. However, for utility models that are "pieced together" from the prior art, according to the situation, several documents of prior art may need to be cited to evaluate its inventiveness.

## **3. Examination Under Rule 13.1 of the Implementing Regulations**

Rule 13.1 of the Implementing Regulations of the Patent Law provides that "for any identical invention – creation, only one patent right shall be granted". This provision sets the principle of prohibition of double – patenting.

In accordance with Rule 64 of the Implementing Regulations of the Patent Law, not in conformity with the provisions of Rule 13.1 of the Implementing Regulations of the Patent Law is one of the grounds for filing a request to invalidate an invention – creation that has been granted patent right.

For inventions and utility models, by "identical invention – creation" as mentioned in Rule 13.1 of the Implementing Regulations, it means that the claimed inventions or utility models are identical; For designs, it means that the designs are identical or similar.

### **3.1 Applications on the Same Date**

#### **3.1.1 Applications Where Patentees Are the Same Person**

Where any person thinks that the grant of two patents to applications filed on the same date to the same patentee are not in conformity with the provisions of Rule 13.1 of the Implementing Regulations of the Patent Law, it/he may request the Patent Re-examination Board to invalidate one of the patent rights.

Under such situation, where the patentee chooses to keep one of the patent right valid by way of abandoning the other, it/he shall submit a statement in writing for the abandoning of the other patent right from the date on which the patent right was granted. The Patent Office shall register and announce it. Where the patentee chooses to keep the patent right which was granted on a later date valid, it/he may declare to abandon the earlier patent right from the date on which the later patent right was granted. Where there exists no other grounds for requesting the

said patent right invalid or where these other grounds are not tenable, the Patent Reexamination Board shall make the examination decision to keep the patent right valid.

### **3. 1. 2 Applications Where Patentees Are Different Persons**

Where any person thinks that the grant of two patents to applications filed on the same date to different patentees are not in conformity with the provisions of Rule 13. 1 of the Regulations of the Patent Law, it/he may request the Patent Reexamination Board to invalidate the two patent rights respectively.

Under such situation, the Board shall normally handle the requests together.

Where the two patentees choose, after negotiation, to keep one of the patent right valid by way of abandoning the other patent right from the date on which the patent right was granted, the said patentee shall submit a statement in writing to abandon its/his patent right. The Patent Office shall register and announce it. Where the patentees choose to keep the patent right which was granted on a later date valid, it/he may declare to abandon the earlier patent right from the date on which the later patent right was granted. Where there exists no other grounds for requesting the patent right which the patentees intend to keep invalid or where these other grounds are not tenable, the Patent Reexamination Board shall make the examination decision to keep the patent right valid.

Where none of the patentees agrees to abandon its/his patent right, and the Board believes that the objects protected by the two patent rights are the same invention – creation, it shall declare both patent rights invalid.

### **3. 2 Applications Filed on Different Dates**

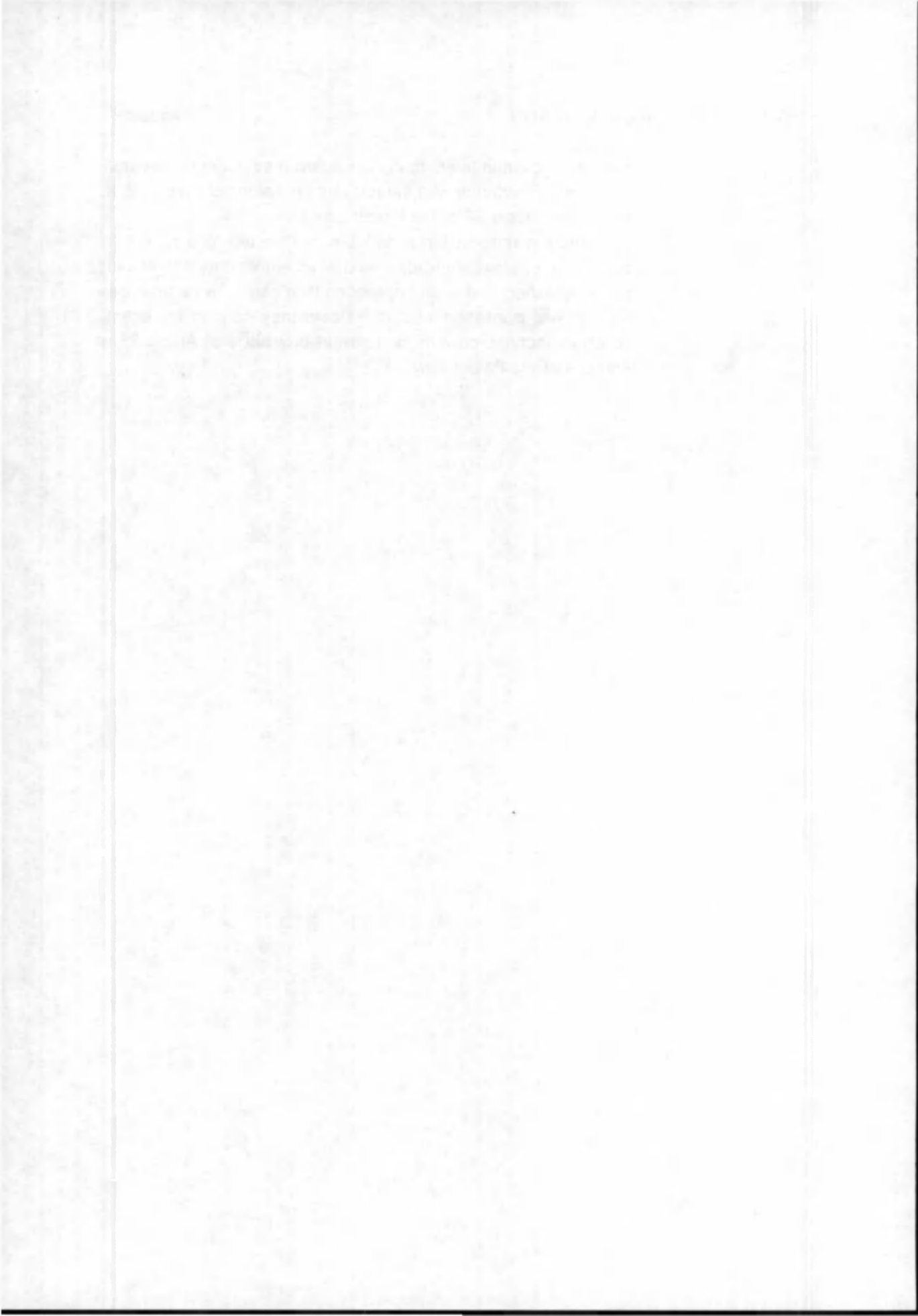
Where any person thinks that the object of protection of a patent right and that of a patent right granted earlier belong to a same invention – creation, which is not in conformity with the provisions of Rule 13. 1 of the Implementing Regulations of the Patent Law, it/he may request the Patent Reexamination Board to invalidate the patent right.

If a request for invalidation is directed to a patent for invention or utility model, and the publication of a patent right which has an earlier filing date already constitutes the prior art of the patent or is a patent which was filed earlier by another person



but was published later, then, the Board may perform the examination in accordance with the relevant provisions of Article 22.2, Article 9 or Article 23 of the Patent Law.

Where a request for invalidation is directed to a patent for design, if a patent application filed at an earlier date has already been published or it is an application filed earlier by another person but was published later, the Board may perform the examination in accordance with the relevant provisions of Article 23 or Article 9 of the Patent Law.



**Part V**  
**Handling of the Patent**  
**Application and Other Matters**

Part V  
Handling of the Patent  
Application and Other Matters

**Chapter 1****Patent Application Documents and Formality Requirements****1. Introduction**

An applicant seeking patent protection for an invention – creation shall file an application for patent with the Patent Office in accordance with the provisions of the Patent Law and its Implementing Regulations. In the examination and approval of a patent application, the applicant shall also have to go through a variety of formalities in connection with the patent application in accordance with the provisions of the Patent Law and its Implementing Regulations or upon the requirements of the examiner. By patent application formalities, it refers to the filing of patent application with the Patent Office by the applicant and the going through of other patent – related matters in the procedures of patent examination and approval.

The request, description, claims, drawings of description and abstract submitted to the Patent Office by the applicant upon filing patent applications in accordance with Article 26 of the Patent Law or the request, drawings or photographs submitted to the Patent Office by the applicant upon filing patent applications in accordance with Article 27 of the Patent Law are referred to as patent application documents. Except the application documents, all the other requests, statements, observations, rectifications and certificates, evidence materials submitted by the applicant, patentee or other parties concerned when going through the various formalities in connection with the application or patent at the time of filing the patent application or thereafter are referred to as other documents.

**2. Form of Filing Patent Application****Rule 3**

Going through the formalities of the patent application shall be performed in writing or in the other forms as prescribed by the Patent Office.

The formalities performed in manners other than in writing, such as in oral form, by phone call or in kind, or by such communication measures as telegram, telex, facsimile, film, etc. which directly or indirectly produce such technical results as printing, typewriting or handwriting, shall be deemed not to have been performed, and shall have no legal effect.

### 3. Applicable Language

#### 3.1 Chinese

##### Rule 4

Except for the written certificates or proofing materials as provided by the departments concerned of a foreign government or as established in a foreign country, the patent application documents and other documents shall be in Chinese.

The Patent Office shall base its examination on the Chinese text of the patent application submitted by the applicant. The attached text of the application in foreign language submitted by the applicant at the time of filling the application shall serve as a reference for the examiner to understand the contents of the patent application in the examination procedures and shall have no legal effect.

#### 3.2 Chinese Characters

The word "Chinese" as mentioned in Section 3.1 of this Chapter refers to the Chinese characters. The patent application documents and other documents shall be written in Chinese.

The Chinese characters shall use the simplified writing form published by the China Writing System Reform Committee in 1964 as the standard. The Patent Office may correct the variant, complex, or non-standardized simplified forms of the characters in the application documents, or invite the applicant to make the correction within the specified time limit.

#### 3.3 Translation of Foreign Languages

##### Rule 4.1

Scientific and technological terms in foreign languages shall be translated into standard Chinese terms in accordance with the provisions. Where no generally accepted translation in Chinese could be found for a specific term, it may be translated in accordance with the general practice, the term in the original language shall be also indicated.

For the foreign measurement unit, the standard symbol and unit shall be used in accordance with the prescriptions of the State.

##### Rule 4.2

At the time of submitting the written certificates and proofing materials as provided by the departments concerned of a foreign government or as established in a foreign country (such as document certifying the right of priority, document certifying the assignment, etc.), the party concerned shall submit also the Chinese translation of the titles of the certificates and documents

concerned. Where the Patent Office thinks it necessary, it may request a Chinese translation of the full text or the abstract of such document to be submitted within a specified time limit. Failure to submit within the specified time limit, the documents shall be deemed not to have been submitted.

#### **4. Prescribed Forms**

##### **Rule 118.1**

The format of the various prescribed forms to be used for filing the patent application shall be established by the Patent Office. If necessary, the Patent Office shall make overall or partial amendments to these formats and publish them accordingly.

For formalities done with non – prescribed forms, the Patent Office may invite the party concerned to make the amendments within the specified time limit or deem it not to have been made.

##### **4.1 Paper**

The paper used for the various documents shall be pliable, sturdy, durable, smooth, lusterless and white, with its quality equal to, or better than, the 80g offset paper.

##### **4.2 Specification**

The specification of paper used for the description, claims, drawings of description, abstract, drawings of abstract and other forms shall be 297mm x 210mm (A4).

##### **4.3 Margin**

For the application documents, there shall be a 25mm margin on the top (if there is a title, from the top of the title to the edge) and on the left of the page respectively, and a 15mm margin on the right and at the bottom from below the page number to the edge of the page respectively.

#### **5. Rules of Writing**

##### **5.1 Typewriting or Printing**

##### **Rule 120.1**

The request, claims, description, abstract and the text matter of the drawings and the abstract drawings shall be typewritten or printed. Mathematical expressions and chemical formula in the above – mentioned documents may be handwritten in a way as provided in map – making.

All other documents may be handwritten unless otherwise provided, but the writing shall be neatly lettered and free from

any alteration.

### 5.2 Typeface and Specification

The Song typeface, imitation Song typeface or regular script shall be used for the various documents. Running hand or other typefaces shall not be allowed.

The characters shall be 3.5mm to 4.5mm high, and the row spacing shall be 2.5mm to 3.5mm.

### 5.3 Method of Writing

The documents shall be written on one side of the paper, arranged in column, and read from left to right unless provided otherwise.

Two or more patent applications shall not be contained in one document; two or more documents (e. g. the description and claims) shall not be contained in one page.

### 5.4 Color of Typeface

The typeface shall be in black and appropriate for direct copying in large quantities by photomechanical process, micro-copy, Xerox printing, etc.. The handwriting and printing shall be clear, solid, non – erasable and non – fading.

### 5.5 Numbering

Where there are two or more pages in one document, the pages shall be numbered in Arabic numerals and arranged in numerical order. The numbering shall be in the upper center of the bottom margin.

## 6. Certifying Documents

The certifying documents which are often used in the procedures for examination and approval of the patent application include the non – service invention certificate, assignment agreement, succession certificate, nationality certificate, certificate of location of headquarters and habitual business office, habitual residence certificate, certificate of the status of legal person, certificate of representative of legal person, certificate of change of the title of legal person, certificate of change of habitual residence, certificate of the priority right ( duplicate copy of the earlier application documents), certificate of assignment of the priority right, certificate of deposit of biological material sample,



certificate of date for mailing the document etc. .

The various certificate documents shall be provided by the competent authorities concerned or be concluded between the parties concerned. For such documents, the original copy shall be provided; where the duplicate copy of the certifying documents is provided, it shall be notarized (except for those that have had centralized authentication).

#### **7. Number of Copies of Document**

##### **Rule 16. 1**

The application documents for patent submitted by the applicant shall be in two copies, one for the original copy and the other for the duplicate copy, with the original copy clearly indicated. Where there is no original copy indicated by the applicant, the Patent Office shall designate one as the original. Where there are differences between the two copies, the original one shall prevail.

