



二零一九年五月五日

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主题: 《专利审查指南修改草案(征求意见稿)》反馈意见

尊敬的宋司长您好:

美国知识产权所有人协会(下称“IPO协会”)感谢国家知识产权局提供的对2019年4月9日发布的《专利审查指南修改草案(征求意见稿)》(下称“《草案》”)提交意见的机会。

IPO协会是一家代表各行业、各技术领域内拥有知识产权或相关权益的公司和个人的国际性行业协会。它拥有大约两百家会员以及超过一万两千多名个人会员。这些个人会员有些从属于公司会员或律所成员,有些是发明人、作者或律师会员。IPO协会的会员遍及三十多个国家。

IPO协会提倡有效和实惠的知识产权,为会员提供广泛的服务,包括支持会员在立法和国际事务中的利益、分析当前知识产权问题、提供教育和信息服务、以及向公众传播知识产权的重要性。

IPO协会感谢国家知识产权局在提高专利质量和审查流程方面所做的努力。我们的反馈意见如下。

第一部分第一章 5.1.1 (3) & 5.1.1 (4)

IPO协会感谢《草案》中对再次分案申请递交时间的澄清。在目前的《审查指南》中,基于前一分案申请存在单一性的缺陷而提出的再次分案申请被当作一个例外,但没有明确指出再次分案申请可以递交的时间。

《草案》中说明了再次分案申请的递交时间应当根据存在单一性的缺陷的分案申请(即按照5.1.1(3)第一二段所述的,收到专利局对分案申请作出授予专利权通知书之日起两个月内,收到驳回决定之日起三个月内,在提出复审请求以后以及对复审决定不服提起行政诉讼期间)。我们也恳请国知局考虑另一个与其他IP5专利局更接轨的方案,即只要有同族专利(不限于最早提交的原申请)还在申请状态中,就允许提交分案申请。

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我们也很乐于见到对再次分案申请人与前分案申请人(而不一定是目前《审查指南》中所述的原申请人)一致的澄清。《草案》中提出分案申请人不符合规定的分案申请将被视为未提出。因为公司申请人常常会因为公司内专利(或申请)权移交或并购等原因发生变化,而著录项目变更手续需要一定的时间,我们恳请国知局在这一段中加入如下允许补正的规定:

5.1.1 (4) 分案申请的申请人和发明人

分案申请的申请人应当与提出分案申请时原申请的申请人相同。针对分案申请提出再次分案申请的申请人应当是该分案申请的申请人。不符合规定的, 审查员应当发出补正通知书, 通知申请人补正。期满未补正的, 审查员应当发出分案申请视为未提出通知书。

第一部分第三章第4节

对于第一部分第三章第4节的修改, IPO协会支持4.4.2中对于设计要点仅在于图形用户界面的, 将所需要的视图缩减为只需要提交图形用户界面所涉及面的一幅正投影产品视图。这一修改将保护适当地着重于图形用户界面上, 朝着认同图形用户界面设计脱离于对产品设计的依赖而成为独立的设计类别迈出了一大步。IPO协会也鼓励国知局允许申请人不依赖于装置而仅对图形用户界面提出权利要求, 或者允许对显示屏幕上的图形用户界面提出权利要求。

IPO协会不支持对4.4.1 and 4.4.3的修改, 即要求设计名称中包括图形用户界面的主要用途以及在简要说明中清楚说明图形用户界面的用途。我们认为图形用户界面的外观设计应当主要按照图片来界定保护范围, 因为外观设计权利保护的是图形用户界面的美观而不是功能或用途。此外, 额外增加对用途说明的要求会不必要地使得外观设计专利的撰写和审查以及专利权的界定更加复杂化, 对于要求国外(如美国)优先权的申请也会增加很多不必要的修改工作。

在上述基础上, 如果《审查指南》最终被修改为要求对图形用户界面用途的说明, 我们督促国知局将对这些用途说明的使用限制于行政功能(例如用于帮助检索和分类), 并表明这些额外的说明并不限制外观设计权利要求的保护范围。

第二部分第四章 3.2.1.1

确定创造性的三步骤中的第二步是需要确定发明实际解决的技术问题。为了确保审查员不会无视说明书中的语句或者申请人的回复而随意确定发明的区别特征所实际解决的技术问题, IPO协会诚挚地建议对第一部分第三章 3.2.1.1(2)作以下修改:

第二部分第四章

3.2.1.1 判断方法

...

