

Kluwer Patent Blog

China may lift curbs on software patents: SIPO proposed revisions to Examination Guidelines

Yuqing Feng, Eddie Wang, Richard Huang (ZY Partners) and Hui Zhang (Baker & McKenzie) · Thursday, December 1st, 2016

In an effort to further enhance protection of Intellectual Property Rights (IPRs) and to promote implementation of the innovation-driven development strategy, the State Intellectual Property Office (SIPO) of China posted online proposed revisions to Guidelines for Patent Examination to solicit public opinions from 28 October to 27 November 2016. The new guidelines are expected to be promulgated and implemented in early 2017.

The proposed revisions include the patent eligibility of computer software and business method, the acceptability of post-filing experimental data for chemistry inventions, the rules of claim amendments during patent invalidation procedures, and the availability of public access to patent documentations. Notably, the proposed revisions may lift the long standing curbs on software patents.

China is simultaneously dealing with a slowing-down economic growth and economic restructuring. In contrast to the traditional industry, business implemented on the premises of Internet and E-commerce has increased dramatically in the past years. On the Single's Day of November 11, 2016, the sales amount at the Alibaba's Tabao mall is up to 17.5 billion USD.

In view of the growth of the new economy, the change and development in technologies can no longer be ignored, and eventually becomes a goal of the Chinese government to enhance patent protection related to the new economy and technologies, and results in change of the long standing standards for patent eligibility of software and business methods.

We summarize below the proposed revisions to the current Guidelines for Patent Examination and some notes:

1. Software patents

Proposed revisions:

“Computer program *per se*” is different from “inventions relating to computer program”. The former belongs to rules and methods for mental activities and is ineligible for patent protection, while the latter is patentable. A software claim maybe drafted in a form of “medium plus computer program process” or as an apparatus claim including a component implemented by a computer program.

Notes:

In the past, a software invention could be drafted only as a process claim or a “means plus function” claim, and the latter is usually construed in a very narrow manner according to embodiments disclosed in the specification. Medium, computer program product and “processor plus process” are not statutory subject matters in China. Consequently, patent protection for software inventions is weak and limited.

This problem may be addressed by the proposed revisions to Guidelines for Patent Examination. Software claims such as “a computer program product”, “a machine-readable medium”, and “an apparatus comprising a processor configured to execute instructions on a computer-readable medium to perform steps of ...” shall become patent-eligible. A comprehensive protection for software patents is now expectable.

Further, it would be easier to enforce an apparatus claim with computer program as a part thereof as such construction is more close to the nature of actual product and technology.

2. Business method

Proposed revisions:

If a claim relating to business model includes not only business rules or method, but also a technical feature, it should not be excluded from being patentable under Article 25 of the Chinese Patent Law.

Notes:

Business method per se is still not eligible for patent under the proposed revisions of Guidelines though, a window is opened. An invention related to business method is usually implemented by software in practice, and viewed to include technical features. For patent applications involving such business method, examiners from the SIPO may conduct regular examination, searching prior art and raising objections for novelty or inventive step, instead of rejecting for non-eligibility.

3. Chemistry inventions

Proposed revisions:

Experimental data submitted after the filing date shall be considered and examined, though it can only be used to prove technical effects that are obvious for those skilled in the art from the original disclosure.

Notes:

The acceptability of post-filing experimental data has been a hot issue for which the SIPO of China received lots of criticizing from industries of US and Europe. In past practice, post-filing data were acceptable (for instance, as a response to Office Action) in patent prosecution, but excluded in patent invalidation procedure later on, which caused granted patents being invalidated due to the adoption of inconsistent examination criteria. Since around 2013, the SIPO has practically become more flexible in accepting post-filing experimental data. However, there is still no a clear guideline, and the outcome of a specific case is not predictable.

Having considered this problem, and to be in line with the international practice, the proposed revisions bring more convenience, reasonableness and predictability for applicants to prosecute chemical patents.

4. Claim amendment in invalidation procedure

Proposed revisions:

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

Notes:

The current rules for amending claims in invalidation procedure are strict. The patentee is only allowed to delete or combine claims, or to delete technical solutions. It is not available to add to a claim certain features (or limitations) of another claim except for incorporating the other claim as a whole.

The proposed revisions bring flexibilities for a patentee to amend claims, i.e., incorporating features from other claims, to defend the patent during invalidation procedure, to avoid unreasonably narrowing the scope of patent in order to maintain the patent.

5. Public accessibility to patent application documents

Proposed revisions:

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

Notes:

In the Europe, Third Party Opinion is a powerful means to prevent the grant of a patent, but not as powerful as in China partially due to the lack of transparency of patent application documents. The SIPO now would like to be more transparent, which is a very positive development. The proposed revisions will facilitate the public to file Third Party Opinion and prior art to block the grant of a patent.

6. Suspension asked by court

Proposed revisions:

The SIPO will suspend a procedure for a patent application or patent for a time period as asked by the court, not limited to six months per suspension or one year in total.

Notes:

Suspension of patent prosecution and other procedures is a tool to avoid escalation of disputes and waste of public resources. The limitation of suspension term put by the current guidelines causes procedural complex to achieve said goals. It's good to note that the SIPO becomes more cooperative and would like to follow a court order to suspend a procedure.

7. Conclusion

The proposed revisions of Guidelines are positive! From the proposed revisions, the SIPO shows political attitude to keep pace with the times and development of economy and technologies. We anticipate that the SIPO will become more transparent and flexible in the procedures of examining, granting and invalidating the patents/applications than before.

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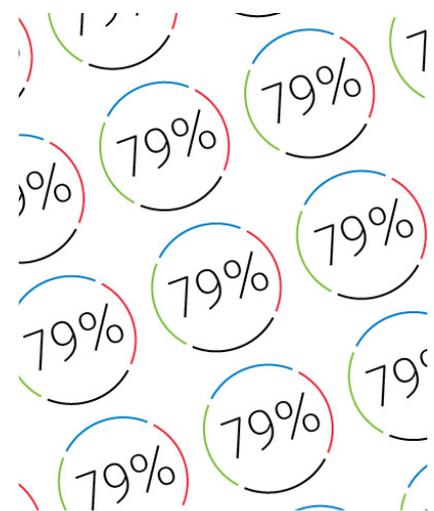
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