Unless otherwise provided in the Implementing Regulations of the Patent Law and the Guidelines and except for the replacement sheet of the application documents, all the other documents submitted to the Patent Office shall be in one copy. Where it is necessary to transfer the documents concerned to another party, the Patent Office may indicate the number of copies needed in the notification.

**Chapter 2****Patent Fees****1. Time Limit for Payment of Fees****Rule 92**

(1) The time limit for the payment of the filing fee is two months from the date of filing. The fees to be paid together with the filing fee include the fees for claiming right of priority (where the right of priority is claimed), additional fee for filing the application (regarded as part of the filing fee) and the printing fee for publishing an application for patent for invention.

The fee for claiming right of priority refers to the fees that are required where the applicant claims the right of foreign or domestic priority. The amount of the fees shall be calculated in accordance with the number of the earlier application(s) that serves as the basis of the priority.

The additional fee for filing an application refers to the fees payable when the number of pages of the description (including drawings) of the application documents is in excess of 30 or the number of claims is in excess of 10. Such fees are calculated in accordance with the number of pages or the number of claims.

The printing fee for publishing the application refers to the fees payable for the publication of the application for a patent for invention at the expiration of eighteen months from the date of filing.

Where the aforesaid filing fee (including the additional fee for filing an application) is not paid or not paid in full within the specified time limit, the application shall be deemed to have been withdrawn. Where the aforesaid fee for claiming right of priority is not paid or not paid in full within the specified time limit, the claim for right of priority shall be deemed not to have been made. Where the aforesaid printing fee for publishing the application is not paid or not paid in full within the specified time limit, the application shall be deemed to have been withdrawn.

**Rule 93****Art. 35. 1**

(2) The time limit for paying the substantive examination fee is three years from the date of filing (or from the earliest priority date where right of priority is claimed). This fee applies only to applications for patent for invention.

**Rule 97**

The time limit for paying the fee for requesting an extension of a time limit shall be due before the date on which the original time limit expires. The amount of this fee shall be calculated according to the length of the extension requested (on a monthly

basis).

Rule 93                   The time limit for paying the request for a restoration of right  
Rule 7. 1               shall be due within two months from the date on which the party  
Rule 7. 2               concerned received the notification issued by the Patent Office  
                          confirming the loss of right ( where the party concerned submitted  
                          a request in accordance with the provisions of Rule 7. 2 of  
                          the Implementing Regulations of the Patent Law ), or within two  
                          month from the date on which the impediment was removed,  
                          and at the latest within two years immediately following the expi-  
                          ration of that time limit ( where the party concerned submitted a  
                          request in accordance with Rule 7. 1 of the Implementing Regu-  
                          lations of the Patent Law ).

Rule 93                   The time limit for paying the reexamination fee is three  
Art. 41. 1               months from the date on which the party concerned received the  
                          decision of rejection of the patent application made by the Patent  
                          Office.

Rule 94                   (3) Before the grant of patent right to an application for pa-  
                          tent for invention, the application maintenance fee shall be paid  
                          from the third year counted from the date of filing.

Rule 95                   The time limit for paying the registration fee for grant of pa-  
                          tent right, the annual fee of the year in which the patent right is  
                          granted, the maintenance fee of the application for each year  
                          other than the year in which the patent right was granted ( for an  
                          application for patent for invention only ), and the printing fee for  
                          the announcement of grant of patent right is two months from the  
                          date on which the party concerned received the notification is-  
                          sued by the Patent Office on the grant of patent right.

(4) The time limit for paying the annual fee and the sur-  
charge, please see Section 2. 2, Chapter 9 of this Part.

Rule 97                   (5) The time limit for paying the fee for a change in the bib-  
                          liographic data, fee for establishing a search report on a utility  
                          model patent, fee for requesting suspension of the patent proce-  
                          dure, fee for requesting invalidation, fee for requesting a com-  
                          pulsory license, and fee for requesting adjudication on the ex-  
                          ploitation fee of a compulsory license is one month from the date  
                          on which the corresponding request is filed.

## **2. Methods of Payment and Setting Accounts**

Rule 91. 1               The fees may be paid directly to the Patent Office ( including  
                          the representative offices ) or paid by way of postal or bank re-  
                          mittance, or in any other way as prescribed by the State Intellec-

tual Property Office. The scope of the payment collection by each representative office shall be separately provided.

Rule 91. 2

Where fees are paid by way of postal or bank remittance, the correct filing number or patent number, title of the fees to be paid and name or title and the address (including postal code) of the person who remits the payment shall be indicated on the money order. Non-compliance with the aforesaid requirement shall be deemed failure to have gone through the formalities of payment.

Where the fees are paid by an party concerned that has no habitual business office or residence in China, the payment shall be made in the designated foreign currency through a patent agency designated by the State Intellectual Property Office, except otherwise provided.

Rule 91. 3

Where fees are paid by postal remittance and if the filing number or patent number and the title of the fees to be paid have been clearly indicated on the money order, the date of remittance indicated by the postmark shall be the date of payment; if the filing number or patent number or the title of the fees to be paid is not indicated on the money order, the fees shall be returned to the sender and the payment shall be deemed not to have been made.

Rule 91. 3

Where the fees are paid by bank transfer and if the filing number or patent number and the title of the fees to be paid have been clearly indicated, the date on which the transfer of such fee is conducted shall be the date of payment; if the filing number or patent number or the title of the fees to be paid is not indicated, the fees shall be temporarily deposited and the payment shall be deemed not to have been made.

Where fees are paid by postal or bank remittance, the time between the date of remittance indicated on the money order and the date of receipt of the money order by the Patent Office is more than fifteen days, the date of receipt by the Patent Office shall be the date of payment unless the party concerned may provide relevant evidence.

All of the fees shall be calculated in RMB (yuan). The fees that shall be paid in foreign currency in accordance with the rules shall be settled after converting the foreign currency to RMB in accordance with the exchange rate provided by the State on the date on which the remittance is made.

### 3. Reduction and Postponement of Payment

The measures of reducing and postponing payment of fees shall be separately issued by the Patent Office.

### 4. Temporary Deposit and Return of Payment

#### 4. 1 Temporary Deposit

Where a receipt cannot be written out nor the remittance be returned to the remitter because of illegible handwriting or for lack of the necessary information on the money order, the money remitted shall be deposited temporarily in the Patent Office's bank account. When the content is clarified after inquiry, a receipt shall be immediately written out, and the date on which the money is withdrawn from the account is deemed to be the date of payment. However, where evidence is submitted within two months from the receipt of the notification of a loss of a right sent by the Patent Office, if it is proved by evidence that it is the fault of the bank or the post office that results in the fees being deposited temporarily, the date of initial remittance shall be the date of payment. If the contents of the payment remain impossible to be clarified for three years after the temporary deposit was made, the account shall be settled and the fees are handed over to the higher authority.

#### 4. 2 Return of Payment

##### 4. 2. 1 Principles of Return of Payment

Rule 91. 4

Where any patent – related fee is paid in excess of the amount as prescribed, paid repeatedly or wrongly, the party concerned making the payment may request a refund within one year from the date of payment, and the Patent Office shall return the payment. The Patent Office shall, in accordance with the rules, on its own initiative, refund a payment for the examination fee for an application which was deemed to have been withdrawn during the preliminary examination and thus has no legal effect or the annual fee paid after the cessation of the patent right was announced. Where the reason for requesting a refund of the payment is that the payment was paid wrongly, evidence of the wrong payment shall be provided. Where it is obvious that the fees have been paid wrongly because the title of the fees were incorrectly indicated, the Patent Office may transfer, ex

*officio*, the fees to the appropriate account. If the money order is incomplete or unclear, and the receipt cannot be written out after verification, the payment shall be refunded.

Payment shall not be returned under the following circumstances:

(1) The party concerned requests the refund of a fee paid in excess of the amount as prescribed, paid repeatedly or wrongly after more than one year from the date on which the payment was made;

(2) The party concerned does not provide evidence of an wrong payment; and

(3) The party concerned requests a refund of a fee paid in accordance with the rules before the request for reduction or postponement of the payment is approved.

#### **4. 2. 2 Effect of Return of Payment**

The returned payment shall be deemed not to have been paid from the beginning.

#### **5. Inquiry about the Payment**

Where an party concerned needs to inquire about the payment of fees, a copy of the bank money order or a copy of the voucher of the postal remittance ( if no receipt of the Patent Office is received ), or a copy of the receipt from the Patent Office ( if the Patent Office has given a receipt ) shall also be provided. The time limit for the inquiry is one year from the date on which the fee was remitted.

## **Chapter 3**

### **Acceptance**

#### **1. Location of Reception**

The Receiving Division of the Patent Office is responsible for receiving patent applications and other relevant documents. The representative offices established by the Patent Office in some of the provinces and cities are responsible for receiving patent applications only. They do not receive foreign – related applications, divisional applications, applications claiming domestic priority or other intermediate documents. The Receiving Division of the Patent Office and these representative offices shall open windows for receiving the applications and documents. Documents that are not registered with the said Receiving Division or Receiving Office shall not enter into the procedures for examination and approval. The Patent Reexamination Board receives requests for reexamination and invalidation and other relevant documents.

The Patent Office shall publish the addresses of the Receiving Division of the Patent Office and the representative offices by way of announcement.

Application documents or other relevant documents that are sent to any individual of the other department of the Patent Office or to any department of the Patent Office other than the Receiving Division shall have no legal effect.

#### **2. Acceptance or Non – Acceptance of Patent Application**

##### **Rule 40**

##### **2.1 Requirement of Acceptance**

The Patent Office shall accept patent applications that are in conformity with the following requirements;

(1) The request shall be included in the application documents, which shall clearly indicate the type of patent applied for, and the name or title and address of the applicant;

(2) The description and the claims shall be included in the application documents for a patent for invention; the description (drawings of the description must be included) and the claims shall be included in the application documents for a patent for utility model; and picture or photograph shall be included in the application documents for a patent for design;

(3) The application documents are typewritten or printed in Chinese. The writing and lines of the application documents

shall be legible and free from alterations. They shall be neat enough for the contents of documents to be identified easily at least. The drawings of the description of the invention or utility model and the pictures of the design shall be drafted with non – erasable ink, and free from alterations;

(4) Where the applicant is a national of a foreign country, the application shall conform with the provisions of Article 19.1 of the Patent Law, and the country to which the applicant belongs shall conform with the provisions of Article 18 of the Patent Law; and

(5) where the applicant is a legal person or resident of Hong Kong, Macao or Taiwan, the application shall comply with the formalities for the appointment of an agency in accordance with the provisions of Section 3.1.1.1, Chapter 1 of Part I of the Guidelines.

#### Rule 40

#### 2.2 Circumstances of Non – Acceptance

In any of the following circumstances, the Patent Office shall refuse to accept the application:

(1) where one of the requirements of acceptance in (1), (2) or (3), Section 2.1 of this Chapter is not complied with;

(2) where a foreign applicant is obviously not entitled to apply for patent for reasons of nationality or residence requirement;

(3) where a foreign applicant, for reasons of nationality or residence requirement, fails to appoint a patent agency designated by the State Intellectual Property Office to prosecute the application as provided in Article 19.1 of the Patent Law ;

(4) where a legal person or resident of Hong Kong, Macao or Taiwan sends the patent application to the Patent Office by mail directly from the region of Hong Kong, Macao or Taiwan; or

(5) where in filing the patent application as an applicant with the Patent Office, a legal person of Hong Kong, Macao or Taiwan fails to appoint a patent agency designated by the State Intellectual Property Office.

#### 2.3 Procedures of Acceptance and Non – Acceptance

After receiving a patent application, the Receiving Division or the representative offices shall comprehensively and carefully review and check all of the documents, issue the notification of acceptance or non – acceptance in accordance with the law.



**2. 3. 1 Procedure of Acceptance**

Where the patent application meets the requirements of acceptance, the examiner shall accept it in the following order.

(1) Determining the date of receipt;

Punch the date of receipt in all of the documents to record the date of receiving the application documents by the Receiving Office. The representative office shall affix the seal, on the request, of the date of receiving the documents and send them to the Patent Office to be punched with the date.

(2) Verifying and checking the number of documents;

Check the total number of the documents, verify the titles and number of the application documents and other documents indicated in the request, and record the result of the check in the request. The application documents shall be numbered page by page, and the total page number of the application documents shall be codified. The page number shall be indicated on the upper right hand corner of each page of the application documents, and recorded in the corresponding place on the inside back cover of the file.

(3) Determining the date of filing

Where the patent application is submitted personally to the Receiving Division of the Patent Office or a representative office, the date of receipt should be the date of filing. Where the patent application is sent by mail, the date of mailing indicated by the postmark on the envelope shall be the date of filing. Where the postmark is illegible, the date on which the Patent Office or the representative office receives the documents shall be the date of filing, the envelope shall be kept in the file. As for a divisional application, the date of filing for the original application shall be its date of filing. The date of submission of the divisional application shall be indicated in the request.

(4) Assignment of the filing number

A filing number shall be assigned to the corresponding patent application according to the order of filing the application. The filing number shall be stuck on the request and the other relevant documents.

(5) Recording the number of the registered letter

Where the patent application is sent by the registered mail, the number of the registered mail shall be recorded in the request.

(6) Inputting and verifying the data

Art. 28

Rule 5. 1

Rule 18. 4

Verify the original text of the documents, input and verify the data, print out the data verification sheet and correct the incorrect data input. The person who made the verification shall affix his seal on the sheet. Where an application for the patent for invention contains the disclosure of one and/or more nucleotide or amino acid sequences, it shall be verified whether or not the CD-ROM or disc of the corresponding sequence listing has been provided and whether or not the sequence listing has been copied into the database.

(7) Preparing notifications of acceptance

The notification of acceptance, notification for the payment of fees or notification of reduction or postponement of payment of fees for examination and approval shall be each prepared in duplicate. The duplicate copy shall be sent to the applicant and the original copy shall be kept in the file. In the notification of acceptance it shall indicate, at least, the filing number, date of filing, name or title of the applicant and the verification information of the documents. The seal of the Receiving Division of the Patent Office or the representative office shall be affixed on the duplicate copy, and the seal of the person who handled the case and the date of issuance of the document shall be affixed on the original one. In the notification of payment of fees, it shall indicate the application fee, additional fees and other fees that the applicant is required to pay when the application is filed and the time limit for paying the fees. The requirements for the payment of the fees shall also be indicated clearly in the notification. In the notification of reduction or postponement of the payment of the fees for examination and approval, it shall indicate the percentage of the reduction or postponement of the payment, the amount payable for the payment after the reduction, the time limit for, and the relevant requirements of, the payment.

