NEWSLETTER

2024.07

QUARTERLY

PANAWELL INTELLECTUAL PROPERTY

Cover: Interior of office block where Panawell locates

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Panawell Intellectual Property, consisting of Panawell & Partners, LLC and Panawell & Partners Law Firm, provide full spectrum of services in all fields of intellectual property rights, such as patent, trademark, copyright, computer software, anti-unfair competition, trade secrets, custom protection, domain name, license, assignment, enforcement, administrative and civil litigation, IP consulting and management.

Frequently Asked Questions about Preliminary Examination and Process after the New Implementing Regulations of the Patent Law and Guidelines for Patent Examination Came into Effect (Excerpt)

1. To what kind of patent applications is the system of incorporation by reference applicable in the application acceptance procedure? How is the deadline for submission of documents calculated? What documents are to be submitted? How is the filing date determined after the submission?

1) Conditions for application of the system of incorporation by reference. (1) They should be invention or utility model patent applications filed on or after January 20, 2024, and not divisional applications. (2) Application documents lack the claims or description, or the utility model application documents lack drawings of the description. (3) priority is claimed in the application. (4) A declaration of incorporation by reference was made when the applications were first filed. If the above conditions are met, the system of incorporation by reference shall be applied in the application acceptance procedure, and the Patent Office shall issue a Notice of Supplementary Submission of Missing Documents.

2) Deadline requirements for the supplementary documents submission. Two months from the date of first filing of the patent application or two months from the date of receipt of the Notice of Supplementary Submission of Missing Documents.

3). Supplementary documents requirements. A Declaration Confirming Incorporation by Reference should be submitted, together with the missing necessary application documents.

4). Filing date determination. If the Declaration Confirming Incorporation by Reference is submitted within the time limit and the missing necessary application documents are submitted and the conditions for acceptance met, the first filing date shall be determined as the filing date of the patent application.

It needs to be noted that the application documents to which incorporation by reference is applied in the application acceptance procedure will be further examined after their entry into the preliminary examination. If the priority is not established, the acceptance of the patent application will be revoked and the declaration of incorporation by reference shall be deemed not to have been filed. If the priority is established, but the contents of the supplementary documents are not included in the copies of the priority application documents and their Chinese translations, and are not included in them after amendment, the filing date will be redetermined, and the date of supplementary submission of the missing documents will be the filing date.

2. Is it only possible to go through the procedure for restoring the overdue priority and add or

correct the priority claim only for patent applications with a filing date after January 20, 2024?

For national applications, pursuant to Article 3 of the Transitional Measures for the Handling of the Related Examination Operation for the Implementation of the Amended Patent Law and its Implementing Regulations released in CNIPA Announcement No. 559, the applicant may submit a request for restoration of the priority or a request for the addition or correction of a priority claim under Rules 36 and 37 from January 20, 2024, regardless of the filing date.

For PCT applications that have entered the national phase in China, according to the CNIPA Announcement No. 559, if the date on which the two-month period from the date of entry expires is after January 20, 2024, the applicant may request priority restoration under Rule 128 of the Implementing Regulations of the Patent Law.

3. Is it possible to submit copies of the priority application documents using DAS when going through the formalities for restoration of overdue priority, making addition to or correction in the priority claim, or for incorporation by reference?

It is possible. However, there will be waiting time for submitting the copies using DAS, and it takes longer time than submitting them directly. In addition, there is a risk of unsuccessful exchanges, resulting in the loss of the applicant's rights for failure to submit the copies within the time limit. Therefore, it is advisable for the applicant to submit copies of the priority application documents directly in order to shorten the processing time and avoid the risks.

4. Can the patentee assign or abandon patent under open license?

For a patent under an open license, the patentee shall first go through the formalities for withdrawing the open license declaration through the patent operation or handling system (web version) before going through the formalities for registering the assignment of the patent right and declaring abandonment of the patent in writing.

5. If the patent is openly licensed, can the patentee and the pledgee go through the formalities to register the patent pledge?

If the patentee pledges the patent under an open license, he or it shall declare in writing that the pledgee agrees to continue to execute the open patent license when registering the patent pledge, otherwise the registration shall not be granted.

6. Is it possible to change the standard of patent royalties and the term of the patent license?

For a patent under an open license, if it is really necessary to change the royalties and/or term of the patent license for legitimate reasons, the royalties and/or term shall be changed by making a new patent open license declaration after finalizing the formalities for declaring withdrawal of the open patent license.

7. Is it possible for a patent under an open license to be solely exclusively or exclusively licensed?

For an openly licensed patent, the patentee cannot re-license the patent solely exclusively or exclusively before the expiry of the term of the open license.

8. Should the addressee in Column 9 Licensor Contact Information in the open patent license declaration form be the same as the contact person indicated in the patent application?

It is not necessary to for them be the same person, and the patentee (applicant) shall designate the corresponding contact person according to actual needs. The contact person in the patent request is the person who, designated by the patent applicant to receive letters from the patent office, is directly related to the smooth communication between the patent applicant and the patent office. However, when the formalities for open patent license declaration are being gone through, if any unit or individual is willing to exploit the open licensed patent, it or he will contact the recipient or directly notify in writing the recipient in accordance with the licensor's contact information in the Declaration Form, which will directly affect the patentee's rights and interests in transforming and using the patent.

(Source: official website of CNIPA)

CNIPA to Introduce XML Format for Filing Patent Applications

The CNIPA plans to stop, from January 1, 2025, accepting forms in PDF and WORD formats (including application documents and intermediate documents) for patent applications and documents filed in electronic form, and accept files in XML format only. The pilot work has now been rolled out for the purpose).

(Source: official website of CNIPA)

CNIPA Announcement on Revised Patent Certificates

According to the CNIPA Announcement No. 581 released on May 10, 2024, the CNIPA has decided to revise the patent certificates: for patents with the date of grant announcement on or after June 1, 2024, the CNIPA will issue the new-version patent certificates, which follow the vertical layout of A4 paper size, and optimize and adjust the layout of the bibliographic items.

As an example, the new version of the invention patent certificate shown below is reduced to and printed on one page:


证书号第XXXXXXX号

发明专利证书

发明名称：XXXXXXXXXXXX

专利权人：XXXXXXXXXXXXXXX

地　　址：XXXXXX XXXXXXXXXXXXX

发 明 人：XXX; XXX

专　利　号：ZL XXXX X XXXXXXX.X　　授权公告号：CN XXXXXXXXX X

专利申请日：XXXX 年 XX 月 XX 日　　授权公告日：XXXX 年 XX 月 XX 日

申请日时申请人：XXX; XXX

申请日时发明人：XXX; XXX

国家知识产权局依照中华人民共和国专利法进行审查，决定授予专利权，并予以公告，专利权自授权公告之日起生效。专利权有效性及专利权人变更等法律信息以专利登记簿记载为准。

局长　　（国家知识产权局印章）

申长雨　　（局长签名章）

XXXX 年 XX 月 XX 日

第 1 页（共 1 页）

(Source: official website of CNIPA)

CNIPA Clarifies Official Fees for Patent Term Compensations

According to the Notification on the Handling of Patent Term Compensation the CNIPA released on January 18, 2024, although the Implementing Regulations of the Patent Law and the Guidelines for Patent Examination came into effect on January 20, the operational work regarding the patent term compensation fees will unfold after the relevant fee standards are released by the financial authorities of the State Council and the CNIPA. If a request for compensation for the term of a patent is submitted before the promulgation and implementation of the relevant fee standards, the fees shall be paid within three months from the date of implementation of the relevant fee standards.

To date, the CNIPA has released clear official fees for patent term compensation. According to the Guidelines for Handling Administrative Intellectual Property Service Matters (2nd Edition) released on May 28, the patentee shall pay a request fee of RMB 200 yuan to the CNIPA for the patent term compensation if the patentee goes through the formalities for patent term compensation.

The procedure for patent term compensation is as follows: the requester submits a request for compensation for the term of the patent or the term of the patent for drugs, pays the request fee for the compensation, and if the request meets the requirements, the CNIPA passes the request though the examination, issues an approval decision on the term compensation, agrees on the compensation, and notifies the requester of the number of days compensated.

