君合研究简讯

2019 年 10 月 9 日

专利审查法律热点问题

《专利审查指南》最新修改内容简介及评述

2019 年 9 月 24 日，国家知识产权局发布了“关于修改《专利审查指南》的决定”（国家知识产权局第 328 号公告）（以下简称“**2019 修改稿**”），决定对《专利审查指南》（以下简称《审查指南》）作出修改，自 2019 年 11 月 1 日起施行。

此次修改响应国家知识产权局提出的专利审查提质增效的要求，对现行《审查指南》中涉及专利申请事项的不清楚、不合理之处进行澄清和改进。本文将介绍对此次修改的以下几个要点，并对修改可能对实务产生的影响进行简要分析。

一、明确了分案申请的递交条件

对基于分案申请再次提出分案申请的情形（以下简称“**再次分案申请**”），现行《审查指南》并未明确规定再次分案申请的提出时机，导致实践中对此问题产生了不同的理解。为此，2019 修改稿明确：再次分案申请的递交时间应当以存在单一性缺陷的分案申请为基础审核，否则不得以该分案申请为基础提交新的分案申请。

这项修改填补了现行《审查指南》中可能出现的“无限分案”的漏洞，即，只要一个专利申请的任一分案申请（“**基础分案**”）收到过指明单一性缺陷的审查意见通知书或者分案通知书（以下简称“**单一性缺陷通知**”），就可能在该基础分案或其任一子代分案结案前继续提交分案申请。而在 2019 修改稿生效之后，申请人只有在收到单一性缺陷通知的某一分案申请结案前才能就该案提交再次分案申请。在实践中，对于一些专利申请（例如涉及新药产品的专利申请），其申请人可能希望对其重要专利家族尽可能长时间地保留提交新分案申请的机会。在 2019 修改稿生效之后，要长时间地保留提交新分案申请的机会将更困难。申请人可以尝试通过提交存在潜在单一性问题的至少一个分案申请，以获得单一性缺陷通知，并在拿到单一性缺陷通知的分案申请结案前采用相同的策略提交更多的带有潜在单一性缺陷的子代分案申请来达到上述目的。

此外，2019 修改还明确了分案申请的申请人和发明人与所基于的申请应当具有对应关系。具体地，分案申请或再次分案申请的申请人，应当与提出该分案申请或再次分案申请时其所基于的申请的申请人相同，否则该分案申请或再次分案申请将不被接受。而分案申请或再次分案申请的发明人，则应当是提出该分案申请或再次分案申请时其所基于的申请的发明人或其中的部分成员。

针对该修改，建议在提交分案申请时注意核查申请人和发明人的一致性，并且在分案申请和/或其所基于的申请会进行申请人变更或者申请人不同的情况下，应根据具体情况选择提交分案的合适时机，以避免多次提交申请人变更。

二、引入延迟审查制度，优化优先审查制度

相对于现行《审查指南》，2019 修改稿的一个亮点是引入了延迟审查制度，为申请人制定其专利

保护策略提供了更多的选择。具体地，2019 修改稿关于延迟审查的规定要点如下：

1) **可延迟审查的专利类型：**发明专利和外观设计专利。

2) **提出请求的时间：**在发明专利提交实质审查请求，或提交外观设计申请的同时提出。

3) **延迟期限：**自延迟审查请求批准生效之日起 1 年、2 年或 3 年。

4) **期限届满后的处理：**相关申请将按顺序待审。

5) **例外情况：**必要时，专利局也可以在延迟期限未届满时终止延迟审查，启动审查程序。

延迟审查制度的引入将给予申请人请求推迟审查的机会，申请人将有更多的时间来考虑其申请的保护范围、是否继续维持该专利申请以及是否提交更多的分案申请等。在实践中，申请人可以将请求延迟审查与分案策略相结合，以达到在尽可能长的时间范围内保留提出新分案申请的机会以及尝试不同的争辩策略的目的。

