

## Part IV

### Examination of Requests for Reexamination and for Invalidity

# Chapter 1 General Provisions

## **1.Introduction**

As pursuant to Article 41.1,the State Intellectual Property Office establishes the Patent Reexamination Board.

The Patent Reexamination Board is composed of the Director, Deputy Directors,principal examiners for reexamination,adjunct principal examiners for reexamination,examiners for reexamination, and adjunct examiners for reexamination.The Commissioner of the State Intellectual Property Office shall hold the office of the Director of the Patent Reexamination Board concurrently. The Deputy Directors,principal examiners for reexamination and adjunct principal examiners for reexamination shall be appointed by the Commissioner from experienced technical and legal experts in the Office.The examiners for reexamination and adjunct examiners for reexamination shall be selected by the Commissioner from experienced examiners and legal staff in the Office.

According to Article 41,the Patent Reexamination Board receives requests for reexamination,and performs examination and makes decisions accordingly.Cases of request for reexamination include those made out of dissatisfaction with the decisions of rejection in preliminary examination stage and in substantive examination stage.

According to Article 45 and 46.1,the Patent Reexamination Board receives requests for invalidation of patent right,and performs examination and makes decisions accordingly.

The Patent Reexamination Board may also appear in court where a party concerned according to law institutes a legal proceeding before the court out of dissatisfaction with a decision made by the Board.

## **2.Principles of Examination**

The principles commonly applied to the procedure of examination on requests for reexamination(hereinafter the reexamination procedure)and to the procedure of examination on requests

Rule 59 for invalidation (hereinafter the invalidation procedure) include principle of legality, principle of fair enforcement of law, principle of examination upon request, principle of conducting examination ex officio, principle of hearing, and principle of publicity.

Art. 21.1

### **2.1 Principle of Legality**

The Patent Reexamination Board shall exercise its administrative competence lawfully. The procedures and decisions of examination on both the cases of request for reexamination (hereinafter reexamination cases) and the cases of request for invalidation (hereinafter invalidation cases) shall be in conformity with the relevant provisions of the laws, regulations and ordinances.

Art. 21.2

### **2.2 Principle of Fair Enforcement of Law**

The Patent Reexamination Board shall act in line with the principles of objectivity, fairness, appropriateness and timeliness, and base its judgment and decisions on facts and take the law as the criterion. It shall exercise its examination competence independently and impartially, and make just decisions after comprehensive, objective and rational analysis and judgment.

Art. 41.1 & 45

### **2.3 Principle of Examination upon Request**

The reexamination procedure and the invalidation procedure shall be initiated at the request of the party concerned.

If the petitioner withdraws his request for reexamination or for invalidation before the Patent Reexamination Board makes a decision concerning the request, the corresponding examination procedure shall be terminated; except for invalidation cases, where based on the examination the Patent Reexamination Board has done, it finds that a decision of invalidating the whole patent or invalidating the patent in part can be made.

If the petitioner withdraws the request after the examination decision has been announced or the decision has been sent out in written form, the effectiveness of the examination decision shall not be affected.

Rules 64 & 72

### **2.4 Principle of Conducting Examinations Ex Officio**

The Patent Reexamination Board may conduct examination of the cases under examination ex officio, rather than confined by

the scope, grounds or evidences raised by the parties.

## **2.5 Principle of Hearing**

Before an examination decision is made, the party adversely affected by the examination decision shall be given an opportunity to make observations on the grounds, evidence, and the ascertained facts on which the examination decision is based, that is to

say, the party adversely affected by the examination decision shall have been informed by means of communication, document exchange, or oral proceeding, of the grounds, evidence, and the ascertained facts on which the examination decision is based, and given the opportunity to make observations.

Where, before an examination decision is made, the patent applicant or patentee has been changed according to an effective judgment made by the People's Court or an effective mediation decision made by the People's Court or a local intellectual property administrative authority, the party concerned after the change shall be given the opportunity to make observations.

Rule 7

## **2.6 Principle of Publicity**

For all other cases except those that need to be kept secret according to the laws and State Council regulations (including cases of request for reexamination made out of dissatisfaction with rejections in the preliminary examination stage), oral proceedings shall be public, and the examination decisions shall be published.

## **3. Collegiate Examination**

Cases that are collegially examined by the Patent Reexamination Board shall be examined by a panel consisting of three or five members, including a chairman, a first member, and one or three second members respectively.

### **3.1 Composition of a Panel**

The Patent Reexamination Board shall determine and change the composition of a panel to examine reexamination or invalidation cases in accordance with prescribed procedure and in the light of division of specialty, amount of cases, and the circumstances regarding the examiners participating in previous ex-

amination procedures of the same patent application or patent.

The heads of appealing divisions of the Patent Reexamination Board and the principal examiners for reexamination are qualified to serve as the chairman of a panel; other members may serve as the chairman subject to the approval of the Director or one of the Deputy Directors of the Board.

Principal examiners for reexamination, examiners for reexamination, adjunct principal examiners for reexamination, and adjunct examiners for reexamination may serve as the first or second member of a panel.

Examiners invited from the examination departments of the Patent Office for specific cases may serve as the second member of the panel.

After a decision is made by the Patent Reexamination Board to uphold a patent right fully or partially, if the same petitioner filed a new request for invalidating the same patent on different grounds or on the basis of different evidence, the first member of the panel that made the previous decision shall not participate in the examination of the new case.

Where an examination decision is overturned by an effective judgment of the People's Court, for examination of the case anew, generally a new panel shall be established.

### **3.2 Provisions on Establishment of a Five-Member Panel**

For the following cases, a five-member panel shall be established:

- (1) cases of great influence in China or abroad;
- (2) cases involving important difficult legal issues;
- (3) cases involving great economic interests.

Where the circumstance so requires, a five-member panel may be established by a decision of the Director or one of the Deputy Directors, or on a proposal from the head of the relevant appealing division or a member of the relevant panel which shall be submitted in accordance with the prescribed procedure to the Director or one of the Deputy Directors of the Board for approval.

For cases examined by a five-member panel, if no oral proceedings have been held before the establishment of such a panel, oral proceedings shall be held.

### **3.3 Distribution of Responsibilities among Panel Members**

The chairman is responsible for comprehensive examination on the reexamination or invalidation procedure, presides over oral proceedings, presides over panel meetings and vote casting, and decides on whether to submit the examination decisions of the panel to the Director or one of the Deputy Directors for approval.

The first member is responsible for comprehensive examination of the case and keeping the file, drafting communications and decisions, managing clerical affairs associated with the parties concerned, and preparing patent document to be published when a partial invalidation decision is made.

The second member shall participate in the examination and assist the chairman and the first member.

### **3.4 Formation of the Examination Opinion of a Panel**

During the examination of reexamination or invalidation cases, the panel shall cast votes on issues including whether an evidence can be taken, an allegation of facts can be testified, and a ground of action can be accepted, and decide according to the majority.

### **4. Examination by a Single Examiner**

Simple cases may be examined by a single examiner.

### **5. Recusal and Non-competition**

Rule 37

Where a panel member of a reexamination or invalidation case falls into one of the circumstances as prescribed in Rule 37, the panel member shall recuse himself from the examination. Where the panel member fails to recuse, the party concerned may file a motion to recuse him.

The close relatives of the Director or Deputy Directors should not represent the parties of a reexamination or invalidation case during the tenure of the Director or Deputy Directors.

The close relatives of the head of appealing division should not represent the parties of a reexamination or invalidation case that will be examined in the appealing division during the tenure of the head of appealing division. The close relatives referred to

above means spouse,parent,child,sibling,grandparent,grandchild and other relatives with maintenance relationship.

The Director or Deputy Directors should not represent the parties of a reexamination or invalidation case within three years since his demission,and other members of the Patent Reexamination Board should not within two years since their demission.

Where the party concerned files a motion to recuse a member of the panel,or he thinks the attorney appointed fall into the circumstances as prescribed above,he shall raise the recusation in written form and explain the causes therein,and attach relevant evidence if necessary.For any recusation raised by a party concerned,the Patent Reexamination Board shall make a decision in written form and notify the party who raised it.

## **6.Examination Decision**

### **6.1 Approval of an Examination Decision**

The panel shall take full responsibility for the recognition of facts,the application of laws,the conclusion,and the format and wording of the examination decision document.

For the following cases,the examination decision made by the panel shall be reviewed and subject to approval by the Director or one of the Deputy Directors of the Board:

- (1)cases examined by a five-member panel;
- (2)cases in which the panel members are divided in their votes;and
- (3)cases which are examined anew after the previous examination decision being overturned by an effective judgment of the court.

Where the Director or Deputy Director of the Board in charge of approving the panel decision does not agree with the decision,he may comment and order the panel to conduct a second deliberation.If the panel does not agree with the opinion of the Director or Deputy Director after a second deliberation,and the Director or more than one Deputy Director of the Board considers necessary,an enlarged meeting shall be held which shall include at least two thirds of the members comprising the Director, the Deputy Directors,and the principal examiners for reexamination of the Patent Reexamination Board,and the examination decision

shall be made according to the majority of the meeting.

The person in charge of approval on an examination decision shall be responsible for his approval on the application of laws and the conclusion of the examination decision.

## **6.2 Composition of an Examination Decision**

An examination decision shall include the following parts:

### **(1) Bibliographic data of the examination decision**

The bibliographic data of the examination decision on a reexamination case shall include the number and the date of the decision, the title of the application appealed, the IPC symbol (or classification code for design), the petitioner for the reexamination, the application number and the filing date of the application appealed, the publication date for invention applications, and the members of the panel.

The bibliographic data of the examination decision on an invalidation case shall include the number and the date of the decision, the title of the patent in dispute, the IPC symbol (or classification code of design), the petitioner for the invalidation, the patentee, the number and the filing date of the patent, the date of announcement of granting the patent, and the members of the panel.

### **(2) Legal bases**

Legal bases of the examination decision mean the relevant provisions of laws or regulations applied as the causes of the examination decision.

### **(3) Main points of decision**

This part is a summary and core statement of the Grounds of Decision in the main text. It is the criteria by which the issues in dispute or the difficult issues of the case are judged. In the main points of the decision, the applied provisions of the Patent Law and its Implementing Regulations shall be further explained and, based on the specific circumstances of the case, instructive conclusions shall be drawn as far as possible.

The main points of decision shall satisfy the following requirements in its form:

- (i) the wording shall be simple and concise;
- (ii) the statements shall be logical, accurate, well organized, well grounded and consistent with the conclusion of the decision;



(iii) it shall not be a conclusion simply reciting the relevant provisions of the Patent Law and its Implementing Regulations, nor a summary of the cause of action and the conclusion of the decision; key sentences satisfying the above requirements may be extracted from the main text of the decision.

#### (4) Brief of the case

This part shall describe in time order the following events or facts: the submission of the request for reexamination or invalidation, scope, cause and evidence of the request, acceptance of the request, submission and exchange of documents, the process of examination and the main disputes. The content of this part shall be objective and true, and consistent with the corresponding records of the case. It shall reflect the course of examination and the main disputes accurately and briefly.

This part shall briefly and concisely outline and summarize the opinions of the parties, clearly and accurately represent the views of the parties, and shall specify all the reasons and evidence of the party to whom the decision is unfavorable.

For reexamination or invalidation cases concerning invention or utility model applications or patents, the decision shall clearly note the contents of the claims to which the decision is related.

#### (5) Grounds of decision

This part shall explain in detail the applied provisions of laws and regulations and the facts on which the examination decision is based, and elaborate the applicability of the provisions to the case. The elaboration in this part shall be detailed to the extent that on the basis of the provisions and facts it is sufficient to draw the conclusion. Specific analyses shall be made on all the causes, evidence and main opinions raised by the party to whom the conclusion is unfavorable so as to explain why the causes are not tenable and the opinions are not accepted.

For cases involving designs, the main contents of the design concerned shall be described objectively in words if necessary.

#### (6) Conclusion

This part shall state the examination conclusion of the case specifically, and instructions as to the follow-up remedies including the time limit of initiation and the competent authority of acceptance shall also be clearly and specifically indicated.

#### (7) Drawings

For cases involving designs, the pictures or photographs of the design shall be attached as the drawings of the decision if necessary.

### **6.3 Publication of an Examination Decision**

The whole text of an examination decision made by the Patent Reexamination Board on a request for reexamination or invalidation shall be published unless where the patent application involved was not published. Where an examination decision shall be published but an action has been brought by the party concerned before the court and has been accepted, the examination decision will be published along with the judgment of the People's Court after the judgment coming into effect.

## **7. Correction and Rejection of a Request**

### **7.1 Correction of Decisions on Acceptance**

Where a request for reexamination or invalidation was not accepted but should have been accepted, or was accepted but should not have been accepted, correction shall be made subject to the approval of the Director or one of the Deputy Directors, and the party concerned shall be notified accordingly.

