2021 年 9 月 22 日

中国国家知识产权局
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关于：“专利审查指南修订草案（征求意见草案）”（2021 年 8 月 3 日）

尊敬的中国国家知识产权局：

知识产权所有人协会（IPO）很高兴有机会回应对2021 年 8 月 3 日发布的*专利审查指南修订草案（征求意见稿）*（“指南草案”）*的评论请求*。

IPO 是一个国际贸易协会，代表着拥有或对知识产权（IP）权利感兴趣的所有行业和技术领域的各种公司、律师事务所、服务提供商和个人的“大帐篷”。IPO 会员包括超过 125 家公司，并遍布 30 多个国家。IPO 倡导有效且可承担的知识产权所有权，并提供广泛的服务，包括支持与立法和国际问题相关的成员利益；分析当前的知识产权问题；提供信息和教育服务；向公众传播有关知识产权重要性的信息。

IPO 的使命是为所有行业和技术推广高质量和可施行的知识产权和可预测的法律体系。我们的愿景是，这将导致全球加速创新、创造力和改善生活所需的投资。

IPO 认识到指南草案的目标的重要性，使指南适应新修订的专利法和实施细则，并从而提高向中国国家知识产权局 (CNIPA) 提交的专利申请质量。IPO 希望我们下面的评论在最终确定指南草案的过程中有所帮助。

总体意见

IPO感激征求意见稿中国国家知识产权局 (CNIPA) 以 2021 年 6 月 1 日生效的新修订的专利法为基础修改当前的专利审查指南。我们特别欢迎针对部分

设计和 GUI 设计所引起的更多的关注，并希望我们下面的评论在最终确定草案的过程中有所帮助。

第 1 部分，第 1 章，第 4.3 节

IPO 对允许提交彩色附图表示赞赏。但是，IPO注意到仅在“必要时”才允许提交彩色附图。IPO 建议一般性地允许提交彩色附图，这有助于在大多数情况下更好地理解发明。因此，IPO 提出以下修订：

> *说明书附图应当使用包括计算机在内的制图工具绘制，线条应当均匀清晰、足够深，不得涂改，不得使用工程蓝图。附图一般使用黑色墨水绘制，~~必要时~~可以提交彩色附图，以便清楚描述专利申请的相关技术内容。*

另外，IPO 还请求贵局说明，如果向 CNIPA 提交彩色附图并被允许，CNIPA 是否会公布这些彩色附图。

第 1 部分，第 1 章，第 6.2.3 节

有时，申请人在优先权期限届满后提出增加优先权要求的请求，虽然优先权期限届满，该申请仍在提出恢复优先权请求的期限内（即在中国专利法实施细则修订草案第三十五条规定的期限）。在这种情况下，问题是申请人是否还需要再次提交恢复优先权的请求。如何处理上述情况，关系到在使用恢复优先权和增加优先权要求这两种制度时，不会造成申请中的混乱。

因此，IPO 建议在第 6.2.3 节末尾添加以下段落：

> ***申请人请求作为优先权基础增加或者更正的在先申请的申请日自本申请的申请日起超过12个月但不超过14个月的，申请人应当在专利法实施细则第三十五条规定的期限提出恢复优先权的请求，审查员应当按照本章6.2.6.2的规定进行审查。***

第 1 部分，第 1 章，第 6.3.3 节

“不丧失新颖性的公开”扩大到包括在国际组织举办的、并得到国家知识产权局的认可的学术会议或技术会议上的首次披露是可取的。但目前尚不清楚哪些国际学术会议或技术会议是被认可的会议，以及会议地点是否有地域要求。我们建议进一步澄清这些方面，并包括提供一份被认可的国际组织清单作为例子。

第 1 部分，第 1 章，第 7.9 节

新增的第 7.9 节针对具有多项发明申请以及特征或要素的简单组合的申请。基于重复授权的理由，专利法已经应对了对同一发明的多项专利申请的问题。关于“不同发明创造特征或要素的简单组合”，这是一个创造性的问题。合法的发明通常来自现有技术中元素的组合或替换。只要该发明符合包括创造性在内的可获得专利的标准，该要素不应成为认定一项发明为非正常申请的唯一依据。

第 7.9 节还列出了不符合诚信原则的情况。IPO 指出，发明通常是渐进式的，并建立在先前的发明之上。因此，专利说明书通常包括取自早期专利和出版物的相同主题。因此，仅仅从其他来源复制或拼凑内容的行为不应成为使专利无效的依据。相反，与基于欺骗意图的其他示例（制造、伪造）一致，IPO 建议将“剽窃”和“拼凑”替换为“剽窃发明”。此外，IPO建议删除“或其他违规行为”和“和其他异常行为”，因为它们含糊不清，会给申请人带来显著的不确定性。专利法第四次修改首次将违反“诚实信用”的行为构成驳回申请或宣告授权专利无效的法律依据。由于这个概念对许多中国申请人来说可能是新概念，“其他异常行为”的构成对申请人来说可能并不显而易见。因此，IPO 建议将其删除，或者替换为更具体的例子，例如，向专利局做出虚假陈述。

此外，第7.9条中表明如果一项发明“与申请人或发明人的实际研发能力和资源条件明显不符的”，则视为非正常专利申请。IPO 担心实体或发明人的实际研发能力难以确定，如果申请人有责任证明这种能力，可能会要求申请人披露有关其运营和未来计划的专有和敏感信息。创新精神包括在组织的传统业务和研发范围之外产生概念和发明的潜力，故此不应将有关的发明视为非正常专利申请。因此，IPO 建议完全删除该语言。

请参阅 IPO 的建议修改，如下所示：

申请专利应当遵循诚实信用原则。根据专利法实施细则第十一条的规定，申请专利
*过程中，编造、伪造、**和剽窃发明**~~抄袭、拼凑或者其他不正当行为~~属于违反专利法第二十条第一款的行为。*

初步审查中，审查员应当参照本指南第二部分第一章第5 节的规定，对申请专利过程中的行为是否明显违反诚实信用原则进行审查。明显违反诚实信用原则的行为包括但不限于下列的情形：~~同时或者先后提交发明创造内容明显相同、或者实质上由不同发明创造特征或要素简单组合变化而形成的多件专利申请的；所提交专利申请存在编造、伪造或变造发明创造内容、实验数据或技术效果，或者~~抄袭、简单替换、拼凑现有技术等类似情况的；~~所提交专利申请的发明创造与申请人、发明人实际研发能力及资源条件明显不符的；违反诚实信用原则、扰乱正常专利工作秩序的其他非正常申请专利行为及相关行为~~。审查员应当发出审查意见通知书，说明理由，并通知申请人在指定期限内陈述意见。申请人未在指定期限内答复的，审查员应当发出视为撤回通知书；申请人陈述意见后仍不符合规定，审查员应当作出驳回决定。

关于IPO 此前就此主题发表的评论，请参阅附件 B 和 C。

第 1 部分，第 3 章，第4.2.2节

应允许图纸中的阴影线。这将符合国际惯例，使外观设计的描绘和解释更加清晰，特别是对于弯曲或凹形的设计。

因此，IPO 提议对草案进行以下修改：

*图片应当参照我国技术制图和机械制图国家标准中有关正投影关系、线条宽度以及剖切标记的规定绘制，并应当以粗细均匀的实线表达外观设计的形状。不得以**~~阴影线、~~**点划线等线条表达外观设计的形状。可以用两条平行的双点划线或自然断裂线表示细长物品的省略部分。图面上可以用指示线表示剖切位置和方向、放大部位、透明部位等，但不得有不必要的线条或标记，如中心线、尺寸线。*

第 1 部分，第 3 章，第4.2.4(3)节

第 4.2.4 节规定发出更正通知或审查意见通知书以解决外观设计申请中的某些缺陷。它还规定，尽管第 4.3 和 4.4.3 节规定要求保护的部分外观设计或图案可以用虚线表示，但仍不可使用虚线示出产品。IPO还认为“指示线”一词的定义是不清楚的。

为清楚起见，并解决与第 4.4.3 节的矛盾，IPO 建议修改第 (3) 款，声明本节中提到的缺陷是指以下内容：

*（3）**在不允许的情况下，**外观设计图片中的产品绘制线条包含有应删除或修改的**~~阴影线、~~**指示线、**~~虚线、~~**中心线、或尺寸线**~~、点划线~~**等。*

第 1 部分，第 3 章，第 4.5 节

本节要求在申请中指明图形用户界面 (GUI) 的“主要用途”及其所应用的产品。然而，图形用户界面和/或产品可能有多种用途，将权利要求限制为主要用途将过于狭窄。

因此，IPO 提议进行以下更改：

*产品名称应当满足本部分第三章第4.1.1 节的规定，并写明图形用户界面的**~~主要~~**用途和其所应用的产品，……*

第 1 部分，第 3 章，第 4.5.3 节

IPO 请求贵局说明如何“应根据动态变化过程的先后顺序标注”。这是否只是序列的注释（例如，变化状态的第一帧）？此外，对于动态动画外观设计，IPO 建议澄清所描绘图像之间的时间段和内容不应被视为要求保护的外观设计的一部分。