在提供延迟审查选项的同时，2019 修改稿还根据现行《专利优先审查管理办法》进一步调整了现行《审查指南》中关于专利优先审查的规定，明确可以提出优先审查请求的专利类型包括发明、实用新型和外观设计，并且规定在同一申请人同日对同样的发明创造既申请实用新型专利又申请发明专利的，对于其中的发明专利申请一般不予优先审查，以节省审查资源。

三、完善了涉及图形用户界面的产品外观设计的申请要求

2019 修改稿对现有《审查指南》中涉及图形用户界面（GUI）的产品外观设计的相关规定进行了梳理，将与 GUI 的外观设计相关的内容合并到新增加的第一部分第三章第 4.4 节，并增加了一些关于 GUI 外观设计的具体申请要求，主要涉及以下三个方面：

1) **产品名称：**要求产品名称应当表明相关 GUI 的主要用途和其所应用的产品，而不应笼统以“图形用户界面”名称作为产品名称。

2) **图片要求：**除了满足现行《审查指南》第一部分第三章第 4.2 节关于外观设计申请图片的要求之外，涉及 GUI 的产品外观设计的图片还应满足以下要求：对于设计要点仅在于 GUI 的，应当至少提交一幅包含该 GUI 的显示屏幕面板的正投影视图；若需要**清楚**显示 GUI 在最终产品中的大小、位置和比例关系，需要提交 GUI 所涉及面的一副正投影最终产品视图；GUI 为动态图案的，应至少提交一个状态的 GUI 所涉面的正投影视图作为主视图，其余状态可仅提交 GUI 关键帧的视图作为变化状态图；对于操作投影设备的 GUI，除 GUI 的视图之外，还应提交至少一幅清楚显示投影设备的视图。

3) **简要说明：**应清楚说明 GUI 的用途，并与产品名称中体现的用途相对应。若仅提交包含 GUI 的显示屏幕面板的正投影视图，应当穷举该 GUI 显示屏幕面板所应用的最终产品。必要时说明 GUI 在产品中的区域、人机交互以及变化过程等。

上述修改明确了对涉及 GUI 的外观设计专利的申请要求，进一步简化了需要提交的视图要求，并允许申请人通过在简要说明中穷举 GUI 显示屏幕面板所应用的最终产品而扩展 GUI 的保护范围。

四、明确了与审查员举行会晤的条件并放宽了对电话讨论的限制

为了提高审查员与申请人的沟通效率，2019 修改稿明确了举行会晤的条件，并放宽了现行《审查指南》对电话讨论的限制。

在举行会晤方面，2019 修改稿删除了现行《审查指南》中关于启动会晤的两个条件，即不再要求申请人必须在第一次审查意见通知发出后，并且在答复审查意见的同时或之后提出会晤要求。在该修改生效以后，审查员和申请人可以在实质审查的任何阶段发起会晤约请或要求。另外，还明确了举行会晤的原则，即“有利于澄清问题、消除分歧、促进理解”，但同时列举了审查员可拒绝会晤的情形：“通过书面方式、电话讨论等，双方意见已经表达充分、相关事实认定清楚的”。

对于技术方案非常复杂的专利申请来说，与审查员会晤为申请人提供了现场演示或解释其发明技术方案的机会。这一方面有利于审查员准确理解发明、将其与现有技术进行对比，另一方面也有利于申请人理解审查员对相关事实和法律问题的认定。此类申请的申请人可以考虑在实质审查的早期阶段提出会晤请求，以加速审查进程。

在电话讨论方面，2019 修改稿将电话讨论与会晤并列，放宽了讨论的内容，也不再仅限于“解决次要的且不会引起误解的形式方面的缺陷所涉及的问题”，而“可以就发明和现有技术的理解、申请文件中存在的问题等”进行电话讨论，这将有效提高审查的效率。2019 修改稿还新增了视频会议、电子邮件等其他的沟通方式，为申请人与审查员提供了更多的沟通渠道。