### **7.2 Correction of Notifications**

Where the Patent Reexamination Board finds that there exists a mistake in any of the various notifications issued by it and the mistake needs to be corrected, correction shall be made subject to the approval of the Director or one of the Deputy Directors, and the party concerned shall be notified accordingly.

### **7.3 Correction of Examination Decisions**

Where it is found that there exists any obvious clerical error in an examination decision on requests for reexamination or invalidation and the error needs to be corrected, correction shall be made subject to the approval of the Director or one of the Deputy Directors, and the party concerned shall be notified by a notification attached with the substitution sheets.

#### **7.4 Correction of Decisions of Deemed Withdrawal**

Where it is found that a request for reexamination or invalidation shall not have been deemed withdrawn, correction shall be made and the corresponding reexamination or invalidation procedure shall be restored subject to the approval of the Director or one of the Deputy Directors, and the party concerned shall be notified accordingly.

#### **7.5 Correction of Other Decisions**

For all other decisions made by the Patent Reexamination Board, if necessary, correction may be made subject to the approval of the Director or one of the Deputy Directors.

#### **7.6 Rejection of a Request**

For any reexamination or invalidation case, which has already been accepted, when it is found after examination that the case fails to meet the requirements for acceptance, a decision of rejection of the request for reexamination or invalidation shall be made subject to the approval of the Director or one of the Deputy Directors.

#### **8. Examination Procedures after an Examination Decision Being Overturned by an Effective Judgment of the Court**

(1) If an examination decision on a request for reexamination or invalidation is overturned by an effective judgment of the People's Court, the Patent Reexamination Board shall make an examination decision anew.

(2) Where the examination decision is overturned for reasons of insufficient evidence or misapplication of laws, the Board shall not make a same decision as the previous one on the same grounds.

(3) Where the examination decision is overturned for reasons of violation of statutory procedures, the Patent Reexamination Board shall make an examination decision anew, with the procedural defects being remedied according to the judgment of the court.

## Chapter 2 Examination of Requests for Reexamination

### 1.Introduction

This Chapter is made pursuant to Article 41 and Rules 60 to 64.

The reexamination procedure is a relief procedure initiated by the applicant who is dissatisfied with the decision of rejection of the application by the Patent Office; meanwhile, it is a continuation of the examination procedure for a patent application.

Therefore, on one hand, the Patent Reexamination Board normally restricts its examination to the grounds and evidence on which the decision of rejection is based, and is not obliged to undertake a comprehensive examination on the patent application; on the other hand, the Patent Reexamination Board may conduct examination ex officio on other obvious substantive defects than those mentioned in the decision of rejection, so as to improve the quality of the patent granted and avoid unreasonable prolongation of the examination and granting procedure.

### 2.Formal Examination of a Request for Reexamination

After the Patent Reexamination Board receives a request for reexamination, it shall carry out formal examination.

Art.41.1  
Rule 60.2

#### 2.1 The Object of a Request for Reexamination

The applicant who is not satisfied with the decision of rejection by the Patent Office may file a request for reexamination with the Patent Reexamination Board. A request for reexamination shall not be accepted if it is not directed to a decision of rejection by the Patent Office.

Art.41.1  
Rule 60.2

#### 2.2 Eligibility as a Petitioner for Reexamination

The applicant of a rejected application may file a request for reexamination with the Patent Reexamination Board. Where the person filing a request for reexamination is not the applicant of the rejected application, the request shall not be accepted.

Where a rejected application has two or more applicants and

the petitioner for reexamination does not include all the applicants, the Patent Reexamination Board shall notify the petitioner to make rectification within a specified time limit. If the defect is not rectified within the time limit, the request for reexamination shall be deemed not to have been made.

Art.41.1

### **2.3 Time Limit**

Rule 60.2

(1) The applicant may file a request for reexamination with the Patent Reexamination Board within three months from the date of receipt of the decision of rejection by the Patent Office. The request for reexamination shall not be accepted if the time of filing the request does not meet this requirement.

(2) Where the time of filing the request for reexamination does not meet the above requirement and the petitioner files a request for restoration of right after the Patent Reexamination Board has made a decision of nonacceptance, if the request for restoration of right is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99.1, the right shall be restored and the request for reexamination accepted; otherwise, the right cannot be restored.

(3) Where the time of filing the request for reexamination does not meet the above requirement and the petitioner files a request for restoration of right before the Patent Reexamination Board has made a decision of nonacceptance, the Patent Reexamination Board may handle the two requests together. If the request for restoration of right is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99.1, the request for reexamination shall be accepted; otherwise, the request for reexamination shall not be accepted.

### **2.4 Format of Documents**

Rule 60.1

(1) The petitioner shall submit request for reexamination and explain the causes therein, and attach the relevant evidence if necessary.

Rule 60.3

(2) Request for reexamination shall comply with the prescribed format. Where the request for reexamination is not in the prescribed format, the Patent Reexamination Board shall notify the petitioner to make rectification within a specified time limit. If, within the time limit, no rectification is made or the de-

fect has not been overcome after two rectifications, the request for reexamination shall be deemed not to have been made.

## **2.5 Fees**

Rules 93 & 94

(1) If the petitioner files the request for reexamination within three months from the date of receipt of the decision of rejection, but has not paid, or not paid in full, the reexamination fee within the time limit, the request for reexamination shall be deemed not to have been made.

(2) Where a request for restoration of right is filed after the Patent Reexamination Board has made the decision that the request for reexamination is deemed not to have been made, if the request is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99.1, the right shall be restored and the request for reexamination accepted; otherwise, the right shall not be restored.

(3) Where the reexamination fee is paid in full after three months from the date of receipt of the decision of rejection and the request for restoration of right is filed before the decision of deeming the request for reexamination not to have been filed is made, the Patent Reexamination Board may handle the two requests together. If the request for restoration of right is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99.1, the request for reexamination shall be accepted; otherwise, the request for reexamination shall be deemed not to have been made.

## **2.6 Formalities Regarding Appointment of Representation**

Rule 15.3

(1) As regards the appointment, dissolution or resignation of appointment in the reexamination procedure, formalities shall be settled before the Patent Office according to the provisions of Chapter 1, Section 6.1 of Part I. However, if the petitioner appoints a patent agency in the reexamination procedure and indicates in the power of attorney that the scope of the power entrusted is limited to matters in the reexamination procedure, the formalities concerning the appointment, dissolution or resignation of appointment shall be settled before the Patent Reexamination Board and the above provisions shall apply *mutatis mutandis*, without the need to change the bibliographic data.

Where the petitioner goes through the formalities concerning the appointment of a patent agency before the Patent Reexamination Board and fails to indicate in the power of attorney that the scope of the power entrusted is limited to matters in the reexamination procedure, a rectification shall be made within the specified time limit; otherwise, the appointment shall be deemed not to have been made.

(2) Where the petitioner has appointed more than one patent agency at the same time, he shall designate in written form one of the agencies as the contact person. If no agency is designated, the Patent Reexamination Board will take the agency entrusted first in the reexamination procedure as the contact person; where more than one agency was entrusted first, the Patent Reexamination Board will take the agency in the first name order as the contact person; where there is no name order (separately entrusted on the same day), the Patent Reexamination Board shall notify the petitioner to designate within a specified time limit, and if no designation is made within the time limit, the appointment shall be deemed not to have been made.

Rule 60.2

(3) Where according to Article 19.1 the petitioner shall appoint a patent agency, if he fails to appoint any agency, the request for reexamination shall not be accepted.

## **2.7 Notification on Formal Examination**

(1) Where, after formal examination, the request for reexamination is considered not in conformity with the relevant provisions of the Patent Law or its Implementing Regulations or these Guidelines and needs to be rectified, the Patent Reexamination Board shall issue Notification to Make Rectification, and invite the petitioner to make rectification within fifteen days from the date of receipt of the notification.

(2) Where the request for reexamination is deemed not to have been made or is not accepted, the Patent Reexamination Board shall respectively issue Notification that Request for Reexamination Deemed Not to Have Been Made or Notification of Nonacceptance of Request for Reexamination to notify the petitioner.

(3) Where, after formal examination, the request for reexamination is considered in conformity with the relevant provisions

of the Patent Law and its Implementing Regulations and these Guidelines, the Patent Reexamination Board shall issue Notification of Acceptance of Request for Reexamination to notify the petitioner.

### **3. Interlocutory Examination**

#### **3.1 Procedure of Interlocutory Examination**

According to Rule 62, the Patent Reexamination Board shall transfer the request for reexamination (including any proof document and the amended application document attached thereto) having passed formal examination to the previous examination department which made the decision of rejection for interlocutory examination, together with the application dossier.

The previous examination department shall provide its opinion on interlocutory examination, and make a Note of Interlocutory Examination Opinion. Except in special situations, interlocutory examination shall be completed within one month after receipt of the dossier.

#### **3.2 Types of Interlocutory Examination Opinion**

There are three types of interlocutory examination opinion:

- (1) that the request for reexamination is allowable, and the decision of rejection is agreed to be revoked;
- (2) that the amended text of the application submitted by the petitioner has overcome the previous defects, and the decision of rejection is agreed to be revoked on the basis of the amendments; and
- (3) that the observations and the amendments submitted by the petitioner are not sufficient to revoke the decision of rejection, and the decision of rejection is maintained.

#### **3.3 Interlocutory Examination Opinion**

- (1) The previous examination department shall specify which of the above types its examination opinion is. Where the examination department maintains the decision of rejection, it shall explain in detail the grounds of rejection maintained and the defects concerned; where the grounds are the same as in the decision of rejection, a brief explanation shall suffice, without the



need to repeat the same.

(2)Where the petitioner has made amendments to the application, the previous examination department shall examine following the guidelines of Section 4.2 of this Chapter.If the examination department believes that the amendments conform with the provisions as provided in Section 4.2 of this Chapter,it shall perform interlocutory examination on the basis of the amended document.Otherwise,it shall maintain the decision of rejection and,in addition to the explanation in detail why the amendments are not acceptable,explain the remained defects in the application to which the grounds of rejection are directed.

(3)Where the petitioner presents new evidence or raises new causes,the previous examination department shall examine the evidence or causes.

(4)The previous examination department shall not raise new grounds or evidence for the rejection,except in the following cases:

(i)supplementing the evidence of common knowledge such as those in a technical dictionary,a technical manual,or a text book well known in the skilled art,to support the allegation of common knowledge in the decision of rejection and the interlocutory examination opinion;

(ii)where the previous examination department believes the text of the application being examined has such defects that it is sufficient to reject the application on the basis of the fact, grounds and evidence of which the applicant has been notified,it shall specify the defects in the interlocutory examination opinion; and

(iii)where the previous examination department believes the defects indicated in the decision of rejection still exist and finds the text of the application being examined has other defects which are obvious and substantive or of the same nature with that indicated in the decision of rejection,it may specify them as well.

For example,the previous examination department once indicated in an office action that claim 1 is not in conformity with Article 22.3,but finally rejected the application on the ground that the amendment of the document is not in conformity with Article 33.If the applicant amends the application back to the

original text, and the previous examination department believes the defect of noncompliance with Article 22.3 still exists, which falls into the above circumstance(ii), then the previous examination department shall specify the defect in the interlocutory examination opinion.

(5) Where an interlocutory examination opinion falls to be the first or second type as provided in Section 3.2 of this Chapter, the Patent Reexamination Board needs not to conduct collegiate examination. It shall make a reexamination decision according to the interlocutory examination opinion, and notify the petitioner. The previous examination department shall restore the examination procedure consequently. The previous examination department shall not directly restore the examination procedure without the reexamination decision being made by the Patent Reexamination Board.

#### **4. Collegiate Examination of Request for Reexamination**

##### **4.1 Examination of Grounds and Evidence**

In the reexamination procedure, the panel normally examines only the grounds and evidence on which the decision of rejection is based.

In addition to the grounds and evidence on which the decision of rejection is based, where the panel finds the text of the application being examined has one of the following defects, it may examine the grounds and evidence related to the defect, and

if the panel confirms the existence of the defect after examination, it shall make a decision of upholding the rejection decision on the basis of said grounds and evidence:

(1) the defects for which it is sufficient to reject the application on the basis of other grounds and evidences of which the applicant has been notified before rejection; or

(2) the defects which are not indicated in the decision of rejection but are obvious and substantive or of the same nature with those indicated in the decision of rejection.

For example, where the decision of rejection indicated that claim 1 did not involve an inventive step, and the panel after examination found that the claimed subject matter was obviously a perpetual

motion machine, it shall make a reexamination decision of upholding the decision of rejection on the ground that the claim is not in conformity with Article 22.4.

For another example, where the decision of rejection indicated that claim 1 was not clear because of indefinite terms and thus failed to define a clear extent of protection, and the panel found that claim 2 was also not clear for the use of the similar indefinite terms, it shall notify the petitioner of the defect as well in the reexamination procedure; if the response of the petitioner

fails to overcome the defect of claim 2, the panel shall make a reexamination decision of upholding the decision of rejection on the ground that claim 2 is not in conformity with Article 26.4.