In addition, according to the Guidelines for Handling Administrative Intellectual Property Service Matters (2nd Edition), the annual fee for the compensated period of the patent term shall be paid in a lump sum, and there is no late payment period, and no fee reduction. Where the annual fee for the compensation period of the patent is not paid one month before the date of expiry of the 20-year patent term, the CNIPA shall issue a Notice of Payment of the Annual Fee for the Compensated Period of the Patent Term to remind the patentee to pay the fee. There is no reinstatement procedure in cases where the annual fee for the compensation period of the patent term is not paid, or not paid in full within the time limit.

(Source: official website of CNIPA)

CNIPA Announces Participation in PPH Improvement Initiative

With a view to further enhancing users' experience of the Patent Prosecution Highway (PPH), the CNIPA announced, in April 2024, that it would join the PPH Improvement Initiative in cooperation with the five IP offices of CNIPA, USPTO, EPO, JPO and KIPO, and set the target of 3 months as the average time for issuing the first office action for patent applications through PPH, and for issuing the next office action after the applicant responds to a preceding office action, so as to provide PPH users with a more predictable examination timeline.

The PPH is a fast-track patent examination channel between different countries or regions, expediting the patent examination through work sharing between patent examination authorities. Since the launch of the first PPH pilot project in November 2011, the CNIPA has established PPH cooperation with patent examination authorities in 32 countries or regions.

(Source: official website of CNIPA)

How to Understand and Apply GPE Inventiveness Examination Provisions-Concurrent Discussion on 2023 Amendments in GPE Inventiveness Chapter

Mr. Richard Yong WANG, Lawyer & Patent Attorney, Panawell & Partners

By the inventiveness, or inventive step, the most important required element for patenting, and representing the innovative height of, an invention-creation, is meant that an invention exhibits prominent substantial characteristics, and represents significant progress or advancement compared with the prior art. According to the examination practice, examiners would issue office actions on the inventiveness of over 60% of the patent applications in the examination process, which may be cited as grounds for rejection or invalidation. Clarifying the standards or benchmark for the examination of inventiveness of inventions is of great significance for improving the quality and effectiveness of granted patents, and for encouraging and supporting innovation activities in the nation. Therefore, in the 2023 Guidelines for Patent Examination (GPE), some important and meaningful amendments have been made to amplify the provisions or rules related to determining the closest prior art, technical problems actually solved by inventions, and those related to the types of evidence of common knowledge.

Pursuant to Article 22, paragraph 3, of the Patent Law, to determine whether an invention possesses inventiveness, it should be judged whether the invention has prominent substantial characteristics, and at the same time, whether it represents significant progress. In determining inventiveness, China's Patent Law adopts the standards of "prominent substantial characteristics" and "significant progress". These standards are essentially similar to the "non-obviousness" and "inventive step" standards adopted by the United States Patent and Trademark Office (USPTO) and the European Patent Office (EPO). However, it emphasizes that the invention must exhibit significant progress, and produce beneficial technical effects compared with the prior art.

I. Regarding Prominent Substantial Characteristics Examination

Under the GPE provisions, determining whether an invention possesses prominent substantial characteristics entails assessing whether the invention, as perceived by those skilled in the art, is obvious relative to the prior art. In other words, if the invention can be derived merely from logical analysis, reasoning, or limited experimentation by those skilled in the art based on the prior art, then it is considered obvious. When assessing whether an invention is obvious, the so-called "three-step approach" is typically employed in the examination, which is essentially consistent with the EPO examination rules, and follows a problem-solution approach. Although other examination methods have been proposed theoretically and judicially,

the three-step approach remains the mainstream method used in the procedures of examination, reexamination and invalidation, as well as in administrative litigation. Therefore, the examination standards and defense strategies regarding the prominent substantial characteristics of inventions (i.e., non-obviousness) will be discussed below according to the sequence of the three-step approach examination.

Step 1: Closest prior art determination

The closest prior art refers to a technical solution within the prior art that is most closely related to the claimed invention. It serves as the basis for determining whether the invention possesses prominent substantial characteristics. In practice, the prior art, including the closest prior art, is typically obtained through search. The documents retrieved from the search often include numerous references, among which only one document or technical solution can be considered the closest prior art. The selection principle is generally to choose the prior art that is most closely related to the claimed invention in terms of technical field, technical problem to be solved, technical effects or use, and/or something that discloses most technical features of the invention. Alternatively, if the technical field differs from that of the invention, the closest prior art may be selected based on its capability of achieving the function of the invention, and it discloses the most technical features of the invention.

However, choosing a different technical solution as the closest prior art possibly impact the final result of the inventiveness examination. Moreover, in practice, it has been observed that examiners sometimes tend to emphasize solely the number of common technical features between the claims of the application under examination and the prior art, while overlooking the relationship between the technical problem to be solved by the invention and that addressed or solved by the prior art. This could lead to some biases in assessing inventiveness.

Therefore, in the GPE as amended in 2023, on the basis of the provisions regarding the determination of the closest prior art that “primary consideration shall be given to a prior art that is identical or similar in technical field,” it has been added that, “wherein the prior art that is associated with the technical problems to be solved by the invention shall be primarily considered." The term "associated with" in relation to the technical problem emphasizes that there should be a connection between the technical problem to be solved by the application under examination and that of prior art. This connection could manifest in various ways, such as explicit recording of the invention's purpose or technical problem in prior art being identical with or similar to that to be solved by the application, or it could be inferred based on the recognition of the existence of such technical problem by those skilled in the art, even if not explicitly documented.

Generally, the purpose of an invention is to solve a

technical problem, and achieve the technical effect through the technical solution. There is a technical connection between the prior art and the technical problem to be solved by the invention. Only when such a connection exists is the prior art more likely to be considered the closest prior art, and serve as the ideal starting point for achieving the invention's purpose. This amendment can guide the inventiveness examination to focus on reconstructing the starting point and process of invention-creation, reducing subjective arbitrariness when selecting the closest prior art, and avoiding, as much as possible, retrospective judgment in the examination process.

Step 2: Determination of distinguishing features of, and technical problem actually solved by, the invention

In step 2, the first task is to analyze the differences between the claimed invention and the closest prior art identified in Step 1, and then determine, based on these distinguishing features, the technical problem actually solved by the invention by considering the technical effects achievable through these features. In this sense, the technical problem actually solved by the invention refer to the technical task to improve the closest prior art in order to achieve better technical effect.

Determining the technical problem actually solved by the invention based on its distinguishing features serves as a link between the previous steps in the application of the "three-step approach" for the purpose of looking for the the direction to find out technical suggestions or insights in step 3. The Gazette No. 328 issued by the China National Intellectual Property Administration (CNIPA) in 2019 has further refined the provisions regarding the determination of technical problem actually solved by the invention in the "three-step approach" outlined in the GPE. It explicitly states that the technical problem actually solved by the invention should be determined based on the technical effects achievable through the distinguishing features "in the claimed invention." Additionally, it emphasizes the principle of considering the technical solution as a whole, where, for the technical features supporting each other and interacting with one another in functionality, the technical effect achieved by the technical features and their relationship in the claimed invention should be globally considered.

Considering the significant importance of objectively analyzing and determining the technical problems actually solved by the invention in the whole process of the "three-step approach," this amendment further elaborates on the issues to be considered and specific exceptional circumstances when the technical problem is re-determined.

1) Issues to Consider When Determining Technical Problem

In practice, the closest prior art identified by examiners often differs from the prior art described by the applicant in the description. Therefore, when, in the examination practice,

determining the technical problem actually solved by the invention based on the closest prior art identified by the examiner, it may differ from the technical problem described by the applicant in the description. In such cases, the technical problem actually solved by the invention should be re-determined based on the closest prior art identified by the examiner. However, during the examination or response to office actions, examiners or patent attorneys often exhibit two extreme understandings of the technical problem actually solved by the invention. They may either determine the problem too broadly, inappropriately expanding or generalizing the technical problem that the invention can actually solve, exaggerating, understating or distorting the technical effect it can achieve, or they may determine the problem too narrowly, allowing guidance on distinguishing features to be included or the distinguishing features directly included in the determined technical problem as the technical problem actually solved by the invention. This can easily lead to the conclusion that the invention is obvious, causing the inventiveness assessment to fall into the trap of hindsight bias.

