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主题: 《专利审查指南修改草案(第二批征求意见稿)》

致中国国家知识产权局:

美国知识产权所有人协会(下称“IPO协会”)感谢有机会对2020年11月10日发布的《专利审查指南修改草案(第二批征求意见稿)》(下称“《修改草案》”)提交意见。

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。它拥有一百七十五家公司会员以及大约一万两千名个人会员。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、提供信息和教育服务、以及向公众传播知识产权的重要性。

IPO协会感谢《修改草案》旨在关注中国经济和技术的快速发展带来的对审查规则的日益增长的需求,并且旨在提高专利审查的质量和效率。我们欢迎对专利审查的实践考量给予详尽的关注,并希望我们的以下意见对《修改草案》的定稿过程有帮助。

## 总体意见

IPO 协会认可中国国家知识产权局（下称“CNIPA”）在《修改草案》中为简化流程和减少形式要求而做出的大量努力。这对提高专利审查效率是一个积极的发展，特别是考虑到中国专利申请量的大幅增长。

与此同时，我们注意到，该《修改草案》中删除了一些案件示例。IPO 协会认为，在为专利审查员提供明确性方面，以及在指导申请人实现更高质量的申请（和权利要求）撰写方面，说明性示例具有重要作用。因此，IPO 协会更倾向于在合适的情况下将说明性示例包括在审查指南中。

关于计算机程序的可专利性（例如，在“第二部分第 9 章第 2 节 - 涉及计算机程序的发明专利申请的审查基准”中），对用以判断申请中是否包含适当客体的多项要求，专利审查指南似乎进行了实质性的改变。对此，IPO 协会持保留态度。实质上，此类判断是政策立场；而且，IPO 协会认为，仅仅在这些修改一致地反映了法律或法规的更高阶修改的情况下，才应该进行这样的实质性修改，所述法规例如在 2020 年 11 月 27 日发布并公开征求意见的《专利法实施细则草案》（下称“《实施细则草案》”）。特别是，我们注意到《实施细则草案》并未建议体现这样的实质性修改，因此，我们认为，这些修改不应出现在专利审查指南草案中。

## 第二部分第二章第 3.2.1 节 - 以说明书为依据

### 权利要求的支持

IPO 协会注意到，第 3.2.1 节规定，审查员应以第二十六条为由提出得不到支持的审查意见。我们认为，要求审查员说明为什么得不到说明书支持的理由是有益的。这将提供充分完整的审查意见的记录。而且，这将使申请人充分理解审查意见的理由，从而适当地回应所提出的审查意见。为此，我们建议在 3.2.1 节中增加以下内容：

如果权利要求的概括使所属技术领域的技术人员有充分理由怀疑该上位概括或并列概括所包含的一种或多种下位概念或选择方式不能解决发明或者实用新型所要解决的技术问题，并达到相同的技术效果，则应当认为该权利要求没有得到说明书的支持。对于这些情况，审查员应当根据专利法第二十六条第四款的规定，**以提出权利要求得不到说明书的支持的审查意见为理由，并提供得不到支持的理由，并要求申请人修改权利要求。**

### 功能性权利要求

从功能而非结构上定义发明要求确立清晰的参数，通过这些参数可以解释功能性权利要求。通过在说明书中提供充分的公开以表明该功能语言的含义，从而实现这样的解释。否则，功能语言过于宽泛和模棱两可，将导致专利成本（公开范围）和专利回报（权利要求范围）之间的不平衡。

过于宽泛和模棱两可的功能性权利要求的顾虑是，即使没有发明任何实现该功能的手段或是仅仅发明了很少的手段，此类权利要求也涵盖了全部期望获得的范围（执行该功能的任何和所有手段）。在此提供一个美国专利实践中的示例，在 1853 年美国最高法院的一项判决中，该案中的发明人发明了电报，并得到了可以涵盖无线电的、保护范围大的权利要求，但发明人并没有发明无线电<sup>1</sup>。差不多一百年后，美国最高法院在 1946 年再次认为，功能性的权利要求撰写产生了保护范围过大的权利要求<sup>2</sup>。随后，美国国会修改了专利法从而形成了一项法律，该法律即是现在的 35 U.S.C. 112(f)。这一修改允许权利要求仅列举功能，但条件是该权利要求将限于专利所公开的用于执行该功能的手段及其等同物。这恢复了专利制度中成本和回报之间的平衡。出于同样的原因，IPO 协会建议在本节中增加一句关于功能性权利要求的解释，如下所示：