IPO 对这一规则允许提交视频档来说明动态 GUI的修订表示欢迎。但是，IPO 建议说明视频档并不会定义或限制外观设计，而只是作为示例提供给审查员参考。

此外，该规则没有指定视频文件必须使用的格式。我们建议将此规则修改为（1）明确视频文件只是示例，以及（2）指定可以提交的视频的文件格式，以促进一致性和公平性，并减少延迟和低效：

> *国务院专利行政部门认为必要时，可以要求外观设计专利申请人提交表明动态图形用户界面变化过程的[**以以下的格式**]视频类文件。**视频类文件并不定义或限制该外观设计，而只是作为示例提供给审查员参考。***

第 1 部分，第 3 章，第 5.2 节

IPO 对在先申请的优先权的要求的澄清表示赞赏。然而，优先权申请通常包含更多的公开内容，除了简单的附图以外例如还有描述性文字。IPO 建议在确定优先权时应考虑优先权申请的所有部分。否则,该规则将严重损害申请人对在先申请中的全部外观设计要求优先权的能力。因此，IPO 建议通过删除“附图”并添加如下附加文本来扩大主题优先权的范围：

> *外观设计专利申请要求优先权的，在先申请的主题应当是发明或者实用新型专利申请~~附图显示~~的主题，或者外观设计专利申请的主题**包括优先权文件中包含的任何附图（例如，取消的附图、附录附图等），以及任何字面描述**。*

第 1 部分，第 3 章，第5.2.1.1节

我们赞扬国家知识产权局就外国优先权要求对草案进行的修改。更具体地说，该修改明确指出，要求外国优先权应是“发明、实用新型或者外观设计专利申请”。

第 1 部分，第 3 章，第 5.2.1.2 节

为与其他司法区保持一致，IPO 建议未提出优先权要求的情况可在指定时间段内得到解决。我们提出以下更改：

*申请人要求优先权的，应当在提出专利申请的同时在请求书中声明；未在请求书中提出声明的，视为未要求优先权，**除非在申请未授权前或在申请日之后的[指定时间段]内得到解决**。*

第 1 部分，第 3 章，第7.4节

本节的第 10 条和第 11 条与本指南其他允许局部外观设计的地方的规定相冲突。第 10 条的冲突在于排除了不可分割的产品的部分；此类零件的部分设计不应被排除（例如“座椅靠背雕刻”、“汽车轮胎胎面”等)。

本部分第11条通过排除仅在产品表面上的图案或颜色和图案组合的部分设计来限制允许的设计范围。这种限定没有明显的原因，它与最近扩大至于部分设计的意图相矛盾。

因此，IPO 提议删除第（10）和（11）条，如下所示：

根据专利法第二条第四款的规定，以下属于不授予外观设计专利权的情形：

…

~~（10）不能在产品上形成相对可分割的独立区域或者构成相对完整的设计单元的局部外观设计。例如水杯杯把的一条转折线,任意截取的眼镜镜片的不规则部分。~~

~~（11）要求专利保护的局部外观设计仅为产品表面的图案或者图案和色彩相结合的设计。例如，摩托车表面的图案。~~

第 1 部分，第 3 章，第8.1节

IPO 请求贵局说明“基本相同”的含义，因为此部分不仅限于“相同”设计，也适用于“基本相同”设计。IPO 还寻求澄清确定“基本相同”的法律标准。

第 1 部分，第 3 章，第8.2节

IPO 请求贵局说明一项设计是否与另一项设计“显著不同”的法律标准。此外，IPO 要求澄清是否可以使用多项设计来评估“在先设计特征的组合”。

IPO 还请求澄清下述条款是否意味着存在审查员可以考虑多项外观设计的非通常情况？

通常情况下，审查员可以根据其获得的现有设计与专利申请要求保护的外观设计单独对比，审查外观设计专利申请是否明显不符合专利法第二十三条第二款的规定。

第 1 部分，第 3 章，第9节

在 IPO的角度，同一产品的两个或多个局部外观设计应该可以不受任何限制地受到保护（例如，在功能或设计上相关）。由于局部外观设计在同一产品中，因此它们已经相关，并且为此添加要求会产生额外的、不必要的要求，导致运用/解释的不明确。

因此，IPO 建议进行如下更改：

同一产品的两个或两个以上无连接关系的局部外观设计~~，如果具有功能或者设计上的关联并形成特定视觉效果的，~~可以作为一项外观设计。~~例如眼镜中的两个镜腿的设计、手机上四个角的设计。~~

第 1 部分，第 3 章，第 9.2 节

根据《指南》的解释，属于同一类别且习惯上同时销售或使用的产品，并且其外观设计具有相同外观设计理念的，可以在一件申请中提出。具有相同设计概念的部件为套装中的整个产品带来价值。因此，根据修改后的专利法，利用局部外观设计制度保护具有相同外观设计理念的部分，是申请人理想的申请策略。因此，建议允许申请人保护成套产品的部分外观设计。

我们建议删除新增的表述“*成套产品中的各项外观设计应为产品的整体外观设计，而非产品的局部外观设计。*”

第 1 部分，第 3 章，第 9.4.2 节和第 10.2 节

由于外观设计的细节已经在申请的附图或图片中显示出来，无论是用实线还是虚线表示，申请人在申请时根据自己的当时需要保护不同的部分是合理和公平的。其次，关于发明的分案申请允许申请人在母申请的基础上通过将不同的特征组合成新的可保护的技术方案来重新撰写权利要求。相比之下，应当允许外观设计申请的申请人将母案申请中显示的不同外观设计要素组合成新的可保护外观设计并提交分案申请，只要该组合没有增加新内容。

对于回复审查意见通知书时的修改，只要该修改没有增加新内容，并且是为了回复审查意见通知书的，则应当予允许。这是专利申请审查的一般规则。在不审查修改是否用于回应审查意见通知书的情况下拒绝修改是不恰当的。

因此，我们建议删除整个 9.4.2 节，该节严重限制了就有价值的外观设计提交分案申请的可能性。

并且我们还建议删除10.2节中增加的内容：

但是，当出现下列情况时，即使修改的内容没有超出原图片或者照片表示的范围，也不能视为是针对通知书指出的缺陷进行的修改，因而不予接受。

（1）将整体外观设计修改为局部外观设计；

（2）将局部外观设计修改为整体外观设计；

（3）将同一整体产品中的某一局部外观设计修改为另一局部外观设计。

如果申请人答复审查意见通知书时提交的修改文本出现上述不予接受的情况，则审查员应当发出审查意见通知书，通知申请人该修改不符合专利法实施细则第五十七条第三款的规定，要求申请人在指定期限内提交符合专利法实施细则第五十七条第三款规定的修改文本。同时应当指出，到指定期限届满日为止，申请人所提交的修改文本如果仍然不符合专利法实施细则第五十七条第三款规定或者出现其他不符合专利法实施细则第五十七条第三款规定的内容，审查员将针对修改前的文本继续审查，如作出授权或驳回决定。

或者，我们建议进行以下更改：

~~但是，~~ *当出现下列情况时，* ***~~即使~~*** *如果修改的内容没有超出原图片或者照片表示的范围，* ***并且如果修改是针对通知中指出的缺陷而进行的，则修改应被允许。否则，如果修改超出原图片或照片表示的范围，或者修改不是针对通知中指出的缺陷做出的，*** *也不能视为是针对通知书指出的缺陷进行的修改，因而不予接受。*

第 2 部分，第 1 章，第 5 节

出于效率和公平的考虑，如果审查员认为违反诚实信用原则，应给予申请人发表意见的机会，而不是在没有提供回应机会的情况下驳回专利申请。

因此，IPO 建议进行以下更改：

诚实信用原则要求申请人秉持诚实、恪守承诺，申请专利时不得损害公共利益或者他人合法权益，不得扰乱专利申请和审查正常秩序。如果有证据证明或有充分理由表明申请人在专利申请过程中存在专利法实施细则第十一条规定的情形， ***审查员应当发出审查意见通知书，说明理由，并通知申请人在规定的期限内陈述意见。申请人未在***

规定期限内答复的，审查员应当发出视为撤回通知；申请人不能克服明显违反诚实信用原则的缺陷的，审查员应当作出驳回决定则申请不应被授予专利权。

第 2 部分，第 8 章，第 6.1.2 节

新的第（4）款增加了违反诚实信用原则作为驳回专利申请的理由。该条款与第 1 部分第 1 章第 7.9 节第一段中的语言相似。我们建议对上述段落进行修改。我们建议在本节进行相应的修改，即：

*（4）申请专利过程中违反诚实信用原则，存在编造、伪造、或剽窃发明**抄袭、拼凑或者其他不正当行为**；*

第 2 部分，第 9 章，总体意见

在 IPO 于 2020 年 12 月 10 日就之前的专利审查指南修订草案（作为附件 A）发表意见后，关于计算机程序的可专利性，IPO 继续对专利审查指南对用于确定申请是否包含适当的专利保护客体的要求做出看似实质性的改变持保留态度。这种决定本质上是一种政策立场，IPO 认为只有在这些实质性变化能够连贯地反映法律法规的更高层次的变化才应该作出，例如中国专利法实施细则草案（“实施细则草案”）于 2020 年 11 月 27 日发布征求意见。我们特别注意到实施细则草案并未提出反映此类实质性变化，因此，我们认为它们不应出现在专利指南修订草案中。