但需要注意的是，对于在与审查员的会晤或者电话讨论中同意的修改，申请人仍需要提交正式的书面文件，除非该修改属审查员可依职权修改的范围。

五、不再以不符合专利法第25条为由绝对排斥涉及人类胚胎干细胞技术的申请

2019 修改稿不再将利用人类胚胎获取干细胞的相关发明创造排除在可授权客体范围之外，明确对“利用未经过体内发育的受精 14 天以内的人类胚胎分离或者获取干细胞的”的相关发明创造，不能以“违反社会公德”为理由拒绝授予专利权。这意味着，在 2019 修改稿生效之后，与人类胚胎干细胞技术有关的专利申请将有可能获得授权，这对于保护生物医药企业的干细胞技术具有重要意义。

六、明确在创造性评述中，技术效果应当是本发明中所能达到的，引用的公知常识通常需要证据证明的情形

2019 修改稿明确，在评述创造性时，在根据发明与对比文件的区别特征所能达到的技术效果确定发明实际解决的技术问题时，该技术效果是“**在要求保护的发明中**”所能达到的技术效果，而不是该区别特征所能达到的任何其他技术效果。另外，修改稿还强调“对于功能上彼此相互支持、存在相互作用关系的技术特征，应整体上考虑所述技术特征和它们之间的关系在要求保护的发明中所达到的技术效果”。实际上，上述原则已经在实务中得到应用，例如在国家知识产权局专利复审委员会作出的第 133119 号复审决定中即应用了该原则(注：此案被评为 2017 年专利复审无效十大案件之一，所涉专利的名称为“一种白芨营养面贴膜用乳液、面贴膜及其制备方法”，申请号为 201310113848.0)。该修改将使审查员对该原则的适用更为统一。

此外，2019 修改稿还明确，审查意见中公知常识的认定通常需要证据予以证明，若申请人对审查员引用的公知常识提出异议，审查员**应当首先**能够提供相应的证据予以证明或说明理由；而当审查员将权利要求中对技术问题的解决做出贡献的技术特征认定为公知常识时，通常应当提供证据予以证明。该修改规范了在审查过程对公证常识的引用。

七、要求无效请求人指明多个证据组合中最主要的结合方式

2019 修改稿明确，在无效请求中引用多篇证据结合对比的情况下，应当**首先将最主要的结合方式进行比较**，以便突出重点。在该修改生效以后，请求人仍可提出多组证据结合方式，但是需要将最主要的结合方式放在前面。在实务中，专利复审和无效审理部已经普遍在口审中要求请求人明确多组结合方式中最主要的结合方式并予以详述。因此，该修改对将来专利无效实务的影响有限。但在今后的无效案件中，请求人需要在撰写无效请求前仔细斟酌各种可能的证据结合方式，将成功率最高的结合方式放在最前面详细阐述。

除了以上介绍的可能影响专利申请实务的几点修改之外，还对审查员检索的程序进行了详细的规定，并且还增加了申请转让程序中对转让文件或主体资格文件的要求。

总而言之，相比于现行《审查指南》，2019 修改稿为申请人提供了更多的选择，允许申请人根据实际需要选择申请优先审查或者申请延迟审查；降低了申请人与审查员举行的会晤、电话讨论的门槛；明确了对涉及 GUI 的外观设计专利申请的申请要求；将可授权客体的范围扩大到特定人类胚胎干细胞相关技术。

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JUNHE BULLETIN

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Patent Examination

A brief introduction and comments on the latest amendments to patent examination guidelines

On September 24, 2019, the Chinese National Intellectual Property Administration, PRC ("**CNIPA**") released the *Decision on Amendments to Patent Examination Guidelines* (No. 328 Order of CNIPA) (hereafter referred to as the "**2019 Amendments**"). The Decision amends the *Patent Examination Guidelines* and the amendments will come into effect on November 1, 2019.