During the collegiate examination, the panel may introduce common knowledge of the skilled art into the examination, or supplement the evidence by providing common knowledge such as those in a technical dictionary, a technical manual, or a text book.

#### **4.2 Examination of the Amendments to an Application**

The petitioner may amend the application at the time of submitting the request for reexamination, responding to Notification of Reexamination (including Notification of Oral Proceedings for Request for Reexamination), or appearing in oral proceedings. Any amendment, however, shall meet the requirements of Article 33 and Rule 60.1.

According to Rule 60.1, amendments by the petitioner shall be limited only to overcome the defects indicated in the decision of rejection or by the panel. Generally, the above requirement is not considered to be met in the following cases:

(1) where a claim amended extends the extent of protection as compared with the claim rejected in the decision of rejection;

(2) where a claim in the amendment is derived from the technical solution that lacks unity with the claims rejected in the decision of rejection;

(3) where the type of a claim is altered, or the number of claims is increased; or

(4) where the amendments are directed to the claims or the description that were not involved in the decision of rejection, unless they are intended merely to correct obvious clerical errors or to amend the defects of the same nature with that indicated in

the decision of rejection.

In reexamination procedure, if the application document submitted by the petitioner is not in conformity with the provision of Rule 61.1, the panel will generally refuse to accept it; and the panel should explain why the amended document is unacceptable in Notification of Reexamination and examine the previous acceptable document. If part of the content of the amended

document is in conformity with the provisions of Rule 61.1, the panel may provide examination opinions on this part, and notify the petitioner that he should amend other part of the text which is not in conformity with the provisions of Rule 61.1 and submit document which is in conformity with the provisions, otherwise the panel will take the previous acceptable text as the basis of examination.

#### **4.3 Manners of Examination**

For a request for reexamination, the panel may conduct examination in written form, by oral proceedings, or in both ways.

According to Rule 63.1, in any of the following circumstances, the panel shall issue Notification of Reexamination (including Notification of Oral Proceedings for Request for Reexamination) or take oral proceedings:

- (1) where the decision of rejection is intended to be upheld;
- (2) where the decision of rejection can be revoked on the condition that the petitioner makes amendments to the application document in accordance with the relevant provisions of the Patent Law, its Implementing Regulations and these Guidelines;
- (3) where further evidence or explanation is required to be submitted by the petitioner; or
- (4) where new grounds or evidence that have not been provided in the decision of rejection need to be introduced.

Where the panel issues Notification of Reexamination, the petitioner shall respond in written form with respect to the defects indicated in the notification within one month from the date of receipt. If the petitioner fails to respond in written form within the time limit, the request for reexamination shall be deemed withdrawn. Any response without concrete contents is regarded as no objections to the examination opinions in Notification of Reexamination.

Where the panel issues Notification of Oral Proceedings for Request for Reexamination, the petitioner shall appear in the oral proceedings or respond in written form with respect to the defects indicated in the notification within one month from the date of receipt. If the notification has indicated the facts that the application fails to conform with the relevant provisions of the Patent Law and its Implementing Regulations and these Guidelines and has provided the grounds and evidence therefor, and the petitioner neither attended oral proceedings nor made response in written form within the time limit, then the request for reexamination is deemed withdrawn.

### **5.Types of Examination Decisions on Requests for Reexamination**

There are three types of examination decisions on requests for reexamination (hereinafter reexamination decisions):

(1) a request for reexamination is not allowed, and the decision of rejection is upheld;

(2) a request for reexamination is allowed, and the decision of rejection is revoked; and

(3) where an application document has been amended and the defects indicated in the decision of rejection have been overcome, the decision of rejection is revoked on the basis of the amended text.

The second type as mentioned above includes the following circumstances:

(i) where the provisions of laws were misapplied in the decision of rejection;

(ii) where the grounds for rejection lacked necessary evidence support;

(iii) where the process of examination failed to follow the statutory procedures. For example, the decision of rejection was based on an application document that had been abandoned by the applicant or on a technical solution not claimed; the applicant was not given a chance in the process of examination to make observations on the grounds, evidence or affirmed facts adopted in the decision of rejection; or the decision of rejection failed to comment on the evidence submitted by the applicant concerning the grounds of rejection, and thus might affect the impartiality of the examination; and

(iv) any other circumstances where the grounds of rejection are not tenable.

#### **6.Delivery of Reexamination Decision**

According to Article 41.1, the Patent Reexamination Board shall deliver the reexamination decision to the petitioner.

#### **7.Binding Force of a Reexamination Decision to the Previous Examination Department**

Where a reexamination decision revokes the decision made by the previous examination department, the Patent Reexamination Board shall remit the relevant dossier to the previous examination department, which shall continue the process of examination.

The previous examination department shall follow the decision of the Patent Reexamination Board, and shall not make a decision contrary to the reexamination decision on the same basis of facts, grounds and evidence.

#### **8.Suspension of the Reexamination Procedure**

In this regard, Chapter 7, Section 7 of Part V shall apply.

#### **9.Termination of the Reexamination Procedure**

The reexamination procedure is terminated where the request for reexamination is deemed withdrawn for lack of response within the time limit.

The reexamination procedure is terminated where the petitioner has withdrawn the request for reexamination before a reexamination decision is made.

The reexamination procedure is terminated where the request for reexamination that has been accepted is rejected for inconformity with the requirements of acceptance.

If a petitioner is not satisfied with the reexamination decision, he may institute legal proceedings before the People's Court according to Article 41.2 within three months from the date of receipt of the reexamination decision; where no legal proceedings are instituted within the specified time limit, or the reexamination decision is upheld by an effective judgment of the People's Court, the reexamination procedure is terminated



# Chapter 3 Examination of Requests for Invalidation

## **1.Introduction**

This Chapter is made pursuant to Articles 45,46,47 and 59 and Rules 65 to 72.

The invalidation procedure is initiated on the request of the party concerned after the announcement of a patent being granted, and is usually an inter parte procedure.

## **2.Principles of Examination**

In the invalidation procedure,in addition to the principles of examination provided in the part of General Provisions,the Patent Reexamination Board shall also follow the principle of res judicata,the principle of disposal by the party concerned,and the principle of confidentiality.

### **2.1 Principle of Res Judicata**

Rule 66.2

After an examination decision on a request for invalidation of a patent has been made,any new request for invalidation of the same patent based on the same causes and evidence shall not be accepted or examined.

Where the causes of request for invalidation (hereinafter the invalidation causes)or evidence thereof for the new request have not been considered in the examination decision of the previous request for invalidation due to the reason of time limit etc.,the new request shall not be regarded as inadmissible under the above-mentioned circumstance.

### **2.2 Principle of Disposal by the Party Concerned**

The petitioner may renounce part or all of the scope,causes and evidence he has raised for the request for invalidation.For the scope,causes or evidence renounced by the petitioner,usually the Patent Reexamination Board will not investigate or examine them any more.

In the invalidation procedure,the party concerned is entitled to compromise with the opposite party at his own wish.In case



where both the petitioner and the patentee have expressed to the Patent Reexamination Board their willingness to compromise, the Board may give the both parties a certain period of time to negotiate, and temporarily refrain from making an examination decision until requested by either party or the time limit as specified by the Patent Reexamination Board has expired.

In the invalidation procedure, if, in response to the request for invalidation, the patentee narrowed the extent of protection of the patent right on his own initiative and the corresponding amended text was accepted by the Patent Reexamination Board, then it shall be deemed that the patentee admitted a larger extent of protection did not conform to the relevant provisions of the Patent Law and its Implementing Regulations and acknowledged the request for invalidation concerning the claim, and thus the burden of proof on the petitioner for invalidation of said claim is exempted.

In the invalidation procedure, if the patentee renounced by declaration some of the claims or some of the multiple designs, it shall be deemed that the patentee admitted that the claims or designs did not conform to the relevant provisions of the Patent Law and its Implementing Regulations and acknowledged the request for invalidation concerning the claims or designs, and thus the burden of proof on the petitioner for invalidation of said claims or designs is exempted.

### **2.3 Principle of Confidentiality**

Before an examination decision is made, any member of the panel without authorization shall neither explicitly nor implicitly reveal to any side of the parties the opinion on the case of himself, of any other Panel member, or of the Director or Deputy Director of the Board responsible for the approval of the case.

In order to ensure impartiality and confidentiality, any member of the panel in principle shall not individually meet with any side of the parties.

### **3. Formal Examination of a Request for Invalidation**

After the Patent Reexamination Board receives a request for invalidation, it shall perform formal examination on it

### **3.1 The Object of a Request for Invalidation**

The object of a request for Invalidation shall be the granted patent. It can even be an expired patent or a renounced patent, but not a patent renounced from the date of application. A request for invalidation shall not be allowable if it is not directed to a patent the grant of which has been announced.

Where, after the Patent Reexamination Board has made an examination decision of partial or whole invalidation of the patent right, the party concerned fails to institute legal proceedings before the People's Court within three months from the receipt of the examination decision, or the examination decision is upheld by an effective judgment of the People's Court, a request for invalidation directed to the patent right which has been invalidated by the examination decision shall not be accepted.

### **3.2 Eligibility as a Petitioner for Invalidation**

Where the petitioner falls into one of the following cases, his request for invalidation shall not be accepted:

(1) the petitioner is not eligible to institute a civil action;

Rule 66.3

(2) where a request for invalidating a design patent is submitted on the ground that the design patent is in conflict with a legitimate right of another individual which was acquired prior to the filing date of the patent, the petitioner fails to prove himself the prior right holder or the interested party.

Wherein, the interested party refers to the person who is entitled to file a lawsuit before the People's Court or request the competent administrative authority to handle the matter regarding the dispute over infringement of the prior right in accordance with the relevant legal provisions;

(3) where the patentee files a request for invalidation of his own patent right and requests to invalidate the whole of the patent, the evidence submitted is not a publication, or not all the patentees of the patent have joined in filing the request for invalidation; and

(4) several petitioners jointly submit a request for invalidation, unless all the patentees request to invalidate their common patent right.

### 3.3 Scope, Causes and Evidence of a Request for Invalidation

(1) The scope to be requested for invalidation shall be clearly indicated in a request for invalidation. If not clearly indicated, the Patent Reexamination Board shall inform the petitioner to make a rectification within a specified time limit. If no rectification is made within the time limit, the request for invalidation shall be deemed not to have been made.

Rules 65.2 & 66.1

(2) The causes for invalidation shall be limited to those prescribed in Rule 65.2 only, and the relevant specific provisions of the Patent Law and its Implementing Regulations shall be indicated as independent causes. A request for invalidation shall not be accepted if the causes for invalidation do not belong to any of those prescribed in Rule 65.2.

Rule 66.2

(3) A request for invalidating a patent shall not be accepted if the causes and evidence are the same as those of a previous request for invalidating the same patent that has been decided by the Patent Reexamination Board, unless the causes or evidence have not been taken into account in the previous decision due to the reason of time limit, etc.

Rule 66.3

(4) For a request for invalidating a patent for design based on the cause that the patent for design is in conflict with a legitimate right of another individual, which was acquired prior to the filing date of the patent, it shall not be accepted if no evidence is submitted to prove such conflict of rights.

Rules 65.1 & 66.1

(5) The petitioner shall explain the causes for invalidation concretely, making reference to all the evidence if applicable. For an invention or utility model patent, if a comparison of technical solutions is required, a specific description shall be given to the relevant technical solutions in the patent concerned and the reference documents, comparative analysis shall be made in that regard. For a design patent, if a comparison is required, a specific description shall be given to the product designs as shown in the drawings or photographs of the patent concerned and the reference documents, comparative analysis shall be made in that regard. For example, where the request for invalidation is based on Article 22.3 and more than one reference document is submitted, the petitioner shall indicate which one is the closest to the patent to be requested for invalidation, state whether the reference

documents are used separately or in combination, give a specific description to the technical solutions in the patent concerned and the reference documents, and make comparative analysis. If they are used in combination and there exist two or more possibilities of combination, the specific manner of combination shall be indicated. For different independent claims, the respective closest reference document may be indicated separately.

Where the petitioner fails to explain concretely the causes for invalidation, or fails to explain with reference to all the evidence or fails to indicate the corresponding evidence for each cause if there is evidence, the request for invalidation shall not be accepted.

Rules 65.1 & 66.4

### **3.4 Format of Documents**

The request for invalidation and its attachments shall be made in duplicate and comply with the prescribed formal requirements. Where the request for invalidation is not in the prescribed form, the Patent Reexamination Board shall notify the petitioner to make rectifications within a specified time limit. If no rectification is made within the time limit or the defect is not overcome after two rectifications within the time limit, the request for invalidation shall be deemed not to have been made.

Rules 93, 94  
& 99.3

### **3.5 Fees**

Where the petitioner fails to pay in full the fee for request for invalidation within one month from the submitting date of the request, the request for invalidation shall be deemed not to have been made.