(2) 确定发明的区别特征和发明实际解决的技术问题

在审查中应当客观分析并确定发明实际解决的技术问题。为此，首先应当分析要求保护的发明与最接近的现有技术相比有哪些区别特征，然后根据该区别特征在要求保护的发明中所能达到的技术效果确定发明实际解决的技术问题。在确认实际解决的技术问题时，除非有其他证据能证明不同，应优先考虑发明人在说明书中写明的以及在答复审查意见书时说明的。从这个意义上说，发明实际解决的技术问题，是指为获得更好的技术效果而需对最接近的现有技术进行改进的技术任务。

第二部分第四章 6.4

IPO 协会建议取消对第二部分第四章 6.4 的修改。《草案》加入了“权利要求中对技术问题的解决没有作出贡献的技术特征，对评价权利要求限定的技术方案是否具备创造性不产生影响”。这一语句意味着被认定为对技术问题的解决没有作出贡献的技术特征将在审查中不对专利性产生影响。

首先，目前的《审查指南》并未对审查员确定技术方案的广度做出规定。这就是说，《审查指南》意指审查员可以认定技术方案与说明书中写明的不同。虽然《审查指南》中要求技术方案由权利要求定义，但审查员还是有可能无视已被发明人定义为与技术方案有关的权利要求限定，而将实际审查限制于某些与说明书中表述为技术方案并不一致的权利要求限定。

其次，各国的惯例都是在权利要求中包括与技术方案直接相关的技术特征，同时也包括本技术领域更通用一些的技术特征。将后者当成了与“改进的技术问题无关”的“固有部件”。然而，为了实现与技术方案《草案》直接相关的技术特征，往往要先建立起必要的技术环境、条件、和系统，这些所谓的“固有部件”正是建造了用于正确完整地审查确立权利要求范围的必要结构。

举例而言，考虑这样一个权利要求：它保护的是一个包含 A 型发动机、B 型变速箱、和 C 型控制单元的引擎系统。控制单元是与技术方案直接相关的技术特征，也就是确定创造性的基础。在本技术领域中，权利要求中的具有权利要求所述控制功能的控制单元只能在 A 型号发动机和 B 型变速箱上实现。权利要求所述的控制单元不能在其他型号的发动机和变速箱上实现技术方案。此外，权利要求中所述的技术问题在其他型号的发动机和变速箱上不存在。因此，对这一权利要求正确的审查就需要考虑包含 A 型号发动机和 B 型变速箱的整体系统。然而，根据《草案》的修改，审查员可以选择无视 A 型号发动机和 B 型变速箱的限定。这样的实操会使得审查员更有可能基于不合适的现有技术文献做出驳回意见。

此外，确定创造性的三个步骤要求考虑权利要求中全部的特征，无视所谓的“固有部件”与此要求不符。

第二部分第八章 4.10.2.2 (4)

IPO 协会很高兴地看到《草案》中要求审查员在申请人对引用的公知常识提出异议时提供相应的证据表明此公知常识是确凿的。我们建议，为了让语义更明确，在句子中加入“基于相应的证据”，以表明审查员说明理由也需要提供证据。另外，我们认为审查员将权利要求中对技术问题的解决作出贡献的技术特征认定为公知常识时，应该提供证据，这个要求是公平合理的。

据上，IPO 协会诚挚地建议对第二部分第八章 4.10.2.2 (4) 作如下修改：

4.10.2.2 审查意见通知书正文

(4) ...