### 2.3.2 Procedures for Acceptance of Divisional Application

#### 2.3.2.1 Procedures for Acceptance of Divisional National Application

For a divisional application, except for receiving and examining it according to the requirements for acceptance of a regular patent application, the Patent Office shall examine the original filing number or the original date of filing as indicated in the request of the divisional application. If the original filing number or

the original date of filing is not indicated in the said request of the divisional application or if the divisional application has changed the kind of protection of the initial application, the application shall be accepted as a regular patent application.

For a divisional application which meets the requirements for acceptance, the Patent Office shall accept it, assign to it a filing number, and acknowledge the original date of filing as its date of filing, and the date of submission of the divisional application shall be put into record. In the meantime, the notification for payment of fees or notification of examination and approval of the reduction or postponement of payment of fees shall be sent out, and the relevant data shall be established and verified.

#### **2.3.2.2 Procedures of Acceptance for Divisional International Application Entering National Phase**

For an international application, if a divisional application is filed after it enters into the national phase, in addition to conducting the examination for acceptance for a regular patent application, the examiner shall verify the original date of filing and the original filing number as indicated in the request of the divisional application. The said original date of filing shall be the date of filing of the international application, and the original filing number is the filing number assigned by the Patent Office when it enters into the national phase in China. In the brackets, the international filing number of the original application shall be indicated as well.

#### **2.3.3 Procedures of Non – Acceptance**

Where a patent application fails to meet the requirements for acceptance, the examiner shall usually issue a notification to refuse the application in the following order.

##### **(1) Determination of date of receipt**

Punch the date of receipt on all of the documents to record the date of receiving the application documents by the Receiving Division.

##### **(2) Draft of notification to refuse the application**

The notification of non – acceptance shall be in duplicate; the duplicate copy shall be sent to the party concerned and the original copy shall be kept in the file. In the notification, it shall indicate, at least, the name or title of the party concerned and the reason of it being refused. The seal of the Receiving Division

of the Patent Office or the representative office shall be affixed on the duplicate copy, and the seal of the person who handled the case and the date of issuance of the notification shall be affixed on the original copy.

**(3) Return of documents**

The documents of the application that are refused shall be returned to the party concerned by mail together with the duplicate copy of the Notification of Non – acceptance.

Where patent applications that are submitted personally to the Receiving Division of the Patent Office or to the representative offices fail to meet the requirements for acceptance, the reasons of why the application is refused shall be explained to the party concerned. In such circumstances, it is not the usual practice to issue a notification of non – acceptance, nor shall any mark made on the application documents.

**3 Receipt or Refusal of Other Documents**

**3. 1 Requirements for Documents to Be Accepted**

Any other documents that meet the following requirements shall be accepted by the Patent Office:

(1) The various documents relate to only one patent application and have the filing number of the patent application indicated on them;

(2) The various documents are written in clear and neat Chinese and are non – erasable. For the documents in a foreign language, a list of the materials in Chinese is attached.

**3. 2 Procedures for Acceptance and Refusal**

When other documents associated with the patent application submitted by the applicant, patentee, or any other party concerned are received by the Receiving Division of the Patent Office, the said division shall carefully check and verify all the documents, receive the documents according to the law or issue a notification of non – acceptance.

**3. 2. 1 Procedures for Acceptance**

Where the other documents meet the requirements for acceptance, the examiner shall receive them in the following order.

**(1) Pre – registration**

The intermediate documents sent by mail should be con-

firmed and registered; the mail transfer form of the incoming and outgoing mail office shall be verified.

(2) Determination of date of receipt

Punch the date of receipt on all of the documents to keep record of the date on which the Receiving Division receives the said documents. Any document that has not gone through the registration and has not been punched of the date by the Receiving division shall not enter into the examination and approval procedure of examination and approval.

(3) Checking the number of documents

Check the number of all the documents; verify the titles and number of the documents indicated by the party concerned on the list; and keep a record of the result of the verification on the list. Where no list is provided by the party concerned, the annex indicated in the principal document shall be verified and the result of the verification shall be recorded in the principal document. Where the filing number of the document as submitted is incorrect, if the correct filing number can be figured out on the basis of the other information, the Receiving Office may, *ex officio*, make a correction. Otherwise, the documents shall be non-acceptable and shall be returned.

(4) Determination of date of submission

Where documents are delivered personally through the Receiving Division of the Patent Office, the date of receipt shall be the date of submission. Where documents are sent by mail, the date of mailing indicated by the postmark on the envelope shall be the date of submission. If the aforesaid postmark is illegible, the date on which the Patent Office receives the documents shall be the date of submission. The envelope shall be kept together with the documents in the file. The date of submission of the documents shall be recorded in the document list. Where no such a list is provided, it shall be indicated in the principal document.

(5) Giving of Receipt for documents received

Where at the time of submitting the documents, there are two copies of the list of the documents attached, the result of the verification shall be indicated on the duplicate copy of the list and shall be sent to the party concerned after being sealed by the Receiving Division of the Patent Office. The original copy of the list, with the seal affixed of the person who handles the matter and the outgoing date indicated, shall be kept in the file.

Where at the time of submitting the documents, no list of documents is attached, or where there is no duplicate copy of the list, the Receiving Division of the Patent Office may not send the acknowledgement of receipt of the documents.

(6) Establishment of electronic database

The relevant data of all the documents shall be input into the computer.

**3. 2. 2 Procedures for Non – Acceptance**

Where the other documents fail to meet the requirements for acceptance, the notification of non – acceptance shall be issued in accordance with the procedures as provided in Section 2. 3. 3 of this Chapter.

**4. Correction of Date of Filing**

Where the applicant, after receiving the Notification of Acceptance, thinks that the date of filing recorded in the Notification of Acceptance is not the same as the date of mailing the application documents, it/he may request the Patent Office to correct the date of filing.

After receiving the request for correction from the applicant, the Receiving Division of the Patent Office shall check whether or not such request conforms to the following requirements:

(1) Whether or not it is submitted within two months from the date of submitting the patent application documents or within one month from the date on which the applicant receives the Notification of Acceptance; and

(2) Whether it is attached with the certification of the date of mailing as provided by the post office that received and delivered the patent application documents.

Where the documents conform to the above – mentioned requirements, the examiner shall verify whether or not the certification is valid. If it is, the date of filing shall be corrected. Where the documents fail to conform to the above – mentioned requirements or where the certification is invalid, the request to change the date of filing shall not be allowed.

Where it is allowed to correct the date of filing, the Notification of Re – Determination of the Date of Filing shall be made in duplicate. The duplicate copy shall be sent to the applicant, and the original one shall be kept in the file. The relevant data shall be amended and the departments concerned shall be

informed accordingly. Where it is decided not to change the date of filing, the notification of the request deemed not to have been made shall be issued to the applicant requesting for correction of the date of filing, the reasons therefore shall be stated.

#### **5. Correction of Mistakes in Procedures of Acceptance**

##### **Rule 57**

The Receiving Division of the Patent Office or the various representative offices shall correct promptly any mistake in the receiving of patent applications once they are discovered, the notification of corrections shall be issued, and the relevant data shall be amended. The documents that are sent to the other examination departments of the Patent Office by mistake shall be returned to the Receiving Division and the reason therefore shall be stated.

Where a patent application which does not meet the requirements for acceptance is being accepted, where an incorrect filing number or date of filing is being assigned, or where the verification of the number of documents has been proved wrong, only the Receiving Division of the Patent Office has the power to make the decisions of rectification.

#### **6. Inquiry**

A register of incoming documents is established in the Receiving Division of the Patent Office. Unless the party concerned can provide the receipt for the receiving of the document or the notification of acceptance issued by the Patent Office or the representative offices, the contents contained in the register shall prevail.

The time limit for inquiry is one year counting from the date on which the document is submitted.

## **Chapter 4**

### **File of Patent Application**

#### **File and Its Composition**

The patent application file is a collection of the documents of a patent application accumulated and kept as the valid original record for verification purpose in the process of its examination and approval and in its valid term of protection.

The patent application file serves as the basis for the examination and approval of patent applications and for the making of various decisions. It records in a detailed and truthful way the whole process of coming into being, growing up and cease of the patent application.

The patent application file consists of a folder and a variety of documents. A duplicate copy in another form as provided by the Patent Office may be made.

#### **1.1 Folder**

A folder is used to keep the documents and for recording the important contents kept in the file; hence, it is an important part of the file as a whole.

When the folder has to be changed due to natural or intentional damage, the complete record on the folder shall be moved to the new folder and the old folder shall be kept with the file and shall not be destroyed without permission.

In the folder there are two binding strips and two document pockets.

On the first binding strip, there shall keep the documents first submitted by the applicant (including the patent application documents and other documents) when the applicant files the patent application with the Patent Office and the original copies of the notification of acceptance and notification for payment of fees or notification of examination and approval concerning a reduction or postponement of payment of fees.

On the second binding strip, there shall keep the other documents produced after the submission of the patent application documents.

In the first document pocket, there shall keep the various documents pending handling or on their mid-way of being handled.

In the second document pocket, there shall keep the bags



for Gazette, in which the documents for publication or for grant of patent are kept.

The flowchart, fee payment, legal status of the application and the title of the incoming and outgoing documents are indicated respectively on the front cover, inside front cover, inside back cover and the back cover of the folder.

## **1. 2 Documents**

The documents in the patent application file come mainly from the following four sources:

(1) The patent application documents and their appendices submitted by the applicant in accordance with the law when it/he files an application for patent for an invention – creation;

(2) The series of decisions made and notifications issued by the examiner and the various responses made by the applicant under the request of the examiner in the course of the Patent Office's examination of the patent application documents;

(3) The documents and proving materials submitted by the applicant when it/he goes through the formalities on its/his own initiative after filing the patent application; and

(4) The various documents submitted by any person in accordance with the law in connection with the patent application or patent, and the documents of the Patent Office, the Patent Re-examination Board, and the people's courts etc. concerning the examination of these documents in the course of examination and approval of the patent application and after the grant of the patent right within its term of protection.

After proper handling, establishment of files and placing on file, the above – mentioned documents constitute important components of the file.

## **2. Principles of Establishment of Files**

### **2. 1 Principles**

When establishing the files, the following principles shall be complied with:

(1) Principle of truthfulness

The collection shall be the original documents produced by the applicant, patentee, parties concerned, examiner and any other person in the filing of the application, the examination and approval of the application as well as in the various legal proceedings of the post – grant procedures. These documents shall

not be replaced, deleted, supplemented or altered at will. Where any correction is to be made, there shall be a decision of amendment, and shall state the reasons therefor.

(2) Principle of one application one file

One patent application shall have one file. The application number of the patent application shall be the number of the file that shall be used for the entire existence of the file.

Where the same applicant intends to go through the identical formalities in respect of several patent application files, it/he shall submit a request for each of the patent application respectively. The related documents shall be placed on its respective files. The applicant shall not leave out any document by using "see..." for cross-reference. For the same applicant, patent applications may be put together to make changes in the name or title of the applicant or the assignment of right, the duplicate copy of the certifying document shall have the same effect as the original one after it is affirmed by the Patent Office.

Where the Patent Office issues notification or decision of the same contents in respect of several patent applications of the same applicant, one notification or decision shall be issued in respect of each patent application. No omissions are allowed.

(3) Principle of chronological order

Where a party concerned goes through the formalities before the Patent Office in accordance with the law, the Patent Office shall handle and place on file in time the various documents submitted by it/him. In addition, the various notifications or decisions made by the examiners of the Patent Office in the course of examination shall be placed on file in time.

The documents in the patent application files shall be placed in a chronological order according to the time when they are handled.

## 2.2 Record Keeping

### 2.2.1 Keeping Record of Documents

All the documents in the file (including incoming and outgoing documents) shall be numbered consecutively in Arabic numerals and recorded in the corresponding item of the file folder.

The documents submitted for the first time by the applicant when filing the patent application and the notification of acceptance shall be bound, numbered and recorded in the inside back

cover of the folder. For the binding of the application for patent for invention or utility model, it shall be in the order of request, abstract of description, drawing of abstract, claims, description and drawings of the description. For the binding of application for patent for design, it shall be in the order of request, drawing or photograph and the brief explanation.

The documents submitted by the applicant on its/his own initiative or in response to the request of the examiner after the patent application was filed and the various documents submitted by any person in respect to this patent application in accordance with the law shall be recorded in the item of incoming documents on the back cover of the folder. The various notifications or decisions issued by the examiner shall be recorded in the item of outgoing documents on the back cover of the folder. The recorded contents shall include the title of the document, date of receiving or dispatching the document and location of the document (page number).

#### **2. 2. 2 Keeping Record of Fee Payment**

When various fee payments are received, the title of the fees and the status of the payment shall be recorded on the inside front cover of the folder. Where it is necessary to go through the formalities of fee payment, the record concerning the fee payment shall be checked first, when the formalities have been gone through, the date of the payment shall be recorded.

#### **2. 2. 3 Keeping Record of Legal Status**

The important legal status of the patent application, in particular the status of the winding up of the application, shall be recorded in the corresponding item of the front cover and in the inside back cover of the folder.

#### **2. 2. 4 Keeping Record of Proceedings**

The status of the operation of a patent application file in the patent examination and approval process, mainly the timing of entry into each procedure, shall be recorded in the corresponding item of the front cover of the folder.

#### **2. 2. 5 Keeping Record of Other Matters**

The classification number, the examination department in charge of the examination and various marks (mark of priority,

mark of request for examination as to substance, mark of confidentiality, mark of payment reduction and postponement, etc. ) shall be recorded in the corresponding item of the front cover of the folder.

### **2. 3 Method of Keeping Record**

The record mentioned in Section 2. 2 of this Chapter shall be made by those in charge of the establishment and the maintenance of the file. For example, the documents submitted by the applicant for the first time shall be placed on file and recorded by a person in the Receiving Division; the classification number and the examination department in charge of the examination of the application shall be recorded by the classification examiner or the examiner for examination as to substance; various notifications and decisions shall be placed on file and recorded by the examiner or procedure management staff; other documents submitted by the applicant shall be recorded by the procedure management staff and placed on file by the examiner in charge of the matter concerned or by the management staff.