Rule 15.3

### **3.6 Formalities Regarding Appointment of Representation**

(1) Where, during the invalidation procedure, the petitioner or the patentee appoints a patent agency, he must submit the power of attorney for invalidation procedure, and the patentee shall indicate in the power of attorney that the scope of the power entrusted is limited to matters in the invalidation procedure. In invalidation procedure, even if the patentee has appointed an agency for the whole term of the patent and continues to appoint the same one, he must also submit the power of attorney for invalidation procedure.

(2)Where,during the invalidation procedure,the petitioner or the patentee appoints a patent agency,and indicates in the power of attorney that the scope of the power entrusted is limited to matters in the invalidation procedure,the formalities concerning appointment,dissolution and resignation of appointment shall be settled before the Patent Reexamination Board,without the need to change the bibliographic data.

Where the petitioner or the patentee appoints a patent agency and fails to submit the power of attorney to the Patent Reexamination Board or the scope of the power entrusted is not indicated in the power of attorney,or the patentee fails to indicate in the power of attorney the scope of the power entrusted is limited to matters in the invalidation procedure,the Patent Reexamination Board shall notify the petitioner or the patentee to make rectifications within a specified time limit.If no rectification is made within the time limit,the appointment shall be deemed not to have been made.

(3)Where the petitioner and the patentee have appointed the same patent agency,the Patent Reexamination Board shall notify the both parties to change their appointments within a specified time limit.If no change of appointment is made within the specified time limit,the later appointment shall be deemed not to have been made; if the both appointments were made on the same date,both of them shall be deemed not to have been made.

Rule 66.1

(4)Where the petitioner shall appoint a patent agency according to Article 19.1,but fails to meet this requirement,the request for invalidation shall not be accepted.

(5)Where the petitioner has appointed more than one patent agency at the same time,he shall designate in written form one of the agencies as the contact person.If no agency was designated,the Patent Reexamination Board will take the agency entrusted first in the invalidation procedure as the contact person; where more than one agency was entrusted first,the Patent ReexaminationBoard will take the agency in the first name order as the contact person; where there was no name order (separately entrusted on the same day),the Patent Reexamination Board shall notify the petitioner to designate within a specified time limit, and if no designation is made within the time limit,the appoint-

ment shall be deemed not to have been made.

(6)Where a party intends to appoint a citizen as his representative, the provisions governing the appointment of a patent agency shall apply mutatis mutandis. The scope of power for a citizen representative shall be limited to making observations and receiving documents in oral proceedings.

(7)The agent is required to submit a specially authorized power of attorney where:

- (i)the agent of the patentee admits the petitioner's request for invalidation;
- (ii)the agent of the patentee amends the claims of the patent;
- (iii)the agents reach a settlement;
- (iv)the agent of the petitioner withdraws the request for invalidation.

(8)For other matters not described in the above,Chapter 1, Section 6.1 of Part I of these Guidelines shall apply mutatis mutandis.

### **3.7 Notifications of Formal Examination**

(1)Where the request for invalidation is found not in compliance with the provisions of the Patent Law,its Implementing Regulations or these Guidelines after formal examination and needs to be rectified,the Patent Reexamination Board shall issue Notification to Make Rectification to invite the petitioner to make a rectification within fifteen days from the date of receipt of the notification.

(2)Where the request for invalidation is deemed not to have been made or is not accepted,the Patent Reexamination Board shall issue Notification that Request for Invalidation Deemed Not to Have Been Made or Notification of Nonacceptance of Request for Invalidation to notify the petitioner.

Rule 68.1

(3)Where,after the formal examination,it is found that the request for invalidation conforms with the relevant provisions of the Patent Law,its Implementing Regulations and these Guidelines, the Patent Reexamination Board shall issue Notification of Acceptance of Request for Invalidation to both the petitioner and the patentee,and transfer copies of the request for invalidation and the relevant documents to the patentee and invite him to

make response within one month from the date of receipt of the notification. Where the patentee has appointed an agency for the whole term of the patent, copies of the request and the relevant documents shall be transferred to said agency.

(4) Where the accepted request for invalidation has to wait for an earlier examination decision on request for invalidation declaring a patent right invalid in whole or in part to come into effect and thus cannot be examined for the time being, the Board shall issue a notification to notify the petitioner and the patentee; after the earlier examination decision has come into effect or is overturned by an effective judgment of the People's Court, the Board shall restore the examination timely.

(5) Where the accepted request for invalidation is involved in a patent infringement case, the Patent Reexamination Board may, at the request of the People's Court or a local intellectual property administrative authority or the party concerned, issue Notification of Examination Status of Request for Invalidation to the People's Court or the local intellectual property administrative authority which is handling the patent infringement case.

#### **4. Collegiate Examination of Request for Invalidation**

##### **4.1 Scope of Collegiate Examination**

In the invalidation procedure, the Patent Reexamination Board usually performs examination pursuant to the scope requested by the petitioner and only on the causes and evidence submitted by the parties concerned, and bears no obligation of a comprehensive examination on the validity of the patent.

Where the Patent Reexamination Board has made an examination decision of partial invalidation of a patent right, and the party concerned does not institute legal proceedings before the People's Court within three months from the receipt of the decision or the examination decision is upheld by an effective judgment of the People's Court, the examination on other requests for invalidation concerning the same patent right shall be directed to the claims maintained.

Rules 65.1 & 67

For causes which are not explained concretely or evidence which is not used to support any cause at the time of submission of the request for invalidation by the petitioner, if no further ex-

planation is provided within one month from the date of filing the request, the Patent Reexamination Board will not take them into account.

For causes for invalidation the addition of which is not in conformity with the provisions of Section 4.2 of this Chapter or evidence by the petitioner the supplement of which is not in conformity with the provisions of Section 4.3 of this Chapter, or evidence by the patentee the submission or supplement of which is not in conformity with the provisions of Section 4.3 of this Chapter, the Patent Reexamination Board will not take them into account.

The Patent Reexamination Board may conduct examination ex officio in the following circumstances:

(1) where the causes raised by the petitioner are obviously inappropriate to the evidence submitted, the Patent Reexamination Board may inform the petitioner of the meanings of the relevant provisions, and allow him to change or change ex officio the causes to suitable ones. For example, where the evidence submitted by a petitioner is a patent for invention previously filed by the same patentee with the Patent Office and later published after the filing date of the patent in dispute, but the cause for invalidation is inconformity with Article 9.1, the Patent Reexamination Board may explain the meanings of Article 9.1 and Article 22.2 and allow the petitioner to change the cause to inconformity with Article 22.2, or ex officio change the cause to inconformity with Article 22.2;

Art.2,5 & 25

(2) where a patent is found to have the defect that obviously falls within the subject matters excluded from patent protection and the defect is not indicated by the petitioner, the Board may introduce a corresponding cause into the invalidation, and perform examination in that regard;

(3) where a patent is found to have such a defect not indicated by the petitioner as to inhibit further examination on the causes raised by the petitioner, the Patent Reexamination Board may introduce ex officio a corresponding cause to the defect into the causes for invalidation, and perform examination on the cause. For example, where the cause for invalidation is that the independent claim 1 does not involve an inventive step, if the claim is not clear and the extent of protection can not be clearly de-



fined,so that there is no base to examine the inventive step of the claim,the Patent Reexamination Board may introduce Article 26.4 into the causes for invalidation and perform examination ex officio;

(4)where the petitioner requests for invalidating some of the claims which have reference relationship among them,does not request for invalidating the other claims on the same ground, and the examination conclusion will be unreasonable if the Board dose not introduce such cause,the Board may ex officio introduce such cause and perform examination on the other claims in that regard.For example,where the petitioner requests for invalidating a patent on the ground that claim 1 possesses no novelty and dependent claim 2 possesses no inventive step,if the Board finds that claim 1 possesses novelty,and claim 2 possesses no inventive step,it may examine the inventive step of claim 1 ex officio;

(5)where the petitioner requests for invalidating some of the claims which have reference relationship among them on the ground that they have some defect,and does not indicate that the other claims have defect of the same nature,the Board may introduce a corresponding cause to the defect into the invalidation and examine the other claims in that regard.For example, the petitioner requests for invalidating claim 1 on the ground that a technical feature has been added to it,therefore it is not in conformity with Article 33,while he does not indicate dependent claim 2 has the same defect,the Board may introduce the cause for invalidation concerning Article 33 to examine dependant claim 2 ex officio;

(6)where the petitioner requests for invalidating a patent on the ground that it is not in conformity with Article 33 or Rule 43.1 and makes a specific analysis and description of the fact that the amendment goes beyond the scope of the original disclosure, but fails to submit the original application document,the Board may introduce the original application document of the patent as the evidence;and

(7)the Patent Reexamination Board may determine ex officio whether a technical means belongs to common knowledge of the art,and may introduce such common knowledge evidence as those in a technical dictionary,technical manual,or textbook into

Rule 67

#### **4.2 Addition of Causes for Invalidation**

(1)Where the petitioner raises additional causes for invalidation within one month from the date of submitting the request, he shall explain the causes concretely within this period; otherwise the Patent Reexamination Board will not take them into account.

(2)Where the petitioner raises additional causes for invalidation after one month from the date of submitting the request, generally the Patent Reexamination Board will not take them into account,unless in any of the following circumstances:

(i)for claims amended by way of combination by the patentee, addition of causes for invalidation is made within the time limit specified by the Patent Reexamination Board,and the added causes are explained concretely within the time limit; or

(ii)the addition is to change the causes for invalidation which are obviously inappropriate to the evidence submitted.

#### **4.3 The Time Limit for Presenting Evidence**

##### **4.3.1 Presenting Evidence by the Petitioner**

(1)Where the petitioner presents additional evidence within one month from the date of filing the request for invalidation,he shall explain concretely the relevant causes for invalidation with reference to the additional evidence within this period; otherwise the Patent Reexamination Board will not take it into account.

(2)Where the petitioner presents additional evidence after one month from the date of filing the request for invalidation, generally the Patent Reexamination Board will not take it into account,unless in any of the following cases:

(i)concerning claims amended by way of combination or counterevidence presented by the patentee,the petitioner presents additional evidence within the time limit specified by the Patent Reexamination Board,and explain the relevant causes concretely with reference to the additional evidence within this period;

(ii)by the closure of oral proceedings,the petitioner presents

such evidence of common knowledge in the skilled art as those in a technical dictionary, technical manual, or textbook, or such complementary evidence for meeting the legal requirement for evidence as a notarial document or the original, and explain the relevant causes concretely with reference to the additional evidence within the period; or

(3) where the petitioner presents evidence in a foreign language, the time limit for submitting the Chinese translation thereof is the same as that for presenting the evidence.

#### **4.3.2 Presenting Evidence by the Patentee**

The patentee shall present evidence within the time limit for response as specified by the Patent Reexamination Board, but he may present, by the closure of oral proceedings, such evidence of common knowledge in the skilled art as those in a technical dictionary, technical manual, or textbook or such complementary evidence used for meeting the legal requirement for evidence as a notarial document or the original.

Where the patentee presents or adds evidence, he shall explain concretely the evidence within the above time limit.

Where the patentee presents evidence in a foreign language, the time limit for submitting the Chinese translation thereof is the same as that for presenting the evidence.

Where the patentee does not present or add evidence within the above time limit, or he fails to explain concretely the evidence within the above time limit, the Patent Reexamination Board will not take it into account.

#### **4.3.3 Presenting Evidence in Extension Period**

Where either of the parties has evidence to prove that his failure to present evidence within the time limit as specified in Section 4.3.1 or 4.3.2 of this Chapter was due to force majeure, he may, within the specified time limit, request in written form the extension of the time limit. If refusal of the request will result in obvious inequity, the Patent Reexamination Board shall allow the extension of the time limit.

#### **4.4 Manners of Examination**

#### **4.4.1 Transfer of Documents**

Rule 68

The Patent Reexamination Board shall, if need be, transfer the relevant documents to the parties concerned. Where it is necessary to prescribe a time limit for submitting the response, the time limit shall be one month. If the party fails to make a response within the time limit, said party shall be deemed to have been aware of the facts, causes, and evidence contained in the transferred documents and does not raise any objection.

Any observations and the attachments submitted by the parties concerned shall be made in duplicate.

#### **4.4.2 Oral Proceedings**

Rule 70

The Patent Reexamination Board may, at the request of the parties concerned or in accordance with the needs of the case, decide to take oral proceedings for a request for invalidation. For specific provisions concerning oral proceedings, see Chapter 4 of this Part.