IPO 还再次恭敬地指出，修订草案与欧洲和美国等其他司法管辖区的专利审查指南有所不同。在欧洲，目前确定计算机程序专利资格的方法是确定权利要求是否具有“技术特征”，例如何时通过技术手段解决技术问题或达到技术效果。通过取消解决技术问题或取得技术效果的要求，修订草案在这方面背离了欧洲的做法。在美国，计算机程序的方法围绕着确定该声明是否“针对”一个抽象概念，如果是，则它是否“明显更多地”引用了该抽象概念，从而不会垄断该抽象概念。指南草案的方法确实包括考虑权利要求“针对”什么，只要它包括“技术手段”。为中国、欧洲和美国的专利资格提供更加一致和统一的方法，特别是在不断增长的计算机程序领域，将有利于所有知识产权利益相关者。

第 2 部分，第 9 章，第 6.1.2 节

由于机器学习正成为许多行业的重点，我们建议在以下条款中明确添加“机器学习”一词：

*如果权利要求的解决方案涉及**机器学习、**深度学习、分类聚类等人工智能、大数据算法的改进，该算法与计算机系统的内部结构存在特定技术关*

联，能够解决如何提升硬件运算效率或执行效果的技术问题，包括减少数据存储量、减少数据传输量、提高硬件处理速度等，从而获得符合自然规律的计算机系统内部性能改进的技术效果，则该权利要求限定的解决方案属于专利法第二条第二款所述的技术方案。

第 5 部分，第 6 章，第 2.3.1 节

IPO 对这一明智的变化表示赞赏，这使得对 CNIPA 发出的通知书作出回应的期限的计算变得更加容易和清晰。

另一方面，IPO 指出，这一变化将大大减少处理复审和无效部门发出的复审通知的时间（1 个月作出回复），以及在审查部发出第一次审查意见通知书之后的审查通知书的时间（2个月作出回复）。这种减少对于需要额外翻译时间的外国申请人来说尤其重要。因此，IPO 建议，如果要实施取消电子传输通知的 15 天邮寄期限的更改，则对复审通知和第一次审查意见通知后的审查意见通知的时间将增加到 3 个月。

或者，IPO 建议为外国申请人保留 15 天的送达时间。

根据我们的经验，当通知或决定以电子方式送达时，通知或决定并不总是即时到达收件人的服务器。相反，可能会出现延误或系统故障，从而阻止即时交付。因此，我们建议将本节修改如下：

*以电子方式送达的通知和决定，以发出日期为送达日期。**以电子方式送达的通知、决定，当事人能够提供证据证明实际收到日期晚于推定收到日期的，以实际收到日期为送达日期。***

第 5 部分，第 7 章，第 8.3 节

第 8.3 节规定了对发明专利和外观设计申请的延迟审查。一般而言，IPO 支持向申请人提供程序以在需要时终止任何延迟。第 8.3 节确实允许申请人请求撤回延期审查请求。如果撤回请求符合“相关要求”，则延迟结束，专利申请按顺序等待审查。目前尚不完全清楚终止延迟审查的“相关要求”是什么意思。IPO 建议增加进一步的解释，以明确“相关要求”的性质。

在修订后的指南中，IPO 注意到第 8.3 节已进一步修订，声明如下：

同一申请人同日（仅指申请日）对同样的发明创造既申请实用新型又申请发明的，一般对已经获得专利权的实用新型所对应的发明专利申请进行延迟审查，延迟期限通常为4 年。

如果发明专利申请和实用新型在同一天提交并且实用新型已经被授权，不清楚为何发明专利申请会自动延迟审查4年。延迟审查发明专利申请可能会剥夺专利权人获得对其企业发展可能很重要的发明专利。如果申请人希望尽早对此类发明专利申请获得授权，似乎申请人无法要求终止此类审查的延迟。具体而言，第 8.3 节的相关部分规定通过提交撤回延期审查请求的请求来终止延迟审查。然而，这似乎只适用于有提出过延迟期审查请求的情况，而不适用于没有提出延迟审查请求而实施延迟审查的情况。

IPO 建议，如果发明专利申请和针对同一发明创造的实用新型在同一天提交且实用新型已被授权，则应为申请人提供终止延迟的选择权。为此，IPO 建议将第 8.3 节最后一段修改如下：

> *同一申请人同日（仅指申请日）对同样的发明创造既申请实用新型又申请发明的，一般对已经获得专利权的实用新型所对应的发明专利申请进行延迟审查，延迟期限通常为4 年。* ***因同一申请人同日（仅指申请日）对同样的发明创造既申请实用新型又申请发明而延迟审查的，在延期期限届满前，申请人可以请求终止延迟，符合规定的，延迟期限终止，专利申请将按顺序待审。***

第 5 部分，第 9 章，第 2 节

IPO 就专利期限补偿 (PTA) 向国家知识产权局寻求以下澄清： (1) PTA 是否计算如下：自专利申请日起 4 年和自请求实质审查之日起 3 年之后的任何额外时间减去任何不属于本条第 2 条专利申请过程中不合理拖延的时间，以及 (2) “申请日”是专利期限的起始计算日期。

IPO 还建议 PTA 由 CNIPA 自动授予专利权人，而无需提交特定请求并支付费用。这与 USPTO 的做法相似，将为申请人提供更好的一致性和效率。

第 5 部分，第 9 章，第 2.1 节

我们建议国家知识产权局在授予通知书中告知申请人是否有PTA，因为这将会减轻申请人去检查其案件是否符合申请PTA的负担。

美国专利商标局从要求申请人计算和请求符合条件的案件的 PTA 转变为目前在特定案件中告知申请人。 美国专利商标局的做法的经验告诉我们，专利局可以建立一个公式来提前计算PTA的可能天数，这在技术上是可能的。由于国家知识产权局在决定是否批准专利权人的PTA请求时也会计算PTA，如果CNIPA在发出授权通知之前自动运行该公式，并告知申请人PTA的可能性，那么对于CNIPA和专利权人来说都将是方便的，并促进实践的协调。

因此，我们建议在第 2 部分第 8 章第 6.2.2 节的末尾添加以下内容：

授予通知书应说明是否有 PTA以及 PTA 的天数。

第 5 部分，第 9 章，第 2.2 节

IPO请求 CNIPA 澄清 PTA 条款是如何计算特定案例的，最好为此类计算提供一些具有代表性的示例。IPO 还请求澄清如何收取和/或计算申请 PTA 的官方费用。

第 5 部分，第 9 章，第 2.2.1 节

IPO 注意到，第 2.2.1 条规定，实质审查请求的日期被解释为发明专利申请进入实质审查阶段通知书的发布期。由于实际该上发布日可能是申请人提交审查请求后的几个月，因此该条款将延迟其中一个 PTA 期限开始计算的日期，从而可能减少 PTA 天数。而且，这种解释也不符合专利法第四十二条第二款的规定。

专利法第四十二条第二款规定：“自发明专利申请日起满四年，且自实质审查请求之日起满三年后授予发明专利权的，国务院专利行政部门应专利权人的请求，就发明专利在授权过程中的不合理延迟给予专利权期限补偿，但由申请人引起的不合理延迟除外。法律以提出实质审查请求之日为三年期的起始点，已经足够明确。

此外，根据《中美第一阶段贸易协议》第 1.12 条第 2(a)项的规定，“就本条款而言，不合理的延迟至少包括在在中国提出专利申请之日后超过 4 年，或在提交实质审查请求后3年的专利授权的延迟，以较晚者为准”。

此外，IPO 注意到，第 2.2.1 条规定，由于以下情况造成的延误不属于专利申请过程中的不合理延误：依照专利法实施细则第六十六条规定修改专利申请文件后被授予专利权的复审程序。我们的理解是，本节所称复审程序是指申请人在复审程序中修改权利要求的情况，不包括申请人在复审程序中未修改权利要求的情况。这里的逻辑似乎是，如果申请人为了获得专利权而在复审阶段修改了权利要求，那么由于专利复审程序造成的延误由申请人承担，因此这种延误是不归咎于专利局。

但是，在实践中，实质审查部门的专利性评估可能出现不完整或不正确的情况，申请人将实质审查部门的决定上诉到专利复审部门。随着专利复审部门对实审部门在事实认定或法律适用上的错误进行更正，申请人修改了权利要求，使申请处于更好的可授权状态。我们认为，在这种情况下，专利复审程序造成的延误不应归类为不合理延误。复审程序是当申请人和实质审查部门对案件的可专利性评估出现分歧时，向申请人提供的一种救济措施。复审程序是对专利申请进行实质审查程序

的合理延伸。考虑到上述情况，我们建议从2.2.1节中删除“依照专利法实施细则第六十六条规定修改专利申请文件后被授予专利权的复审程序”。

作为总结，我们建议从第 2.2.1 节中删除以下内容：

授权过程中的不合理延迟时间是指发明专利的授权公告日减去自发明专利申请日起满四年且自实质审查请求之日起满三年的日期。以下情形引起的延迟不属于授权过程中的不合理延迟：中止程序、保全措施、行政诉讼程~~序、依照专利法实施细则第六十六条规定修改专利申请文件后被授予专利权的复审程序~~。

此处的专利申请日，是指专利法第二十八条规定的申请日。对于国际申请，是指进入中国国家阶段的日期。对于分案申请，是指分案申请递交日。

~~*实质审查请求之日是指实质审查请求生效日，实质审查请求生效日为发明专利申请进入实质审查阶段通知书的发文日。*~~

第 5 部分，第 9 章，第 3.1 和 3.5 节

对于药物专利在申请药品专利的专利期限延长 (PTE) 时应处于有效状态且应涵盖该药品的合理规定，IPO表示赞赏。

IPO 注意到，如果认为有关的药物专利不涵盖该药物，则会发出通知，PTE 申请人可以回应。IPO 请求就本通知的以下内容进行澄清：(1) 本通知是否由实质审查部门的审查员发出；（二）本通知的发出次数是否有限制；(3) 如果对通知的答复最终被拒绝，该通知是否可以上诉，以及向哪个机构提出上诉。

IPO 还提出应允许使用不同专利的多次请求，但只能补偿一项专利，因此建议对第 3.1 节进行如下所示的更改：

请求药品专利期限补偿应当满足以下条件：

...