In response to the requirements of CNIPA to improve the quality and efficiency of patent examinations, the 2019 Amendments clarify some of the unclear and unreasonable aspects in the current *Patent Examination Guidelines* ("**Examination Guidelines**"). This article introduces some of the key points of the amendments, and briefly analyzes the impact that the amendments may have.

I. Clarification of the conditions for filing divisional applications

With respect to the filing of a further divisional application based on an existing divisional application ("**Further Divisional Application**"), the current Examination Guidelines do not clearly stipulate a time limit, which has led to different understandings of this issue under the current practice. Hence, the 2019 Amendments specify that the time limit for filing a Further Divisional Application should be examined on the basis of an existing divisional application that is rejected by an examiner on the grounds of a lack of unity. No Further Divisional Application can be accepted if this application is based on a divisional application having no unity defect.

This amendment corrects the legal loophole of "unlimited divisions" that may occur under the current Examination Guidelines. According to the current Examination Guidelines, as long as any divisional application of a parent patent application (the "**Basic Division**") receives an office action raising a unity issue or a notification on filing a divisional application (collectively referred to as the "**Notification of Unity Defect**"), a Further Division Application may be accepted before the closing of the Basic Division or any of its sub-divisions. However, after the 2019 Amendments come into effect, applicants can file a Further Divisional Application only before the closing of a specific divisional application, subject to a Notification of Unity Defect. In practice, for some patent applications such as those

relating to a new drug, the applicants may hope to delay the filing of a divisional application for their important patent families for as long as possible. When the 2019 Amendments come into effect, it may be harder to have the opportunity of filing a new divisional application for a long period of time. Applicants may try to achieve this by filing at least one divisional application with a potential unity issue to obtain a Notification of Unity Defect, and then file further sub-divisions with a potential unity defect by adopting the same strategy before the closing of the former divisional application, subject to a Notification of Unity Defect.

Furthermore, the 2019 Amendments also clarify that the applicant(s) and the inventor(s) of a divisional application should correspond to the applicant(s) and the inventor(s) of the application on which it is based (the "**Basic Application**"). Specifically, at the time of filing, the applicant(s) of a divisional application or a Further Division Application must be identical to the applicant(s) of the Basic Application, otherwise the application will not be accepted. The inventor(s) of a divisional application or a Further Division Application must be the inventor(s) or some of the inventors of the Basic Application at the time of filing such a divisional application or Further Divisional Application.

Due to the above amendment, it is recommended to check the consistency of the applicant(s) and the inventor(s) when filing a divisional application. In the event where the applicant(s) of the divisional application and/or the Basic Application will be changed or are not the same, it is recommended to file the divisional applications at a nominated time, depending on the specific circumstances of the case, to avoid filing multiple requests to change the applicant(s).

II. Introduction of deferred examination and optimization of prioritized examination

Compared with the current Examination Guidelines, one of the highlights of the 2019 Amendments is the introduction of deferred patent examination, which provides more options for applicants to develop their patent protection strategies. Specifically, the main points concerning the provisions of deferred examination in the 2019 Amendments are as follows:

a) **Types of patent applications entitled to deferred examination**: invention and design patent applications.

b) **When to file a request for deferred examination**: at the time of filing a **request** for substantive examination for an invention patent application, or at the time of filing a design patent application.

c) **Deferment period**: one, two or three years from the effective date of approving the request for deferred examination.

d) **Procedures after the expiration of the deferment period**: related applications **will** be added to the waiting list for examination.

e) **Exceptions**: when necessary, the Patent Office may terminate the deferred examination before the expiration of the deferment period and initiate the substantive examination process.

The introduction of the deferred examination provides an opportunity for applicants to defer examinations, which may give applicants more time to consider the protection scope of their applications, whether to maintain their applications, whether to file further divisional applications and the like. In practice, applicants may apply a strategy of combining deferred examinations and divisional applications, so as to reach the goal of preserving the opportunity of filing a divisional application

for as long as possible, and having an opportunity to argue for patentability in different ways.