#### **4.4.3 Notification of Examination on Request for Invalidation**

In the invalidation procedure, the Patent Reexamination Board may issue Notification of Examination on Request for Invalidation

to both parties concerned in any of the following circumstances:

(1) where the facts alleged or evidence presented by the parties concerned are unclear or doubtful;

(2) where the patentee has amended his claims on his own initiative, but the amendment is not in conformity with the relevant provisions of the Patent Law, its Implementing Regulations or these Guidelines;

(3) where the Patent Reexamination Board needs to introduce ex officio causes or evidence not mentioned by the party concerned; or

(4) any other circumstance under which the issuance of Notification of Examination on Request for Invalidation is necessary.

For the party to which the notification of examination is directed, it shall respond within one month from the date of receiving the notification. If no response is made within the time limit, the party shall be deemed to have been aware of the facts, causes

and evidence contained in the notification and does not raise any objection.

#### Rules 68 & 70

#### 4.4.4 Selection of Manners of Examination

In the invalidation procedure, the examination shall be performed in any of the following manners depending on the circumstances.

(1) If the Patent Reexamination Board has transferred the documents of the request for invalidation to the patentee, then, at the expiration of the specified time limit for making a response, no matter whether the patentee has made a response or not, so long as no oral proceedings is requested by him, and the Patent Reexamination Board considers that the evidence submitted by the petitioner is sufficient, and the causes for invalidating the whole patent are tenable, it may directly make an examination decision of invalidating the whole patent; if the petitioner requests to invalidate the patent only in part, the Patent Reexamination Board may also directly make an examination decision of invalidating the patent in the same part. If the patentee has submitted a response, the response may be transferred to the petitioner along with the examination decision so directly made.

(2) If the Patent Reexamination Board has transferred the documents of the request for invalidation to the patentee, then, at the expiration of the specified time limit for making a response, no matter whether the patentee has made a response or not, so long as the Patent Reexamination Board finds, upon consideration, the scope as requested for invalidation by the petitioner is tenable in part, and possibly a decision of invalidating the patent in part is to be made, the Patent Reexamination Board shall issue Notification of Oral Proceedings and conclude the case through oral proceedings. If the patentee has submitted a response, the response shall be transferred to the petitioner along with Notification of Oral Proceedings.

(3) If the Patent Reexamination Board has transferred the documents of the request for invalidation to the patentee, and the patentee has made a response within the time limit, then, so long as the Patent Reexamination Board considers that the causes in the response are well founded, and a decision of upholding the patent is to be made, the Patent Reexamination Board shall,

depending on the specific circumstance of the case,choose to issue either Notification of Transfer of Documents or Notification of Examination on Request for Invalidation to perform the examination in written form; or issue Notification of Oral Proceedings along with Notification of Transfer of Documents to conclude the case through oral proceedings.

(4)If the Patent Reexamination Board has transferred the documents of the request for invalidation to the patentee and the patentee failed to respond within the specified time limit,so long as the Patent Reexamination Board considers that the evidence submitted by the petitioner is insufficient and that the causes for invalidating the patent are not tenable,and a decision of upholding the patent is to be made,the Patent Reexamination Board shall,depending on the specific circumstance of the case, choose to either issue Notification of Examination on Request for Invalidation to perform the examination in written form,or issue Notification of Oral Proceedings to conclude the case through oral proceedings.

If,after the issuance of Notification of Oral Proceedings, the oral proceeding is not taken on schedule due to reasons on the part of the parties concerned,the Patent Reexamination Board may directly make an examination decision.

#### **4.5 Combined Examination of Cases**

In order to increase the efficiency of examination and lighten the burden of the parties concerned,the Patent Reexamination Board may hear cases in combination.The circumstances for combined examination include the following:

(1)where more than one case of request for invalidation is directed to the same patent,the Patent Reexamination Board shall as far as possible take the oral proceedings in combination; and

(2)for cases of request for invalidation directed to different patents,where part or all of the parties concerned are the same and the facts of the cases relate to each other,the Patent Reexamination Board may,at the request in written form of the party concerned or at its own initiative,take the oral proceedings in combination.

The evidence in different cases of invalidation heard in combination

cannot be used in a combinative way.

## **4.6 Amendment to Patent Documents in the Invalidation Procedure**

### **4.6.1 Principles of Amendment**

Any amendment to the patent documents of a patent for invention or utility model shall be limited to the claims only, and shall follow the following principles:

- (1) the title of the subject matter of a claim can not be changed;
  - (2) the extent of protection can not be extended as compared with that in the granted patent;
  - (3) the amendment shall not go beyond the scope of disclosure contained in the initial description and claims; and
  - (4) addition of technical features not included in the claims as granted is generally not allowed.
- The patent document of a design patent cannot be amended.

### **4.6.2 Manners of Amendment**

Subject to the above principles of amendments, the specific manners of amendment are generally limited to deletion of a claim, combination of claims, and deletion of a technical solution.

Deletion of a claim means one (or more) claim, such as an independent claim or a dependent claim, is removed from the claims.

Combination of claims means that two or more claims dependent on a same independent claim and having no relation of dependency are combined together. Under this circumstance, all the technical features of the combined dependent claims constitute a new claim. The new claim shall contain all the technical features of each of the dependent claims thus combined. The dependent claims subordinated to a same independent claim shall not be combined together unless the independent claim is amended.

Deletion of a technical solution means to remove one or more technical solutions from several parallel technical solutions defined in the same claim.



#### **4.6.3 Restrictions to Manners of Amendment**

Before the Patent Reexamination Board makes a decision on the request for invalidation, the patentee may either delete a claim or delete a technical solution contained in a claim.

The patentee may amend the claims by the way of combination within the time limit for response only in one of the following circumstances:

- (1) in response to the request for invalidation;
- (2) in response to causes for invalidation or evidence added by the petitioner;
- (3) in response to causes for invalidation or evidence not mentioned by the petitioner but introduced by the Patent Reexamination Board.

Rule 88

#### **4.7 Suspension of the Invalidation Procedure**

In this regard, Chapter 7, Section 7 of Part V shall apply.

#### **5. Types of Examination Decisions on Request for Invalidation**

There are three types of examination decisions for a request for invalidation, which are:

- (1) declaring a patent right invalid in whole;
- (2) declaring a patent right invalid in part; and
- (3) maintaining the validity of a patent right.

Declaring a patent right invalid includes the situations of declaring a patent right invalid in whole and declaring a patent right invalid in part. According to Article 47, any patent right which has been declared invalid shall be deemed to be non-existent from the date of filing.

In the invalidation procedure, where the causes for invalidation directed to some of the claims of an invention or utility model patent are tenable and the causes for invalidation directed to other claims (including the claims after amendment by way of combination) are untenable, the decision for the request for invalidation shall declare invalid those claims to which the causes for invalidation are tenable and maintain the validity of the other claims. For a design patent having designs of several products of independent use, where the causes for invalidation directed to some of the product designs are tenable and the causes directed to

other product designs are untenable,the decision for the request for invalidation shall declare invalid those product designs to which the causes for invalidation are tenable and maintain the validity of the other product designs.For example,for a design patent which has two or more similar designs of the same product, if some causes for invalidation concerning some of the designs are tenable and the causes concerning the other designs are untenable,the decision on request for invalidation shall declare invalid those designs to which the causes for invalidation are tenable and maintain the validity of the other designs.Both of the above decisions are examination decisions of the type declaring a patent right invalid in part.

Where a patent right is declared invalid in part,the part of the patent right so invalidated shall be deemed non-existent from the date of filing,and the part of the patent right that are maintained valid (including the amended claims)shall be deemed existent from the date of filing at the same time.

## **6.Delivery,Registration and Announcement of Examination Decision on Request for Invalidation**

### **6.1 Delivery of Decision**

According to Article 46.1,the Patent Reexamination Board shall deliver the examination decision on the request for invalidation to the both parties.

For a request for invalidation that involves an infringement dispute,where the relevant People's Court or local intellectual property administrative authority had been notified before the initiation of the examination on the request for invalidation,the Patent Reexamination Board shall,after making the decision,deliver the examination decision and Notification of Termination of Examination on Request for Invalidation to the People's Court or local intellectual property administrative authority.

### **6.2 Registration and Announcement of Decision**

According to Article 46.1,after the Patent Reexamination Board has made an examination decision of declaring the patent right invalid(in whole or in part),if the party concerned does not

institute legal proceedings before the people's court within three months from receipt of the decision, or the decision is upheld by an effective judgment of the People's Court, the examination decision shall be registered and announced by the Patent Office.

#### **7.Termination of the Invalidation Procedure**

Rule 72

Where the petitioner withdraws his request for invalidation before the Patent Reexamination Board makes an examination decision on it, the invalidation procedure terminates, unless, based on the examination it has done, the Patent Reexamination Board finds that a decision invalidating the patent right in whole or in part can be made.

Rules 70.3  
& 72.2

Where the petitioner fails to make a response to Notification of Oral Proceedings within the specified time limit and fails to appear in the oral proceedings so that the request for invalidation is deemed withdrawn, the invalidation procedure terminates, unless, based on the examination it has done, the Patent Reexamination Board finds that a decision invalidating the patent right in whole or in part can be made.

Where a request for invalidation, which has been accepted is found to be in conformity with the requirements for acceptance and is thus rejected, the invalidation procedure terminates.

After the Patent Reexamination Board has made a decision of examination, the party concerned does not institute legal proceedings before the people's court within three months from receipt of the decision, or the decision is upheld by an effective judgment of the People's Court, the invalidation procedure terminates. After the Patent Reexamination Board has made an examination decision of declaring a patent right invalid in whole, the party concerned does not institute legal proceedings before the people's court within three months from receipt of the decision, or the decision is upheld by an effective judgment of the People's Court, the invalidation procedures in all other cases concerning the same patent right shall terminate.

# Chapter 4 Provisions Concerning Oral Proceedings in the Reexamination and Invalidation Procedures

## **1.Introduction**

The procedure of oral proceedings is a formal administrative hearing procedure provided pursuant to Rules 63 and 70, the aim of which is to ascertain the facts through investigation and provide the parties concerned with opportunity to make observations before the panel.

Rule 70.1

## **2.Determination of Oral Proceedings**

In the invalidation procedure, the party concerned may request for oral proceedings and explain the reasons therefor to the Patent Reexamination Board. The request shall be submitted in written form.

The parties concerned in the invalidation procedure may request for oral proceedings based on any of the following reasons:

- (1) one of the parties requests for face-to-face cross-examination of evidence and debate with the opposite party;
- (2) there is a need to explain the facts to the panel;
- (3) there is a need to demonstrate a material object; or
- (4) there is a need to call a witness giving evidential statement in testimony.

For cases of request for invalidation for which no oral proceedings has been taken, where the Patent Reexamination Board receives a request from the party concerned for oral proceedings in written form based on one of the reasons mentioned above, the panel shall decide to take oral proceedings.

In the reexamination procedure, the petitioner for reexamination may request for oral proceedings and explain the reasons therefor to the Patent Reexamination Board. The request shall be submitted in written form.

The petitioner for reexamination may request for oral proceedings based on any of the following reasons:

- (1) there is a need to explain the facts or causes to the panel;
- or

(2)there is a need to demonstrate a material object.

Where the petitioner for reexamination requests for oral proceedings,the panel shall decide whether to take oral proceedings in accordance with the needs of the case.

In the invalidation or reexamination procedure,the panel may decide on its own initiative whether to take oral proceedings in accordance with the needs of the case.For the same case where oral proceedings have been taken,if necessary,oral proceedings may be taken once again.

Subject to the approval of the Director or Deputy Director, the Patent Reexamination Board may take itinerant oral proceedings and handle cases on the spot.All necessary expenses shall be borne by the Board.

### **3.Notification of Oral Proceedings**

Rules 70.2,  
70.3 & 72.2

In the invalidation procedure,after the determination of taking oral proceedings,the panel shall issue Notification of Oral Proceedings to the parties concerned,informing them of the date,place and other matters of the oral proceedings to be taken. Normally the date and place of oral proceedings shall not be changed once they are fixed.Where it is necessary to change the date or place in a special situation,the change shall be subject to agreements by the both parties or the approval by the Director or Deputy Director of the Board.The parties shall submit the acknowledgment of receipt of the notification to the Board within seven days from the date of receipt.Where the petitioner for invalidation fails to submit the acknowledgment of receipt within the specified time limit and fails to appear in the oral proceedings, the request for invalidation shall be deemed withdrawn,and the invalidation procedure terminates.Unless,based on the examination it has done,the Patent Reexamination Board finds that a decision declaring the patent right invalid in whole or in part can be made.Where the patentee does not appear in the oral proceedings,the proceedings may be taken by default.

Rule 63.1

In the reexamination procedure,after the determination of taking oral proceedings,the panel shall issue Notification of Oral Proceedings to the petitioner for reexamination,informing him of the date and place of and matters to be investigated in the

oral proceedings to be taken. Where the panel considers the patent application is not in conformity with the relevant provisions of the Patent Law and its Implementing Regulations, it shall notify the petitioner for reexamination of the specific facts, grounds and evidence thereof along with Notification of Oral Proceedings.