To avoid the aforementioned problem, the 2023 GPE emphasize the objective analysis of the relationship between the technical features and technical effect when determining the technical problem actually solved by the invention. On the one hand, the technical effect achievable through the distinguishing features of the invention should be determined to make the re-determined technical problem align with the technical effect. On the other, the technical problem actually solved by the invention should not incorporate the technical means proposed by the invention to solve the problem. These technical means should neither be identified as distinguishing features themselves, nor include guidance or implications regarding the distinguishing features.

To further illustrate this principle, the 2023 GPE have adaptively included a case study involving a consumer electronic device. In this case, the claimed invention is a consumer electronic device that comprises a biometric authentication unit for user account authorization. This authentication unit is based on or utilizes a combination of fingerprint authentication and at least one other authentication method selected from palm print, iris, retinal, or facial features. The description states that using at least two authentication methods can enhance the user accounts security. The closest prior art discloses a consumer electronic device that only utilizes fingerprint information for identity authentication. The key difference lies in the invention's use of at least two biometric features for identity authentication. Based on the technical effect achievable through this distinguishing feature in the invention, the technical problem actually solved by the invention should be "how to enhance the user accounts security in consumer electronic devices,“rather than "how to increase the usage of palm prints or other biometric authentication methods" or "how to enhance the security of consumer electronic

devices by adding authentication methods." Otherwise, it would imply directly incorporating the "technical suggestion or insight" into the technical problem, which will affect the objective evaluation of inventiveness.

2) Addition of a Special Circumstance for Technical Problem Re-determination

To the 2023 GPE has been added a special circumstance for re-determining the "technical problem actually solved by the invention," which occurs when all the technical effects of the invention are equivalent to those of the closest prior art. In such instances, the re-determined technical problem provides an alternative technical solution different from the closest prior art. This addition is prompted by the observation that in the examination practice, certain inventions exhibit equivalent technical effects compared with the closest prior art, without demonstrating "better technical effects," yet they offer an alternative technical solution with a different technical concept. The provisions of the former GPE on the technical problem re-determination did not cover this scenario. The amended GPE include "providing an alternative technical solution different from the closest prior art" as a special circumstance for re-determining the technical problem actually solved by the invention, aiming to comprehensively reflect the patterns and characteristics of innovation making. It's important to note that defining the technical problem as "providing an alternative technical solution different from the closest prior art" does not necessarily imply that the proposed technical solution does, or does not, possess inventiveness. It is still required to determine, based on the technical problem, whether the invention is obvious to those skilled in the art.

Step 3: Determination of whether the claimed invention is obvious to those skilled in the art

In this step, starting from the closest prior art and the technical problem actually solved by the invention determined in Step 2, it is determined whether the invention is obvious to those skilled in the art. In this determination, what needs to be ascertained is whether there is a technical suggestion or insight within the prior art as a whole, namely, whether the prior art suggests applying said distinguishing features to the closest prior art to solve its existing technical problem (i.e., the technical problem actually solved by the invention). Such a suggestion would motivate those skilled in the art, when faced with said technical problem, to improve the closest prior art, and thereby arrive at the claimed invention. If such a technical suggestion exists in the prior art, the invention is deemed obvious, and lacks prominent substantial features.

The presence of any one of the following circumstances would typically suggest the existence of such a technical suggestion in the prior art:

(1) Said distinguishing features are common knowledge, e.g., regular means, used in the field to

solve the re-determined technical problem or technical means disclosed in textbooks, technical dictionaries, technical manuals, and other reference materials to solve the re-determined technical problem.

(2) Said distinguishing features are technical means related to the closest prior art, e.g., technical means disclosed in other parts of the same reference. These technical means serve the same purpose as the distinguishing features in the claimed invention to solve the re-determined technical problem.

(3) Said distinguishing features are technical means disclosed in another reference, where these means serve the same purpose as the distinguishing features in the claimed invention to solve the re-determined technical problem.

In years of practice as a patent attorney, this author has observed an implicit two-step logic in step 3, involving: 1) determining whether the distinguishing features are disclosed in the prior art; and 2) determining whether the prior art provides a suggestion to apply these disclosed distinguishing features to the closest prior art to solve its existing technical problems.

Specifically, in determination point 1), it should be first ascertained whether the distinguishing features identified in Step 2 are disclosed in any prior art other than the closest prior art. If at least one of these distinguishing features is not disclosed in any other prior art, further examination is required to ascertain whether these undisclosed distinguishing features constitute common knowledge or regular technical means in the field. If the answer is negative, meaning that these distinguishing features are not common knowledge or regular technical means in the field, then it is, typically, not necessary to proceed to said determination point 2). In such cases, the claimed invention can be directly deemed non-obvious to those skilled in the art. This is because if at least one distinguishing feature is not disclosed in the prior art, it is unlikely that there would be any suggestion in the prior art to apply those distinguishing features to the closest prior art to solve its existing technical problems.

If the result of determination point 1) is affirmative, meaning that all the distinguishing features are disclosed in the prior art or it is determined that all these distinguishing features are common knowledge, then it is still necessary to ascertain whether the prior art provides a suggestion to apply these distinguishing features to the closest prior art to solve its existing technical problems, thus proceeding to determination point 2). Furthermore, within the determination point 2), the suggestion includes two scenarios: A) whether there is a suggestion in the prior art to combine these distinguishing features with the closest prior art; and B) whether there is a suggestion in the prior art that such a combination can be used to solve the technical problems identified in step 2. These suggestions can be explicitly disclosed in the prior art or readily inferred by those skilled in the art from reading the prior art. If either

suggestion is lacking, it cannot be concluded that the prior art provides a suggestion to apply these distinguishing features to the closest prior art to solve its existing technical problems.

In step 3, there has been a longstanding issue troubling examiners and other practitioners regarding the burden of proof with respect to common knowledge. The 2023 GPE responded positively to this issue. The last paragraph in Section 4.10.2.2 (4) of Chapter Eight in Part II of the GPE lays out the requirements to examiners when invoking common knowledge argument in the examination office action, refining and clarifying the provisions concerning citation of common knowledge in the office action. Firstly, the sequence of responses from the examiners when applicants object to a common knowledge citation has been adjusted, changing from "explain the reasons or provide the corresponding evidence " to "provide the corresponding evidence or explain the reasons", thereby clarifying the principle of examiner's priority in presenting evidence when the applicant disputes the common knowledge cited by the examiner. Secondly, at the end of this paragraph, a sentence has been added: "In the examination office action, when the examiner determines the technical features contributing to the solution of technical problems in the claim as common knowledge, they generally should provide evidence for such determination", which outlines the principle requirement that examiners should generally provide evidence when they determine the "invention points" asserted by the applicant as common knowledge. This would strengthen the evidence awareness of examiners, and clarifies the requirement for providing evidence.

II. Regarding Significant Progress Assessment

Under the GPE provisions, when assessing whether an invention represents a significant progress or advancement, the main consideration should be given to whether the invention has beneficial technical effects. The GPE list several beneficial technical effects, for example, the invention has better technical effect or performance than the prior art, such as improved quality, increased production yield, energy savings, or environmental pollution prevention and control; the invention provides a technical solution with a different conceptual approach, achieving technical effects that are generally comparable to the prior art; the invention represents a new trend in technological development; and despite its negative effects in some aspects, the invention has significantly positive technical effects in other aspects.

The 2023 GPE did not make any amendments to the provisions for determining significant progress, but it is evident that, in practice, with the advancement of technology and understanding, considerations regarding technical effects are not limited to the listed items mentioned above.