*（5）一个药品同时存在多项专利的，~~只能请求~~**可以多次要求药品专利期限补偿，** **但最终只对**其中一项专利给予药品专利期限补；*

第 5 部分，第 9 章，第 3.2 节

IPO 建议请求者可以是专利权人或上市许可持有人 (MAH)。或者，IPO 建议在第 3 款中有多个专利权人时，作为 MAH 的专利权人可以是代表。

因此，IPO 提议进行如下更改：

*药品专利期限补偿请求应当由专利权人**或药品上市许可持有人**提出。专利权人与药品上市许可持有人不一致的，应当征得药品上市许可持有人书面同意。*

专利权人请求药品专利期限补偿的，应当自药品上市许可申请获得批准之日起三个月内向专利局提出请求，并且缴纳相应费用。对于获得附条件上市许可的药品，应当自获得正式上市许可之日起三个月内向专利局提出请求，但补偿期限的计算以获得附条件上市许可之日为准。

*专利权属于多个专利权人共有的，药品专利期限补偿请求应当由代表人办理**，代表人可以是上市许可持有人**。已委托专利代理机构的，药品专利期限补偿请求应当由专利代理机构办理。*

第 5 部分，第 9 章，第 3.3 节

与上述 IPO 提议的第 3.1(5) 节中允许针对不同专利的多项请求一致，IPO 建议专利权人必须为每项专利提交单独的请求。国家知识产权局还可以考虑在对同一药物提出多个请求时提高申请费。

因此，IPO 提议进行以下更改：

*提出药品专利期限补偿请求时，**就每一个单独专利的申请，**请求人应当提交如下材料：*

...

第 5 部分，第 9 章，第 3.4 节

根据自 2020 年 7 月 1 日起生效的国家药品监督管理局（NMPA）分类体系，虽然创新药可以获得 PTE，但只有属于以下药物分类的改良型新药才能获得 PTE：

a)化学药物
- 2.1 对已知活性成份成酯，或者对已知活性成份成盐的药品
- 2.4 含有已知活性成份的新适应症的药品

b) 2.2 类对疫苗菌毒种改进的疫苗
c) 治疗用生物制品第2.2 类中增加新适应症的生物制品
d) 中药第2.3 类，即增加功能主治的中药。

尚不清楚指南草案中上述的清单是否排他的，并因此排除以下类别的药物获得PTE：

- ●化学药品
  - ● 2.1 含有用拆分或者合成等方法制得的已知活性成份的光学异构体，或者改变已知盐类活性成份的酸根、碱基或金属元素，或者形成其他非共价键衍生物（如络合物、螯合物或包合物），且具有明显临床优势的药品。
  - ● 2.2 含有已知活性成份的新剂型（包括新的给药系统）、新处方工艺、新给药途径，且具有明显临床优势的药品。
  - ● 2.3 含有已知活性成份的新复方制剂，且具有明显临床优势。
- ●除了上述b) 和c)以外所有的生物药品。

IPO请求澄清上述可以获得PTE创新药是否，即未在境内外上市的药品，包括化学药1类、创新疫苗1类、创新生物制品1类。

如果改良型新药存在上述限制，IPO 建议取消上述限制，以便 PTE 可用于改良型新药的所有药物专利。即使是已经在海外或国内以已知剂量和适应症上市的药物，也可能基于这些已知药物得到的可以获得专利的改进。IPO指出，中国专利法（2020年）和中美第一阶段贸易协定（2020年）对可以获得PTE的药品种类没有上述的限制。

第 5 部分，第 10 章，第 2.1 节

IPO 对这一变化表示赞赏，它允许甚至潜在的被控侵权人获得实用新型或外观设计专利的专利权评估报告（报告）。

第 2.1 条规定，专利权人、利害关系方或潜在的被控侵权人可以请求国家知识产权局对专利作出评价报告。IPO 建议修改第 2.1 节中规定的“潜在的被控侵权人”的定义，以使其更加清晰。IPO 还建议澄清潜在被许可人可以获得报告，因为潜在被许可人也可能对相关实用新型或外观设计专利有很大的利益关系。

因此，IPO 提出以下修订：

*潜在的被控侵权人是指**目前**任何有可能成为被控侵权人的单位或者个人，**包括潜在许可人**。*

第 5 部分，第 10 章，第2.2节

IPO 欢迎扩大对专利权评估报告的允许请求，以包括未授权申请。但是，我们认为可以改进或澄清该规则，以便更彻底地评估实用新型或外观设计专利的可专利性。例如，对于未授权专利的评估报告请求应允许在处理办理登记手续之外的时间提出，包括在专利未授权而不适用注册程序的其他时间。此外，其他利益相关方

应该可以提出请求，而不仅仅是申请人。最后，如果实用新型/外观设计专利申请尚未获得授权，我们希望澄清是否会做出评估报告。

因此，IPO 提议进行以下修改以加强评估报告程序，以便更好地处置劣质专利：

针对下列情形提出的专利权评价报告请求视为未提出：

*（1）未授权公告的实用新型专利申请或者外观设计专利申请，**但利害关系人**~~申请人在~~专利未授权~~是在办理登记手续~~时提交专利权评价报告请求的除外；*

第 5 部分，第 10 章，第 2.3 节

IPO 注意到，第 2.3 节规定，为了让潜在的被控侵权人获得报告，需要“律师函”。IPO 建议进一步澄清什么样的“律师函”是适格的(例如，专利权人律师的警告函，和/或潜在被控侵权人自己的律师的信函)。

第 5 部分，第 10 章，第 6.2(2)节

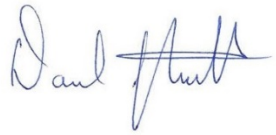
该条款赋予专利权人在被诉侵权人要求出具评价报告时，对负面评价报告提出更正请求的权利。出于公平的考虑，我们认为没有理由不将该权利扩展到利害关系人。

因此，IPO 提出以下修订：

（2）请求人请求启动
请求人认为作出的专利权评价报告存在需要更正的错误的，可以在收到专利权评价
*报告后两个月内提出更正请求，请求人不是专利权人的，专利权人**或利害关系人**可以在上述期限内提出更正请求。期满后提交的，其请求视为未提出。*

IPO 感谢中国国家知识产权局对 IPO 在此提交的意见的关注，并欢迎进一步对话和提供补充意见的机会。

真挚地，



丹尼尔·J·施陶特
主席

附件

A：2020 年 12 月 10 日 对《专利审查指南》修订草案的意见
B: 2021 年 1 月 11 日 对专利法实施细则修改草案的意见
C：2021 年 6 月 5 日 对关于规范专利申请行为的若干规定的修正案草案的意见。

September 22, 2021

China National Intellectual Property Administration
Department of Treaty and Law
Examination Policy Division
No. 6, Xitucheng Lu
Jimenqiao Haidian District
Beijing, People's Republic of China
100088

Via Email: *tiaofasi@cnipa.gov.cn*

Re: "Draft Revised Patent Examination Guidelines (Draft for Solicitation of Comments)" (3 August 2021)

Dear China National Intellectual Property Administration:

The Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the request for comments on the *Draft Revised Patent Examination Guidelines (Draft for Solicitation of Comments)* ("Draft Guidelines") published on 3 August 2021.

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property (IP) rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP rights.

IPO's mission is to promote high quality and enforceable intellectual property rights and predictable legal systems for all industries and technologies. Our vision is that this will result in the global acceleration of innovation, creativity, and investment necessary to improve lives.

IPO recognizes the importance of the objective of the Draft Guidelines to adapt the guidelines to the newly-amended Patent Law and Implementing Regulations, and thereby to improve the quality of patent applications filed at the China National Intellectual Property Administration (CNIPA). IPO hopes that our comments below will be helpful during the process of finalizing the Draft Guidelines.