The panel shall notify the petitioner for reexamination that he may choose either to attend the oral proceedings to make oral observations or to make observations in written form within the specified time limit. The petitioner for reexamination shall submit the acknowledgment of receipt of the notification to the Board within seven days from the date of receipt, and indicate definitely whether he will attend the oral proceedings. Failure to submit the acknowledgment of receipt within the specified time limit is deemed not intending to attend the oral proceedings.

Where the specific facts, grounds and evidence for which the patent application is not in conformity with the relevant provisions of the Patent Law or its Implementing Regulations have been indicated in Notification of Oral Proceedings, if the petitioner for reexamination neither appears in the oral proceedings nor makes observations in written form within the specified time limit, the request for reexamination shall be deemed withdrawn.

The acknowledgement of receipt of Notification of Oral Proceedings in the invalidation or reexamination procedure shall be signed or sealed by the party concerned. Where the party concerned expresses its intention to appear in the oral proceedings, names of the persons to appear in the oral proceedings shall be clearly indicated. Where the party concerned intends to call a witness having given evidential statement in testimony before the panel, it shall so indicate in the acknowledgement of receipt of Notification of Oral Proceedings, and provide the name and affiliation (or occupation) of the witness and the facts to be testified.

For each party concerned, the number of persons including its agent appear in the oral proceedings shall not exceed four. Where in the acknowledgement of receipt the indicated number of persons to appear in the oral proceedings is less than four, others may be designated to appear in the oral proceedings before the proceedings start. Where a party has more than one person to appear in the oral proceedings, it shall designate one of them as

the first speaker to address primarily.

Where a person concerned cannot appear in the oral proceedings on the fixed date, he may appoint his patent agent or any other person to appear on his behalf.

Where a party concerned has appointed a patent agency according to Article 19, the patent agency shall designate its patent agents to appear in the oral proceedings.

#### **4.Preparation Before Oral Proceedings**

Before oral proceedings start, the following work shall be done by the panel:

(1) transferring in the invalidation procedure the relevant documents submitted by a party to the opposite party;

(2) reading and studying the files, understanding the details of the case, and identifying the key points in dispute and the main issues to be investigated and debated;

(3) holding a panel meeting prior to the oral proceedings to decide on the distribution of duties of the panel members in the oral proceedings, the order and contents of the investigation, main issues to be ascertained, and various circumstances likely to occur during the oral proceedings and the corresponding handling;

(4) preparing necessary documents;

(5) announcing the relevant information of taking the oral proceedings two days before the oral proceedings (unless the oral proceedings are not taken in public); and

(6) preparations concerning other administrative matters for the oral proceedings.

#### **5.Taking of Oral Proceedings**

Oral proceedings shall be taken on the scheduled date.

Oral proceedings shall be taken in public, unless they need to be kept confidential in accordance with the provisions of the laws or regulations.

##### **5.1 The First Stage of Oral Proceedings**

Before oral proceedings start, the panel shall check the identities of the persons appear in the oral proceedings and make sure

they are eligible to appear.

Oral proceedings shall be presided over by the chairman. The chairman opens the oral proceedings, and introduces the panel members; the party concerned introduces the persons appear in the oral proceedings on its part and, where two parties appear, the opposite party shall be consulted for any objection to the eligibility of the persons appearing on either part; the chairman announces the rights and obligations of the parties concerned, inquires whether the party concerned would file a motion to recuse the panel members, and whether the party concerned requests to call a witness in testimony or to make a demonstration of material evidence.

In inter parte oral proceedings, the parties concerned shall be inquired as to whether they are willing to make compromise. If both parties have the willingness and intend to compromise before the panel, the oral proceedings shall halt. Where there is little difference in expectations of the two parties, the oral proceedings may be suspended; where there is great difference in their expectations and it is difficult for them to reach a compromise in a short period of time, or where any of the parties has no willingness to compromise, the oral proceedings shall continue.

## **5.2 The Second Stage of Oral Proceedings**

Before starting the investigation in oral proceedings, if necessary, the facts of the case may be briefed by a panel member. The investigation starts thereafter.

In oral proceedings of the invalidation procedure, first the petitioner for invalidation states the scope to be requested for invalidation and the causes therefor, and briefly describes the relevant facts and evidence. Then, the patentee makes a response. After that, the panel checks the scope and the causes for invalidation and the evidence submitted by both parties, and determines the scope of oral proceedings. Where a party raises new causes or presents new evidence in oral proceedings, the panel shall determine whether the causes or evidence are to be considered in accordance with the relevant provisions. If they are decided to be considered, the opposite party shall have the options to make an oral response before the panel or in written form afterwards.



as it is the first time for him to become aware of the causes or evidence. Then, the petitioner for invalidation shall adduce evidence for the causes for invalidation. Next, the patentee may examine the evidence and, if need be, raise counterevidence followed by examination by the opposite party. Where in a case there are many causes for invalidation, facts or evidence to be affirmed, the panel may require the parties to adduce and examine evidence regarding the causes for invalidation and the alleged facts one by one.

In oral proceedings of the reexamination procedure, after the panel has told the petitioner the main issues to be investigated, the petitioner for reexamination may make submissions. Where the petitioner for reexamination makes amendments to the application document before the panel, the panel shall examine whether the amendments are in conformity with the relevant provisions of the Patent Law, its Implementing Regulations and these Guidelines.

In oral proceedings, in order to identify comprehensively and objectively the facts, the panel may question the parties or witnesses about the relevant facts and evidence, and may also require the parties or witnesses to make explanations. Questioning shall be impartial, objective, specific and clear.

### **5.3 The Third Stage of Oral Proceedings**

In oral proceedings of the invalidation procedure, following investigation is the proceeding of debate. If both parties have no dispute about the evidence and facts of the case, then the proceeding of debate may be taken directly on the basis of the evidence and facts recognized by both parties. The parties may respectively make observations and debate on the matters in dispute and the application of laws and regulations to the facts as shown by the evidence. During the debate, the panel members may raise questions, but shall neither make any tendentious statement nor argue with any of the parties. If in the course of debate any party raises a fact or evidence previously submitted but not examined, the chairman may halt the proceeding of debate and restore the proceeding of investigation. The debate shall continue after the completion of investigation.

After the parties have completely submitted their observations,

the chairman announces the end of the debate, and invites the parties to make their final statements. In making the final statements, the petitioner for invalidation may insist on his request for invalidation or withdraw the request. He may also renounce part of the causes for invalidation and the corresponding evidence, or narrow the scope to be requested for invalidation. The patentee may insist on his demand for rejecting the request for invalidation, or declare to narrow down the scope of patent protection or renounce part of the claims. Thereafter, the two parties may try to compromise again as they did at the start of the procedure.

In oral proceedings of the reexamination procedure, after investigation the panel may make tendentious observations on the relevant issue. If necessary, the panel may notify the petitioner for reexamination of the specific facts of and grounds and evidence for which the patent application is considered not in conformity with the relevant provisions of the Patent Law, its Implementing Regulations and the Guidelines, and hear the submissions of the petitioner for reexamination.

#### **5.4 The Forth Stage of Oral Proceedings**

In oral proceedings, the panel may adjourn for deliberation as the case needs.

The chairman announces temporary adjournment and the panel deliberates. Then, the oral proceedings are resumed. The conclusion of oral proceedings shall be announced by the chairman. It may be either a conclusion of the examination decision, or any other conclusion, such as a conclusion that the facts of the case have been clearly identified and an examination decision is ready to be made. To this time, the oral proceedings come to an end.

#### **6. Suspension of Oral Proceedings**

In any of the following circumstances, the chairman may announce the suspension of oral proceedings and, if necessary, fix a date for the resume of the oral proceedings:

- (1) where the party concerned files a motion to recuse some panel member;
- (2) where the parties require negotiation for compromise;
- (3) where there is a need for further demonstration of the

invention-creation; or

(4) any other circumstance where the panel deems necessary.

### **7. Termination of Oral Proceedings**

For cases where the facts are clearly identified, an examination decision is ready to be made, and the examination decision needs not to be approved by the Director or Deputy Director of the Board, the panel may announce the conclusion of the examination decision on the spot.

For cases which conclusion of examination decision is planned to be announced on the spot but shall be subject to the approval of the Director or Deputy Director of the Board, the conclusion of the examination decision shall be announced after the approval.

Where the panel does not intend to announce on the spot the conclusion of an examination decision, the chairman shall make a brief explanation.

In any of the above three circumstances, it shall be the chairman who announces the termination of oral proceedings. Thereafter, the full text of the decision shall be delivered to the parties in written form within a certain period of time.

### **8. Absence of a Party Concerned**

Where one of the parties fails to appear in the oral proceedings, the panel shall take the oral proceedings according to the prescribed procedures so long as the presence of the other party in the oral proceedings complies with the procedural requirements.

### **9. Quit From Oral Proceedings**

During oral proceedings for a request for invalidation or reexamination, the parties shall not quit without permission of the panel. Where a party quits from oral proceedings without permission of the panel or is expelled by the panel due to disruption to the oral proceedings, the proceedings may be taken by default. However, in this case, record shall be made as to the observations already made by the party and to the fact that the party quitted or was expelled, and shall be signed and confirmed by the

party or the panel members.

#### **10. Witness in Testimony**

A witness who has provided oral evidence and has been indicated in the receipt of Notification of Oral Proceedings may testify in oral proceedings. Where the party concerned requests to call a witness in testimony during oral proceedings, the panel may decide whether to accept the request according to the circumstance of the case.

The witness shall produce his identification before testifying before the panel. The panel shall inform him of the legal obligation of honest testifying and the legal consequence of providing false evidence. The witness to be called in testimony shall not be allowed to audit the oral proceedings. Where a witness is inquired, the other witnesses shall not attend, unless they are required to make cross-examination of the evidence.

The panel may inquire a witness. In inter parte oral proceedings, the both parties may alternatively inquire a witness. The witness shall answer the inquiries of the panel definitely, and may refuse to answer unrelated questions of either party.

#### **11. Recordation**

In oral proceedings, the secretary or a panel member designated by the chairman shall take the minutes of the proceedings. The person who takes the minutes shall note down the important items of the oral proceedings in the Record of Oral Proceedings. In addition to the minutes, the panel may use audio or video equipment to record.

After important items of oral proceedings being noted down or the termination of oral proceedings, the panel shall hand the minutes to the parties for reading. For errors or mistakes in the minutes, the party concerned may request the person who takes the minutes to make rectification. After being confirmed, the minutes shall be signed by the parties and kept in file. Where any party refuses to sign, the chairman shall note it in the Record of Oral Proceedings.

The above-mentioned important items of oral proceedings include:

(1) in oral proceedings of the invalidation procedure, the

claims renounced by the party concerned, the scope to be invalidated, and the causes or evidence for the request for invalidation;

(2) in oral proceedings of the invalidation procedure, important facts acknowledged by the both parties;

(3) in oral proceedings of the reexamination procedure, the specific fact, ground and evidence for which the application is not in conformity with the relevant provisions of the Patent Law, its Implementing Regulations and the Guidelines and of which the panel has notified the petitioner for reexamination in oral proceedings, and the main contents of the submissions by the petitioner for reexamination; and

(4) other important items which need to be noted down.

## **12. Public Audiences**

The public may be admitted to oral proceedings. Public audiences have no right to address the panel. Without prior approval, photographing, audio or video recording is not permitted. Public audiences shall not send any relevant message to the parties appear in the oral proceedings.

If necessary, the Board may require public audiences to go through the formalities for auditing.

## **13. Rights and Obligations of the Parties Concerned**

The chairman shall, at the beginning of oral proceedings, notify the parties of their rights and obligations in the oral proceedings.

(1) Rights of a party concerned

A party concerned shall have the right to request for recusing a panel member; the right to make compromise with the opposite party in the invalidation procedure; the right to call a witness having provided oral evidence in testimony before the panel in oral proceedings and the right to request for demonstration of material evidence; and the right to debate. A petitioner for invalidation shall have the right to withdraw the request; the right to abandon some causes for invalidation and the corresponding evidence; and the right to narrow down the scope to be requested for invalidation. A patentee shall have the right to renounce part of the claims and the corresponding evidence submitted. A petitioner for reexamination shall have the right to withdraw his

request for reexamination; and the right to submit amendments to the application.

(2)Obligations of a party concerned

A party concerned shall abide by the rules of oral proceedings and keep the order of oral proceedings; shall request the approval of the chairman before speaking,and shall not interrupt the speech of the other party; and shall provide rational reasoning in debate.Observations and debate shall be restricted to the scope,which is relevant to the examination of the case as defined by the panel.The party concerned shall bear the burden of proof for what he alleges,and shall explain reasons in opposing the allegations of the opposite party.During oral proceedings, any party shall not quit from oral proceedings midway without permission of the panel.

# Chapter 5 Examination of Design Patent in the Invalidation

## Procedure

### 1.Introduction

This Chapter mainly deals with the examination of design patent concerning Articles 23 and 9 in the invalidation procedure. With regard to the examination concerning other provisions related to the request for invalidation of design patent, Chapter 3 of Part I shall apply.