审查员在审查意见通知书中引用的本领域的公知常识应当是确凿的，如果申请人对审查员引用的公知常识提出异议，审查员应当能够提供相应的证据予以证明或基于相应的证据说明理由。在审查意见通知书中，审查员将权利要求中对技术问题的解决作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。

第二部分第七章 6.2.3

IPO协会理解在类似技术领域中进行扩展搜索的必要性。我们注意到《草案》中提出了扩展搜索可以在功能类似的技术领域，这意味着在扩展搜索中发明的结构环境和整体系统可能得不到应有的考虑。此类的扩展搜索如果和《草案》中第二部分第四章6.4所造成的对“固有部件”的忽视联合起来，会造成审查中对权利要求的释义进行不合理的拓宽。具体来说，权利要求中的系统中技术上新颖的特征可能会仅仅基于功能而因为一个在其他技术领域完全不同的系统被驳回。因此，我们诚恳地建议对第二部分第七章6.2.3作以下修改：

6.2.3 扩展检索

...

在功能类似的技术领域进行的扩展检索，应当考虑权利要求中的以及说明书中描述的技术问题，技术方案，以及实现此功能所必须的结构。

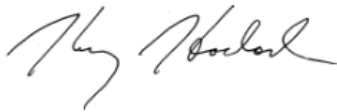
第四部分第三章 3.3

《草案》中提出，在无效宣告程序中，请求人对涉案专利和对比文件的技术方案的比较分析时，如果是结合对比，存在两种或者两种以上结合方式的，应当“首先将最主要的结合方式进行比较分析”。IPO 协会对这一要求表示不赞同，因为它不仅不必要，还过于简化了很多无效宣告请求中的创造性分析。在很多情况下，对比文件的多种结合都同样重要，同样值得审查员的重视。我们担心这一修改会使得审查员不够重视甚至忽视很多重要的对比文件结合。因此，我们诚挚地建议取消对第四部分第三章 3.3 的修改。

随信附上本信的翻译版本。IPO 协会再次感谢国家知识产权局给予此次机会提出反馈意见。我们也非常愿意进一步交流或能有机会提供更多的信息。

此致

美国知识产权所有人协会谨启



Henry Hadad
主席

附件：IPO 协会对《专利审查指南修改草案（征求意见稿）》的反馈意见(英文版)



5 May 2019

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Re: *Comments on Draft Patent Examination Guidelines (for Public Comments) (April 9, 2019)*

Dear Chairman Song:

Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the request for comments on the Draft Patent Examination Guidelines (for Public Comments) ("Draft") dated 9 April 2019.

IPO is an international trade association representing companies and individuals in all industries and fields of technology who own, or are interested in, intellectual property ("IP") rights. IPO's membership includes about 200 companies and close to 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO membership spans over 30 countries.

IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP rights.

IPO commends the China Intellectual Property Administration (CNIPA) for its efforts in improving patent quality and examination process. Our comments are as follows.

Part 1, Chapter 1, Sections 5.1.1 (3) and 5.1.1 (4)

IPO welcomes the clarification about the filing date of a second divisional application. In the current version of the Examination Guidelines, the filing of another divisional application based on a unity defect of an already-filed divisional application is treated as an exception, in that the filing date does not need to be based on the status of the original application. However, the Examination Guidelines do not specify when the second divisional application can be filed. The proposed amendment in the Draft specifies that the filing date of the second divisional application is based on the already-filed divisional

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application (*i.e.*, within 2 months of receiving a Notice to Grant Patent Right, within 3 months of receiving a Decision of Rejection, or during the pendency of a Reexamination, as provided in the first and second paragraphs of 5.1.1 (3)). As an alternative, CNIPA might consider harmonizing its divisional practice with that of the other IP5 Patent Offices, which generally have no limitation on when to file a divisional as long as there is a pending family member (not necessarily the very first parent case).

Similarly, we welcome the clarification about the applicant of another divisional application being the same as that of the existing divisional application (rather than that of the original application, as stated in the current Examination Guidelines). However, the proposed amendment in the Draft states that inconformity with this provision would result in the (newly-filed) divisional application being deemed as not having been filed. Because it is common for company applicants to change title (due to, for example, intra-company assignments, mergers and acquisitions), and because the recordation of title change takes time, we recommend adding language to this paragraph to allow for rectification as shown below.