When keeping a record, it shall be in blue or black ballpoint pen or in fountain pen. It shall not be in pencil or other instruments that can be erased easily.

When it is necessary to make any correction in the record, the seal of the person who made the correction shall be affixed at the place of the correction, and shall make the contents of the correction still legible.

### **2. 4 Putting in Order and Dividing of Volumes**

When the examination and approval procedure is over, the patent application file shall be straightened out.

Where the total pages of the documents in the file are over 150 pages, they shall be kept in separate volumes. The inseparability of the documents shall be kept in mind when the documents are put into separate volumes. Clearly marks shall be made on the cover of each volume and the total number of the volumes shall be indicated on the first volume ( including volume one ).

## **3. Legal Effect**

The patent application file is a true record of the legal procedures of the examination and approval, reexamination and invali

dation of the patent, as well as the relevant procedures resulting from disputes over ownership of right.

After a patent application is filed, the applicant may amend the application documents during the examination and approval or other procedures, which may result in inconsistency between the published text and the original documents. During the examination, the examiner shall base his/her examination on the original documents, taking into consideration of the amendments that comply with the prescriptions. The amendments shall be affirmed and announced in the text based on which the patent right is granted.

#### **4. Consultation and Copy**

##### **Art. 21.2**

Until the publication of the application for patent for invention and the announcement of the grant of patent for utility model or design, the Patent Office shall have the duty to keep them confidential. Except those involved in the preliminary examination, no one is allowed to inspect or copy the patent application files. Where an applicant has difficulty in making response to an office action due to failure to keep the original documents, copy may be allowed upon approval of its/his written request therefore.

##### **Rule 117.1**

Any person may file a request with the Patent Office to consult and copy the file of a published application for patent for invention and the file of the application for utility model or design which has been granted patent. He can consult and copy the related file in accordance with the prescriptions upon approval by the Patent Office.

#### **4.1 Contents for Consultation and Copy**

(1) For the file of an application for patent for invention which has been published but the 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, i. e., the application documents, formality documents directly relating to the application, publication documents, notifications and decisions issued by the Patent Office to the applicant during the preliminary examination and the text of the responses submitted by the applicant in respect to the notifications.

(2) For the file of a patent application whose grant of patent right has been announced, the contents in the file which may be consulted and copied include the application documents, the

formality documents directly relating to the application, publication documents for the application for patent for invention, documents for announcement of grant of patent right, text of the various notifications and decisions issued by the Patent Office to the applicant or parties concerned in the examination proceedings which have been closed (including preliminary examination, examination as to substance, examination of reexamination and invalidation) and the text of the responses submitted by the applicant or the parties concerned in respect to the notifications.

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

(4) Except for the contents mentioned above, consultation of the other documents shall not be allowed.

#### **4.2 Procedures for Consultation and Copy**

The following procedures shall be followed for consultation and copy of the documents in the file of a patent application:

(1) The person who requests for consultation and/or copy files a request in writing and pays the prescribed fees;

(2) After having verified and checked the relevant certificates or identifications, a staff member of the Patent Office shall retrieve the file from the department where the file is kept and sort out the file in accordance with the provisions of Section 4.1 of this Chapter and take away the documents of which no consultation or copy is allowed;

(3) The Patent Office makes an appointment with the person who requests for consultation and/or copies on the timing therefore and issues the notification of inspection;

(4) The person requesting for consultation shall inspect the documents at the designated place based on the notification of consultation and copy the documents as needed;

(5) The staff member of the Patent Office shall rearrange the patent application file that has been inspected, put in the file the original copy of the certificates for consultation and the duplicate copy of the identification, and return the file to the department concerned.

## 5. Preservation Period and Destruction

### 5.1 Preservation Period

The files of the closed patent applications are divided into two categories: files of patent applications that are closed before the grant of patent right (having been deemed to have been withdrawn, having been withdrawn on its/his own initiative or having been rejected) and files of patent applications that are closed after the grant of patent right (patent right having been deemed to have been abandoned, patent right having been abandoned on its/his own initiative, patent right ceases to be valid for failure to pay the annual fee, expiration of patent right, invalidation of patent right).

Rule 117.2-3

The preservation period for the files closed before the grant of patent right is three years and for the files closed after the grant of patent right is five years, counting from the date on which the relevant file is closed.

The preservation period for the files of the original application of divisional applications shall be counted from the date on which the last divisional application is closed.

The preservation period of the file of an important patent application may be extended according to circumstances upon approval of the Commissioner in charge.

### 5.2 Destruction

Before destroying the files, an inventory of the destroyed files shall be created by the computer. The inventory shall include the file number, the basic bibliographic data and the date of destruction of the files. After the commissioner in charge approves the inventory and signs the order of destruction, the department in charge of keeping the files shall execute the work of destruction.

## **Chapter 5**

### **Keeping Secret of Patent Applications**

#### **1. Scope of Contents to Be Kept Secret**

The scope of patent applications to be kept secret as provided in Article 4 of the Patent Law covers both inventions – creations relating to national security at one hand and inventions – creations relating to other vital interests of the State at another hand. According to Rule 8.1 of the Implementing Regulations of the Patent law, where the Patent Office receives an application for a patent for invention which relates to State secret of national defense and is required to be kept secret, the Patent Office shall forward the application to the Patent Department of National Defense for examination. According to Rule 8.2 of the Implementing Regulations of the Patent law, the Patent Office, after receipt of an application for patent for invention which is required to be examined for the purpose of security, shall send it to the relevant competent department under the State Council for examination.

In conclusion, the scope of patent applications subject to be examined by the Patent Office for the purpose of security covers only the applications for patent for invention relating to the vital interests of the State.

#### **2. Criteria for Keeping Secret of Patent Application**

The criteria to be observed for an application to be kept secret is provided by the competent departments of the State Council.

#### **3. Procedures for Keeping Secret of Patent Application**

##### **3.1 Request for Keeping Secret of Patent Application**

###### **(1) By the applicant**

Where the applicant for a patent for invention considers that its/his invention concerns the vital interests of the State, it/he shall indicate it in the Request to keep the application secret when filing the application for a patent for invention, or make a request for keeping the application secret in writing after the filing of the patent application and before the publication of the application by the Patent Office (i. e. within fifteen months from the date of filing or date of priority).

###### **(2) By the Patent Office**



At the time of conducting patent classification, the examiner shall pick out applications for patent for invention that relate to national security or vital interests of the State.

### 3.2 Determination of Keeping Secret of Patent Application

The examiner responsible for secret patent application shall conduct the examination of the patent application in respect of which a request for keeping it secret has been submitted in accordance with the criteria concerning secrecy. The examiner shall determine whether or not it is necessary to keep the application secret depending on the different circumstances according to the following procedures:

(1) Where the contents of the invention relates to national security, the application shall be transferred to the Patent Department of National Defense in accordance with the provision of Rule 8.1 of the Implementing Regulations of the Patent Law and notify the applicant accordingly.

(2) Where it is obviously unnecessary to keep the invention secret, the applicant shall be thus notified. If, after the applicant makes observations, the examiner for secret patent application still believes that it is not necessary to keep the invention secret, he shall make a decision of not keeping it secret and notify the applicant accordingly.

#### Rule 8.2

(3) Except for cases where inventions are obviously not necessary to be kept secret, the examiner for secret patent application shall send a copy of the application documents (including the Request, description, description drawings, claims and abstract) to the competent authorities of the State Council for examination. The said authorities shall, within four months from receipt of the application, notify the Patent Office of the result of the examination. Then the said result shall be promptly notified to the applicant by the Patent Office. Where there is no response from the competent authorities of the State Council within the specified time limit, the examiner for secret patent application shall make a decision of not keeping the invention secret and notify the applicant that the application shall be treated as a regular patent application.

### 3.3 Procedures of Examination and Approval for Patent Application Requesting to Be Kept Secret

The examiner for secret patent application shall put the label

of "secret" on the file of the patent application which has been decided to be kept secret. He shall establish the location and status card for the file of the secret application, make a corresponding label in the computer system to keep it under management until the decision on declassification is made.

An examiner designated by the Patent Office shall conduct both the preliminary examination and the examination as to substance to the secret patent application.

The preliminary examination shall be conducted in accordance with the criteria identical with those for regular applications for patent for invention. After passing through the preliminary examination, the secret patent application shall not be published and shall directly enter into substantive examination if the request for substantive examination has been filed and the relevant fees paid.

The substantive examination shall be conducted in accordance with the criteria identical with those for the regular application for patent for invention. If the examiner finds that there is no cause for rejection after the examination as to substance, a notification of grant of patent right shall be made. The examiner for secret patent application shall notify the applicant to go through the formalities for the registration of the patent right.

The announcement for grant of patent right for secret patent application shall publish only the patent classification number, patent number, date of filing of the patent application and the date of announcement of patent right.

#### **4. Procedures of Declassification of Keeping Secret**

##### **4.1 Submission of Request for Declassification of Keeping Secret**

###### **(1) By applicant or patentee**

The applicant for, or the patentee of, a secret patent may request in writing for declassification of keeping the application/patent secret.

###### **(2) By the Patent Office**

The Patent Office shall conduct review to the secret patents every two years and request to declassify the patents which it considers no longer necessary for being kept secret.

##### **4.2 Determination of Declassification of Keeping Secret**

The decision on declassification of keeping secret shall be made by the Patent Office after consulting with the competent authorities that held it necessary to keep the relevant patent se-

cret.

The applicant or patentee requesting for declassification of keeping secret shall provide a certified document of approval from the competent authorities of the State Council that originally held it necessary to keep the application/patent secret. Failing to do so, the application/patent shall continue to be kept secret. The applicant or patentee shall be notified of the result of examination relating to its/his request of declassification of keeping secret by the Patent Office.

Where, after the review, the Patent Office considers it no longer necessary to keep the application or patent secret, it shall make a decision on whether or not to do so after consulting with the competent authorities that originally held it necessary. Then the applicant or patentee shall be notified, by the Patent Office, of the decision accordingly.

#### **4.3 Procedures for Declassification of Keeping Secret of Patent (Application)**

The examiner for secret patent shall make a label of declassification for keeping secret of the related patent (application). The application for patent for invention, after the declassification, shall be treated as a regular patent application in both the examination and approval procedures and that of administration. After the declassification of keeping secret of a patent for invention, it shall be announced in the column of declassification of keeping secret in the Patent Gazette, the offprint of its description shall be published and the said patent shall be handled as a regular patent.

## **Chapter 6**

### **Notification and Decision**

#### **1. Formation of Notification and Decision**

##### **1.1 Notification and Decision**

During the procedures for examination and approval of an application for patent and that which are after the grant of patent, various notifications and decisions shall be made by the examiner, examiner of reexamination as well as the staff members for other matters under different circumstances. These notifications and decisions principally include Notification of Acceptance, Office Action, Notification of Rectification, Notification of Passing Through the Examination for Formalities, Notification of Application Being Deemed to Have Been Withdrawn, Notification of Restoration of Right for Examination and Approval, Notification of Expiration of Time Limit, Notification for Payment of Fees, Notification of Decision on Reduction and Postponement of Payment of Fees for Examination and Approval, Notification of Passing Through the Preliminary Examination, Notification of Publication, Notification of Entry into Procedures of Examination as to Substance, Notification of Grant of Patent Right, Notification of Going Through Formalities of Registration, Notification of Patent Right Being Deemed to Have Been Abandoned, Notification of Termination of Patent Right, Decision of Rejection, Decision of Reexamination, Decision of Examination Concerning Request for Invalidation of Patent Right, etc..

##### **1.2 Drafting of Notification and Decision**

In drafting the notifications and decisions, the relevant provisions of the Patent Law, its Implementing Regulations and the Guidelines for Examination shall be complied with.

###### **1.2.1 Composition**

The notification and decision usually comprise the following three parts unless specifically provided in other Sections and Chapters of the Guidelines.

(1) Bibliographic data: With regard to notification, this part shall include, at least, the name or title of the party concerned (where there are two or more persons in one side of the parties, they may indicate only the representative, but the contents of the notification shall have effect on all the persons which are repre-

sented by the representative) and the filing number of the patent application to which the notification relates. With regard to decision, this part shall, at least, include the name or title of all the parties concerned and the filing number of the patent application to which the decision relates. In this part, it is preferable to include the title of the invention – creation of the patent application to which the notification or decision relates.

(2) Text: this part shall include, at least, the title, contents and conclusion of the notification and decision.

(3) Ending: this part shall include, at least, the seal of the Patent Office and the date of issuance of the document.

### 1. 2. 2 Drafting

The phrasing of notification and decision shall be simple and concise. Where a notification or decision is unfavorable to the interesting party, the grounds shall be explained and the follow – up legal procedures indicated.

Generally speaking, the notification and decision shall be typewritten or printed. Where the notification or decision contains only little wording, it may be written in hand. The handwritten notification and decision shall be neat, clear and free from any alterations.

### 1. 3 Number of Copies of Notification and Decision

The notification or decision in the procedures of examination and approval of the patent application shall be normally in duplicate: the original copy and the duplicate copy. In the procedures of invalidation of patent right, the number of copies of the notification or decision shall depend on the number of the parties participating in the procedures.

Both the original copy and the duplicate copy shall be signed or sealed by the person who handles the case. When it is necessary to be examined and verified, the seal of the person who is in charge of the examination and verification shall be affixed. Moreover, the official seal of examination of the Patent Office of the State Intellectual Property Office or the Patent Reexamination Board shall be affixed, and the date of issuance indicated. The original copy shall be kept in the file and the duplicate copy delivered to the interesting party.

## Rule 5

**2. Service of Notification and Decision****2. 1 Modes of Service****2. 1. 1 Service by Mail**

Mail service of documents refer to send the notification and decision to the parties concerned through the post office. The documents shall be sent by registered mail and the registration number, address and name of the addressee, type of document, filing number of the patent application concerned, date of issuance of the document and department issuing the document shall be input into the computer unless otherwise provided for. Where the mailing documents are returned, the date when the documents were returned shall be recorded.

**2. 1. 2 Personal Delivery**

Upon the approval of the Patent Office, the patent agency may receive the notification and decision at a place and time as designated by the Patent Office. Under special circumstances, upon the approval of the Patent Office, the party concerned may also receive the notification and decision at a place and time as designated by the Patent Office.