通常，对产品权利要求来说，一般使用结构特征来限定发明。在某一技术特征无法用结构特征来限定，或者技术特征用结构特征限定不如用功能或效果特征来限定更为恰当，而且该功能或者效果能通过说明书中规定的实验或者操作或者所属技术领域的惯用手段直接和肯定地验证的情况下，可以使用功能或者效果特征来限定发明。功能性权利要求的要素应解释为仅覆盖专利说明书所公开的、执行要求保护的函数的结构特征及其等同物。

## 第二部分第三章第 5 节 - 不丧失新颖性的宽限期

IPO 协会希望澄清，他人何时未经申请人同意而露了发明的内容，第三人知悉了前述发明并随后再次公开了这些内容，将能够适用专利法(第四次修订)**第 24 条第 4 款**（而不是第 24 条第 3 款）规定的给予申请人的六个月的宽限期。

## 第二部分第九章第 2 节 - 涉及计算机程序的发明专利申请的审查基准

关于判断发明是否记载了适当的客体以保护计算机程序，IPO 协会希望在以下各项问题上寻求进一步的明确性。<sup>3</sup>

### 明确性

对于与计算机程序有关的申请的审查，IPO 协会注意到三个主要问题。第一个涉及确定申请包含适当的专利保护客体的要求。尽管当前的《专利审查指南》和《修改草案》都要求发明（1）解决技术问题，（2）在此过程中采用技术手段，并且（3）获得符合自然规律的技术效果，但是，修改部分指出，利用了计算机实施的技术手段，其**必然**解决技术问题并获得技术效果。我们认为，这实际上将考量

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<sup>1</sup> *O'Reilly v. Morse* (56 U.S. 62, 112)(1853).

<sup>2</sup> *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946).

<sup>3</sup> 如上所述，IPO 的顾虑在于，如果这些修改并没有在法或者细则的更高位阶修改中被一致地涉及，《修改草案》中建议的修改会实质性影响计算机程序的可专利性标准，并甚至引起对于如果适用可专利性标准的更大困惑。

(1) 和 (3) 纳入了考量 (2)，并且尚不清楚《修改草案》是否打算保留要素 (1) 和 (3) 作为可授权客体的实际要求。

在此需要明确，CNIPA 是否意图正式删除要素 (1) 和 (3)。例如，是否存在这样的情况，其中存在“技术手段”，但是由于该技术手段未被用于解决技术问题或者获得技术效果，使得申请仍然没有记载合适的客体？

需要明确的第二个问题在于新增加的情形一和情形二，它们提供了定义发明是否包含“技术手段”的示例。在情形一中，对于记载了例如计算机的信息处理设备，且记载了“通过上述信息处理设备执行计算机程序来实现控制和处理的内容”的申请，视为存在技术手段。这种情况看起来类似于在美国实践中曾用于确定专利适格性分析但现在已废止的“机器或转换”测试的“机器”分支。

对于情形一，不清楚信息处理设备“实现控制和处理”需要什么。“实现控制和处理”是否仅要求信息处理设备执行权利要求中所述的要素，或者“实现控制和处理”是否需要对其**其它事物**的控制和处理（例如打开橡胶模具）？

在情形二中，对于**没有记载**信息处理设备，但仍然记载了“通过执行计算机程序来实现控制和处理的内容”的申请，视为存在技术手段。IPO 协会将情形二解释为与这样的情况相关，即，权利要求不是肯定地记载了信息处理设备，但是出于实现权利要求要素的实际情况，明显是需要信息处理设备的。对“实现控制和处理”一词意味着什么，情形二引发了同样的顾虑。

对于情形二，尚不清楚在何种情况下权利要求已经充分暗示了存在“实现控制和处理”的信息处理设备。我们注意到，在第二部分第 9 章第 2 节有一些构成技术方案的技术的特定示例。为了进一步明确起见，如果能够提供一些不构成技术方案的技术的进一步示例，将会是有用的。另外，下面的示例将会是有帮助的，即，权利要求没有肯定地记载信息处理设备但仍属于情形二所设想的场景的特定示例，以及权利要求没有肯定地记载信息处理设备并且也不属于情形二所设想的场景的示例。