To conclude, the amendments made to the 2023 GPE have systematically improved the approach to

inventiveness examination with an aim to offer guidance and standardization for examiners to correctly understand the legislative purpose and legal implications of inventiveness, grasping the essence of inventions, and objectively and fairly assessing their contribution to the prior art. Furthermore, these amendments can also encourage applicants to pay more attention to elucidating the essence of their inventions in their application and drafting process, facilitating more effective communication with examiners. This, in turn, will lead to better and timelier protection of genuine inventions-creations, enhance the quality of granted patents, and ultimately fulfill the role of the patent system in encouraging invention creation and promoting technological innovation.

Author:

Mr. Richard Yong WANG

Mr. Wang received his bachelor's degree in 1991 from the department of computer science of East China Normal University and his master's degree from the Institute of Computing Technology of the Chinese Academy of Sciences in 1994. In 2005, he received degree of master of laws from Renmin University of China. From 1994 to 2006, Mr. Wang worked with China Patent Agent (HK) Ltd, as a patent attorney and director of Electrical and Electronic Department. Mr. Wang joined Panawell in January 2007.

Mr. Wang is a member of the All-China Patent Attorneys Association (ACPAA), Sub-Committee of Electronic and Information Technology of ACPAA, LES China and AIPPI China, and FICPI China

In the past years, Mr. Wang has handled thousands of patent applications for both domestic and foreign clients, and he has extensive experiences in application drafting, responding to office actions, patent reexamination and invalidation proceeding, patent administrative litigation, infringement litigation, software registration and integrated circuit layout design registration. As a very experienced patent attorney and attorney-at-law, Mr. Wang also participated in many patent litigation cases on behalf of a number of multinational companies as leading attorney. Mr. Wang's practices include computer hardware, computer software, communication technology, semiconductor devices and manufacturing process, automatic control, household electrical appliances, and etc.

How to Read Chinese Patent Documents and Get Its Information

Ms. Xiaohui ZHAO, Senior Legal Counsel, Panawell & Partners

In the patent and technology fields, the value of patent documents is self-evident. Acquaintance with the Chinese patent document numbering system not only helps us quickly identify patent documents, but also greatly improves the efficiency and accuracy of our access to them.

Patent documents are patent application documents and announced documents of granted patents published by the intellectual property offices of various countries in the statutory procedures. A patent document number is a unique identification number assigned to each document by the intellectual property office in such procedures in the process of patent application publication and patent grant announcement.

In the course of searching and using Chinese patent documents, the Chinese patent document numbering system encountered includes the following patent document numbers, namely:

Application number - an identification number given to an invention, utility model or design patent application when the China National Intellectual Property Administration (CNIPA) accepts the patent application;

Patent number - an identification number given to an invention, utility model or design patent when it is patented;

Publication number - an identification number given to a set of published invention patent application documents when the invention patent application is published;

Announcement or issue number – an identification number given to a set of announced patent documents when the grant of a patent to an invention, utility model or design is announced;

A patent document number is equivalent to the "identity card" of the patent document. Since the implementation of the patent system in China, the patent document numbering system has gone through four stages of development: the first stage ran from 1985 to 1988; the second 1989 to 1992; the third 1993 to June 30, 2004; and the current forth stage started from July 1, 2004. This article will be focusing on the current version of the document numbering system put in place on that date, and on the ways or routes to obtain patent documents.

I. Explanation of Chinese Patent Document Numbers

1. Patent Application Numbers and Patent Numbers

Application number: There are three types of patent applications: invention patent, utility model, and design patent applications. A patent application of any class, regardless of whether it complies with the patentability requirements, is given an application number as long as it is successfully accepted. The composition of the application number goes as follows:

(1).An application number for any of the three types of patents consists of a chronically arranged 12-digits and a dot "." and one check digit, for example, 202310102344.5, the first four digits of which indicate the year of application, with the year written in the year of the Common Era. For example, 2023 means that the year of acceptance of the patent application is 2023 AD;

(2).The fifth digit indicates the type of patent application for which protection is sought, as follows:

1-indicates an invention patent application;

2-indicates a utility model patent application;

3-indicates a design patent application;

6-indicates the registration of an international design patent under the Hague System that has entered the national phase in China;

8-Indicates a Chinese national phase invention patent application based on a PCT patent application;

9-Indicates a Chinese national phase utility model patent application based on a PCT patent application.

(3) The sixth to twelfth digits (a total of 7 digits) indicate the sequential number of the application in the current year, and then a dot "." is used to separate the patent application number from the check digit, the last digit.

Patent number: The patent application number is preceded by the letter string "ZL" to form the patent number, and ZL is the combination of the initials of the Chinese pinyin for "patent", indicating that the patent application has been patented. Take the patent application number 202310102344.5 for example, the patent number of this patent is written as ZL202310102344.5.

Fourth-stage Chinese Patent Document Numbering System

Type of patent applications	Application No.	Publication No.	Grant announcement No.	Patent No.
invention	202310102344.5	CN1 00378905**A**	CN1 00378905**B**	ZL202310102344.5
invention (national phase)	202380100001.3	CN1 00378906**A**	CN1 00378906**B**	ZL202380100001.3
utility model	202320100001.1		CN2 00364512**U**	ZL202320100001.1
utility model (national phase)	202390100001.9		CN2 00364513**U**	ZL202390100001.9
design	202330100001.6		CN3 00123456**S**	ZL202330100001.6
International design applications under the Hague System	202360000673.9		CN3 08608701**S**	ZL202360000673.9

2. Patent Application Publication Number and Patent Announcement Number

Publication refers to the publication of an invention patent application at the expiration of the 18-month period from the filing date (or priority date) or at the request of the applicant for earlier publication after the application for a patent has passed the the preliminary examination.

Announcement refers to a grant or patenting announcement when an invention patent application is granted the patent without finding any ground or reason for rejection after the substantive examination; a grant announcement of the grant of the utility model or design patent when the utility model or design patent application is granted the patent without finding any ground or reason for rejection after the preliminary examination; and an announcement of partial invalidation of a patent for invention, utility model or design.

A document number for any of all the patent descriptions or specifications published since July 1, 2004 consist of a string of letters CN, the Chinese country code, and 9 digits, as well as 1 letter or 1 letter plus 1 number (the announcement number of an invention or a PCT application shall be implemented from Issue 29 of Volume 23, and a grant or patenting announcement number for any of the three classes of patents shall be implemented from Issue 35 of Volume 23). Among them, the first digit after the letter string CN indicates the type of patent application for which protection is sought: 1 - invention, 2 - utility model, and 3 - design. It should be pointed out here that the document numbers of "Chinese national phase invention patent application and Chinese national phase utility model patent application based on a PCT patent application" and "international design applications" are no longer arranged separately, but are grouped together with inventions, utility models and designs respectively. The second to ninth digits are the serial number, and the three types of patents are arranged in order according to their respective serial number sequences, accumulated year by year, and the invention patent grant announcement number follows the patent document number assigned to the invention patent application when it is first published, and the last letter or 1 letter plus 1 number is the patent document class identification code.

◆Patent document class identification codes and their meanings

The invention patent document class identification codes are:

A: Invention patent application;

A8: Invention patent application (title page corrections);

A9: Invention patent application (full text corrections);

B: Invention patent;

B8 : Invention patent (title page corrections);

B9 : Invention Patent (full text corrections);

C1-C6 : Invention patent (partially declared invalid).

Invention Patent Document No. (publication No.; announcement No.)

Patent document types	The combined use of patent document number, country code, and type code		Explanation
publication of Chinese invention application	Publication Number	CN 1 00378905 A	Different patent applications should be sequentially numbered
		CN 1 00378906 A	
publication of Chinese invention application(title page re-published)		CN 1 00378905 A8	The same patent application shall continue to use the first assigned publication number
publication of Chinese invention application(full text re-published)		CN 1 00378905 A9	
granted text of Chinese invention patent	Announcement number	CN 1 00378905 B	The announcement number of the same patent application shall continue to use the first assigned publication number
granted text of Chinese invention patent(title page re-published)		CN 1 00378905 B8	
granted text of Chinese invention patent(full text re-published)		CN 1 00378905 B9	
announcement of Invalidation of the part of the Patent Right (the first time)		CN 1 00378905 C1	
announcement of Invalidation of the part of the Patent Right (the second time)		CN 1 00378905 C2	

Utility Model Patent Document No. (announcement No.)