Except for the receipt for notification of acceptance of application and for documents submitted in person at the Receiving Office, the delivery in person of all other documents shall go through the formalities of being recorded and signed. Under special circumstances, the party concerned shall be invited to sign on the original copy of the notification and the decision or on the file of the application and the name, number and the organization responsible for issuing the ID of the party concerned shall be recorded.

**2. 1. 3 Announcement**

Where the address is not clear and the documents can not be sent by mail or where the notifications and decisions have been returned by the post office because the address is not detailed enough, the Patent Office may notify the party concerned by making an announcement in the patent gazette. At the expiration of one month from the date of the announcement, the document shall be deemed to be delivered.

## **2. 2 Addressee**

### **2. 2. 1 Where No Patent Agency Being Appointed by Party Concerned**

Where an application for patent or a request for invalidation of patent right is filed, and no patent agency is appointed, the document shall be sent to the liaison person named in the request. Where no such person is named in the request, the party concerned shall be the addressee. Where there are two or more parties concerned, and a representative is designated who is not the first party concerned named in the request, the addressee shall be the representative; otherwise, the party concerned named first in the request shall be the addressee.

The liaison person named in the request refers to a person who is designated by the applicant or the party concerned only for the convenience of receiving documents from the Patent Office. Where an individual applicant or party concerned is sure to receive documents from the Patent Office, they may not designate a liaison person. Usually, where the applicant or party concerned is an entity, the liaison person shall be a staff member of the entity. Where the applicant or party concerned is a natural person, the liaison person shall be one who is convenient in receiving documents from the Patent Office and can promptly deliver them to the applicant or the party concerned. An applicant or party concerned can name only one liaison person.

### **2. 2. 2 Where Patent Agency Being Appointed by Party Concerned**

If within the scope of the power entrusted in the Power of Attorney in connection with a patent application, the addressee of the notifications and decisions shall be the patent agency.

Where a patent agent is designated by the patent agency, the addressee is the patent agent. Where two patent agents are designated, the addressee shall be the two patent agents.

### **2. 2. 3 Other Circumstances**

Where the party concerned is of civil disability, on condition that the Patent Office is so notified, the addressee of the notification and decision shall be the legal guardian or legal agent.

## Rule 5

**2. 3 Date of Service****2. 3. 1 Service by Mail**

Where a notification or decision is served by mail, the 16th day from the date of mailing shall be presumed to be the date on which the party concerned receives the notification and decision. Where evidence is submitted by the party concerned proving that the actual date of receipt is later than the presumed date of receipt, the actual date of receipt shall be the date of service.

**2. 3. 2 By Personal Delivery**

Where notification or decision is delivered personally, the date on which the notification or decision is received shall be the date of delivery. Where, with the approval of the Patent Office, the patent agency receives a notification or decision at a location designated by the Patent Office, the date on which the patent agency receives the notification or decision shall be presumed to be the 16th day from the date of delivery.

**2. 3. 3 Service by Announcement**

Where an announcement is made in the patent gazette for a notification or decision, the date on which a notification or decision is received shall be presumed to be the date of expiration of one month counting from the date of the announcement. The party concerned may provide a detailed address and request for a second service by mail after notice of the announcement. But the date on which the notification or decision is received shall remain the date of expiration of one month counting from the date of the announcement.

**3. Handling of Returned Documents and Inquiry of Documents****3. 1 Handling of Returned Documents**

The notification or decision of a document has been returned by mail shall be recorded in computer by the department in charge of outgoing mail and then be sent to the department which made the notification or decision to handle.

When handling the documents that are returned, careful analysis shall be made first to the various documents contained in the application file that are submitted by the applicant and its/his agency, and the reasons of why documents are returned back should be figured out. Where correct address and addressee



could be established, the documents shall be sent again after rectification.

If, after the handling, the documents that are returned back could be in no way being sent by mail again or are returned back again, where necessary, depending on the nature of the notification and decision, the documents shall be served by making an announcement.

The documents that are returned (together with the envelope) shall be put into the file after being signed by the person handling the matter.

### 3. 2 Inquiry of Document

Where the addressee complains that he has not received a notification or decision, the department that made the notification or decision shall make an inquiry of it. Such inquiry shall begin with the department in charge of the outgoing mail in the Patent Office, and the person filing the complaint shall be notified of the result of the inquiry (including date of issuance, registered number and addressee of the notification or decision).

Where it is required to further inquire the service of the documents, the formalities of carrying out the inquiry shall be gone through by the addressee (the Patent Office may charge the payment of inquiry fees). The department in charge of the outgoing mail shall consult with the Post Office located in the place where the addressee lives through the post office where it stays. Where the finding of the inquiry reveals that the responsibility of non – arrival of the documents rests on the Patent Office or the Post Office, the notification or decision shall be sent again as soon as possible. Where the finding of the inquiry reveals that the responsibility of non – arrival of the documents rests on the incoming and outgoing mailing department of the entity to which the addressee belongs or on the addressee itself/himself or on a person having connection with it/him, the Patent Office may re – serve the duplicate copy of the relevant notification or decision at the request of the party concerned. However, the date of service shall remain unchanged.

The time limit for inquiry is ten months counting from the date of issuance of the document.

## **Chapter 7**

### **Time Limits, Restoration of Right and Suspension**

#### **1. Types of Time Limit**

##### **1.1 Prescribed Time Limit**

The prescribed time limit refers to the various time limits as prescribed in the Patent Law and its Implementing Regulations, such as, the time limit for request for examination as to substance of an application for patent for invention (Article 35. 1 of the Patent Law), and the time limit for an applicant to go through the formalities of registration (Rule 54. 1 of the Implementing Regulations of the Patent Law).

##### **1.2 Specified Time Limit**

The specified time limit refers to the time limit made by the patent examiner or staff member of the Patent Office in the various notifications under the Patent Law and its Implementing Regulations for an applicant or any other person concerned to make a response or perform a certain act. For example, it is provided in Article 37 of the Patent Law that when the Patent Office finds, after the examination as to substance of an application for patent for invention, that the application is not in conformity with the provisions of the Patent Law, the applicant shall be notified to make observations on, or amendments to, the application within the specified time limit. This is a time limit specified by the examiner. Besides, it is provided in Rule 4. 2 of the Implementing Regulations of the Patent Law that if a certificate or certified document submitted under the Patent Law and its Implementing Regulations is in a foreign language, the Patent Office, when it considers it necessary, may request that the party concerned provide the Chinese translation of the certificate or the certified document within a specified time limit. This is also a time limit fixed by the examiner.

The length of a specified time limit shall be determined by the examiner depending on the circumstances and shall be indicated in the relevant notification.

A specified time limit shall be in general two months. In the procedures of examination as to substance of application for patent for invention, the time limit for the applicant to response to the first office action shall be four months. A one – month time limit may be fixed for less complicated action. The time limits

mentioned above shall be counted from the date on which the party concerned has presumably received the notification.

## 2. Counting of Time Limit

### 2.1 *Dies a Quo* of Time Limit

(1) Counting from such fixed date as the date of filing, date of priority and date of announcement of grant of patent right etc.

Most prescribed time limits are counted from a fixed date such as the date of filing, date of priority and date of announcement of grant of patent right. For example, it is provided in Article 42 of the Patent Law that the duration of the patent right shall be counted from the date of filing. It is also provided in Article 29.1 of the Patent Law that an application for patent for invention or for utility model claiming the priority based on a foreign application shall be made within twelve months, counting from the date on which the application was first filed in a foreign country (date of priority).

(2) Counting from the date on which a notification or decision is presumably received

All of the specified time limits and part of the prescribed time limits are counted from the date on which a notification or a decision is presumably received. For example, the time limit for the applicant to make observations on, or amendments to, the application specified by the examiner in accordance with Article 37 of the Patent Law (specified time limit) is counted from the date on which the Office Action is presumably received by the applicant. The time limit for the applicant to go through the formalities of registration as provided in Rule 54.1 of the Implementing Regulations of the Patent Law (prescribed time limit) is counted from the date on which the notification on grant of patent right is presumably received by the applicant.

#### Rule 5.3

The date on which a document is presumably received refers to the fifteenth day from the date of the issuance of the said document by the Patent Office (the date is indicated in the notification and the decision). For example, where a notification is issued to an applicant on July 4, 2001 by the Patent Office, the date on which the notification is presumably received shall be July 19, 2001.

### 2.2 Expiration of Time Limit

The date of expiration of a time limit shall be the last day of the prescribed or specified time limit counted from the *Dies a*

*Quo* of the time limit. The relevant acts shall be completed before, or at the latest on, the date of expiration.

Rule 5. 1

For all the documents submitted to the Patent Office, the date of the submission of the documents shall be the date of mailing indicated by the postmark or the date of personal delivery. If the date of the postmark on the envelope is illegible, the date on which the Patent Office receives the document shall be the date of submission, except where the date of mailing is proved by the party concerned. For all the documents sent to another department other than the Receiving Office, or to any examiner, the date of mailing shall be of no legal effect, the date on which the Receiving Office of the Patent Office actually receives the document shall be the date of submission. The date which was punched on the document shall be regarded as the date of receipt by the Patent Office.

2. 3 Counting of Time Limit

Rule 6

The first day (*Dies a Quo*) of any time limit is not to be counted in. Where a time limit is counted by year or by month, it shall expire on the corresponding day of the last month; if there is no corresponding day in that month, the time limit shall expire on the last day of that month. For example, the date of filing of an application for a patent for invention is June 1, 1998, the expiration date for requesting the examination as to substance shall be June 1, 2001, rather than May 31, 2001. For another example, if a notification is sent by the Patent Office on December 16, 1999, the date on which it is presumably served is December 31, 1999. If the specified time limit for this notification is two months, the expiration date shall be February 29, 2000.

Rule 6

If a time limit expires on an official festival or holiday, the time limit shall expire on the first working day immediately after that official festival or holiday. The official festivals refer to the New Year's Day (one day), the Spring Festival (three days), the International Labor Day (three days), the National Day (three days); and the official holidays refer to Saturday and Sunday of each week. Where the official festival or holidays are readjusted by an announcement, the announcement of the Beijing Municipal Government shall prevail. For example, where the date of filing of an application for a patent is March 1, 2001, the date for paying the filing fee shall expire on May 8, 2001, i. e., the first working day of May (May 1 - 3 are the holidays for Inter

national Labor Day, and May 4 – 7 are the readjusted holidays).

### 3. Monitoring of Time Limit

#### 3.1 Determination of Time Limit

A time limit is always determined at the *dies a quo* of that time limit. For example, after an application for patent is filed by an applicant, and the date of filing is fixed, the various time limits which are counted from the date of filing shall be determined while the file is established for that patent application. The examiner or staff member, when making the various notification and decision in connection with the time limits, shall determine the time limits for making a response that are counted from the date on which the notification or decision is presumably received.

#### 3.2 Modes of Monitoring Time Limit

The various time limits are monitored by means of the computer or the paper cards or by the combination of the two. After an applicant has gone through the formalities relating to a time limit, the date of going through such formalities shall be recorded, and compared with the expiration date of the corresponding time limit by means of the computer or paper cards, so that the legitimacy of the formalities that have been gone through in respect of the time limit could be ascertained.

The time limit is monitored on a day to day basis and is handled once a week. If a time limit has not been eliminated at the expiration of one month of the said time limit, it shall be handled by means of the computer or cards, and a decision shall be made accordingly. For example, a notification was sent by the Patent Office on September 4, 2001 requesting an applicant to provide the Chinese translation of a certain evidentiary document in foreign language within one month. The date on which the notification was received presumably by the applicant should be September 19, 2001, and the expiration date of the time limit October 19, 2001. Where the Patent Office failed to receive the reply from the applicant, it should handle the application in the week in which November 19, 2001 was included, a notification of the document being deemed not to have been provided should be made and the applicant should be notified accordingly.

### 3.3 Notification of Expiration of Time Limit

(1) At the time of three months before the expiration of the time limit for requesting the examination as to substance of an application for patent for invention, if no such request has been made or where the corresponding fee has not been paid, a notification shall be made to notify the applicant to go through the relevant formalities.

(2) At the time of fifteen days after the expiration of the time limit for the payment of the annual fee, a notification of payment shall be made relating to the relevant fees that have not been paid. The applicant shall be notified to pay the relevant fees and the surcharge as provided in Rule 96 of the Implementing Regulations of the Patent Law within the time limit for late payment.

No notification shall be made before the expiration of the other time limits.

### 4. Extension of Time Limit

#### 4.1 Request for Extension of Time Limit

Rule 7.3

A party concerned may request the Patent Office to extend a time limit if it/he cannot perform or complete a certain act or procedure within the time limit with justified reasons.

Rule 7.3

Rule 97

The request for extension of time limit shall be made in writing before the expiration of the time limit and the corresponding fee for the extension shall be paid before the expiration of the time limit. The fee for such request shall be counted by month.

Rule 70

The extension of time limits shall be limited only to those that are specified by the Patent Office. However, in the procedures for examination of request for invalidation, the specified time limit prescribed by the Patent Reexamination Board shall not be extended.

#### 4.2 Approval of Request for Extension of Time Limit

The request for extension shall be examined and approved by the department that has made the corresponding notification or decision.

Where the extension of time limit is less than one month, it shall be counted as one month. In general, the extension of time limit shall not exceed two months. In general, for a time limit which is specified in the same notification or decision, it may be extended only once.

After the examination of a request for extension of time limit,

a notification of examination shall be issued to notify the party concerned. Where the request for extension meets the requirement, a change shall be made to the expiration date of the time limit in the relevant file and database, and the monitor of the time limit shall be re-established accordingly.

## **5. Handling of Failure to Meet Time Limit**

### **5.1 Check Before Taking Disciplinary Action**

The consequence of failing to meet a time limit on the part of an applicant or patentee is the loss of the corresponding right, including mainly, right to apply for a patent, patent right or right of priority etc..

Before making a decision on taking disciplinary action, the examiner and staff member of the Patent Office shall check again whether or not it is necessary to make such a decision. The decision shall be made only when it is ascertained that the applicant or patentee has not completed an act that should have been completed within the prescribed or specified time limit.