The applicant of a divisional application shall be the same as that of the initial application when the divisional application is filed. The applicant who files another divisional application based on an already filed divisional application shall be the applicant of the divisional application. Where there is any inconformity with the provisions, the examiner shall issue the Notification to Make Rectification notifying the applicant to make rectification. Where no rectification is made within the time limit, the examiner shall issue the Notification that Divisional Application Deemed Not to Have Been Filed.

Part 1, Chapter 3, Section 4

With respect to the proposed amendment in Part 1, Chapter 3, Section 4, IPO supports the proposed change in Section 4.4.2 to reduce the required views to only one orthographic projection view when the essential features of the design lie only in the graphical user interface. This change will more appropriately focus protection on the graphical user interface, and is a step toward design protection that more appropriately recognizes graphical user interface design as an independent field of design endeavor by reducing its subordination to product design. IPO also encourages CNIPA to allow applicants to claim a graphical user interface alone, independent of a device, or to claim a graphical user interface for a display screen.

IPO does not support the proposed changes to Section 4.4.1 and 4.4.3 of Part I, Chapter 3, which would require that the use of a graphical user interface be included in the name of a design and that the application include an explanation of this use. IPO believes that the design should be interpreted primarily based on the drawings because a design right protects the aesthetics of a graphic user interface, not the function nor use. Furthermore, introducing additional requirements for explanation can needlessly complicate preparation and examination of the design application, as well as interpretation of the design after it has patented. The requirements would also result in more and unnecessary amendment work for design applications claiming foreign, such as U.S., priorities.

Nevertheless, if a change to the Guidelines is made that requires additional description or explanation of a design, IPO urges CNIPA to limit the use of such additional description or

explanation to only administrative functions (such as facilitating search and classification), and to specify that the additional description or explanation does not limit the scope of the design.

Part 2, Chapter 4, Section 3.2.1.1

The 3-step process for determining inventiveness requires in step 2 determining the technical solution actually solved by the invention. To prevent the examiner from arbitrarily asserting a technical problem to be solved by a distinguishing feature by ignoring the recitation in the specification and in the response from the applicant, IPO respectfully suggest amending Part 2, Chapter 3, 3.2.1.1 (2), second paragraph as follows.

During examination, the examiner shall objectively analyze and determine the technical problem actually solved by the invention. For this purpose, the examiner shall first determine the distinguishing features of the claimed invention as compared with the closest prior art and then determine the technical problem that is actually solved by the invention on the basis of the technical effect of the distinguishing features in the claimed invention, with priority given to the technical problem solved by the invention recited in the specification, and/or pointed out by the applicant in a response to an examination report, unless otherwise proven. The technical problem actually solved by the invention, in this sense, means the technical task in improving the closest prior art to achieve a better technical effect.

Part 2, Chapter 4, Section 6.4

IPO submits that Chapter 4.6.4 not be amended as proposed. Specifically, the Draft states that “technical features in the claims which have not made contribution over the solution of the technical problem do not influence the determination of whether the technical solutions as defined in the claims involve an inventive step.” This language implies that technical features deemed to make no contribution to the solution of the technical problem will not be afforded patentable weight during examination.

First, the current Guidelines make no provision with regards to the breadth of the examiner’s determination of the solution to the technical problem. In other words, the Guidelines imply that the examiner may determine the technical solution to be different from that which is set forth in the specification. The current Guidelines do set forth that the determination of the technical solution will be the solution that is defined in the claims. However, under the current Guidelines, the examiner may still restrict substantive examination to certain select claim limitations that may not conform to the technical solution described in the specification, while ignoring claim limitations that the applicant has defined to be directed to the technical solution.