需要明确的第三个问题与“技术手段”分析有关。为了满足情形一或情形二中的“技术手段”的要求，信息处理设备是否必须执行所有权利要求要素，还是可以允许其仅执行某些权利要求要素？回顾历史上在美国实践中应用的“机器或转换”测试的“机器”分支，有关必须由机器执行哪些权利要求要素的问题使评估权利要求是否符合该测试的客体要求变得困难。是否需要计算机执行充分“核心”的权利要求要素，或是仅仅包含无关紧要的额外解决问题的要素，围绕这些问题存在很多不明确的地方。因此，IPO 协会建议明确，权利要求要素的哪些组成部分必须包含“技术手段”。作为总体原则，IPO 协会认为应从整体上解释权利要求，而不是以割裂的方式解释。

IPO 协会还希望指出，《修改草案》与其他司法管辖区（例如欧洲和美国）的专利审查指南有所不同。在欧洲，判断计算机程序可专利性的当前方法是确定权利要求是否具有“技术特性”，例如当通过使用技术手段解决技术问题或达到技术效果时。《修改草案》在这方面偏离了欧洲的做法。在美国，用于计算机程序的方法

围绕判断权利要求是否“针对”抽象概念，如果是，则判断其是否记载“明显更多”使其不垄断抽象概念。《修改草案》的方法的确包括对权利要求所“针对”的内容的考虑，只要它包括“技术手段”即可。

对于专利客体问题，在中国，欧洲和美国提供更一致和统一的方法，尤其是在不断发展的计算机程序领域，这对所有知识产权利益相关者都会是有益的。

### **第五部分第七章第 8.3 节 - 延迟审查**

IPO 协会注意到第 8.3 节的如下规定，即，如果与同一发明创造相关的实用新型申请与该发明申请同时提交并获得批准，则该发明申请的实质审查将被延迟。

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

我们相信，在当前专利框架下，申请人可以同时提交发明和实用新型申请，这为保护具有现时市场价值和长期竞争优势的发明提供了重要的工具。《修改草案》没有指出将对发明申请延迟进行实质审查的时间长度，这会给申请人带来很大的不确定性。另外，还不清楚这种延迟将会如何影响专利期限的延长。因此，IPO 协会建议删除以上段落，或者提供有关延迟时长以及对专利期限延长的任何影响的明确指南。

我们感谢中国国家知识产权局对 IPO 协会在这里所提交意见的关注，我们欢迎进一步的交流以及提供进一步意见的机会。

随信附上本信的翻译版本。

此致



**Daniel J. Staudt**  
美国知识产权所有人协会主席

附件：IPO 协会对《专利审查指南修改草案（第二批征求意见稿）》的反馈意见（英文版）



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10 December 2020

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

***Re: Draft Amendments to the Patent Examination Guidelines (Second Batch of Draft for Solicitation of Comments)(10 November 2020)***

Dear China National Intellectual Property Administration:

The Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the request for comments on *Draft Amendments to the Patent Examination Guidelines (Second Batch of Draft for Solicitation of Comments)* ("Draft Amendment") published on 10 November 2020.

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 rights. IPO's membership includes 175 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 appreciates that the Draft Amendment aims to address the increasing demand for examination rules brought by the rapid development of China's economy and technology, and to improve the quality and efficiency of patent examination. We welcome the detailed attention given to practical considerations regarding patent examination, and hope that our comments below will be helpful during the process of finalizing the Draft Amendment.

## **General Comment**

IPO recognizes the extensive efforts undertaken by the China National Intellectual Property Administration (“CNIPA”) in the Draft Amendment to streamline processes and reduce formality requirements. This a positive development towards increasing efficiency of patent examination, particularly in view of the significant increase in patent filings in China.

We noticed that, at the same time, some case examples have been removed in this Draft Amendment. IPO believes that illustrative examples serve an important purpose in providing clarity to patent examiners and guiding applicants to enable higher quality application (and claim) drafting. Thus, IPO favors the inclusion of illustrative examples in examination guidelines where applicable.

In regard to patentability of computer programs (such as in “Chapter 9, Part II, 2 Examination Criteria of Invention Applications Relating to Computer Programs”), IPO has reservations about the Patent Examination Guidelines making seemingly substantive changes in the requirements for determining whether applications contain appropriate subject matter for patent protection. Such determinations are, in essence, policy positions, and IPO believes such substantive changes should only be made if they are coherently reflective of higher-order changes to the laws or regulations, such as the draft Implementation Regulations of the Patent Law of China (“Draft Implementing Regulations”) published for comment on November 27, 2020. In particular, we note that the Draft Implementing Regulations do not propose to reflect such substantive changes and, thus, we do not believe it should occur in the draft Patent Amendment Guidelines.