Patent document types	The combined use of patent document number, country code, and type code		Explanation
granted text of Chinese utility model patent	announcement number	CN 200364512 U	Different patent applications should be sequentially numbered
		CN 200364513 U	
granted text of Chinese utility model patent（title page re-published）		CN 200364512 U8	The same patent shall continue to use the first assigned announcement number
granted text of Chinese utility model patent（full-text re-published）		CN 200364512 U9	
announcement of Invalidation of the part of the utility model Patent Right (the first time)		CN 200364512 Y1	The same patent shall continue to use the first assigned announcement number
announcement of Invalidation of the part of the utility model Patent Right (the second time)		CN 200364512 Y2	

The utility model patent document class identification codes are:

U: Utility model patent;

U8: Utility Model Patent (title page corrections);

U9: Utility Model Patent (full text corrections);

Y1-Y6: Utility model patent (partially declared invalid).

The design patent document class identification codes are:

S: Design Patent;

S8: Design Patent (title page corrections);

S9: Design Patent (full text corrections);

S1-S6: Design patent (partially declared invalid).

Design Patent Document No. (announcement No.)

Patent document types	The combined use of patent document number, country code, and type code		Explanation
granted text of Chinese design patent	announcement number	CN 3 00123456 S	Different patent applications should be sequentially numbered
		CN 3 00123457 S	
granted text of Chinese design patent（full-text re-published）		CN 3 00123456 S9	The same patent shall continue to use the first assigned announcement number
announcement of Invalidation of the part of the design Patent Right (the first time)		CN 3 00123456 S1	The same patent shall continue to use the first assigned announcement number
announcement of Invalidation of the part of the design Patent Right (the second time)		CN 3 00123456 S2	

3.Chinese Patent Bibliographic Items Information

INID Code: Identification code for bibliographic items in patent documents. It is the acronym of the Internationally Agreed Numbers for the Identification of (bibliographic) Data.

1). Names of Bibliographic Items of Invention and Utility Model Patent Documents and Corresponding INID Codes

(10) Patent document identification sign;

(12) Title of patent document;

(15) Correction data of patent document;

(19) Name of the national authority that publishes or announces the patent documents;

(21) Application number;

(22) Filing date;

(30) Priority data;

(43) Application publication date;

(45) Grant announcement date;

(48) Corrected document publication date;

(51) International patent classification;

(54) Title of invention or utility model;

(56) Reference;

(57) Abstract;

(62) Data of original application of divisional application;

(66) National priority data;

(71) Applicant;

(72) Inventor;

(73) Patentee;

(74) Patent agency and patent attorney;

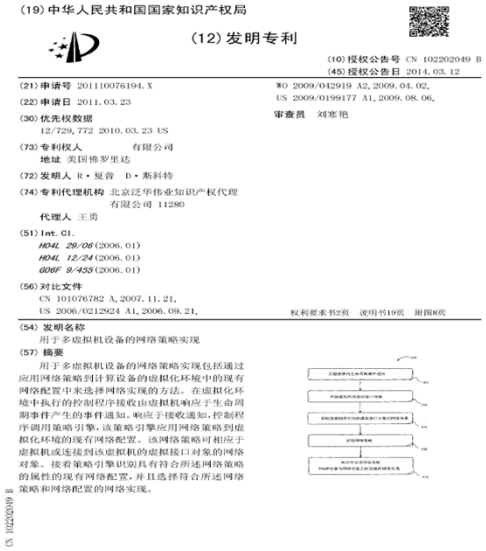
(83) Biological depository information;

(85) Date of entry of a PCT international application into the national phase;

(86) Application data of PCT international application;

(87) Publication data of PCT international application;

(Sample of the first page of the invention patent announcement text)



(19) 中华人民共和国国家知识产权局

(12) 发明专利

(10) 授权公告号 CN 102202049 B
(45) 授权公告日 2014.03.12

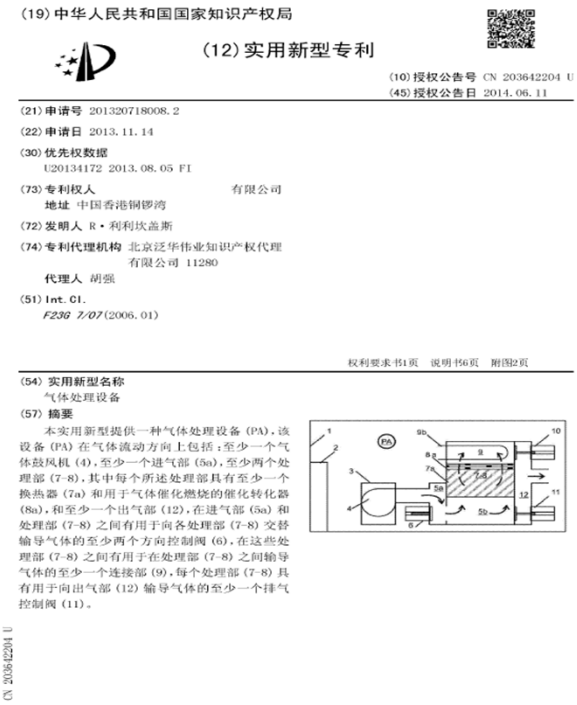
(21) 申请号 201110076194.X
(22) 申请日 2011.03.23
(30) 优先权数据
12/729,772 2010.03.23 US
(73) 专利权人 有限公司
地址 美国佛罗里达
(72) 发明人 R·夏普 D·斯科特
(74) 专利代理机构 北京泛华伟业知识产权代理有限公司 11280
代理人 王勇
(51) Int.Cl.
H04L 29/08 (2006.01)
H04L 12/24 (2006.01)
G06F 9/455 (2006.01)
(56) 对比文件
CN 101076782 A, 2007.11.21,
US 2006/0212924 A1, 2006.09.21,
WO 2009/042919 A2, 2009.04.02,
US 2009/0199177 A1, 2009.08.06,
审查员 刘寒艳
权利要求书2页 说明书19页 附图8页

(54) 发明名称
用于多虚拟机设备的网络策略实现

(57) 摘要

CN 102202049 B

(Sample of the first page of the utility model patent announcement text)



(19)中华人民共和国国家知识产权局

(12)实用新型专利

(10)授权公告号 CN 203642204 U
(45)授权公告日 2014.06.11

(21)申请号 201320718008.2
(22)申请日 2013.11.14
(30)优先权数据
U20134172 2013.08.05 FI
(73)专利权人 有限公司
地址 中国香港铜锣湾
(72)发明人 R·利利坎盖斯
(74)专利代理机构 北京泛华伟业知识产权代理有限公司 11280
代理人 胡强
(51)Int.Cl.
F23G 7/07(2006.01)

权利要求书1页 说明书6页 附图2页

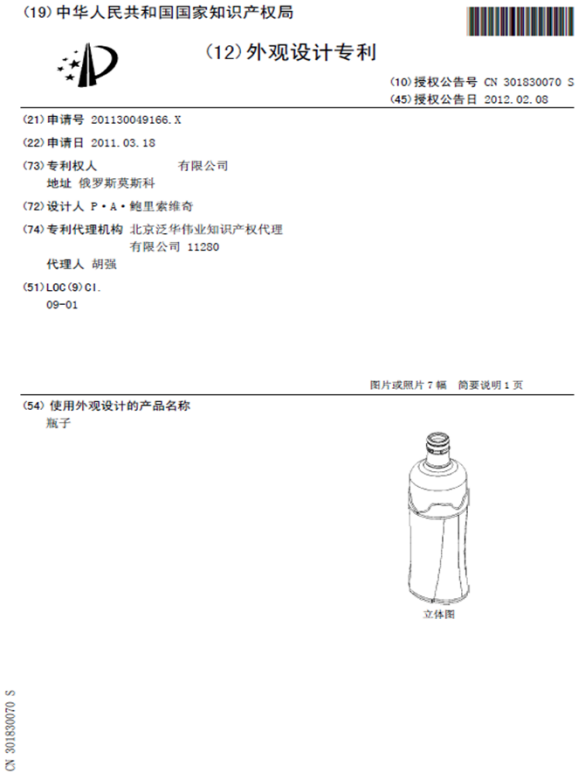
(54)实用新型名称
气体处理设备
(57)摘要
本实用新型提供一种气体处理设备(PA),该设备(PA)在气体流动方向上包括:至少一个气体鼓风机(4),至少一个进气部(5a),至少两个处理部(7-8),其中每个所述处理部具有至少一个换热器(7a)和用于气体催化燃烧的催化转化器(8a),和至少一个出气部(12),在进气部(5a)和处理部(7-8)之间有用于向各处理部(7-8)交替输导气体的至少两个方向控制阀(6),在这些处理部(7-8)之间有用于在处理部(7-8)之间输导气体的至少一个连接部(9),每个处理部(7-8)具有用于向出气部(12)输导气体的至少一个排气控制阀(11)。

