A SUMMARY OF THE LATEST AMENDMENTS TO THE GUIDELINES FOR PATENT EXAMINATION IN CHINA

29 October 2019

The China National Intellectual Property Administration (CNIPA) Guidelines for Patent Examination set detailed rules and explanations for Chinese patent examiners to determine the patentability of an invention, a utility model or a design. The CNIPA makes amendments to the guidelines from time to time in order to assist examiners in improving the process. On September 25, 2019, the CNIPA announced that new guidelines will take effect as of Nov. 1, 2019. It has been two years since the previous amendment to the guidelines was introduced, and the new rounds introduce a number of important changes around prosecution practice, including divisional application filings, inventive step assessment, and GUI design registration requirements. Below is a summary of the key changes and their impacts.

1. Divisional applications

The current practice in the Chinese patent office is relatively strict on voluntarily filing of a first divisional application – the first Chinese filing (parent) must be under prosecution (pending). In other words, a voluntary divisional application is not permitted when the parent filing is already granted or rejected (and not appealed). However, the requirements regarding the filing of subsequent divisional applications (i.e. a new divisional from a previous divisional) were quite loose. Therefore, a common strategy for patent agents was to draft multiple independent claims with no coordination of a divisional application. The expectation was that the examiner would surely raise a unity objection at some point. This strategy provided an applicant with a practical means for filing further divisional applications without limitations on time or number.

The new guidelines stipulate that, if the examiner raises a unity objection against a
divisional application (second filing), the time allowed for the applicant to file a further
divisional application (third filing) will depend on the timeline of the second filing. That is,
the applicant must submit the third filing when the second filing is still pending. The
amendment means that one cannot file further divisional applications infinitely using the
above strategy.

Another change regarding divisional applications under the new guidelines is that, after
Nov. 1, 2019, an applicant for a divisional application cannot be different from its parent
application. If the applicant of the parent application is to change, the change must be
made before filing the divisional application. On the other hand, if the applicant of the
divisional application is to change, the change must be made on or after filing the divisional
application.

2. Inventive steps

There is a standard analysis, often called the "three-step method", for a Chinese examiner
to determine whether a claim is inventive in view of the prior art. Such an analysis
includes: (1) determining the closest prior art reference; (2) determining distinguishing
technical feature(s) not disclosed by the closest prior art reference and technical
problem(s) to be solved by the distinguishing technical feature(s); and (3) judging whether
the distinguishing feature(s) are obvious in view of another reference or common general
knowledge (CGK).

Previously there were many complaints from applicants about this standard analysis,
especially regarding the identification of technical problem(s) and CGK. For identifying the
technical problem, a Chinese examiner typically focused on the distinguishing feature per
se in an isolated way, but that same official ignored how the feature interacted with other
features in the entire system. For CGK, in the past, many examiners simply regarded a
particular feature as CGK without providing any evidence of such.

The new guidelines aim to address the first issue by specifically asking examiners to
"determine actual technical problem(s) to be solved based on the technical effect(s)
achievable by the distinguishing technical feature(s) in the invention claimed to be
protected ". Further, the changes specify that "for the technical features that are mutually
supported or interactive between each other, examiners should consider, in a bigger
picture, the technical effect(s) achievable by these technical features and their
relationships". Examiners will now be required to consider a technical feature by
understanding how it acts in the entire invention, rather than seeing it as an isolated part.
The new guidelines restrict examiners from arbitrarily alleging that a feature is CGK by requiring examiners to provide evidence when a feature accountable for solving the technical problem is seen as CGK. Additionally, if the applicant raises an objection against the CGK alleged by the examiner, examiners will now be required to provide evidence of the GGK or explain the reason for the objection.

3. GUI design registration

Registering Graphic User Interfaces (GUI) as a design patent has been a hot topic in China, because there was no clear rule in the previous guidelines for protecting graphic content. The revised versions give some clear examples how to protect GUIs in a design patent.

First, a GUI must be based on a real product such as a display module or a mobile phone. This means that the displayed content per se is not patentable. Rather, there must be a physical object on which the GUI is to be shown. Therefore, instead of naming a design as a "GUI", the applicant must identify a physical product having a GUI. For example, a design application can be based on a refrigerator with a GUI for controlling temperature or a display panel with a GUI for streaming video, etc.

If the applicant does not wish to protect other features of the physical product, then only the front view showing the GUI is necessary for the application. If the GUI is for a projector, then a view of the projector and a view of the GUI are both required. In addition, the applicant must specify in a brief description that the design concept is contained in the GUI and what the GUI is designed to do.

4. Stem cell research

In China, stem cells of human embryos and their preparation method are clearly defined as patent ineligible subject matter. In patent examination practice under the current guidelines, determination of patent eligibility of stem cells mainly focuses on whether inventions utilizing stem cells of human embryos fall into the category of "industrial and commercial use of human embryos". The revised guidelines provide a more flexible approach on patent eligibility in this area.

Although "industrial and commercial use of human embryos" is still deemed not to be patentable, the use of stem cells separated from human embryos (with less than 14 days of in vivo development) is recognized as patent-eligible subject matter. Furthermore, the
new guidelines recognize that "stem cells separated from human embryos do not belong to a human body at the various stages of its formation and development".

5. Other amendments

Other important amendments are contained in the guidelines. They include requirements as follows:

- the applicant now has the option to defer the substantive examination for 1, 2 or 3 years;
- the examiner may discuss substantive issues in an application with the applicant/patent agent in a face-to-face interview, a telephone interview, an email exchange or a video conference, while the applicant/patent agent may request such a form of communication for substantive issues as long as the examiner also agrees it is necessary; and
- the examiner must follow three steps to carry out a prior art search. The three steps are (1) a preliminary search based on information about the patent family, the applicant(s) and the inventor(s); (2) a regular search based on the technical field of the application; and (3) an extended search based on similar functionalities. Notably, the extended search based on similar functionalities was not necessarily required in the past.

Overall, the new guidelines benefit applicants because examination procedures are more flexible and examiners are more restricted in their reasons for rejections. However, voluntary divisional practice has become more restrictive. We expect both examiner and applicant practices and strategies to change under the new guidelines and we will keep you posted as new developments arise.

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