### 2.Prior Design

According to Article 23.4, the prior design refers to the design known to the public before the date of filing in China or abroad (or the priority date, where priority is claimed).

The prior design includes designs that are made known to the public by publishing, public use or other means in China or abroad before the date of filing. With regard to the time limit, means of disclosure, etc., of the prior design, Chapter 3 of Part II shall apply.

Usual design refers to the prior design, which is so familiar to a normal consumer that the mention of its name would remind him of that particular design. For example, when packing box is mentioned it would remind people of a design with the shape of cuboid or cube.

Art.2.4

### 3.Objects of Judgment

In the examination of design patent, the objects to be compared are called objects of judgment. The design patent requested for invalidation is hereinafter referred to as the patent concerned and the object of judgment to be compared with the patent concerned is hereinafter referred to as the comparative design.

In determining the objects of judgment, for the patent concerned, in addition to the drawings or photographs of the design patent, the determination shall also be made in accordance with facts such as whether the brief explanation contains any request for protection of colour or whether it has such content as

“the existence of boundless unit pattern of two-side continuation or four-side continuation in plane product”(boundless design).

There are six types of the patent concerned.

(1)Design of mere shape

A design of mere shape refers to a shape design of a product that has no definition by pattern and no request for protection of colour.

(2)Design of mere pattern

A design of mere pattern refers to a pattern design of a plane product that has no request for protection of colour and is boundless.

(3)Design of shape and pattern

A design of shape and pattern refers to a shape and pattern design of a product that has no request for protection of colour.

(4)Design of shape and colour

A design of shape and colour refers to a shape and colour design of a product that has request for protection of colour but has no definition by pattern.

(5)Design of pattern and colour

A design of pattern and colour refers to a pattern and colour design of a plane product that has request for protection of colour and is boundless.

(6)Design of shape,pattern and colour

A design of shape,pattern and colour refers to a shape,pattern and colour design of a product that has request for protection of colour.

#### **4.Subject of Judgment**

The examination of whether a design patent is in conformity with Article 23.1 and 23.2,shall be made according to the knowledge and cognitive capability of a normal consumer of the product incorporating the patent concerned.

Different categories of design patent products have different consumers.A normal consumer of a certain category of product incorporating a design shall have the following characteristics:

(1)common knowledge of the designs and commonly used design methods incorporated in the same or similar products as that incorporating the patent concerned before its filing date.For



example, a normal consumer of cars shall know about the cars on the market and have general information of cars available from the frequently shown advertisement in the media.

The types of commonly used design methods include design transformation, mosaic, replacement, etc.

(2) certain capability of distinguishing the differences in shape, pattern and colour between design patent products, but without notice to the minor differences in shape, pattern or colour of products.

## **5. Examination in Accordance with Article 23.1**

According to Article 23.1, any design for which patent right may be granted shall not be a prior design, nor has any entity nor individual filed before the date of filing with the patent administration department under the State Council an application relating to the identical design and disclosed in patent documents announced after the date of filing.

The patent concerned shall not be a prior design means that there is no design identical or substantially identical with the patent concerned in the prior design. An identical design application which was filed by any entity or individual with the Patent Office and published on or after the filing date of the patent concerned (including the filing date), is called "conflicting application". Wherein, identical designs mean that the designs are identical or substantially identical.

Determining whether the comparative design constitutes a conflicting application for the patent concerned shall be made in accordance with all the content of the published comparative design. When comparing the comparative design with the design of the product claimed by the patent concerned, whether the comparative design includes a design identical or substantially identical with the patent concerned shall be decided. For example, the patent concerned requests for protection of colour, while the published comparative design contains colour, even though the comparative design has no request for protection of colour, the design contains colour in the comparative design could be used to compare with the patent concerned; also, the published comparative design includes reference view of the state in use, even though the reference view of the state in use contains design

which has not been claimed,the non-claimed design could be used to compare with the patent concerned to decide whether they are identical or substantially identical.

## **5.1 Criteria for Judgment**

### **5.1.1 Identity of Designs**

Identity of designs means that the patent concerned and the comparative design are designs for the same category of products, and all the design elements of the patent concerned are identical with the corresponding design elements of the comparative design,wherein design elements refer to shape,pattern and colour of a design.

If the difference between the comparative design and the patent concerned is merely a result of commonly used materials substitution or the difference only lies in the function,internal structure,technical performance or dimension of the product,and the difference does not lead to any change in the design of the product,the comparative design and the patent concerned are still identical designs.

In determining the category of product,reference may be made to the title,international classification for designs and the shelves classification of the product when it is on sale,however, the determination of whether two products belong to the same category shall be based on whether the uses of the two products are identical.The products of the same category refer to the products that have completely the same use.For example,although the internal structure of a mechanical watch and an electronic watch are different,they have the same use,and therefore they are of the same category.

### **5.1.2 Substantially Identical Designs**

The judgment of substantially identical designs is only limited to designs of the same or approximate category of products. Where the patent concerned and the comparative design are for products of neither the same nor approximate category, without making a comparison and judgment of the two,it can directly be determined that the patent concerned and the comparative design are not substantially identical,for example,designs of

towel and carpet.

Products of approximate categories refer to products that have similar use. For example, a toy and a tiny ornament are products of approximate categories, because they have similar use. It should be noted that for products having multiple uses, if some of the uses are the same and some are not, they are regarded as products of approximate categories. For example, a watch equipped with an mp3 player and a mere watch both have the use of timing, and therefore they are products of approximate categories.

If a normal consumer can see from the overall observation of the patent concerned and the comparative design, that their difference simply falls into the following circumstances, then the patent concerned and the comparative design are substantially identical:

(1) the difference lies in only slight changes in some fine details which cannot be noticed paying normal attention, for example the designs of venetian blind differ only in the number of slats;

(2) the difference exists in the parts which cannot be seen easily or cannot be seen at all when in use, however, the circumstance where there is evidence showing that the special design in the parts which cannot be seen easily has notable visual effect for a normal consumer makes an exception;

(3) the difference is a result of the substitution of one design element as a whole by said design element of the usual design commonly known for the category of product, for example, changing the shape of a cookie jar with pattern and colour from the cube to the cuboid;

(4) the difference exists in that the patent concerned is simply a repeated and continuous arrangement or an increase/decrease in the continuous number of the comparative design as a design unit following the normal arrangement of the category of product, for example, repeated and continuous arrangement of the rows of the seat in cinema or a increase/decrease in the number of the rows of seats; and

(5) the difference exists in that the patent concerned and the comparative design are a mirror image.

## **5.2 Method of Judgment**

The comparison and judgment of designs shall be based on the perspective of a normal consumer defined in Section 4 of this chapter.

### **5.2.1 One-to-One Comparison**

Generally the patent concerned shall be compared with only one comparative design, rather than with two or more comparative designs in combination.

If the patent concerned contains several designs of products which can be used separately, such as designs of a set of products or two or more similar designs for the same product, each of the designs may be separately compared with a different comparative design.

If the patent concerned is for a product comprising at least two components which are to be used when they are assembled together, the patent concerned may be compared with, as a single comparative design, a combination of prior designs that have a clear interrelation of assembly and are of the number corresponding to that of the components.

### **5.2.2 Direct Observation**

The comparison of designs shall be based on direct visual observation, rather than with the aid of magnifier, microscope, chemical analysis, or other instruments or means. The parts or elements that cannot be directly identified by eyes shall not form the basis of judgment. For example, if viewed visually, some textile products are identical or similar in the shape, pattern and colour. However, if viewed under a magnifier, there is much difference in their texture.

### **5.2.3 Targeting at Only the Appearance of a Product**

In the comparison of designs, account shall be taken only of the appearance of a product, considering the visual effect produced by the elements of shape, pattern and colour of a product or their combination.

Where the extent of protection of the patent concerned is defined only by part of its elements, the other elements will not

be considered when compared with a comparative design.

If the patent concerned applies to the component part of a product, the comparison of designs shall be made simply by comparing the corresponding part of the comparative design with the patent concerned, without taking the rest part into account.

For a product which uses transparent material to form its appearance, the shape, pattern and colour inside the transparent part which is visible through eyesight shall form part of the design for the product.

#### **5.2.4 Whole Observation and Comprehensive Judgment**

The comparison of designs shall be made through the approach of whole observation and comprehensive judgment. The approach of whole observation and comprehensive judgment means to determine on the observation of the patent concerned and the comparative design as a whole rather than on part or details of the designs.

##### **5.2.4.1 Determining the Information Disclosed by a Comparative Design**

Where the drawings or photographs of the comparative design do not display all the views of the product, the determination of information disclosed by the comparative design shall be based on the cognitive capability of a normal consumer.

If, based on the cognitive capability of a normal consumer, the design on the other parts of the product or in other varied states can be inferred according to the content disclosed by the drawings or photographs of the comparative design, the design on the other parts of the product or in other varied states is deemed to be also disclosed. For example, where the product is symmetrical with an axis, plane or center, if the drawings or photographs disclosed only one symmetrical side of the design, the other symmetrical side of the design is deemed to be also disclosed.

##### **5.2.4.2 Identifying the Patent Concerned**

The patent concerned shall be identified according to the drawings or photographs in the granted design document. The brief explanation can be used to interpret the design of the product

as shown in the drawings or photographs.

#### **5.2.4.3 The Comparison between the Patent Concerned and the Comparative Design**

The comparison between the patent concerned and the comparative design shall be made through the approach of whole observation and comprehensive judgment.

If the undisclosed part in the drawings or photographs of the comparative design is a part usually not drawing attention of a normal consumer in the state of use, and the change in this part does not notably influence the overall visual effect of the product, taking fans of an air-conditioner as an example, if the drawings or photographs of the comparative design do not disclose the bottom side and rear side of the fans, and the change which the patent concerned does in the bottom side or rear side is considered not sufficient to influence the overall visual effect of the product, then the whole observation and comprehensive judgment of the two designs will not be affected.

If the part of the patent concerned corresponding to the undisclosed part in the drawings or photographs of the comparative design is a usual design of the category of products and does not draw attention of a normal consumer, for example, if the undisclosed part in the drawings or photographs of the comparative design is a hind baffle plate for a truck, while the hind baffle plate of the patent concerned is merely a usual design of this category of products, then the whole observation and comprehensive judgment of the two designs will not be affected.

#### **5.2.5 Judgment Concerning Combination Product and Product of Variable States**

##### **5.2.5.1 Combination Product**

The combination product refers to a single product assembled by multiple components.

For an assembled product with only one option of assembly, such as an electronic kettle assembly comprising a kettle and a heater, when purchasing and using this category of product, a normal consumer will have an impression of the overall design of the electronic kettle after its components being assembled. Another

example is a blender ice machine comprising a blending cup, an ice cup and a base. When purchasing and using this category of product, a normal consumer will have an impression of the overall appearance of the blender assembled by the blending cup and the base, and the overall appearance of the ice machine assembled by the ice cup and the base. Therefore, the judgment shall target at the overall appearance of the product in the abovementioned assembled states, rather than at the appearance of each individual components.

For an assembled product with more than one option of assembly, such as a plug-in units toy, when purchasing and using this category of product, a normal consumer will have an impression of the design of each individual component. Therefore, the judgment shall target at the appearance of each individual component of the plug-in product, rather than the appearance of the whole product after being plugged in.

For a combination product without the need to assemble its components, such as poker cards and pieces of chess, when purchasing and using this category of product, a normal consumer will have an impression of the design of each individual component. Therefore, the judgment shall target at the appearance of each individual component.

#### **5.2.5.2 Product of Variable States**

A product of variable states means a product, which can be in various states when on sale or in use.

As for a comparative design, such a product in all its variable states may be compared with the patent concerned. As for the patent concerned, such a product shall be taken only in its state of use to compare with a comparative design, and the judgment shall be made considering comprehensively the design of the product in its various states of use.

#### **5.2.6 Judgment on Design Elements**

##### **5.2.6.1 Judgment on Shape**

In respect of the overall shape of a product design, a circle is considerably different from a triangle or a quadrilateral, generally they shall not be taken as substantially identical, unless the overall

shape of a product falls into the category of usual design.  
For a product like packing box, the judgment shall be made based on its shape in use.

#### **5.2.6.2 Judgment on Pattern**

Difference in pattern includes differences in such elements as subject, composition, expression and lines designed. Change in colour may also result in the difference in pattern. Where the subject is identical, but the composition, expression and lines designed are different, generally the pattern may not be deemed substantially identical.

Words and numbers on the exterior of a product, including the name of the product, are a category of pattern, and account shall be taken of its decorative function as part of the pattern, rather than of the meaning and pronunciation of them.