### **5.2 Decision of Taking Disciplinary Action**

The decision on taking disciplinary action against failure to meet a time limit mainly include: application deemed to have been withdrawn, right of patent deemed to have been abandoned, termination of patent right, application is not to be accepted, request deemed not to have been made, or right of priority deemed not to have been claimed, etc..

The drafting of the decision on taking disciplinary action shall be in compliance with the relevant provisions of Chapter 6 of this Part and shall be made within one month from the date on which the time limit expires.

### **5.3 Handling after Decision of Taking Disciplinary Action**

Once a decision on taking disciplinary action is made, the person in charge shall write down the title of the decision and the date of making the decision in the file of the patent application.

Once a decision on taking disciplinary action is made, there shall be a two-month period (from the date on which the decision is presumably served) for requesting restoration of right. Where no request for restoration of right is made at the expiration of the time limit, or where the request for restoration of right does not meet the requirements, the corresponding decision on taking disciplinary action shall be announced in the patent gazette four

months after the date of issuance of the decision (where the decision concerns a published patent application for invention or an announced patent), and the date of the announcement of the decision shall be indicated in the file. The file of the application shall then be transferred to the relevant storehouse for the invalidate files.

Where after the decision on loss of right to apply for a patent or loss of patent right is made, the Patent Office has received relevant document, the date of submission of that document shall be checked. Where the date of submission is prior to the date on which the original time limit expires and the document meets the requirement concerned, the decision thereof shall be revoked and a notification of correction shall be made as soon as possible. Where the date of submission is later than the date on which the original time limit expires or if the document does not meet the requirement concerned, the decision on taking disciplinary action shall be upheld. The document concerned shall not be returned.

## **6. Restoration of Right**

### **6.1 Scope of Application**

In Rule 7.1 –2 of the Implementing Regulations of the Patent Law, the requirements for requesting restoration of right which is lost due to failure to meet a time limit are set forth. However, Rule 7.4 of the Implementing Regulations also prescribes that the loss of right due to failure to meet the following four time limits, namely, disclosures not causing loss of novelty, time limits for right of priority, term of patent right and the prescription for instituting legal proceedings are not subject to restoration of right.

### **6.2 Formalities**

Any request for restoration of right shall be made in writing, the grounds thereof and the certified documents concerned shall be attached.

The request for restoration of right under Rule 7.2 of the Implementing Regulations of the Patent Law shall be submitted within two months from the date of receipt of the decision made by the Patent Office on taking disciplinary action, and the corresponding fees shall also be paid at the same time. The request for restoration of right under Rule 7.1 of the Implementing Regu-



lations of the Patent Law shall be submitted within two months from the date on which the impediment is removed, at the latest within two years immediately following the expiration of that time limit.

At the time of requesting for restoration of right, the party concerned shall complete the act which it/he has not, but should have, completed and eliminate the cause that leads to the loss of right. For example, where an application for a patent is deemed to have been withdrawn due to failure to pay the application fee, at the time of requesting for restoration of right to apply for a patent, the applicant shall pay the prescribed application fee.

### 6.3 Examination and Approval

The examiner shall examine the request for the restoration of right in accordance with the provisions of Sections 6.1 and 6.2 of this Chapter. Where the request meets the requirements, the restoration of right shall be approved. Where within the specified time limit, though the request has been made in writing and the relevant fees paid, it is still not in conformity with other requirements, the party concerned should be notified to make rectification or go through relevant formalities within a specified time limit. For example, where the evidence submitted by the party is not sufficient or where the applicant declares that it/he fails to make a rectification which should be rectified due to loss of notification by it/him. However, where the right of priority is deemed not to have been claimed either because the applicant fails to submit a copy of the earlier application document or a copy of the certificate of assignment of priority, if such documents are not submitted at the time the applicant initiates the procedures of request for restoration, the right shall not be restored. Where no rectifications are made within the time limit or where it does not meet the requirements after the rectification, the right shall not be restored. A notification of the decision on the examination concerning the restoration of right shall be made, and the party concerned shall be notified accordingly.

The procedures of examination and approval or the post – grant procedures shall proceed if the right of application for a patent or the patent right is restored by the Patent Office. Where the decision on taking disciplinary action has been announced, the decision of restoration of right shall be announced in addition

in the patent gazette.

## 7. Procedures of Suspension

Rule 86. 1

Rule 87

Suspension of procedures refers to an action of the Patent Office to suspend the relevant procedures at the request of a party concerned involved in a dispute over the ownership of right or under the demand of the court when a dispute over the right to apply for a patent or ownership of patent right is accepted by the local authority for intellectual property affairs ( or the corresponding functional authority ) or the people's court , or when the Court has ordered the adoption of measures for a patent right preservation.

### 7. 1 Requirements for Request of Suspension

Rule 86. 1

The following requirements shall be met for requesting the Patent Office to suspend the relevant procedures :

(1) Where the request of suspension is filed by a party concerned , the dispute over the ownership of right to apply for patent or of patent right shall have been accepted by the local authority for intellectual property affairs or by the people's court. Where assistance to enforce the adoption of measures of patent right preservation is demanded by the court, the said order should have been made ;

(2) The party requesting for the suspension shall be either the party concerned in a dispute over the ownership of right or the Court that has decided to adopt the measures for patent right preservation ; and

(3) Where the requests for the suspension of procedures is filed by a party concerned , it/he shall pay the fees for request for suspension.

### 7. 2 Scope of Suspension

The scope of suspension refers to the following :

(1) Suspension of the procedures for withdrawing an application for patent , abandoning of patent right , assignment of right , or changing of the name or title of the applicant or patentee which are directly related to the loss or transfer of right ;

(2) Suspension of making notification or decision which directly related to the enforcement of the decision concerning the handling of patent dispute or the judgment or ruling , such as application deemed to have been withdrawn , termination of patent

right, grant of patent right, or patent right deemed to have been abandoned, etc. ;

(3) Suspension of the procedures for the grant of patent right, issuance of patent certificate and announcement of the grant of the patent right; and

(4) Suspension of all of the procedures of examination, re-examination or examination of request for invalidation.

### 7.3 Formalities and Examination and Approval of Request for Suspension

Rule 86. 2  
Rule 90(5)  
Rule 97

When requesting the Patent Office to suspend the relevant procedures, the party concerned who is involved in a dispute over the ownership of right to apply for a patent or patent right shall submit a request for suspension and attach, as the proving material, a copy of the document acknowledging the receipt of the relevant request from the local authority for intellectual property affairs (or corresponding functional authority) or the people's court, and the fee for the request for the suspension shall be paid within one month from the date of the submission of the request.

Where the court requests assistance to enforce the measures of patent right preservation, the notification requesting assistance to enforce the measures of patent right preservation and a copy of the order of the court shall be provided.

After receiving the request and the relevant documents provided by the party concerned, the following shall be examined by the Patent Office:

(1) Whether or not the request is submitted by the party concerned involved in the dispute over the ownership of right as indicated in the relevant certified document;

(2) Whether or not the authority acknowledging receipt of the dispute has the jurisdiction over the dispute of ownership of right to apply for a patent or of patent right;

(3) Whether or not the filing number, title of the invention – creation, the owner of the right and other items indicated in the certified document meet the requirements; and

(4) Whether or not the party concerned has paid and paid enough the fees for requesting the suspension within one month from the date of submission of the request.

Where the person requesting for suspension is not the same as the party concerned indicated in the certified document, or

the patent application or the patent is not the same as that involved in the dispute over the ownership of right or where the authority accepting the dispute has no jurisdiction over the dispute, the request for suspension shall be deemed not to have been made.

Where the request for suspension does not meet the formal requirements or the certified document is neither the original nor the copy thereof, the Patent Office shall notify the party concerned to make rectification within one month. If no rectification is made before the expiration of the time limit, the request of suspension shall be deemed not to have been submitted.

Where the party concerned fails to pay or pay in full the fees for the request for suspension within one month from the date of the submission of the request, the request for suspension shall be deemed not to have been made.

Where a request for suspension has been deemed not to have been made, the examiner shall issue a notification and notify the person who has filed the request for suspension accordingly.

Where the requirements are met or met after the rectification is made, the Patent Office shall enforce the suspension, and both parties to the dispute over the ownership of right to apply for a patent or of the patent right shall be notified.

Where the request of assistance of the court to enforce the measures of patent right preservation meets the requirements, the court shall be notified accordingly and the patent right preservation shall be announced.

#### 7.4 Time Limit of Suspension

##### Rule 86.3

For the request for suspension made by a party concerned to a dispute over the ownership of the right to apply for a patent or of patent right, the duration of the suspension shall generally not exceed one year. By this, the suspension shall end one year from the date of filing the request for suspension. The Patent Office shall then notify both parties that are involved in the dispute over ownership of the right concerned.

Where within one year of the suspension no decision is made on the dispute over the ownership of right to apply for a patent or of the patent right and it is necessary to continue the suspension, the party who made the request shall request to extend the suspension within the time limit of the suspension.

Where no request for extension of suspension is made when the time is due, the Patent Office shall resume the relevant procedures in one – month time on its own initiative, and notify both parties accordingly.

**Rule 87**

For procedures suspended by the Patent Office under the request of the people's court to assist the enforcement of the measures of patent right preservation, if, at the expiration of the time limit for the preservation and the people's court fails to make an order to continue the preservation, the time limit of suspension shall be deemed to have expired, the Patent Office shall resume the relevant procedures in one – month time on its own initiative, notify the court and the patentee, and make an announcement accordingly.

**7. 5 Revocation of Suspension**

After the decision made by the local authority for intellectual property affairs (or the corresponding functional authority) or the judgment made by the people's court takes effect (after the change of bibliographic data when necessary, ), the Patent Office shall revoke the suspension.

After receiving the decision or the judgment submitted by the party concerned or the local authority for intellectual property affairs (or corresponding functional authority) or the people's court, the Patent Office shall examine the following:

(1) Whether or not the document of the decision or judgment is valid, i. e. , whether or not it is the official copy (original copy or duplicate copy) and whether or not it is made by the authority which has jurisdiction over the case;

(2) Whether or not the document of the decision or judgment has taken effect, i. e. , whether or not the time limit for appeal has expired (there is no time limit of appeal for documents of mediation). Where it can not be determined whether or not the document has taken effect, the examiner shall send a notification to the adversary party to inquire about whether or not it/he has intention to appeal. Where no response is made within the time limit or where it is clearly expressed that there will be no appeal, the document shall be deemed to have taken effect.

Where the documents meet the requirements and no change of owner of right is involved, the suspension shall be revoked as soon as possible. The parties concerned shall be notified and the original procedures shall be resumed. Where the documents

meet the requirements but the change of owner of right is involved, the examiner shall notify the party that has obtained the right to go through the formalities to correct the bibliographic data within three months from the date of receipt of the notification to revoke the suspension and to go through the other formalities that are required to complete during the suspension but have not been completed. Where the formalities are not gone through within the time limit, the right to apply for patent or of patent shall be deemed to have been abandoned. Where the party concerned that has obtained the right having gone through the formalities in accordance with the law, the suspension shall be revoked as soon as possible. The parties concerned shall be notified and the original procedures shall be resumed.

**Chapter 8****Compilation of Patent Gazette and Full Text of Description**

Rule 89

**1. Patent Gazette****1. 1 Types of Patent Gazette**

The patent gazettes compiled and published by the Patent Office shall include Patent Gazette for Invention, Patent Gazette for Utility Model and Patent Gazette for Design. Each of the three kinds of Patent Gazette shall be published once a week. If necessary, additional issues may be published upon the approval of the Commissioner.

**1. 2 Contents of Patent Gazette****1. 2. 1 Patent Gazette for Invention**

Patent Gazette for Invention shall include the publication of the applications for patent for invention, grant of patent for invention, secret patent, matters relating to patent for invention and the index.

**1. 2. 1. 1 Publication of Application for Patent for Invention**

Where an application for patent for invention is found to have met the requirements after the preliminary examination, the preparation for the publication of the application shall begin at the expiration of fifteen months from the date of filing (or date of priority if right of priority is claimed), and the application shall be published at the expiration of eighteen months from the date as mentioned above. Where an applicant requests to publish its/his application on an earlier date, such preparation shall start from the date on which the application is found in conformity with the requirements after the preliminary examination, and the application shall be published at the expiration of three months. At the expiration of fifteen months from the date of filing (date of priority, if claimed), if it is found that, for various reasons, an application for a patent for invention is not in conformity with the requirements of the preliminary examination, the publication of the application shall be put off. For any application for a patent for invention which is rejected, deemed to have been withdrawn, withdrawn by the applicant on its/his own initiative, or treated as a secret application in the procedures of preliminary examination, no publication shall be made to it.

The contents of publication for an application for patent for invention shall contain the bibliographic data, abstract and drawing of abstract. Where there is no drawing in the description, the drawing of the abstract may be omitted. By the term of bibliographic data, it mainly refers to: the symbol of International Patent Classification, number of filing, number of announcement (number of publication), date of filing, matters concerning the right of priority, matters concerning the patentee, matters concerning the inventor, matters concerning the patent agency and the title of the invention etc. .

#### **1. 2. 1. 2 Grant of Patent Right for Invention**

Where, according to the notification of grant of patent right and the notification of going through the formalities of registration made by the Patent Office, the applicant for patent for invention has paid in time the patent registration fee, the annual fee of the year when the patent right is granted and the application maintenance fees for all the years with the exception of year in which the patent right is granted, the patent application shall enter the phase of preparation for the announcement of grant of patent right and the grant shall be announced.

The bibliographic data relating to the grant of a patent for invention refer to: the symbol of International Patent Classification; patent number; number of announcement of grant of patent (number of publication); date of filing; date of announcement of grant of patent; matters relating to right of priority, matters relating to the patentee, matters relating to the inventor, matters relating to the patent agency; and the title of invention etc. .

#### **1. 2. 1. 3 Secret Patent**

For a secret patent, it shall publish only the matters relating to the grant of secret patent and the declassification of secret patent. The bibliographic data in connection with the publication of secret patent shall include: the symbol of international classification, patent number, date of filing, and date of announcement of grant of patent right.

After the declassification of secret application for a patent for invention, it shall be announced in the Patent Gazette in the column for declassification of secret application/patent, and its description shall be published in full in pamphlet form.