CN 203642204 U

2) Names of Bibliographic Items of Design Patent Documents and Corresponding INID Codes

(10) Patent document identification sign;
(12) Title of patent document;
(15) Correction data of patent document;
(19) Name of the national authority that publishes the patent document;
(21) Application number;
(22) Filing date;
(30) Priority data;
(45) Grant announcement date;
(48) Corrected document publication date;
(51) International Design Classification (the Locarno Classification);
(54) Name of the product incorporating the design;
(56) Reference;
(62) Data of original application for divisional application;
(72) Designer;
(73) Patentee;
(74) Patent agency and patent attorney;
(80) International design registration number or international design registration number of international design.

(Sample of the first page of the design patent announcement text)



(19)中华人民共和国国家知识产权局

(12)外观设计专利

(10)授权公告号 CN 301830070 S
(45)授权公告日 2012.02.08

(21)申请号 201130049166.X
(22)申请日 2011.03.18
(73)专利权人 有限公司
地址 俄罗斯莫斯科
(72)设计人 P·A·鲍里索维奇
(74)专利代理机构 北京泛华伟业知识产权代理有限公司 11280
代理人 胡强
(51)LOC(9)Cl.
09-01

图片或照片7幅 简要说明1页

(54)使用外观设计的产品名称
瓶子

立体图

CN 301830070 S

II. Ways to Obtain Chinese Patent Documents

In the first part above, we have explained in detail the Chinese patent document numbers, and this part will be focusing on the ways or routes to obtain the Chinese patent documents.

1.CNIPA website (free online resources) https://www.cnipa.gov.cn/

1).China Patent Publication and Announcement Database:

Enter the homepage of the website, then enter the patent operational system, and choose to enter the China patent publication and announcement interface of http://epub.cnipa.gov.cn/. You need to register and log on first, and you can enter the application number, publication number, announcement number and other relevant information to search the relevant patent and download it. The database includes all the Chinese patent publication and announcement data from September 10, 1985 to the present day, substantive examination and validity, patent termination, patent transfer, bibliographic changes, patent licensing and other transaction data information.

2) China Patent Examination Information Database:

If you need to obtain more relevant application information, enter the CNIPA patent examination information search interface https://tysf.cponline.cnipa.gov.cn/am/#/user/login

Enter the application number, invention title, applicant and other information of the relevant application to search for the relevant published patent documents. Through this interface, you can view a series of related information, such as the case status (pending the substantive examination, rejection, patent right validity, etc.), application information (agency of the applicant and inventor, etc.), examination information (office actions from the patent office, applicant submitted responses), fee information (fees due and fees paid) and a series of related information (some information is not accessible to the public).

2. Official website of the European IP office (free online resources) https://worldwide.espacenet.com/advancedSearch?locale=en_EP

You can search and download the application number, publication number, or announcement number of the Chinese patent applications.

3. Other Patent Database Websites (free online resources)

CNKI Patent Sub-database website: https://kns.cnki.net/kns/brief/result.aspx?dbprefix=SCOD

Websites, such as Wanfang patent sub-database website: http://new.wanfangdata.com.cn/index.html

China Intellectual Property Network (www.cnipr.com), China Patent Information Center (www.cnpat.com.cn), China Patent Information Network Search System (www.patent.com.cn), all provide free search and access to the Chinese patent resources.

References:

[1] ZC 0007-2012 Chinese Patent Document Number Standard;

[2] ZC 0008-2012 Chinese Patent Document Class Identification Code;

[3] ZC 0009-2012 Chinese Patent Document Bibliographical Items; https://www.cnipa.gov.cn/art/2012/11/14/art_527_146111.html ;

[4] The Documentation Information Research Course Group of the Shanghai Science and Technology University, Four Stages of Chinese Patent Documents Numbering System, http://wjk.usst.edu.cn/2020/0419/c10156a218346/page.htm ;

[5] Tang Caixiang, Department of the CNIPA Patent Documentation Department, Chinese Patent Document Numbering System, https://www.taodocs.com/p-319860911.html?v=undefined;

[6] The China National Intellectual Property Administration,Guidelines for Patent Examination, the Intellectual Property Press, Beijing, 2009;

[7] Tian Lipu. Basic Course on Invention Patent Examination [Search Volume][M], the Intellectual Property Press, Beijing, 2008;

[8] The CNIPA Official website.

Author's Profile:

Ms. Xiaohui ZHAO graduated from Tianjin Normal University with a bachelor's degree in English translation in 2008, and joined Panawell LLP in 2012 as a senior legal counsel. Having accumulated rich practical experience in patent processing and prosecution management and patent search for many years, she is very much familiar with the key and difficult points of all the aspects of the patent agency process and Chinese and foreign patent search, and she has undertaken a great deal of complex and difficult patent processing, prosecution and search tasks. On top of all this, she has gained a relatively in-depth understanding and research capability of the patent laws of China and other major countries and regions, such as the United States, Europe, Japan, and the Republic of Korea.

(Continuing from the article of the same title in the Newsletter published in April, 2024)

Summary of SPC IP Tribunal Decisions 2023

With a view to highlighting the judicial concepts, trial ideas and adjudication methods of the Intellectual Property Tribunal (IPT) of the Supreme People's Court (SPC) in technology-related IP and monopoly cases, the IPT selected 96 from the 4,562 cases concluded in 2023, summarized 104 key points, and put them into the Summary of the SPC IP Tribunal Decisions 2023, which was released on February 23, 2024 for the benefit of research and for the reference of all sectors of the society.

I. Patent Grant and Confirmation Cases

16. Determination of novelty and inventiveness of utility model patent comprising method features

【Case No.】 (2021) SPC IP Final No.422

Key point:: For utility model patent claims that comprise both the shape and structure of the product, and the manufacturing method or process of the product, when determining its novelty and inventiveness, if the method feature can make the product have a specific shape or structure, it has a defining effect on the scope of protection of the utility model patent. When determining novelty and inventiveness, the specific shape or structure resulting from the method should be compared with the shape and structure of the prior art, rather than comparing the method itself with the method of the prior art.

17. Determination of similar and related technical field in the determination of inventiveness of utility model patent

【Case No.】 (2022) SPC IP Final No.41

Key point: When determining the technical field of a utility model patent, the technical solution defined by the claims shall be taken as the object, the title of the subject matter as the starting point, and the function and use of the patented technical solution shall be comprehensively considered. A technical field that is similar to the function and use of the patented technical solution constitutes a similar technical field in the technical field of the patent; The technical field in which the technical features of the patented technical solution and the those closest to the prior art are applied constitute the relevant technical field in the technical field of the patent.

18. Whether the use-defined title of the subject matter has an actual defining effect on the scope of protection of the utility model patent

【Case No.】 (2021) SPC IP Final No.847

Key point: Whether the use-defined title of the subject matter of a utility model patent has an actual defining effect on the scope of protection of the claims shall be comprehensively determined in light of the type of utility model patent, taking into account the relationship between the title and the technical solution defined by the claims, and whether the title of the subject matter has a substantial impact on the shape and structure of the subject matter itself.