Second, it is common practice in all countries for claim language to recite features that are directed to the proposed technical solution in conjunction with recitations of more generic features of the technology. The Draft refers to the latter as “inherent parts” which “have no relevance to the technical problem regarding the improvement.” These are oftentimes necessary, however, to establish a technical environment, condition, or system that enables the features directed to the technical solution to be realized. Therefore, these “inherent parts” create the necessary structure that sets up the metes and bounds of the claim for well-directed and thorough examination.

For example, consider a claim directed to an automobile engine system having a Model A Motor, a Model B Transmission, and a Model C Control Unit. The Control Unit is the technical feature directed to the technical solution for which an inventive step will be determined. In this technical field, the claimed Control Unit having the types of claimed control functions can only be implemented with the Model A Motor and the Model B Transmission. The technical solution of the claimed Control Unit cannot be realized with a different type of motor or transmission. Furthermore, the technical problem recited in the claims does not occur in a different type of motor or transmission. Therefore, the consideration of the overall system having the Model A Motor and Model B transmission is necessary for proper examination of this claim. However, under the proposed revised Guidelines, the examiner could choose to ignore the limitations directed to the Model A Motor and the Model B Transmission. This practice would increase the likelihood of prior art rejections based on inappropriate prior art references.

Additionally, ignoring “inherent parts” is not consistent with the three-step rule for inventiveness determination, which requires all the features to be considered.

Part 2, Chapter 8, Section 4.10.2.2 (4)

IPO welcomes the proposed amendments that require evidence be provided for irrefutable common knowledge relied on by the examiner when the applicant objects to the common knowledge. To further reduce ambiguity, we propose adding “based on such evidence” to clarify that evidence is also needed to support the examiner’s stated reasoning. Additionally, we consider it to be fair and reasonable to require the examiner to provide evidence when a technical feature contributing to the solution of the technical problem is deemed common knowledge.

Therefore, IPO respectfully recommends that paragraph 5 of Section 4.10.2.2 (4) be revised as follows:

<p>The common knowledge of the art cited in the Office Action by the examiner shall be irrefutable. Where the applicant has objections to the common knowledge cited by the examiner, the examiner shall provide corresponding evidence for proof or state the reasons <u>based on such evidence</u>. In the Office Action, where the examiner takes the technical features in claims which have made contribution over the solution of a technical problem as common knowledge, the evidence for proof generally shall be provided.</p>

Part 2, Chapter 7, Section 6.2.3

IPO recognizes that extended search into analogous technical fields may be required for thorough examination. However, the Draft stipulates that the extended search can be conducted in terms of function. The proposed amendment implies that the structural environment of the claimed invention and the overall system might not be considered in the extended search. This type of extended analogous field search for function, implemented concurrently with the proposed amendment to Part 2, Chapter 4, Section 6.4 in which the examiner can choose to ignore “inherent parts,” will create unreasonably broad claim interpretations during examination.

Namely, technologically novel features for a claimed system could be rejected in view of a wholly different system of an unrelated field entirely based on function. Therefore, IPO respectfully recommends the following addition to the end of Section 6.2.3.

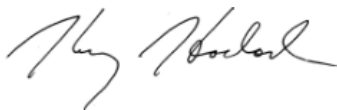
The extended search based on analogous function should take into account the technical problems, solutions and any and all structure of the claims as recited and/or described in the application specification as necessary to carry out the function.

Part 4, Chapter 3, Section 3.3

The proposed amendment adds a provision that, when analyzing inventiveness by using two or more combinations of prior art references in an Invalidation Petition, the petitioner should “first analyze and compare the most important combination.” IPO does not support the proposed change. This provision is unnecessary and is an undue simplification of inventiveness analyses in many invalidation petitions. In many situations, the different combinations of prior art references are equally important and deserve equal attention from the examiners. We fear that this revision could lead the examiners to not sufficiently consider, or even to disregard, many important combinations of prior art references. Therefore, IPO respectfully recommends that Part 4, Chapter 3, Section 3.3 not be amended.

Attached please find this letter as translated. We again thank you for permitting IPO to provide comments and would welcome any further dialogue or opportunity to provide additional information.

Sincerely,



Henry Hadad
President

Attachment