## **Chapter 2, Part II, Section 3.2.1, Support in the Specification**

### **Support for the Claims**

IPO notes that Section 3.2.1 provides that the Examiner shall raise an objection of lack of support on the ground of Article 26. We believe it would be beneficial to require that an Examiner state their reasoning for why there is a lack of support in the description. This would provide for a fully developed record of the objection. Also, this would allow the applicant to fully understand the reasons for the objection and thus properly respond to the objection raised. To this end, we would recommend the following addition to section 3.2.1:

*If the generalization of a claim is such that the person skilled in the art has sufficient reasons to doubt that one or more specific terms or options included in the generic terms or parallel options cannot solve the technical problem aimed to be solved by the invention or utility model and achieve the same technical effects, then it shall be taken that the claim is not supported by the description. In these cases, the examiner shall raise an objection of, **and provide the reasons for,** lack of support on the ground of Article 26. 4 and invite the applicant to amend the claim.*

### Functional Claiming

Defining an invention functionally rather than structurally requires establishment of clear parameters through which functional claims can be interpreted. Such interpretation is accomplished by setting forth in the specification an adequate disclosure showing what was meant by that functional language. Otherwise, the functional language is overly broad and ambiguous resulting in an imbalance between the patent cost (scope of disclosure) and the patent reward (scope of claims).

A concern with overly broad and ambiguous functional claims is that they foreclose an entire area of endeavor (any and all means that perform the function) even though no means or only a few means were invented to achieve the function. To provide one example as illustrated in U.S. patent practice, in a decision by the U.S. Supreme Court in 1853, the inventor in that case created a telegraph and received broad claims that would cover a radio, which the inventor did not create.<sup>1</sup> Almost a hundred years later, the US Supreme Court in 1946 again held that functional claiming yields overly broad claims.<sup>2</sup> Subsequently, the U.S. Congress amended the patent statute to create a law that is now codified as 35 U.S.C. 112(f). That amendment allowed claims reciting only function, but with the condition that the claim would be limited to the means disclosed by the patent to perform the function, and their equivalents. This restored the balance between cost and reward in the patent system. For the same reason, IPO recommends that this section include an additional sentence on interpretation of functional claiming, as shown below:

*Usually, for product claims, generally the structural features shall be used in defining the invention. When a certain technical feature cannot be defined by a structural feature, or it is more appropriate to be defined by a feature of function or effect than by a structural feature, and the function or effect can be directly and affirmatively verified by experiments or operations as stated in the description or by customary means in the art, definition by features of function or effect can be used in defining the invention. **Functional claim elements shall be interpreted as covering only the structural features performing those claimed functions as disclosed in the patent specification and equivalents thereof.***

### **Chapter 3, Part II, Section 5, Grace Period for Non-Prejudicial Disclosures**

IPO would like to seek clarification that when the invention is disclosed by another person without the applicant's consent, and a third person learns of the invention and subsequently re-discloses the invention, the six-month grace period available to the applicant under **Article 24(4)** of the Fourth Amendment to the Patent Law will apply (instead of Article 24(3)).

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<sup>1</sup> *O'Reilly v. Morse* (56 U.S. 62, 112)(1853).

<sup>2</sup> *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946).



## **Chapter 9, Part II, 2 Examination Criteria of Invention Applications Relating to Computer Programs**

Regarding the determination of whether an invention recites appropriate subject matter for patent protection on computer programs, IPO would like to seek further clarity on certain issues below.<sup>3</sup>

### Clarity

IPO sees three primary issues relating to clarity in examination of applications relating to computer programs. The first relates to requirements for establishing that an application contains appropriate subject matter for patent protection. While the current Patent Examination Guidelines and Draft Amendment both require an invention to (1) solve a technical problem, (2) adopt a technical means in doing so, and (3) obtain a technical effect in conformity with the laws of nature, the amended section states that use of a technical means implemented by a computer would *necessarily* solve a technical problem and obtain a technical effect. We believe that this effectively folds considerations (1) and (3) into consideration (2), and it is unclear whether the Draft Amendment intends to keep elements (1) and (3) as actual requirements for patentable subject matter.