19. Impact of the coordinating and cooperative relationship of the distinguishing technical features with other technical features on the determination of motivation for improvement

【Case No.】(2021) SPC IP Final No.1226

Key point: In determining inventiveness, if there is a coordinating and cooperative relationship between the claimed technical solution and the distinguishing technical features of the closest prior art and other technical features, the technical effects produced by the distinguishing technical features and the technical problems solved by the distinguishing technical features are based on premise of the technical effect of the other technical features, and the corresponding technical features in the closest prior art are unlikely to produce the same technical effects based on the purpose of the invention and the inventive conception, then those skilled in the art will not usually have the motivation to improve in the face of the prior art. The claimed technical solution is not obvious to those skilled in the art.

20. Technical enlightenment of the substitution between chemical pharmaceutical ingredients and traditional Chinese medicine ingredients in the invention of pharmaceutical compositions

【Case No.】(2021) SPC IP Final No.593

Key point: When judging whether there is a technical enlightenment for the substitution between the chemical components and the components of traditional Chinese medicine in the invention of a pharmaceutical composition, it is usually necessary to consider not only the inherent effect of the pharmaceutical ingredients, but also the relationship between them and other pharmaceutical components in the pharmaceutical composition.

21. Application of the principle of bioelectronic isotropism to the inventiveness determination

【Case No.】(2021) SPC IP Final No.846

Key point: To determine whether the substitution between two groups in a drug compound is common knowledge in the art, the principle of bioelectronic isotropism can usually be considered. However, for non-classical bioelectronic isosterages, whether a person skilled in the art will carry out a specific group substitution usually requires the prior art that can prove the structure-activity relationship of such drugs as evidence, and the application of the concept of bioelectronic isosterone should not be arbitrarily expanded.

22. Determination of inventiveness of patent relating to acupuncture

【Case No.】(2022) SPC IP Final No.132

Key point: In the evaluation of the inventiveness of traditional Chinese medicine patents relating to acupuncture and moxibustion, the cognitive characteristics of those skilled in the art and the laws of traditional Chinese medicine treatment should be combined to identify and distinguish the technical features and prudently judge whether the technical solution is obvious, especially any simplistic application of evaluation methods for modern medical technology should be avoided, and the degree of innovation of the technical

solution of traditional Chinese medicine should not be underestimated.

23. Determination of prior design disclosure time

【Case No.】 (2022) SPC IP Final No.393

Key point: In the absence of other evidence to support it, the "date of manufacture" indicated on the nameplate on the existing design evidence usually should not be directly identified as the "date of disclosure of sale" or "date of disclosure of use".

24. Determination of whether the design is clearly different

【Case No.】 (2022) SPC IP Final No.567

Key point: If the patented design is only the design features of different parts of the same reference design on the same type of product, and the usual design techniques, such as centering and symmetry, are used to assemble or replace it, it can generally be considered that the patented design and the reference design are only slightly different, and generally do not have a unique visual effect.

25. Determination of enlightenment from combination of existing design features

【Case No.】 (2022) SPC IP Final No.821

Key point: If the combination of existing design features to form a patented design requires major changes and adjustments, such as cohesion and echoing, transition and coordination, to form a harmonious whole with appearance and function, it can generally be considered that the combination process is beyond the knowledge level and cognitive ability of the average consumers, and it is difficult to think of combining such design features, and it can be determined that the existing design does not offer enlightenment or inspiration on the combination.

26. Determination of prior lawful rights in paragraph 3 of Article 23 of the Patent Law

【Case No.】 (2023) SPC IP Final No.42

Key point: In an administrative dispute over the grant and confirmation of a design patent, the rights or interests that have been obtained before the filing date of the present patent and still lawfully exist at the time of filing the request for patent invalidation may constitute prior lawful rights as provided for in paragraph 3 of Article 23 of the Patent Law.

27.Plaintiffship of interested party to a patent ownership dispute in patent confirmation administrative case

【Case No.】 (2023) SPC IP Final No.836

Key point: After the patent administration department declares the patent claims invalid in whole or in part, if the party claiming the right in a patent ownership dispute case initiates an administrative lawsuit for patent confirmation, it may be determined that he or it constitutes a potential interested party in the decision on the

review of the invalidation request at issue, and it is not appropriate to rule to dismiss the lawsuit simply on the grounds that the plaintiff is not qualified; Whether a party constitutes a qualified plaintiff in an administrative lawsuit for patent right confirmation depends on the outcome of the trial of a patent ownership dispute case, and if the patent ownership dispute has not been substantively resolved, the trial of the administrative lawsuit for patent right confirmation may be suspended in light of the circumstances.

28. Determination that the invalidation review proceedings violates the principle of hearing

【Case No.】 (2021) SPC IP Final No.888

Key point: Where the requester for invalidation only asserts that the patent does not have novelty and therefore does not have inventiveness, and does not put forward other specific reasons on the lack of inventiveness of the patent, and the patent administration department does not inform the patentee of other specific reasons regarding the lack of inventiveness of the patent, nor does it give the patentee an opportunity to state his or its opinions on such specific reasons, and directly determines that the patent is novel, but not inventive, and the patentee claims that the examination procedure for invalidation violates the principle of hearing, and constitutes a violation of statutory proceedings, the people's court shall support the claim.

29. Legal consequences of patent agency or patent attorney requesting invalidation of a patent in the name of another person

【Case No.】 (2022) SPC IP Final No.716

Key point: Where a patent agency or patent attorney requests the invalidation of a patent in the name of another person, it constitutes a substantial violation of Rule 18 of the Patent Agency Regulations which stipulates that a patent right shall not be invalidated in one's or its own name, and the people's court may transfer the clues of the suspected violation to the relevant authorities for handling in accordance with the law.

II. Patent ownership and infringement cases

30. Effect of limiting or restrictive statement on the scope of protection of other claims citing the limited claims

【Case No.】 (2022) SPC IP Final No.681

Key point: When the patentee makes a interpretation of a claim during the invalidation request examination proceedings, even if the claim is ultimately declared invalid, the relevant limiting interpretation is still applicable to other claims that cite the claim.

31. Determination and impact of induced evidence collection

【Case No.】 (2022) SPC IP Final No.2586

Key point: Where a patentee directly provides a

drawing containing the complete technical solution of the patent involved in the case to another person, and requires him to manufacture in accordance with the drawing, without declaring that it involves its patent, it constitutes an act of collecting evidence that induces others to infringe the patent right at issue, and the people's court shall not determine the fact of infringement solely on the basis of such evidence.

32. Determination of the person liable for infringement when the combined use of a product falls within the scope of patent protection

【Case No.】 (2021) SPC IP Final No.2270

Key point: Where different products manufactured by the same entity can be used in combination, and the combined use falls within the scope of patent protection, the person liable for infringement shall be determined on the basis of the technical solution actually formed at the time of use, focusing on whether the formation of the technical solution is decided by the consumer or the manufacturer. If the relevant products could have been used separately, but the consumer combined them for use according to their own needs, it can generally be determined that the technical solution of the combined product is decided by the consumer, and the manufacturer should not be taken as the person liable for infringement. If the relevant products cannot be used separately but must be used coordinately with each other, and the consumer combines them together according to the specific structure, function, instructions for use, etc., it can generally be determined that the technical solution of the combined product is decided by the manufacturer, and the manufacturer should be taken as the person liable for infringement.

33. Determination of manufacturer of allegedly infringing product

【Case No.】 (2021) SPC IP Final No.2301

Key point: The manufacturer of a product in the sense of the Patent Law does not only refer to the performer of a specific manufacturing act. The organizer who organizes production resources, coordinates upstream and downstream production links, and determines the technical solution of the product may also constitute the manufacturer of the allegedly infringing product.

34. Determination of e-commerce platform's display content and manufacturing act

【Case No.】 (2022) SPC IP Final No.2021

Key point: The people's court may comprehensively consider the labeling of the product model, place of origin, and quantity, as well as descriptions such as "factory direct sales" in the product sales links displayed by the accused infringer on e-commerce platforms, and reasonably presume that the allegedly infringing products were manufactured by him or it.