While providing the option for deferred examination, the 2019 Amendments further revise the provisions concerning prioritized examinations of patent applications under the current Examination Guidelines in accordance with the current *Administrative Measures for Prioritized Patent Examination*. The 2019 Amendments specify that the types of patent applications entitled to prioritized examination are invention, utility model and design. Moreover, according to the 2019 Amendment, if the same applicant files an invention application and a utility model application for the same invention on the same day, the invention patent application normally will not be approved for prioritized examination for the purpose of saving resources of said examinations.

III. Adjustment to the requirements on design applications involving Graphical User Interfaces

The 2019 Amendments streamline the provisions of the current Examination Guidelines that are relevant to designs involving graphical user interfaces ("**GUIs**"), incorporate the contents related to GUI designs into a newly added Section 4.4 of Chapter 3, Part I, and add specific requirements regarding GUI design applications, which mainly cover the following three aspects:

a) **Product name**: The product name must indicate the primary purpose of the GUI and the product to which it applies, and a general description such as "graphical user interface" should not be taken as the product name.

b) **Requirements of images**: In addition to the **requirements** of images as stipulated in Section 4.2, Chapter 3, Part I of the current Examination Guidelines, images of a product design involving GUI should also meet the following requirements: i) at least one image, including the front view of the display screen panel of the GUI, should be submitted if the design points only lie in the GUI ; ii) if it is necessary to clearly show the size, position and scaling of the GUI in the final product, the applicant should submit a front view of the plane of the final product which includes the GUI; iii) if the GUI is dynamic, the applicant should submit the front view of the plane including the GUI in one state as the major view, and the views of key frames of the GUI in other states can serve as views of various states; and iv) regarding a GUI for operating a projector, applicants should submit at least one view that clearly shows the projector in addition to the views of the GUI.

c) **Brief description**: The purpose of a GUI should be clearly stated and correspond to the use embodied in the product name. If only a front view of the display screen panel including the GUI is submitted, all final products to which the display screen panel including the GUI can be applied should be listed in an exhaustive way, and applicants should state the display location of the GUI in the product, any human-computer interactions and change the process of the GUI when necessary.

The above amendments clarify the application requirements for design applications involving GUIs, further simplify the requirements of the images to be submitted, and allow applicants to broaden the protection scope of the final products that have GUIs, by listing in a brief description all the final products where the display screen panel, including the GUIs, applies.

IV. Clarification of the conditions for

interviews with examiners and the relaxation of constraints on telephone discussions

To increase the efficiency of communications between examiners and applicants, the 2019 Amendments clarify the conditions for face-to-face interviews with examiners, and relax the constraints on telephone discussions with examiners under the current Examination Guidelines.

Regarding face-to-face interviews with examiners, the 2019 Amendments remove two conditions for initiating an interview in the current Examination Guidelines. In particular, applicants no longer have to request an interview only: (i) after the issuance of the first office action; and (ii) at the time of or after a response to the office action. When the amendments become effective, examiners and applicants can initiate a meeting at any time during the substantive examination proceedings. Moreover, the principle of holding a meeting is specified as "*being advantageous for clarifying issues, eliminating discrepancies and promoting understanding*". However, examiners can refuse to meet with applicants if "*the opinions of both parties have been fully presented and relevant facts are clearly determined by writing, telephone discussions, etc*." under the 2019 Amendments.

For patent applications involving complicated technical solutions, meeting with examiners can provide applicants with an opportunity to demonstrate or explain the technical intricacies of inventions to the examiners. On the one hand, this helps examiners to understand an invention more accurately and compare it with the prior art. On the other hand, it is beneficial for applicants to understand examiners' opinions on relevant facts and legal issues. Applicants with complicated applications may consider filing a request for an interview meeting at an early stage of the substantive examination proceedings to expedite the examination.