There is a need for clarity on whether CNIPA intends to formally remove elements (1) and (3). For example, are there any situations in which a “technical means” exists, but an application would nevertheless not recite appropriate subject matter because the technical means is not used to solve a technical problem or to obtain a technical effect?

The second issue relating to clarity resides in the newly added Case I and Case II, which provide examples defining whether an invention includes a “technical means.” In Case I, a technical means is deemed to exist for an application that recites an information processing device such as a computer and “content of realizing control and process by the aforementioned information processing device executing a computer program.” This situation appears similar to the “machine” prong of the now-abrogated “machine-or-transformation” test used in determining patent eligibility analysis in U.S. practice.

It is unclear under Case I what is required for “realizing control and process” by an information processing device. Does “realizing control and process” require simply that the information processing device performs the recited elements of a claim, or does “realizing control and process” require controlling and processing *of something else* (such as opening of a rubber mold)?

In Case II, a technical means is deemed to exist for an application that *does not recite* an information processing device, but nevertheless recites “content of realizing control and process by the aforementioned information processing device.” IPO interprets Case II as pertaining to where a claim does not positively recite an information processing device, but where an information processing device is clearly required as a practical matter to

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<sup>3</sup> As mentioned above, IPO is concerned about changes being proposed in the Draft Amendment substantively impacting the patentability standards for computer programs and even causing broader confusion on how to apply patentability standards, without these changes being coherently addressed in higher-order changes to the laws or regulations, such as the draft Implementation Regulations of the Patent Law of China.

implement the claim elements. Case II presents the same concern regarding what the phrase “realizing control and process” means.

It is not clear under Case II when a claim has sufficiently implied the existence of an information processing device “realizing control and process.” We note that there are specific examples of technologies that provide for a technical solution under Part II Chapter 9, Article 2. It would be useful to have further examples of technologies that do not provide such a technical solution for even greater clarity. Also, specific examples in which a claim does not positively recite an information processing device yet still falls into the scenario contemplated by Case II, as well as examples in which a claim does not positively recite an information processing device and also does not fall into the scenario contemplated by Case II would be helpful.

The third issue on clarity relates to the “technical means” analysis. To satisfy the “technical means” requirement under Case I or Case II, must the information processing device perform all claim elements, or can it merely perform some of the claim elements? Referring back to the “machine” prong of the “machine-or-transformation” test historically applied in U.S. practice, questions about which claim elements must be performed by a machine created difficulty in evaluating whether a claim was eligible for patenting under the test. Much ambiguity existed around whether a computer performed a sufficiently “central” claim element or simply an element comprising insignificant extra-solution activity.” Accordingly, IPO suggests clarifying which components of a claim element must comprise the “technical means.” As a general principle, IPO believes that claims should be interpreted holistically rather than in a piece-meal fashion.

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

Providing for a more consistent and uniform approach to patent eligibility in China, Europe, and the United States, particularly in the ever growing area of computer programs, would be beneficial to all IP stakeholders.

### **Chapter 7, Part 5, Section 8.3, Deferral of Examination**

IPO notes that Section 8.3 provides that the substantive examination of an invention application will be deferred if a utility model application relating to the same invention creation as the invention application is filed at the same day and has been granted by saying:

*If the same applicant files both an invention application and a utility model application for the same invention creation at the same day (only means*

*filing date), and if the utility model application has been granted, the substantive examination of the invention application will be deferred.*

We believe that the availability under the current patent framework for applicants to file both invention and utility model applications provides an important tool to protect inventions that have immediate market value and long-term competitive advantage. The Draft Amendment does not indicate for how long the substantive examination of the invention application will be deferred, which would create substantial uncertainty for applicants. It is also unclear how such a deferral would impact patent term extension. Therefore, IPO recommends that either the above paragraph be deleted or that clear guidance be provided on the duration of the deferral and any impact on patent term extension:

We thank the China National Intellectual Property Administration for its attention to IPO's comments submitted herein, and we welcome further dialogue and opportunity to provide additional comments.

We have enclosed this letter as translated herewith.

Sincerely,

A handwritten signature in blue ink, appearing to read "Daniel J. Staudt". The signature is fluid and cursive, with a prominent horizontal stroke across the middle.

Daniel J. Staudt  
President

Attachment