General Comments

IPO appreciates that the Draft for solicitation of comments updates the current patent examination guidelines of the China National Intellectual Property Administration (CNIPA) and is based on the newly-amended patent law that went into effect June 1, 2021. We especially welcome the increased attention being directed to both partial designs and GUI designs and hope that our comments below will be helpful during the process of finalizing the Draft.

Part 1, Chapter 1, Section 4.3

IPO applauds the allowance of the submission of colored figures. It is noted, however, that the submission of colored figures is only allowed "when absolutely necessary." IPO suggests making submission of colored figures allowable generally, which could help facilitate understanding the invention better in most cases. IPO therefore proposes the following amendment:

> *The drawings in the specification should be drawn by a drawing tool including a computer and be drawn in black ink, the lines should be uniform, clear, sufficiently dark, without colors and alterations, and the use of engineering blueprints is not allowed. The drawings generally are drawn with black ink, and color drawings could be submitted* ~~***when absolutely necessary***~~ *to clearly describe the relevant technical content of the patent application.*

IPO also asks for clarification whether, if colored figures are submitted and allowed by CNIPA, if CNIPA would publish these figures in color.

Part 1, Chapter 1, Section 6.2.3

Sometimes when the applicant files a request for the addition of priority claim after the priority period expires, although the priority period has expired, the application is still within the time limit for filing a request for the restoration of right of priority (that is, within the time limit specified in Rule 35 of the draft revised Implementing Regulations of the Patent Law of China). In this case, the question is whether the applicant still needs to submit another request for the restoration of the right of priority. How to deal with the above-mentioned situation relates to whether the two systems of the restoration of right of priority and the addition of priority claim can be applied without causing confusion in the application.

IPO therefore recommends adding the following paragraph to the end of Section 6.2.3:

> ***If the filing date of the prior application on which the applicant requests for addition or correction as the basis of priority is more than 12 months but not more than 14 months from the filing date of this application, the applicant shall file a request for restoration of priority within the time limit specified in Rule 35***

of the Implementing Regulations of the Patent Law, and the examiner shall conduct examination in accordance with the provisions in Section 6.2.6.2 of this Chapter.

Part 1, Chapter 1, Section 6.3.3

It is good that "disclosures without loss of novelty" has been expanded to include first disclosures at academic conferences or technical conferences held by international organizations and recognized by CNIPA. However, it is not yet clear which international academic conferences or technical conferences are the recognized conferences, and whether there are geographical requirements for the venue of the conference. We recommend making further clarifications on these aspects, and also including a list of recognized international organizations as examples.

Part 1, Chapter 1, Section 7.9

Newly-added Section 7.9 targets applications with multiple invention filings and simple combinations of features or elements. The concern with multiple patent applications on the same invention is already dealt with under the Patent Law in the form of double patenting rejections. With respect to "simple combination of different invention-creation features or elements," that is an issue of inventive step. Legitimate inventions often arise out of combinations or substitution of elements in existing technology. So long as the invention meets patentability standards including inventive step, this element should not be the sole basis for deeming an invention to be an abnormal application.

Section 7.9 also lists circumstances which do not comply with the principle of good faith. IPO notes that inventions are often incremental and build upon prior inventions. Therefore, it is common for specifications to contain the same subject matter taken from earlier patents and publications. Thus, the mere act of copying or piecing together content from other sources should not be the basis for invalidating a patent. Rather, consistent with the other examples (fabricating, forging) which are based on intent to deceive, IPO recommends that "plagiarizing" and "cobbling together" be replaced instead with "plagiarizing an invention." In addition, IPO suggests that "or other irregularities" and "and other abnormal behaviors" be deleted as they are vague and introduce substantial uncertainty for applicants. The Fourth Amendment to the Patent Law is the first time where behaviors violating "good faith" form a legal basis to reject an application or invalidate a granted patent. As this concept will likely be new to many PRC applicants, what constitutes "other abnormal behaviors" may not be obvious to applicants. Therefore, IPO recommends its deletion, or in the alternative, replacement with more specific examples, e.g., making false statements to the patent office.

In addition, Section 7.9 deems an invention to be an abnormal patent filing if it is "obviously inconsistent with the actual research and development capabilities and resource conditions of the applicants or inventors." IPO is concerned that the actual R&D capabilities of an entity or inventor are difficult to ascertain, and if the applicant has the burden to prove this capability, applicants could be required to disclose proprietary and sensitive information

regarding their operations and future plans. The spirit of innovation includes the potential to generate concepts and inventions outside of an organization's traditional business and R&D scope, which should not be used to deem an invention an abnormal patent filing. Therefore, IPO recommends deleting this language in its entirety.

Please see IPO's proposed changes, shown below:

> *Principle of good faith shall be complied with in applying for patents. In accordance with the provisions of Rule 11 of the Patent Law, making up, forging,* ***and*** *plagiarizing* ***an invention, cobbling together or other irregularities*** *in the process of applying for patents amount to behaviors contrary to Article 20.1 of the Patent Law.*
>
> *In the preliminary examination, the examiner shall, under the provisions of Chapter 1, Section 5 of Part I of the Guidelines, examine whether or not the behaviors in the process of applying for patents are obviously contrary to the principle of good faith. The behaviors obviously contrary to the principle of good faith include but are not limited to:* ***filing, either at the same time or successively, multiple patent applications that contain obviously the same invention-creation contents or which are essentially formed by a simple combination and variation of different invention-creation features or elements; filing patent applications where there are fabricating, forging or altering of invention-creation contents, experimental data or technical effects, or*** *copying, simply replacing, or making up of the prior art or other similar situations****; and filing patent applications where the invention-creations are obviously inconsistent with the actual research and development capabilities and resource conditions of the applicants or inventors; and other abnormal behaviors of applying for patents and relevant behaviors that are contrary to the principle of good faith, or disrupt the normal order of patent work.*** *The examiner shall issue an Office Action, explaining the reason and notifying the applicant to make observations within a specified time limit. Where the applicant fails to make any response within the specified time limit, the examiner shall issue a Notification that Application Deemed to be Withdrawn. Where the requirements are still not met after the applicant makes observations, the examiner shall decide Rejection.*

Please see attachments B and C for earlier comments made by IPO on this subject matter.

Part 1, Chapter 3, Section 4.2.2

Shading (shadow) lines in drawings should be permitted. This would be consistent with international practice and would make depiction and interpretation of a design clearer, particularly for designs with curved or concave shapes.

IPO therefore proposes the following change to the draft:

> *The drawings shall be made in accordance with the provisions on normal projection, width of lines, and section mark of the state standards of technical drawing and mechanical drawing. Solid lines of even thickness shall be used to show the shape of the design. Such lines as* ***shadow lines and*** *dot-dash lines shall not be used to show the shape of a design. Two parallel double-dotted lines or natural*

gestures can be used to show the omitted part of a long and thin product. The indicative lines may be used to show the section *place and direction, enlarged parts, and transparent parts without unnecessary lines and marks, such as central lines, size lines. The drawings shall show the design clearly.*

Part 1, Chapter 3, Section 4.2.4(3)

Section 4.2.4 provides for the issuance of a Notification to Make Rectification or an Office Action to address certain defects in a design application. It also provides that dotted lines may not be used to show the product, despite the provision in Sections 4.3 and 4.4.3 that a claimed partial design or a pattern can be indicated by dotted lines. IPO also believes that the meaning of the term "indicative line" is unclear.

For the sake of clarity, and to resolve contradiction with Section 4.4.3, IPO suggests that Subsection (3) be amended to state that the defects mentioned in this section refer to the following:

(3) where, in the drawings of the design, there are ~~***a shadow line, indicative line, dotted line,***~~ *central line,* ***or*** *dimension line,* ~~***or dot-dash line,***~~ *and so on to show the product****, where such lines are impermissible in showing the product, and where such lines*** ~~***which***~~ *shall be deleted or amended.*

Part 1, Chapter 3, Section 4.5

This section requires that the "main use" of the graphical user interface (GUI) and the product to which it applies be indicated in the application. However, the GUI and/or the product may have multiple uses, and limiting the claim to the main use would be unduly narrow.

IPO therefore proposes the following change:

The name of the design of the product shall comply with provisions in Section 4.1.1. of Chapter 3 of this Part, and that a design including a graphical user interface shall indicate the ~~***main use***~~ ***uses*** *of the graphical user interface and the product to which the graphical user interface is applied.*

Part 1, Chapter 3, Section 4.5.3

IPO seeks clarification of how the "views of variation states shall be annotated in accordance with the sequence of the dynamic changing process." Is this simply an annotation of the sequence (e.g., first frame of the variation states)? Also, for animated designs, IPO suggests that it be clarified that the period and content between the depicted images should not be considered part of the claimed design.

IPO welcomes the amendment to this rule to allow submission of video files to illustrate dynamic GUIs. However, IPO suggests it should be made clear that the video file

does not define or limit the design, but is just being provided as an example for the examiner's reference.