In terms of telephone discussions, the 2019 Amendments expands on the scope of discussions via telephone, which is no longer limited to "*solving problems regarding minor and non-misleading formality defects*". Instead, applicants may set up a telephone discussion with examiners on the understanding of the invention and the prior art and the problems that exist in the applications, which will improve the efficiency of examinations. By adding the communication means, such as video conferences, e-mails and the like, the 2019 Amendments provide the option for more communication channels for applicants and examiners.

What should also be noted is that applicants should submit a formal written document for the amendments agreed by the examiner in the meeting or the telephone discussion, unless the amendments fall within the scope of the examiner's ex officio modification.

V. No exclusion on applications relating to Human Embryonic Stem Cell Technology solely on the grounds of non-compliance with Article 25 of the Patent Law

In the 2019 Amendments, inventions related to the use of human embryos to obtain stem cells will no longer be excluded from the scope of patentable subject matters. The 2019 Amendments specify that "*for inventions relating to stem cells isolated or obtained from human embryos within 14 days after fertilization that have not developed in vivo*", such inventions should not be rejected on the ground of "violating social morality". This means that, after the 2019 Amendments come into force, patent applications related to human embryonic stem cell technology may have the chance to be granted patent rights, which is valuable to biopharmaceutical companies in need of protection for stem cell related technologies.

VI. Clarification that technical effects should be those achieved in the claimed invention under examination when evaluating inventiveness, and the requirements on evidence when citing common knowledge

The 2019 Amendments clarify that in the examination of inventiveness when identifying the technical problems solved by an invention in accordance with the technical effect achieved by the distinguishing feature of the invention with respect to the reference documents, the technical effect should be that achieved **"in the claimed invention"**, rather than any other technical effects that the distinguishing feature can achieve. The 2019 Amendments also emphasize that "*for technical features that functionally support each other and have an interactive relationship, the technical effect achieved by such technical features and their relationships in the claimed invention should be considered as a whole*". In fact, this principle has been applied in practice, for example, in the Decision of Reexamination No. 133119 issued by the Patent Reexamination Board of CNIPA (Note: This case was considered as one of the "Top Ten Patent Reexamination and Invalidation Cases in 2017", which involved the invention patent No. 201310113848.0.). This amendment will facilitate the application of the principle more uniformly by examiners.

In addition, the 2019 Amendments also specify that common knowledge cited in an office action normally needs evidence for proof. If the applicant objects to the common knowledge cited by the examiner, the examiner **should** provide corresponding evidence as proof or explain the reasons. If the examiner deems that the technical feature in the claims contributing to solving the technical problem belongs to common knowledge, he or she usually should provide relevant evidence as proof. The 2019 Amendments regulates the citation of common knowledge during the examination proceeding.

VII. Requirements for the petitioner for invalidation to specify the primary combination among multiple combinations of evidence

The 2019 Amendments clearly stipulate that when citing multiple evidence in a request for invalidation, the **primary combination should be first compared with the claims,** and focus on the key points. When the 2019 Amendments come in to effect, the petitioner that requests for invalidation can still submit multiple sets of evidence, but the primary combination should be placed at the beginning. In practice, such rules have been generally followed by the Patent Reexamination and Invalidation Department in oral hearings for invalidation cases. Therefore, such amendments will only have a limited impact on future patent invalidation practices. But in the future, for invalidation cases, petitioners should carefully consider the various possible combinations of evidence before filing a request for invalidation and put the combination with the highest likely success rate at the forefront, and state in most detail the opinions of the petitioner.

In addition to the amendments described above that may affect the practice of patent application, the procedures for the examiner's search are also specified in the 2019 Amendments, and the requirements for the transfer documents or the qualification documents in the procedure of patent assignment are also added.

In summary, compared to the current Examination Guidelines, the 2019 Amendments provide applicants with more options, allow applicants to apply for prioritized examinations or deferred examinations based on their actual needs, relax the constraints on meetings and

telephone discussions between applicants and examiners, clarifies the application requirements for design patent applications involving GUIs, and broadens the scope of patentable subject matter to include specific technologies involving human embryonic stem cells.

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