35. Determination of equivalence of numerically-defined technical features

【Case No.】 (2021) SPC IP Final No.985

Key point: It is not appropriate to absolutely exclude the application of the doctrine of equivalence to the technical features of invention or utility model patents that are defined by numerical values or continuously changing numerical ranges, but they should be stringently restricted. When the numerical value or numerical range with differences is basically the same technical means to perform substantially the same function, and achieve substantially the same effect, and those skilled in the art can associate it without creative labor, and, at the same time, if it is determined that the relevant technical features are equivalent and do not violate the reasonable expectations of the public for the scope of protection of the claims, and can fairly protect the patent right, it may be determined that the relevant technical features constitute equivalent technical features after comprehensively considering such relevant factors as the technical field, type of invention, and content of the amendment to the claims.

36. Consideration of distinguishing design features of patents in design similarity determination

【Case No.】 (2021) SPC IP Final No.728

Key point: When determining the similarity of the patented design and the allegedly infringing design, the design features of the patented design that are different from the existing design shall be determined, and such features shall be considered as the part that has more impact on the overall visual effect of the design. The parties may provide evidence or explain the above-mentioned distinguishing design features; where the parties' evidence or explanations are insufficient, the people's court would determines the distinguishing design features based on the knowledge level and cognitive ability of the average consumers.

37. Treatment of user's or seller's non-infringement counterclaim based on manufacturer's prior use right

【Case No.】 (2022) SPC IP Final No.839

Key point: Where the use, offer to sell, or sale of a product manufactured by the prior user right holder in accordance with the law after the filing date of the patent, and the user or seller claims non-infringement of the patent on the ground of the manufacturer's prior use right, the people's court shall support the claim.

38. Determination of lawful source defence in the lease relationship

【Case No.】 (2022) SPC IP Final No.2869

Key point: If the accused infringer can submit evidence to prove that the infringing product was leased to him or it and the leasing term has not expired, and that it has paid a reasonable rent and does not know and should not know that the product is an infringing product, the people's court may determine that his or its lawful source defense is established.

39. Determination of infringement cessation liability during patent assignment in patent infringement litigation

【Case No.】(2022) SPC IP Final No.1923

Key point: During the trial of a patent infringement dispute case, if the original patentee assigns or transfers the patent right involved in the case, its qualification as a party to the litigation will not be affected. If the people's court finds that the allegedly infringing act constitutes infringement, it shall support the original patentee's litigant claim to cease the infringement under the law, unless the accused infringer can prove that it has obtained permission from the current patentee.

40. Calculation of damages for patent infringement by non-publicly sold products

【Case No.】(2022) SPC IP Final No.1584

Key point: The goal of damages for patent infringement is to restore the patent right owner to the state it should have been in if the infringement had not happened, for the purpose to maintain the momentum for innovation. For products that are not publicly sold, since the infringement damages cannot be directly calculated through their market sales, the products related to the exploitation of the patented technical solution and the most direct link to obtain market benefits can be used as a reference basis for the calculation of infringement damages according to the specific circumstances of the case.

To Be Continued ...

(Source: official website of BIPC)

Strategy for Filing Applications in Respect of Non-standard Goods Items

In trademark practice, Goods and services recorded in the Classifications of Similar Goods and Services (Classifications for short) and items of goods acceptable in online applications are usually referred to as the standard goods items, while those not presented in the Classifications as the non-standard goods items.

The non-standard goods items mainly refer to products or service models arising out of the market developments.

However, in practice, it is easy to receive a notice of correction or even a notice of non-acceptability for a non-standard goods application, which makes the applicant tend to substitute it with a standard goods item in the application, but this practice would make it impossible for the applicant's emerging product or service model to be truly protected, thus damaging the rights due to the failure to protect the product or service model in future cases of revocation, invalidation and/or infringement.

To avoid this situation, if the applicant needs to specify a non-standard goods item in the application, he or it should describe the goods as clearly and accurately as possible, so as to enable the examiner to understand its specific function and classify it. If it is indeed difficult to describe clearly, consider replacing it with a combination of the superordinate concept of a standard goods item and its closest subordinate concept. If you are unsure which specific class the emerging goods item belongs to in the current Classifications, you may consider filing an application in respect of a goods of similar class to keep the trademark right viable and prevent others from preemptively file an application for it.

In short, in case of non-standard goods items, applicants should not use inappropriate substitutes for fear of receiving a notice of correction, as this practice is not conducive to protecting their rights and to promoting the improvement and perfection of the Classifications.

Back Cover: Exterior of office block where Panawell locates

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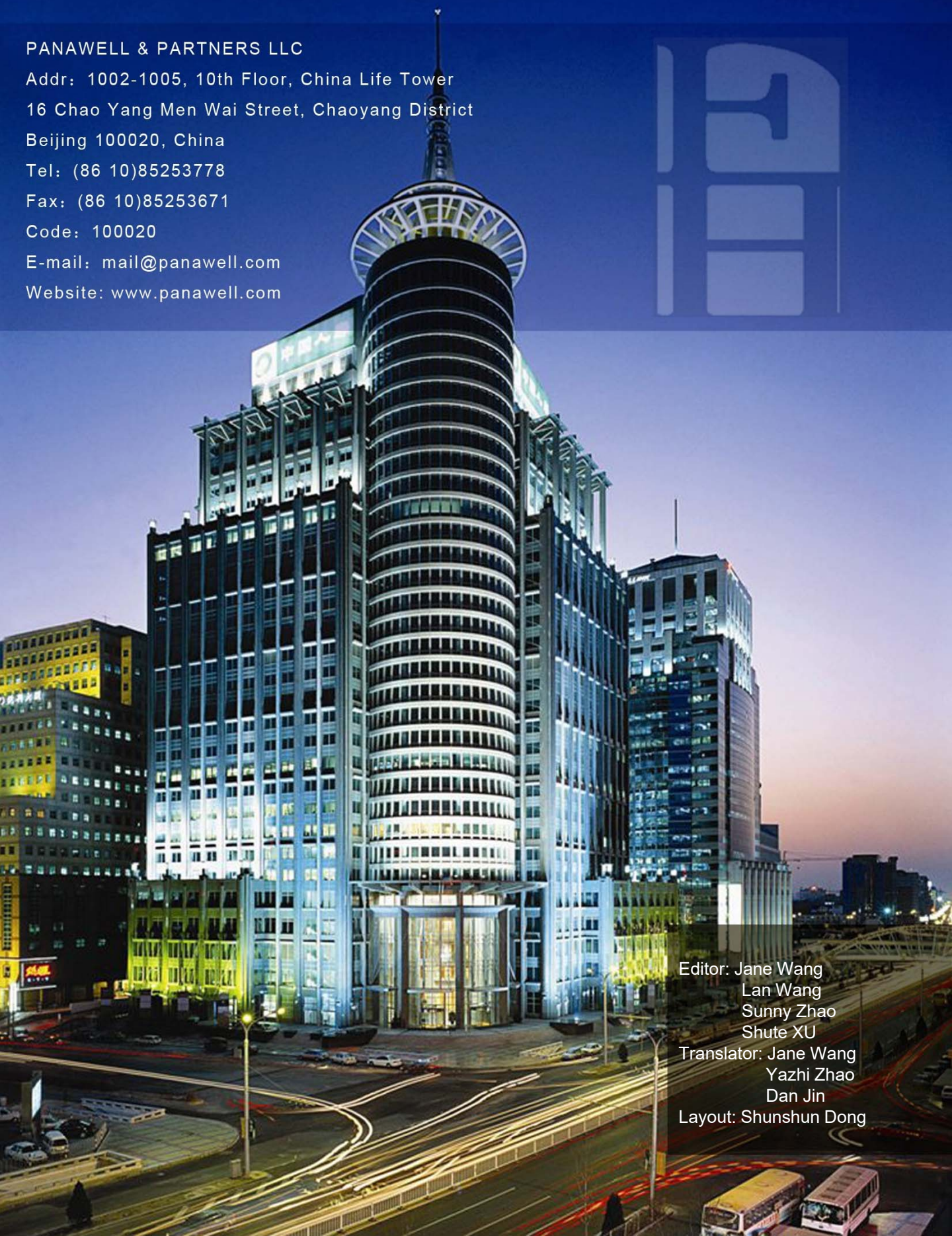

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