Moreover, the rule does not specify the formats that the video files must use. We propose amending this rule to: (1) make clear that the video files are just examples, and (2) specify the file formats for videos that can be submitted, to promote consistency and fairness, and reduce delay and inefficiencies:

> *Where the patent administration department under the State Council deems necessary, it may require the applicant for a patent for design to submit video files,* ***[in the following formats: ,]*** *showing the changing trend of the dynamic graphical user interface.* ***The video file does not define or limit the design, but is only an example for the examiner's reference.***

Part 1, Chapter 3, Section 5.2

IPO appreciates the clarification of the requirements for an application to claim priority to an earlier application. However, a priority application typically contains more disclosures (for example descriptive text), than simply drawings. IPO proposes that all parts of a priority application should be considered when determining a right to priority. Otherwise, this rule would seriously impair the ability of applicants to claim priority to the entirety of the designs in the prior application. IPO therefore proposes broadening the scope of subject matter priority by deleting "drawings" and adding additional text as shown below:

> *Where a patent application for design claims priority, the subject matter of the previous application shall be the subject matter shown in the* ~~***drawings of the***~~ *patent application for invention or for utility model, or the subject matter of the patent application for design,* ***including any figures or drawings included in the priority document (e.g., canceled figures, appendix figures, etc.), as well as any written description****.*

Part 1, Chapter 3, Section 5.2.1.1

We commend CNIPA for its amendment to the Draft regarding a claim to foreign priority. More particularly, this amendment makes clear that a claim to foreign priority shall be based on the previous application being "a patent application for invention or for utility or for design."

Part 1, Chapter 3, Section 5.2.1.2

For consistency with other jurisdictions, IPO proposes that the failure to make a priority claim be curable within a specified period of time. We propose the following changes:

*Where any applicant claims the right of priority, he shall make a 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**, unless cured while the application is pending or within [specified time period] after the filing date**.*

Part 1, Chapter 3, Section 7.4

Clauses 10 and 11 of this section conflict with the allowance of partial designs provided elsewhere in these guidelines. Clause 10 is in conflict by excluding parts of a product that cannot be partitioned; partial designs for such parts should be not be excluded (for example, "carving of seat backrest," "tread of automobile tire," etc.).

Clause 11 of this section limits the scope of allowable designs by excluding partial designs that are only a pattern or combination of color and pattern that are on the surface of a product. No reason for this change is apparent, and it contradicts the recent expansion of scope to include partial designs.

IPO thus proposes deleting clauses (10) and (11) as shown below:

According to Article 2, clause 4 of the Patent Law of China, the following situations are ineligible for patent protection for design:
...
~~(10) partial design for a part of the product that cannot form a relatively divisible independent area on the product or form a relatively complete design unit. For example, a transition line of a handle of a water cup, an irregular part of a spectacle lens that is arbitrarily intercepted;~~
~~(11) where a partial design claiming protection of the patent are only a design relating to the pattern or the combination of the color with pattern on a surface of a product. For example, the pattern on the surface of a motorcycle.~~

Part 1, Chapter 3, Section 8.1

IPO seeks clarification, in view of the inclusion of "substantially identical," that this section is not limited to "identical" designs, but also applies to "substantially identical" designs. IPO also seeks clarification of what the legal standard is for determining "substantially identical."

Part 1, Chapter 3, Section 8.2

IPO seeks clarification of the legal standard for determining whether a design "significantly differs" from another design. Further, IPO requests clarification on whether multiple designs can be used to assess "combination of prior design features."

IPO also seeks clarification whether the provision excerpted below means that there

are abnormal circumstances under which the examiner can consider multiple designs:

> *Under normal circumstances, the examiner can compare only one prior design obtained by him with the design claimed by the patent application to examine whether the design patent application is obviously not in compliance with the provisions of Article 23.2.*

Part 1, Chapter 3, Section 9

In IPO's view, two or more partial designs of the same product should be protectable without any qualification (e.g., related in function or design). By the very fact that the partial designs are in the same product, they are already related, and adding qualifications to this creates an additional, unnecessary requirement with unclear applications/interpretation.

IPO therefore proposes making the change shown below:

> *Two or more partial designs of the same product that are not connected can be regarded as a design* ~~***if they are related in function or design and form a specific visual effect. For example, the design of two temples in glasses and the design of four corners on mobile phones***~~*.*

Part 1, Chapter 3, Section 9.2

As explained in the Guidelines, products which belong to the same class and are customarily sold or used at the same time, and the designs of which have the same concept of design, may be filed in one application. The parts sharing the same concept of design bring value to whole products in the set. As a result, to protect the parts sharing the same concept of design by utilizing the partial design system according to the amendments of the Patent Law is an ideal filing strategy for applicants. Therefore, it is suggested to allow applicants to protect partial designs for products in a set.

We propose deleting the newly-added language "*Each design in products in a set shall be the design for the whole product, and shall not be partial design of the product.*"

Part 1, Chapter 3, Section 9.4.2 and Section 10.2

As the details of designs have been already shown in the drawings or pictures of an application regardless of whether or not they are represented in solid lines or in dashed lines, it is reasonable and fair for applicants to protect different parts depending on their needs at the time. Second, divisional applications regarding inventions allow an applicant to redraft the claims by combining different features into new protectable technical solutions based

on a parent application. Comparably, it shall allow applicants of design applications to combine different design components shown in parent applications into new protectable designs and file in divisional applications, as long as the combination does not add new matter.

As to amendments when responding to an Office Action, as long as the amendment does not add new matter and is for responding to the Office Action, it shall be accepted. This is the general rule for patent prosecution. It is not appropriate to reject an amendment without examining whether or not the amendment is for responding to the Office Action.

Thus, we propose deleting the whole of section 9.4.2, which severely restricts the possibility of filing divisional applications regarding valuable designs.

And we also propose deleting the added contents in Section 10.2 of:

> *However, for the following amendments, even if the amendment does not go beyond the scope of the disclosure as shown in the initial drawings or photographs, the amendment cannot be deemed to be made in response to the defects as indicated in the Notification, and shall not be accepted:*
> *(1) modifying an overall design into a partial design;*
> *(2) modifying a partial design to an overall design;*
> *(3) modifying a partial design for a part of the overall product to a partial design for another part of the same overall product.*
>
> *If the amended document submitted by the applicant in reply to the Notification falls within the above unacceptable circumstances, the examiner shall issue a notification, notify the applicant that the amendment does not comply with provisions of Rule 57.3, request the applicant to submit the amended document in conformity with Rule 57.3 within a specified time limit. At the same time, it should be pointed out that if the amended document submitted by the applicant still does not comply with the provisions of Rule 57.3 or contains contents not in conformity with provisions of Rule 57.3, the examiner shall continue to examine the document submitted before the amendment is made, for example, to make a decision to grant or to reject.*

Alternatively, we propose the following changes:

> ***~~However, for~~*** ***For*** *the following amendments,* ***~~even~~*** *if an amendment does not go beyond the scope of the disclosure as shown in the initial drawings or photographs* ***and if the amendment is made in response to the defects as indicated in the Notification, the amendment shall be accepted. Otherwise if the amendment goes beyond the scope of the disclosure as shown in the initial drawings or photographs or if the amendment is not in response to the defects as indicated in the Notification,*** *the amendment cannot be deemed to be made in response to the defects as indicated in the Notification, and shall not be accepted.*

Part 2, Chapter 1, Section 5

For reasons of efficiency and fairness, opportunities should be given to the applicant to state his opinions if the examiner believes that the principle of good faith is violated, rather than rejecting the patent application without such opportunity being given.

IPO therefore recommends the following changes:

> *The principle of good faith requires applicants to uphold honesty and abide by their promises, and must not harm the public interest or interests of others when applying for a patent, and must not disrupt the normal order of patent application and examination. If there is evidence or sufficient reason to show that the applicant has the circumstances specified in Rule 11 of the Implementing Regulations of the Patent Law in the process of applying for a patent,* ***the examiner shall issue an Office Action, explain his reasons, and notify the applicant to state his opinion within the specified time limit. If the applicant fails to reply within the specified time limit, the examiner shall issue a notice of deemed withdrawal; the examiner shall decide rejection if the applicant cannot overcome the defect of an obvious violation of the principle of good faith*** ~~***the application shall not be granted the patent right.***~~

Part 2, Chapter 8, Section 6.1.2

New clause (4) adds violation of the principle of good faith as a reason for rejecting a patent application. This clause parallels the language in the first paragraph of Part 1, Chapter 1, Section 7.9. We proposed changes in that paragraph above. We propose making corresponding changes in this section, namely:

> *(4) the applicant commits fabrication, forgery,* ***or*** *plagiarism* ***of an invention*** ~~***, cobbling together or other irregularities***~~ *in violation of the principle of good faith in the patent application process;*

Part 2, Chapter 9, general comment

After IPO's comments dated 12/10/20 on previous draft amendments to the Patent Examination Guidelines (attached as Attachment A), in regard to patentability of computer programs, IPO continues to have reservations about the Patent Examination Guidelines making seemingly substantive changes in the requirements for determining whether applications contain appropriate subject matter for patent protection. Such determinations are, in essence, policy positions, and IPO believes such substantive changes should only be made if they are coherently reflective of higher-order changes to the laws or regulations, such as the draft Implementing Regulations of the Patent Law of China ("Draft Implementing Regulations") published for comment on November 27, 2020. In particular, we note that the Draft Implementing Regulations do not propose to reflect such substantive changes and, thus, we do not believe they should occur in the draft Patent Amendment Guidelines.