**1. 2. 1. 4 Other Matters Relating to Patent for Invention**

Other matters relating to patent for invention shall be published. They refer to the various decisions and notifications made by the Patent Office relating to an application for a patent for invention and a patent for invention, including: taking effect of a request for the examination as to substance; decision of the Patent Office to conduct the examination as to substance on its own initiative; rejection, withdrawal and deemed withdrawn of the application for a patent for invention after its publication; deemed abandonment of patent right; invalidation of patent right; cessation of patent right, restoration of right; transfer of the right of patent application or of patent right; grant of compulsory license for exploitation of patent; submission for record of patent license contract for exploitation; pledge and preservation of the patent right and their discharge; change of bibliographic data; relevant matters and notices; corrections of the Patent Office and other related matters.

**1. 2. 1. 5 Index**

The indexes of invention are divided into two categories: the index of publication and index of announcement of grant of patent. In each type of the indexes it is further divided into index of symbol of international classification, index of number of filing (or index of number of patent), index of applicant (or index of patentee) and a table of comparison between the number of publication and number of filing (number of announcement of grant of patent and number of patent).

**1. 2. 3 Patent Gazette for Utility Model**

The contents of Patent Gazette for Utility Model shall include the grant of patent right for utility model, matters concerning patent for utility model and the index.

**1. 2. 2. 1 Grant of Patent Right for Utility Model**

Where, according to the notification of grant of patent right and the notification of going through the formalities of registration made by the Patent Office, the applicant for patent for utility model has paid in time the patent registration fee and other relevant fees, the patent application shall enter into the phase of preparation for the announcement of grant of patent right and the grant shall be announced.

The contents of grant of patent right for utility model shall include: the bibliographic data, the abstract and the drawings of the abstract. The bibliographic data shall mainly include: the symbol of International Patent Classification, patent number, number of announcement of grant of patent right (number of publication), date of filing, date of announcement of grant of patent right, matters relating to the right of priority, matters relating to the patentee, matters relating to the designer, matters relating to patent agency; and the title of utility model etc..

#### **1. 2. 2. 2 Other Matters Relating to Patent for Utility Model**

Other matters relating to a patent for utility model shall be published, they refer to the various decisions and notifications made by the Patent Office concerning the application for a patent for utility model and the patent for utility model, including invalidation of patent right, cessation of patent right, restoration of right; transfer of the right of patent application and of patent right, grant of compulsory license for exploitation of patent, submission for record of patent license contract for exploitation, pledge and preservation of the patent right and their discharge, change of bibliographic data, relevant matters and notice, correction of the Patent Office, and other related matters.

#### **1. 2. 2. 3 Index**

The indexes of announcement of grant of patent right for utility model shall include index of symbol of International Patent Classification, index of number of patent, index of patentee and a table of comparison between the number of announcement of grant of patent right and number of patent.

#### **1. 2. 3 Patent Gazette for Designs**

The contents of the Patent Gazette for Designs shall include the grant of patent right for design, matters concerning patent for design and the index.

##### **1. 2. 3. 1 Grant of Patent Right for Design**

Where, according to the notification of grant of patent right and the notification of going through the formalities of registration made by the Patent Office, the applicant for patent for design has paid in time the patent registration fee and other relevant fees, the patent application shall enter into the phase of prepara-

tion for the announcement of grant of patent right and the grant shall be announced.

The contents of the grant of patent right for design shall include the bibliographic data, drawing or photograph of the design and the brief explanation. If there is no such brief explanation in the patent documents, the explanation shall not be included. The bibliographic data mainly include: the symbol of classification, number of patent, number of the announcement of grant of patent right (number of publication), date of filing, date of grant of patent right, matters relating to the right of priority, matters relating to the patentee, matters relating to the designer and matters relating to the patent agency, and the title of product incorporating the design etc. .

### **1. 2. 3. 2 Other Matters Relating to Patent for Design**

Other matters relating to patent for design shall be published. They refer to the various decisions and notifications made by the Patent Office concerning an application for a patent for design and patent for design, including invalidation of patent right, cessation of patent right; restoration of right, transfer of the right of patent application and of patent right; grant of the compulsory license for the exploitation of patent; submission for record of patent license contract for exploitation, pledge and preservation of the patent right and their discharge, change of the bibliographic data, relevant matters and notice, correction of the Patent Office, and other related matters.

### **1. 2. 3. 3 Index**

The indexes of announcement of grant of patent right for design shall include index of the symbol for design classification, index of number of patent, index of patentee and a table of comparison between the number of announcement of grant of patent right and the number of patent.

## **1. 3 Compilation of Patent Gazette**

### **1. 3. 1 Compilation of Publication of Application for Patent for Invention**

The documents for publication of an application for patent for invention shall meet the requirements for the photoengraving, and the bibliographic data shall be consistent with the informa-

tion contained in the patent application file which has been served as the basis for the preparation of making such publication.

The publication of applications for a patent for invention shall be arranged in the order of the International Patent Classification symbol. Those having identical main international classification symbols shall be arranged in the order of their filing numbers. Each application for patent shall take one third of a printed page. Where there are too many contents contained in the bibliographic data of an application for patent, and there is difficulty in compilation, an application for patent may also take two thirds of a printed page or the full page of it.

### **1. 3. 2 Compilation of Grant of Patent Right for Invention**

The documents of an application for patent for invention serving as the basis for the grant of patent right shall meet the requirements of photoengraving (for the portion of drawings) and regular process (for the portion of text matter), and the bibliographic data shall be consistent with the information contained in the patent application file which has been served as the basis for the grant.

The grant of the patent right for invention shall be arranged in the order of the symbols of International Patent Classification. Those having the identical main international classification symbols shall be arranged in the order of their filing numbers. Each page shall be divided into two columns, the left column and the right column and shall be compiled from top to bottom and from left to right in a continuous way.

### **1. 3. 3 Compilation of Grant of Patent Right for Utility Model**

The application documents for a patent for utility model serving as the basis for the grant of patent right shall meet the requirements of photoengraving, and the bibliographic data shall be consistent with the information contained in the patent application file which has been served as the basis for the grant.

The grant of the patent right for utility model shall be compiled in the order of the symbols of International Patent Classification. Those having the identical main international classification symbols shall be compiled in the order of their filing numbers. Each patent application shall take one third of a printed page. Where there are too many contents contained in the bib-

liographic data of an application for patent, and there is difficulty in compilation, an application for patent may also take two thirds of a printed page or the full page of it.

#### **1. 3. 4 Compilation of Grant of Patent Right for Design**

The documents of an application for patent for design serving as the basis for the grant of the patent right shall meet the requirements of photoengraving, the co – relation between the various views shall be correct, and the bibliographic data shall be consistent with the information as contained in the patent application file which has been served as basis for the grant.

The grant of the patent right for design shall be compiled in the order of the symbols of design classification. Those having the identical classification symbols shall be compiled in the order of their filing numbers. Each patent shall take one printing page. Where the drawings are numerous, and there is difficulty in compilation, a patent for design may take two or more printing pages.

#### **1. 3. 5 Compilation of Other Matters**

The compilation of other matters in the various Patent Gazette shall follow the following principles:

(1) The decision made by the Patent Office on the loss of right of an application for a patent for utility model or for design before the grant of patent right shall not be published. The decision made by the Patent Office on the loss of right of an application for a patent for invention before the publication of that application shall not be published;

(2) The various decisions made by the Patent Office which have taken effect shall be published;

(3) Where more than two identical matters are to be published in the same issue of Patent Gazette, they shall be arranged in the order of their main classification numbers; where the main classification numbers are identical, they shall be arranged in the order of the filing numbers.

##### **1. 3. 5. 1 Taken Effect of Request for Examination as to Substance, Decision Made by the Patent Office to Proceed to Examination as to Substance with Regard to an Application for Patent for Invention on Its Own Initiative**

This part is for the published applications for patent for in-

vention only. The items to be published shall include the main classification symbol, patent application number and date of filing.

**1. 3. 5. 2 Rejection, Withdrawal and Deemed Withdrawal of Application for Patent for Invention after Publication**

This part is for the published applications for patent for invention only. The items to be published shall include the main classification symbol, patent application number and date of publication.

**1. 3. 5. 3 Application for Patent for Invention Deemed to Have Been Abandoned to Obtain Patent Right**

The items to be published in this part shall include the main classification symbol of an application for patent for invention and the patent application number.

**1. 3. 5. 4 Grant of Compulsory License to Exploit a Patent**

The items to be published in this part shall include the main classification symbol, patent number and date of announcement of grant of patent right.

**1. 3. 5. 5 Cessation of Patent Right**

The items to be published in this part shall include the main classification symbol, the patent number, date of filing and date of announcement of grant of patent right.

**1. 3. 5. 6 Patent License Contract for Exploitation Submitted for Record**

The items to be published in this part shall include the main classification symbol, patent number, date of filing, date of announcement of grant of patent right, type of license (sole, exclusive or non – exclusive) and date of submitting for record.

**1. 3. 5. 7 Pledge and Preservation of Patent Right and Their Discharge**

The items to be published in this part for pledge (preservation) shall include the main classification symbol, patent number, date of filing, date of announcement of grant of patent right and the effective registration date of pledge (preservation).

The items to be published for discharge of pledge (preser-

vation) shall include the main classification symbol, patent number, date of filing, date of announcement of grant of patent right and date of discharge.

#### **1. 3. 5. 8 Transfer of Patent Application and/or of Patent Right**

The items to be published in this part shall include the main classification symbol, patent application number (patent number), items of change, owner of right before the change, owner of right after the change and effective date of registration.

#### **1. 3. 5. 9 Announcement of Invalidation of Patent Right**

The items to be published in this part shall include the main classification symbol, patent number, date of announcement of grant of patent right, number of decision of invalidation and date of decision of announcement of invalidation of patent.

#### **1. 3. 5. 10 Restoration of Right**

The items to be published in this part shall include the main classification number, patent application number (patent number), title of the original decision and date of announcement of the original decision.

#### **1. 3. 5. 11 Matters of Notification**

Where the mailing address is not clear and the Patent Office is unable to notify the party concerned to make response or to go through the formalities within the prescribed or specified time limit, the notification shall be published in the column of notification. The items to be published shall include the main classification symbol, application number, addressee and title of the document.

#### **1. 3. 5. 12 Other Relevant Matters**

In this column, it shall publish the items which are not prescribed in the various columns but need to be published.

#### **1. 3. 5. 13 Correction**

Where any printing errors or any other mistakes are found in the Patent Gazette, the Patent Office shall correct them promptly in the column for correction. The different types of errors or mistakes shall be published respectively. The items to be published shall include the main classification symbol, application number

or patent number, volume number and page number of the original announcement, item to be corrected and contents before and after the correction.

### **1. 3. 6 Compilation of Index**

#### **1. 3. 6. 1 Index of Classification Symbol**

For invention and utility model, the index shall be compiled in accordance with the International Patent Classification symbols; For designs, the index shall be compiled in accordance with the design classification symbols.

All the classification symbols of an application for patent or patent shall be compiled.

The index of the classification symbol shall be arranged in the order of the classification symbols. Where the classification symbols are the same, they shall be arranged in the order of the application number or patent number.

The items in the index of the classification symbols shall include the classification symbol, publication number or number of announcement of grant of patent right, application number or patent number, applicant or patentee (the applicant or patentee named first) and title of the invention, utility model or design.

#### **1. 3. 6. 2 Index of Filing Number or Patent Number**

The index of filing number or patent number shall be compiled in the order of the filing numbers or patent numbers.

The items covered in the index of filing numbers or patent numbers shall include the filing number or patent number, publication number or the number of announcement to grant the right, main classification symbol, applicant or patentee (the first undersigned applicant or patentee) and title of invention, utility model or design.

#### **1. 3. 6. 3 Index of Applicant or Patentee**

The index of applicant or patentee shall be compiled in the order of Pinyin of the characters of the name or title of the applicant or patentee. Those having the identical first Chinese character for their names, they shall be arranged in the order of the second Chinese character, and so on so forth. Titles in the foreign language shall precede all other names and follow the alphabetic order. Where the applicants or patentees are the



same, they shall be arranged in the order of the filing number or the patent number.

The items covered in the index of the applicant or patentee shall include the applicant or patentee, main classification symbol, filing number or patent number, publication number or the number of announcement of grant of patent right and title of invention, utility model or design.

## **2. Full Text of Description**

### **2. 1 Types of Full Text of Description**

The full text of the description compiled and published by the Patent Office shall include the description of the unexamined application for patent for invention, description of the patent for invention and the description of patent for utility model.

The full text of the description shall be published weekly on the same day as that of the corresponding Patent Gazette.

The full text of the description of the confidential patent application or confidential patent shall not be published.

### **2. 2 Contents of Full Text of Description**

#### **2. 2. 1 Description of Unexamined Application for Patent for Invention**

The publication code of the description of the unexamined application for patent for invention is "A". The publication includes the front page, claims, description and drawing of description.

The front page consists of the bibliographic data, abstract and drawing of the abstract. Where there is no drawing in the description, there shall be no drawing of the abstract. The contents of the front page shall be consistent with those of the corresponding patent application published in the Patent Gazette on the same day.

Claims, description and its drawings contained in the documents submitted on the filing date shall be authentic.

#### **2. 2. 2 Description of Patent for Invention**

The publication code of the description of the patent for invention is "C". The publication shall include the front page, claims, description and its drawings if there are drawings in the description.

The front page consists of the bibliographic data, abstract

and drawing of the abstract. If there is no drawing in the description, there shall be no drawing of the abstract. Compared with the contents contained in the corresponding patent for invention published in the Patent Gazette on the same day, the contents of the front page include the items of the examiner and the reference documents in addition.

The claims, description and its drawings shall be based on the text designated by the examiner in the notification of grant of the patent right.

Where, in the invalidation process after the grant of patent right for invention, the maintenance of patent right is based on the amendment of the patent documents, the amended claims of the patent for invention shall be re – published. Its publication code is “C1”. The date of the announcement of the amended claims shall be indicated.

### 2. 2. 3 Description of Patent for Utility Model

The publication code of the description of the patent for utility model is “Y”. The publication shall include the front page, claims, description and its drawings.

The front page consists of the bibliographic data, abstract and drawing of the abstract. The contents of the front page shall be consistent with those of the corresponding patent for utility model published in the Patent Gazette for utility model on the same day.

