



THINK FORWARD

New Amendments to SIPO's Guidelines for Patent Examination

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The State Intellectual Property Office of China ("SIPO") on March 1, 2017 finalized the amendment to its Guidelines for Examination; the amendments included patentability of business method patents, enhanced claiming options for software-related inventions, post-filing submission of experimental data for chemical inventions, liberalized amendment practice in post-grant invalidation proceedings, and availability of prosecution documents of Chinese patents and applications.

Business Method Patents

In preparation for the emergence of the financial technology, or "fintech" industry, SIPO is loosening up patent protection for innovation relating to novel business models. Previously excluded from patentability under Article 25 of the Chinese Patent Law, the new amendments now clarify that a business oriented innovation may qualify for patent protection provided that it includes technical features.

As revised, an applicant should do well following the European approach when applying for a business method patent, putting special emphasis on the business method's "technical" features which solve "technical" problems in a non-obvious manner.

Software-related Inventions

In the past, patent protection for software related inventions was rather limited; their claims were commonly drafted a process claim, or an apparatus claim based on the computer program flow wherein each component is regarded as a function module required to realize each step in the said computer program flow or each step in the said method. Such apparatus claims are regarded as the function module architecture of the computer program described in the description, rather than entity devices needed to realize the said solution mainly through hardware.

Under the revised Guidelines, software claims may now include a computer program product, a machine-readable medium, or a Beauregard type of claim, which focuses on "an apparatus comprising a processor configured to execute instructions on a computer-readable medium to perform steps of"

An applicant should pursue all new possibilities and include as many claim types as needed in the patent application; among other things, it will to make it easier to enforce software patents once they are granted.

Public Access to Prosecution History Files

In an effort to be more transparent, SIPO will make available to the public application documents relating to preliminary and substantive examinations, such as Office Actions, applicant Responses, Search Reports and Decisions issued by the SIPO, before the application is granted.

Post-filing Submission of Experimental Data for Chemical Inventions

Previously, the Guidelines explicitly stated that when evaluating sufficiency of disclosure, “examples and experimental data submitted after the filing date shall not be considered.” This practice was subject to criticism by many overseas groups, such as the U.S. group, Intellectual Property Owners Association.

The amended Guidelines now state that “the examiner shall examine the post-filing experimental data submitted by the applicant.” However, it is expected that the newly submitted data can only prove technical effects that are obvious for those skilled in the art from the original disclosure.

Amending Claims in an Invalidation Proceeding

Previously, the options to amend a claim in an invalidation proceeding were rather restricted. The patentee is allowed to cancel claims, combine claims, or to delete technical solutions.

Under the revised Guidelines, an applicant is now additionally allowed to amend claims by incorporating one or more limitations from other claims.

Furthermore, while a patentee is still not allowed to correct obvious errors contained in the description, the patentee may now correct obvious errors in the claims.

In response to the amendment(s) made by the patentee, the petitioner who filed invalidation proceeding is allowed to add new invalidation grounds, except for cancelation of the claim(s).

The new Guidelines become effective on April 1, 2017.

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