IPO also respectfully notes again that the Draft Amendment diverges from patent examination guidelines found in other jurisdictions such as Europe and the United States. In Europe, the current approach to determine patent eligibility of computer programs is to ascertain whether the claims have a "technical character," such as when a technical problem is solved by using technical means or a technical effect is achieved. By removing the requirements for solving a technical problem or obtaining a technical effect, the Draft Amendment deviates from the approach in Europe in this regard. In the United States, the approach for computer programs revolves around determining whether the claim is "directed to" an abstract idea and, if so, whether it recites "significantly more" such that it does not monopolize the abstract idea. The Draft Amendment's approach does include consideration as to what the claim is "directed to" so long as it includes a "technical means." Providing for a more consistent and uniform approach to patent eligibility in China, Europe, and the United States, particularly in the ever growing area of computer programs, would be beneficial to all IP stakeholders.

Part 2, Chapter 9, Section 6.1.2

Since machine learning is becoming an emphasis for many industries, we suggest to add the term "machine learning" explicitly to the provision below:

> *If the claimed solution involves* ***machine learning,*** *deep learning, classification and clustering artificial intelligence, improvements in big data computing, the computing algorithm and the internal structure of the computer system having a specific technical relationship, can solve the technical problems of how to improve hardware computing efficiency or execution efficiency, including reduced data storage, reduced amount of data transmission, enhanced hardware processing speed, etc., to obtain the technical effect of improving the internal performance of the computer system that conforms to the laws of nature, the solution defined by the claim belongs to the technical solution described in Article 2, Paragraph 2 of the Implementing Rule of the Patent Law.*

Part 5, Chapter 6, Section 2.3.1

IPO applauds this sensible change, which makes calculation of deadlines for responding to notifications issued by the CNIPA easier and clearer.

On the other hand, the IPO notes that this change would significantly reduce the time to handle re-examination notices issued by the Re-examination and Invalidation Department (1 month to respond), and office actions subsequent to the first office action issued by the Examination Division (2 months to respond). This reduction is particularly significant to foreign applicants, who require additional time for translation. As such, IPO suggests that if this change to remove the 15-days mail period for electronically transmitted notifications is to be implemented, the time to respond to re-examination notices and office actions subsequent to the first office action are increased to 3 months.

Alternatively, IPO suggests retaining the 15-days mail period for foreign applicants.

Further, in our experience, when the notification or decision is served electronically, the notification or decision does not always arrive at the server of the recipient in time. Instead, there may be delays or system failures that prevent timely delivery. Hence, we suggest amending this section as follows:

For notices and decisions served electrically, the date of issuance shall be the date of service. ***For notices and decisions served electronically, if a party can provide evidence to prove 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.***

Part 5, Chapter 7, Section 8.3

Section 8.3 provides for a deferral of examination for invention-creations and design applications. In general, IPO supports providing a procedure to an applicant to terminate any deferral period if desired. Section 8.3 does allow the applicant to request withdrawal of a request for deferred examination. If the request for withdrawal meets "related requirements," then the deferral period is terminated and the patent application is pended for examination in order. It is not entirely clear what is meant by the "related requirements" in order to grant the termination of a deferral period. IPO suggests that further explanation be added to make the nature of the "related requirements" clear.

In the amended guidelines, IPO notes that Section 8.3 has further been amended to state as follows:

> *Where the same applicant applies for both utility model and invention for the same invention-creation on the same day (here referring to the date of filing only), the invention patent application corresponding to the utility model for which a patent right has been granted shall be subject to deferred examination, and the deferral period is generally 4 years.*

It is not clear why the invention patent application would automatically be deferred for a period of 4 years if both the invention patent application and a utility model are filed on the same day and the utility model has been granted. The delay in examining the invention patent application would potentially deprive a deserving patentee of an invention patent that may be important in the development of their enterprise. It does not appear that an applicant would be able to request that such a deferral period be terminated if the applicant desires to have the earliest possible issuance of such an invention patent application. Specifically, the relevant portion of Section 8.3 provides for a termination of a deferral period by filing a request for withdrawal of a request for deferred examination. However, this appears to apply only in cases where a request for deferred examination was filed, and not to situations where deferred examination is imposed without a request for deferred examination.

IPO suggests that it is important to provide an applicant with an option to terminate a deferral period in cases where the invention patent application and the utility model directed to the same invention-creation are filed on the same day and the utility model has been granted. To this end, IPO suggests that the last paragraph of Section 8.3 be amended as follows:

Where the same applicant applies for both utility model and invention for the same invention-creation on the same day (here referring to the date of filing only), the invention patent application corresponding to the utility model for which a patent right has been granted shall be subject to deferred examination, and the deferral period is generally 4 years. ***Before the expiration of the deferral period imposed due to the filing of both a utility model and invention for the same invention-creation on the same day, the applicant may request that the deferral period be terminated. Where such a request meets related requirements, the deferral period will be terminated and the patent application will be pended for examination in order.***

Part 5, Chapter 9, Section 2

IPO seeks clarification from the CNIPA on the following regarding the patent term adjustment (PTA): (1) whether the PTA is calculated as follows: Any additional time after 4 years from patent application date and 3 years from date of requesting substantive examination minus any time not classified as unreasonable delay during the patent prosecution process in this Section 2, and (2) the "application date" is the date the term of a patent is calculated from.

The IPO also proposes that the PTA is granted to a patentee automatically by the CNIPA, for which a specific request is not required to be filed, and with payment of a fee. This parallels the practice at the USPTO and would promote harmonization and efficiency for applicants.

Part 5, Chapter 9, Section 2.1

We suggest CNIPA inform applicants in the notification of grant whether or not PTA is available, as this would reduce the burden on applicants to take action to check regarding whether or not their cases are qualified to request PTA.

The experience in the USPTO in changing from asking applicants to calculate and request the PTA for qualified cases to the current practice of informing applicants of the availability of PTA in specific cases tells us that it is technically possible to set up a formula to calculate the days of possible PTA in advance by the patent office. Since, when CNIPA determines whether or not to approve the PTA request by the patentee it will calculate the PTA, it would be convenient for both CNIPA and the patentee, and promote harmonization of practice, if CNIPA automatically ran the formula before issuing the notification of grant and informed the applicant of the possibility of PTA.

We thus propose to add the following to the end of Part 2, Chapter 8, Section 6.2.2:

The notification of grant shall indicate whether or not PTA is available and days of PTA.

Part 5, Chapter 9, Section 2.2

IPO seeks clarification from the CNIPA on how the PTA term is calculated for a particular case, ideally providing some representative examples for such calculations. IPO also seeks clarification of how the official fee for requesting PTA would be charged and/or calculated.

Part 5, Chapter 9, Section 2.2.1

IPO notes that Section 2.2.1 provides that the date of request for substantive examination is interpreted as the date of issuance of a notification of the invention patent application entering substantive examination. Since practically the issuance date could be months after the applicant files the request for examination, this provision would delay the date where one of the PTA periods starts to calculate, potentially reducing the number of PTA days. Moreover, this interpretation is not in line with Article 42(2) of the Patent Law.

According to Article 42(2) of the Patent Law, "if a patent for invention is granted after four years from the date of application and after three years from ***the date of the request for substantive examination***, the patent administration department under the State Council shall accord the compensation of the duration of the patent right for the unreasonable delay during the prosecution of the patent for invention, at the request of the patentee, except for the unreasonable delay caused by the applicant." The law sets the starting point of the three-year period at the date of the request for substantive examination, which is sufficiently clear and definite.

Furthermore, according to Article 1.12, Item 2(a) of the China-US Phase I Agreement, "For purposes of this provision, an unreasonable delay shall at least include a delay in the issuance of the patent of more than four years from the date of filing of the application in China, or three years *after a request for examination of the application*, whichever is later".

Further, IPO notes that Section 2.2.1 states that the delay caused by the following situation is not part of unreasonable delay during patent prosecution: reexamination procedure for patents granted with amendments to patent application documents in accordance with Article 66 of the Implementing Rules of the Patent Law. Our understanding is that the reexamination procedure mentioned in this section refers to a circumstance in which the applicant amended the claims during the reexamination procedure, but does not include the circumstance in which the applicant did not amend the claims during the reexamination procedure. The logic here seemingly is that if the applicant, in order to obtain a patent right, has amended the claims at the reexamination stage, then the applicant shall be held responsible for the delay due to the patent reexamination procedure, and therefore such a delay is not attributable to the Patent Office.

However, in practice, situations may arise in which the patentability assessment from the substantive examination division is incomplete or incorrect so that the Applicant appeals the decision from the substantive examination division to the patent reexamination

division. Along with the patent reexamination division correcting the errors either in fact-finding or the application of the law made by the substantive examination division, the Applicant amends the claims to put the application in a better state for allowance. We believe that in such a situation, delay due to the patent reexamination procedure shall not be classified as not unreasonable delay. The reexamination procedure is a remedy provided to the applicant where the applicant and the substantive examination division differ in their patentability assessments. The reexamination procedure is a reasonable extension of the substantive examination procedure in prosecuting a patent application. In consideration of the above, we propose deleting "reexamination procedure for patents granted with amendments to patent application documents in accordance with Article 66 of the Implementing Rules of the Patent Law" from section 2.2.1.