Claims, description and its drawings shall be based on the text designated by the examiner in the notification of grant of the patent right.

Where, in the invalidation process after the grant of patent right for utility model, the maintenance of the patent right is based on the amendment of the patent documents, the amended claims of the patent for utility model shall be re – published. Its publication code is “Y1”. The date of announcement of the amended claims shall be indicated.

### 2. 3 Correction of Description

Where any error in the description of the patent or in the description of the unexamined application for patent for invention is found, the Patent Office shall correct it. The corrected description shall be re – published, with the correction indicated in the errata sheet.

Rule 57

Rule 89. 1 (16)

**Chapter 9****Grant and Cessation of Patent Right****1. Grant of Patent Right****1. 1 Procedures of Grant of Patent Right****1. 1. 1 Notification of Grant of Patent Right**

Art. 39

Art. 40

Where it is found after the examination as to substance of an application for the patent for invention or after the preliminary examination of an application for the patent for utility model or design that there is no cause for rejection of the application, the Patent Office shall make a decision to grant the patent right, issue the patent certificate and register and announce it. The patent right shall take effect as of the date of announcement.

Before making the decision to grant the patent right, the Patent Office shall issue to the applicant the notification of grant of patent right.

Where both a patent for invention and a patent for utility model have been granted to an identical invention – creation, the applicant may be given a chance to make a choice. Only when the applicant has submitted its/his declaration to abandon the patent right for utility model, shall the Patent Office issue the notification to grant the patent right for invention. If the applicant insists on keeping the patent right for utility model, the Patent Office shall make a decision to reject the said application for the patent for invention.

**1. 1. 2 Notification to Go through Formalities of Registration**

Rule 54. 1

At the same time when the Patent Office issues the notification of grant of patent right, it shall also issue the notification to the applicant requesting it/him to go through the formalities of registration. The applicant shall go through the formalities of registration within two months from the date of receipt of the notification.

**1. 1. 3 Formalities of Registration**

Rule 95

When the applicant goes through the formalities of registration, it/he shall pay the registration fee for the grant of the patent right, the annual fee of the year in which the patent right is granted and the printing fee for the announcement of the grant of the patent right. The maintenance fee of the application of the years

other than the year in which the patent right is granted shall be paid for the application for a patent for invention.

At the time when the applicant goes through the formalities of registration, it/he shall also pay the stamp tax for the patent certificate.

#### **1. 1. 4 Issuance of Patent Certificate, Registration and Announcement of Decision of Grant of Patent Right**

Rule 54. 1

Art. 39

Art. 40

Where the applicant goes through the formalities of registration within the prescribed time limit, the Patent Office shall issue the patent certificate (including the decision to grant the patent right), register and announce it.

The patent right shall take effect as of the date of the announcement.

After the applicant has gone through the formalities of registration, the Patent Office shall prepare the patent certificate, and make preparations for the registration of the grant of the patent right and the announcement of the decision to grant the patent right. After the patent certificate is made, it may be sent to the patentee in accordance with the provisions of Section 2. 1. 1, Chapter 6 of this Part. In special circumstances, it may also be delivered directly to the patentee in accordance with the provisions of Section 2. 1. 2, Chapter 6 of this Part.

#### **1. 1. 5 Right to Patent Right Deemed to Have Been Abandoned**

Rule 54. 2

Where the applicant fails to go through the formalities of registration within the prescribed time limit after the Patent Office issues the notification of grant of patent right, the applicant shall be deemed to have abandoned its/his right to the patent right, and the applicant shall be notified accordingly. Such notification shall be made within one month from the date of expiration of the corresponding time limit, and the legal procedures for restoration of the right shall be indicated. Where no request for restoration of the right is received within four months from the date of issuance of the notification, the file of the patent application shall be moved to the library of the invalid files. For applications for patent for invention, before the file of the patent application being moved to the library of the invalid files, it shall be announced that the applicant of the application is deemed to have been a-

**Rule 95**

bandoned its/ his right to the patent right in the Patent Gazette.

For applications for patent for utility model or design, where the applicant fails to pay or pay in full the registration fee for the grant of the patent right, the printing fee for the announcement of the grant of the patent right or the annual fee of the year in which the patent right is granted, or for applications for patent for invention, where the applicant fails to pay or pay in full the registration fee for the grant of the patent right, the printing fee for the announcement of grant of patent right, the annual fee of the year in which the patent right is granted and the application maintenance fee for all the years except the year in which the patent right is granted, the formalities for registration of the grant of patent right shall be deemed not to have been gone through. Where the applicant has paid all the above – mentioned fees but failed to pay the stamp tax of the patent certificate, the patent certificate shall not be issued, but the procedures of registration and the announcement thereof shall proceed as usual. The patent certificate shall be issued only when the applicant has paid the stamp tax.

**1.2 Patent Certificate****1.2.1 Form of Patent Certificate**

The patent certificate shall contain the important bibliographic data concerning the patent right, the hallmark of the Patent Office, signature of the Commissioner, and date of announcement of the grant of the patent right.

The said bibliographic data shall include the patent certificate number ( serial number ), the title of the invention – creation, the patent number ( i. e. the filing number ), the filing date, the inventor or designer and the patentee.

Where the bibliographic data of a patent is too long to be contained in one page, additional page( s ) may be attached.

**1.2.2 Duplicate Copy of Patent Certificate**

Where for one patent there are two or more patentees, the Patent Office may issue, at the request of the co – patentee( s ), the duplicate copy( ies ) of the patent certificate. However, the number of the duplicate copies of the patent certificate for one patent shall not exceed the number of the co – patentees. Furthermore, if after the issuance of the patent certificate, there has

been any change in the name of the patentee due to assignment, succession or presenting as gift of the patent right, the Patent Office shall not issue any duplicate copy of the patent certificate to the new or newly added patentee.

After the patent right ceases, the Patent Office shall issue no more the duplicate copy of the patent certificate.

The duplicate copy has the word "copy" indicated on it, and the Patent Office shall charge a fee for the duplicate copy.

### 1. 2. 3 Replacement of Patent Certificate

Where according to the settlement of the local authorities for intellectual property affairs ( or corresponding functional authority) or the judgment of the people's courts on a dispute over the ownership of the patent right, the patent right is returned to the person who made the request, the party concerned may, after the said settlement or judgment takes effect and at the same time when going through the formalities to change the patentee, request the Patent Office for the replacement of the patent certificate. When requesting for the replacement of the patent certificate, the original certificate shall be returned and the handling fee for the replacement shall be paid. The Patent Office shall verify the patent application file after receiving the request to replace the patent certificate. If the request meets the requirements, it shall prepare a new patent certificate and issue it to the party concerned. The original patent certificate shall be put into the file of patent application concerned with the word "replacement" indicated thereon.

Where there is any typing error in the patent certificate, the patentee may return the certificate and request the Patent Office to correct it. The Patent Office shall correct the error after verification, and shall send the replaced certificate to the patentee. The original certificate shall be put into the file of the patent application with the word "replacement" indicated thereon.

No replacement of the patent certificate shall be made in the case of any change in the bibliographic data because of assignment, succession, or presenting as gift of the patent right. No patent certificate shall be re – issued if the patent certificate is lost, unless the Patent Office is responsible for the loss.

### 1. 3 Patent Register

#### 1. 3. 1 Form of Patent Register

Rule 88

The Patent Office shall establish the Patent Register at the time when the patent right is granted. The contents to be recorded in the Patent Register include the grant of the patent right, transfer of the patent application or of the patent right, invalidation of the patent right, cessation of the patent right, restoration of the patent right, pledge and preservation of the patent right and their discharge, patent license contract for exploitation submitted for the record, compulsory license for exploitation of the patent, and change in the name, nationality and address of the patentee.

The Patent Office may register, *ex officio*, the grant of the patent right, the invalidation of the patent right, the cessation of the patent right, the restoration of the patent right, the pledge and preservation of the patent right and their discharge, the patent license contract for exploitation submitted for the record, and the compulsory license for exploitation of the patent. The registration of the transfer of the patent application or of the patent right, and of the change in the name, nationality and address of the patentee shall be made upon the request of the party concerned.

The items recorded in the Patent Register shall be stored in the computer database. When necessary, the paper copy may be printed out by the computer, which shall take effect when it is affixed with the seal of the certification.

#### 1. 3. 2 Legal Effect of the Patent Register

As at the time when the patent right is granted, the contents of the Patent Register are consistent with those recorded in the patent certificate, what recorded in the Patent Register and in the patent certificate have the same legal effect. After the grant of the patent right, as the change in the legal status of the patent is recorded only in the Patent Register, if, as a result of which, the contents contained in the Patent Register are not consistent with that of the patent certificate, the contents contained in the Patent Register shall prevail.

#### 1. 3. 3 Duplicate Copy of Patent Register

Rule 117. 1

After the announcement of grant of patent right, any person

may request the Patent Office to issue a copy of the Patent Register. When any person requests the Patent Office to issue a copy of the Patent Register, it/he shall pay the appropriate fee,

Upon receipt of the said request and the payment of the fee, the Patent Office shall make a duplicate copy of the Patent Register by computer. The duplicate copy shall be affixed with the special purposed seal for certificate, and shall be sent to the person who made the request after making a verification of the file of the patent application and after being assured that no error has been found out. Then, this shall be recorded in the file of the application concerned.

## **2. Cessation of Patent Right**

### **2. 1 Cessation Due to Expiration of Term of Patent**

Art. 42

The duration of patent right for inventions shall be twenty years, and the duration of patent right for utility models and patent right for designs shall be ten years counted from the date of filing.

When the duration of a patent right expires, it shall be promptly registered in the Patent Register and shall be announced in the Patent Gazette respectively. Then, the corresponding file of the application shall be moved to the library of invalidated files.

### **2. 2 Cessation of Patent Right Due to Patentee's Failure to Pay Annual Fee in Accordance with the Prescriptions**

#### **2. 2. 1 Annual Fee**

Rule 95

The annual fee of the year in which the patent right is granted shall be paid at the time of going through the formalities of registration, and the subsequent annual fees shall be paid in advance within one month before the expiration of the preceding year.

##### **2. 2. 1. 1 Year**

A one year's time for a patent is counted from the date of filing. It is irrelevant to the date of priority or that of grant of the patent right. It is also not necessarily relevant to a calendar year. For example, the date of filing of an application for a patent is June 1, 1999, the first year of that patent application is counted from June 1, 1999 to June 1, 2000, and the second year of the patent application is counted from June 2, 2000 to June 1, 2001



and so on.

### 2. 2. 1. 2 Amount of Annual Fee Payable

The annual fee shall be paid in the amount as prescribed in the fee schedule. For example, suppose the date of filing of an application for a patent is June 3, 1997, the application was granted patent right on August 1, 2001 (date of announcement of grant of patent right), the applicant should have paid the annual fee for the fifth year when it/he went through the formalities of registration, the patentee shall pay the annual fee for the sixth year between May 3 and June 3 of 2002 in the amount as prescribed for the sixth year.

### 2. 2. 1. 3 Surcharge

Rule 96

Where the patentee fails to pay the annual fee in time (not including the annual fee of the year in which the patent was granted), or where the fee has not been paid in full, the patentee shall be invited to pay the fee or to make up the insufficiency within six months from the expiration of the time limit within which the annual fee is due. If at the time of making the payment or of making up the insufficiency, it is less than one month from the date of the expiration of the time limit, no surcharge shall be paid. Where the late payment is made over one month later from the date of expiration of the time limit within which the annual fee is due, the corresponding amount of the surcharge shall be paid, and the amount of the surcharge shall be calculated as follows:

(1) If it is one or two months (including the one or two full months) later than the prescribed time limit, a surcharge of 5% of the annual fee shall be paid;

(2) If it is two or three months (including the two or three full months) later than the prescribed time limit, a surcharge of 10% of the annual fee shall be paid;

(3) If it is three or four months (including the three or four full months) later than the prescribed time limit, a surcharge of 15% of the annual fee shall be paid;

(4) If it is four or five months (including the four or five full months) later than the prescribed time limit, a surcharge of 20% of the annual fee shall be paid;

(5) If it is five or six months (including the five or six full months) later than the prescribed time limit, a surcharge of 25%

of the annual fee shall be paid.

Where within the period of six months for late payment, the patentee makes a second late payment due to failure to pay in full in the first payment, a surcharge shall be paid which is the appropriate percentage of the full of the corresponding annual fee. The said percentage shall be calculated according to the months delayed for payment from the prescribed time limit.

Where failure to pay or pay in full the annual fee and/or surcharge leads to cessation of patent right, in the procedure for restoration of right, the patentee, except for paying the full of the annual fee, shall pay or make up the insufficiency of a surcharge of 25% of the annual fee.

### **2. 2. 2 Cessation**

Where at the expiration of the time limit for late payment, the patentee still fails to pay or pay in full the annual fee and /or the surcharge, a notification to cease the patent right shall be made within two months, but not earlier than one month from the expiration of the time limit for late payment. And the applicant shall be notified accordingly. Where the patentee does not request for restoration of right or where the request for restoration of right is not approved, the said notification shall be registered and announced in the Patent Register and the Patent Gazette respectively at the expiration of four months from the issuance of the notification of cessation. After that, the file of the patent application shall be moved to the library for invalidated files.

The date of cessation of the patent right shall be the date on which the previous year ends.

### **2. 3 Patentee Abandons Patent Right on Its/His Own Initiative**

Where the patentee abandons its/his patent right on its/his own initiative, a statement shall be made in writing in the form uniformly prepared by the Patent Office. The abandonment of patent right refers to the abandonment of the entire patent right. The statement of partial abandonment of patent right shall be deemed not to have been made. Where the patentee, who is not the authentic owner of the patent right, requests to abandon the patent right in bad faith, the authentic patentee (effective legal documents shall be provided to prove such) may request to cancel the statement.

Where the patent that is abandoned belongs to two or more

patentees, an agreement of consent of all the patentees shall be submitted. Where only some of the patentees request to abandon the right of the patent, they shall go through the formalities to make a change in the bibliographic data.

Where a statement to abandon the patent right meets the requirements as provided, it shall be approved, and the matters concerned shall be recorded and announced in the Patent Register and the Patent Gazette respectively.