In summary, we would recommend the following deletions from section 2.2.1:

> *The unreasonable delay in the patent grant process refers to the issuance date of an invention patent minus the date of four years from the application date and three years from the date of the request for substantive examination. Delays caused by the following circumstances are not unreasonable delays in the patent grant process: suspension procedures, preservation measures, administrative litigation procedures****, and reexamination procedure for patents granted with amendments to patent application documents in accordance with Article 66 of the Implementing Rules of the Patent Law****.*
>
> *The date of filing of the patent here refers to the date of filing specified in Article 28 of the Patent Law. For an international application, it refers to the date of entering the Chinese national phase. For a divisional application, it refers to the date of filing of the divisional application.*
>
> ***The date of the request for substantive examination refers to the effective date of the request for substantive examination, and the effective date of the request for substantive examination is the date of mailing of a notification of the invention patent application entering substantive examination phase.***

Part 5, Chapter 9, Sections 3.1 and 3.5

IPO applauds the sensible stipulation that the drug patent at issue should be in force when applying for patent term extension (PTE) for drug patents, and should cover the drug.

IPO notes that if it was considered that the drug patent at issue does not cover the drug, a notification would be issued that the PTE applicant could respond to. IPO seeks clarification on the following regarding this notification: (1) whether this notification is to be issued by an examiner of the Substantive Examination Division; (2) whether there is a limit on the number of issuances of this notification; and (3) if the response to the notification was ultimately rejected, whether this notification could be appealed, and to which authority.

IPO also proposes that multiple requests using different patents should be allowed, but only one patent can be compensated, and therefore suggests the changes shown below to Section 3.1:

> *The following conditions shall be met when requesting compensation for drug patent term:*
>
> *...*
>
> *(5) If there are multiple patents related to one drug,* ***~~only one patent can be requested to be~~ multiple requests*** *to be compensated for drug patent term* ***may be made, but in the end only one patent will be compensated;***

Part 5, Chapter 9, Section 3.2

IPO proposes that the requester can be either the patentee or the marketing authorization holder (MAH). Alternatively, IPO proposes that in paragraph 3 when there are multiple patentees, the patentee who is the MAH may be the representative.

IPO therefore proposes the changes shown below:

> *The request for compensation for drug patent term shall be made by the patentee* ***or by the MAH****. If the patentee is inconsistent with the MAH, written consent of the MAH shall be obtained.*
>
> *Where the patentee requests compensation for drug patent term, he/she shall make a request to CNIPA within three months from the date when the approval for drug marketing is passed, and pay the corresponding fees. For a drug with conditional marketing approval, the request shall be submitted to CNIPA within three months from the date when the formal marketing approval is obtained, and the compensation period shall be calculated on the date when the conditional marketing approval is obtained.*
>
> *Where the patent is co-owned by multiple patentees, the request for compensation for drug patent term shall be handled by the representative****, who may be the MAH patentee****. Where a patent agency has been entrusted, the request for compensation for drug patent term shall be handled by the patent agency.*

Part 5, Chapter 9, Section 3.3

Consistent with allowing multiple requests with different patents in Section 3.1(5) as IPO proposes above, IPO proposes that the patentee must submit separate requests for each patent. CNIPA might also consider applying escalating filing fees when more than one request is filed for the same drug.

IPO therefore proposes the following changes:

> *The petitioner shall submit the following materials when making a request for compensation for drug patent term****, in separate requests for each patent****:*

...

Part 5, Chapter 9, Section 3.4

According to the National Medical Products Administration (NMPA) classification system effective since 1 July 2020, while innovative drugs could obtain PTE, only improved new drugs belonging to the following drug classifications are allowed to obtain PTE:

a) Chemical drug
   - 2.1 Chemical drugs that contain esterified known active ingredients, or salt of known active ingredients
   - 2.4 Chemical drugs for new indications that contain known active ingredients.

b) Preventive biological drugs class 2.2, vaccine with strain improvement.
c) Therapeutic biological drugs class 2.2, for new indications of improved already marketed products.
d) Chinese medicine class 2.3, for new indications of Chinese medicine.

It is unclear from the draft whether the above is an exclusive list, and therefore excludes the following classes of drugs from obtaining PTE:

- Chemical drugs
  - 2.1 Drugs that contain an optical isomer of known active ingredients obtained by resolution or synthesis, or change in acid group, basic group, or metallic element of known active ingredients of salt, or formation of other non-covalent bond derivatives (e.g., complex, chelate or clathrate), and have significant clinical advantages.
  - 2.2 Drugs that contain known active ingredients with new dosage form (including new drug delivery system), new formulation process or new route of administration, and have significant clinical advantages.
  - 2.3 New compound preparations that contain known active ingredients and have significant clinical advantages.
- All biological drugs other than b) and c) above.

IPO seeks clarification on the above innovative drugs that could obtain PTE, that are drugs that have not been marketed in China or overseas, including chemical drugs class 1, innovative vaccines class 1, and innovative biological products class 1.

If the above restrictions exist for improved new drugs, IPO recommends removing the above restrictions so that PTE is available to all drugs patents for improved new drugs. Even for drugs that have been marketed overseas or in China with known dosage and indications, there could be improvements over such known drugs for which patents could be granted. IPO notes that there is no restriction on the type of drugs that could obtain PTE in the Chinese Patent Law (2020) and the China-US Phase I Agreement (2020).

Part 5, Chapter 10, Section 2.1

IPO applauds the change to allow even potential alleged infringers to obtain the patentability evaluation report (the report) for utility models or design patents.

Section 2.1 provides that a patentee, an interested party, or a potential alleged infringer may request the CNIPA to make an evaluation report of a patent. IPO suggests that the definition of a "potential alleged infringer" set forth in Section 2.1 be amended for greater clarity. IPO also suggests clarifying that potential licensees may obtain the reports, as potential licensees could also have a strong interest in the relevant utility model or design patents.

IPO therefore proposes these amendments:

> *The potential alleged infringer refers to any entity or individual that* ***may currently be an alleged infringer or*** *may become an alleged infringer****, including potential licensees****.*

Part 5, Chapter 10, Section 2.2

IPO welcomes the expansion of allowed requests for an evaluation report of a patent to include pending applications. However, we think the rule can be improved or clarified to allow for a more thorough process for evaluating the patentability of a utility model or design patent. For example, the request for an evaluation report for a pending patent should be allowed to be made at times other than when handling registration procedures, including other times while the patent is pending but no registration procedure is applicable at the time. Also, the making of the request should be available to other interested parties, not just the applicant. Finally, we would appreciate clarity on whether an evaluation report will issue if the utility model/design patent application has not yet been granted.

IPO thus proposes the following changes to strengthen the evaluation report procedure, to allow for better disposal of poor quality patents:

> *The request for an evaluation report of patent filed under the following circumstances shall be deemed to have not been filed:*
> *(1) where the request is made on the utility model or design patent application that has not been granted, except that the* ~~***applicant***~~ ***interested party*** *files the request for the evaluation report of patent* ~~***when handling registration procedures***~~ ***while the patent is pending****;*

Part 5, Chapter 10, Section 2.3

IPO notes that section 2.3 stipulates that in order for a potential alleged infringer to obtain the reports, a "lawyer's letter" is required. IPO suggests further clarifying what kind of "lawyer's letter" would qualify (for example, a cease and desist letter from the patentee's lawyers, and/or a letter from the potential alleged infringer's own lawyer).

Part 5, Chapter 10, Section 6.2(2)

This clause gives the patentee the right to request corrections to a negative evaluation report when the accused infringer requests the issuance of the evaluation report. We see no reason why this right should not be expanded to interested parties, out of fairness.

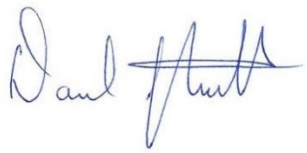
IPO therefore proposes the following revision:

(2) Initiated by the Petitioner on his Request

Where the petitioner thinks that in the evaluation report of patent there is any mistake that needs to be corrected, he may submit a request for correction within two months from the date of receipt of the evaluation report of patent, where the petitioner is not the patentee ***or the interested party****, the patentee* ***or the interested party*** *may submit a request for correction within the above-mentioned time limit. If submitted after the expiration of the time limit, the request shall be deemed to have not been submitted.*

IPO thanks the China National Intellectual Property Administration for its attention to IPO's comments submitted herein, and welcomes further dialogue and opportunity to provide additional comments. IPO has enclosed this letter as translated herewith.

Sincerely,



Daniel J. Staudt
President

Attachments

A: 12/10/20 comments on Draft Amendments to the Patent Examination Guidelines
B: 1/11/21 comments on Draft Amendments to the Implementing Regulations of the Patent Law
C: 6/5/21 comments on Draft Amendments to Several Stipulations Regarding Regulating the Act of Applying for a Patent.