#### **5.2.6.3 Judgment on Colour**

The judgment on colour shall be made in a comprehensive way, taking account of the three properties of colour, i.e. hue, saturation, and lightness, and also combination and collocation of two or more colours. Hues of colour refer to shades of all categories of colours, such as vermilion, bright blue, lemon yellow, pink green, etc. Saturation means the degree of brilliance of colours. Lightness refers to the degree of brightness of colours. The white colour is the brightest, while the black colour is the darkest.

For monochromatic designs, only change in colour still makes them substantially identical.

### **6. Examination in Accordance with Article 23.2**

According to Article 23.2, any design for which patent right may be granted shall significantly differ from prior design or the combination of prior design features. The patent concerned significantly differs from prior design or the combination of prior design features in the following circumstances:

- (1) the patent concerned is not significantly different from the prior design of the product of the same or approximate category;
- (2) the patent concerned is transformed from the prior design,



the design features of the two are identical or only have very slight difference, and there's an inspiration for the specific transformation in the prior design of the product of the same or approximate category; and

(3) the patent concerned is a combination of the prior design or prior design features, the prior design and the corresponding part of the patent concerned are identical or only have very slight difference, and there's an inspiration for the specific combination in the prior design of the product of the same or approximate category.

If the patent concerned is transformed and combined from the prior design, the judgment shall be made based on the comprehensive observation in accordance with (2) and (3).

It should be noted that when a unique visual effect results from the above-mentioned transformation and/or combination, there could be an exception.

Prior design features refer to part of design elements of the prior design or their combination, such as shape, pattern, colour of the prior design or their combination, or the design of a component of the prior design, such as the design of the component of an integral design product.

#### **6.1 Comparison with the Prior Design of the Product of the Same or Approximate Category**

If a normal consumer finds that the difference between the patent concerned and the prior design does not notably influence the overall visual effect of the product through a comprehensive observation on them, then the patent concerned is not significantly different from the prior design. Judgment on notable influence limits to designs of the product of the same or approximate category.

Generally, in determining whether there is significant difference between the patent concerned and the prior design of the product of the same or approximate category, the following factors shall be further considered comprehensively:

(1) in the whole observation of the patent concerned and the prior design, the parts which can be seen easily in use shall be paid more attention to, generally the design changes in the parts which can be seen easily when they are used have more notable

influence on the overall visual effect than the design changes in the parts which cannot be seen easily or cannot be seen at all. For example, the rear side and bottom side of a television do not draw attention of a normal consumer when the television is used, therefore, for television the design changes in the parts which can be seen easily when they are used have more notable influence on the overall visual effect than the design changes in the rear side that cannot be seen easily and the design changes in the bottom side that cannot be seen at all. However, the circumstance where there is evidence showing that the special design in the parts which cannot be seen easily has notable visual effect for a normal consumer is an exception;

(2) where designs in some parts of a product are proved to be usual designs commonly known for the category of product (for example, design of column form for a tin), the changes in other parts have more notable influence on the overall visual effect. For example, since the contour of the cross section of a section steel is usually rectangle, the change in other parts of the cross section has more notable effect;

(3) a special shape exclusively determined by the function of a product generally does not notably influence the overall visual effect. For example, the shape of the curved surface of a cam is dictated by its specific motion track, such a difference generally does not notably influence the overall visual effect; the circular shape of tyre is exclusively determined by its function, so the pattern on the tyre has more notable influence on the overall effect; and

(4) if the difference lies only in minor changes in some fine details, the difference is not sufficient to have notable influence on the overall visual effect, the two are not significantly different. For example, both the patent concerned and the comparative design are electronic rice cookers, and the difference lies only in the different shapes of the control buttons, since control buttons are only minor designs of a detail in an electronic rice cooker, and occupy a very small portion of the overall design, the change in them is not sufficient to have notable influence on the overall visual effect.

It should be noted that the design designated by the essential features of the design in the brief explanation does not necessarily

have a notable influence on the overall visual effect, and it does not necessarily result in the significant difference between the patent concerned and the prior design. For example, as to the auto design, the brief explanation points out that the essential features of the design lie in the bottom side of the auto, however the design of the bottom side does not have a notable influence on the overall visual effect of the auto.

As to the judgment on notable influence, section 5.2 of this chapter shall apply.

## **6.2 Transformation of the Prior Design, Combination of the Prior Design or its Design Features**

### **6.2.1 Method of Judgment**

With respect to the judgment on transformation of the prior design and combination of the prior design or its design features, it could be made as the following steps:

(1) to determine the content of the prior design, including shape, pattern, colour or their combination;

(2) to compare the prior design or its design features with the respective part of the patent concerned; and

(3) where the prior design or its design features are identical with the respective part of the patent concerned, or the two only have very minor difference, to determine whether there is an inspiration for the specific transformation and/or combination in the prior design for the product of the same or approximate category.

If there is an above-mentioned inspiration, the two are not significantly different. The exception is where the transformation and/or combination produce a unique visual effect.

### **6.2.2 Transformation of the Prior Design**

Transformation means to apply the design of one product to another product. Simulation of natural object and natural scenery, as well as application of a simple shape, pattern, colour or their combination into design of a product also fall into the category of transformation.

The following types of transformation fall into the circumstances where there is an obvious inspiration for the transformation,

and designs arising therefrom are not significantly different from the prior design:

(1)the design which simply adopts the basic geometric shape or only slightly changes it;

(2)the design which simply simulates the original form of natural object or natural scenery;

(3)the design which simply simulates the entire or partial shape,pattern,colour of well-known building or work;and

(4)the design for product like toy,decoration,food,which is transformed from the design of other category of product.

If the above-mentioned circumstances give rise to unique visual effect,there could be an exception.

### **6.2.3 Combination of the Prior Design or its Design Features**

Combination,including mosaic and replacement,means to produce a design by merely aggregating two or more designs or design features,or replacing the design feature of one design with another design feature.A design which is produced by simply repeating the arrangement of a design or design feature as a unit, is considered as a combination design.The above mentioned combination also contains mosaic and replacement using simulation of natural object or natural scenery,and those using simple shape,pattern,colour or their combination.

The following types of combination fall into the circumstances where there is an obvious inspiration for the combination, and designs arising therefrom are not significantly different from the combination of the prior design or its design features:

(1)the design which is produced by merely aggregating multiple prior designs or their slightly changed forms for the product of the same or approximate category.For example,an integral design which is produced by merely aggregating multiple component parts;

(2)the design which is produced by replacing the design feature of a design with another design feature or its slightly changed form of the product of the same or approximate category; and

(3)the design of product which is produced by merely aggregating the prior design of shape for the product with the prior pattern,colour or their combination; or by replacing the pattern,

colour or their combination in one prior design with those in another prior design.

If the above-mentioned circumstances give rise to unique visual effect, there could be an exception.

#### **6.2.4 Unique Visual Effect**

Unique visual effect means that the patent concerned produces unexpected visual effect, comparing with the prior design.

As to the combined design, where each prior design or design feature only stands alone, or merely aggregate with each other, without producing interaction in visual effect, generally the combination would not be considered to produce unique visual effect.

The design which produces unique visual effect is significantly different from the combination of the prior design or its design features.

#### **7. Examination in Accordance with Article 23.3**

A design patent which is found to be in conflict with any other person's legitimate right obtained before the patent's filing date (or the priority date, where priority is claimed) shall be declared invalid.

Any other person refers to the civil subject other than the patentee, including natural person, legal person or other entity.

Legitimate right refers to the right or interest which is recognized by laws of the People's Republic of China and is still valid prior to the filing date of the patent concerned. It includes trademark rights, copyright, right to enterprise's name (including right to trade name), right to image and right to the special packaging and decoration of well-known goods, etc.

Obtaining prior to the filing date means that the prior legitimate right is obtained before the filing date of the patent concerned. To be in conflict means that the design patent constitutes an unauthorized use of the subject matter of prior legitimate right, therefore the exploitation of the patent would infringe the relevant legitimate right or interest of the prior right holder.

In the invalidation procedure, the petitioner shall bear the burden of producing evidence for his allegation, including proving himself the right holder or interested party of the prior right

and the validity of the prior right.

### **7.1 Trademark Rights**

The prior trademark right refers to the trademark right of any other person protected by laws of the People's Republic of China before the filing date of the patent concerned. Where the patent concerned makes use of a design which is identical or similar to the prior trademark, without the trademark holder's authorization, and the exploitation of the patent would mislead the relevant public or produce confusion in the relevant public, and infringe the trademark holder's related legitimate right or interest, the patent concerned shall be held to be in conflict with the prior trademark right.

To determine whether the respective design in the patent concerned is identical or similar to the prior trademark, generally the standard to judge the identity or similarity of trademark shall apply.

As to the registered trademark, which is well known to the relevant public in China, in determining whether there's a conflict of rights, the category of product could be properly broadened.

### **7.2 Copyright**

The prior copyright refers to the copyright, which is legally entitled to by any other person either by creating a work independently or by means of inheritance or transfer. The work refers to the subject matter protected by Copyright Law of the People's Republic of China and its Implementing Regulations.

Where there is a possibility of contact with any other person's copyrighted work, the patent concerned makes use of a design identical or substantially similar to the work, without the copyright holder's authorization, and the exploitation of the patent would infringe the prior copyright holder's related legitimate right or interest, the patent concerned shall be held to be in conflict with the prior copyright.

## **8.Examination in Accordance with Article 9**

"Identical invention-creation" referred to in Article 9 means for designs, that the claimed designs for product shall be identical

or substantially identical. The comparison shall be made based on the whole comparison of all design elements.

Where the patent concerned contains multiple designs, each design shall be compared with the comparative design respectively. If one design of the patent concerned is identical or substantially identical with another design of the other patent, they are considered as identical inventions-creations.

With respect to the judgment of identical or substantially identical designs, Section 5 of this chapter shall apply.

## **9.Verification of Right of Priority**

### **9.1 Circumstances where Verification of Right of Priority is Needed**

A design patent application can only claim the right of foreign priority. Therefore verification of right of priority means verification of right of foreign priority.

Priority shall be verified when any of the following circumstances is found to exist:

(1)the patent concerned is identical or substantially identical with the comparative design,the patent concerned is not significantly different from the comparative design or the combination of its design features,and the publication date of the comparative design is on or after the claimed priority date and before the application date of the patent concerned;

(2)the patent concerned is identical or substantially identical with a design application filed by any entity or individual with the Patent Office,and the application date of the latter is on or before that of the former and on or after the claimed priority date,and the granting announcement date of the latter is on or after the application date of the former; or

(3)the patent concerned is identical or substantially identical with a design application filed by any entity or individual with the Patent Office,and the priority date of the latter is on or before that of the former and on or after the claimed priority date,and the granting announcement date of the latter is on or after the application date of the former.

In the circumstance (3),the right of priority of the patent concerned shall be verified first; where the patent concerned can not enjoy the right of priority and its application date is before the application date of the design filed by any entity or individual, the right of priority of the design filed by any entity or individual as a comparative design shall be verified as well.

### **9.2 Determination of Same Subject Matter for Designs**

The determination of same subject matter for designs shall be based on the design application subsequently filed in China and the content indicated in the first foreign design application.



Designs of same subject matter shall meet both of the following two conditions:

- (1) both of the designs are for same products ; and
- (2) the claimed design in the subsequent application in China is clearly shown in the first foreign application.

Where the drawings or photographs of the claimed design in the subsequent application in China are not completely consistent with those of the first foreign application, or the subsequent application in China contains a brief explanation while the first foreign application does not have the related brief explanation, but based on the application documents of the two, the claimed design in the subsequent application in China has been clearly shown in the first foreign application, it may be determined that the claimed design in the subsequent application in China has the same subject matter as that of the design in the first foreign application, and thus may enjoy the priority of the latter. For example, a first foreign application furnished a front view, a back view, a left view and a space diagram of a product, and the subsequent application in China furnished a front view, a back view, a left view, a right view and a top view of the product, and indicated in the brief explanation that the upward view was omitted since the bottom of the product was rarely seen. Under such circumstance, if only the front view, back view and left view of the subsequent application in China are the same as those of the first foreign application, and the right view and top view of the former have been clearly shown in the space diagram of the latter, it may be determined that the subject matters of the two applications are the same, and the subsequent application in China may enjoy the right of priority of the first foreign application.

### **9.3 Conditions for Entitlement to Right of Priority**

In this regard, Chapter 3, Section 4.1.1 of Part II shall apply *mutatis mutandis*. However, the filing date of the subsequent application in China shall be no later than 6 months from the filing date of the first foreign application.

### **9.4 Effect of Right of Priority**

In this regard, Chapter 3, Section 4.1.3 of Part II shall apply *mutatis mutandis*.

### **9.5 Multiple Priorities**

According to Rule 32.1, in a design patent application one or more priorities may be claimed; where multiple priorities are claimed, the priority period for the application shall be calculated from the earliest priority date.

For a design patent containing several products of independent use value, if the designs of one or more products therein have respectively the same subject matter as the designs in one or more first foreign applications, the design patent may enjoy one priority or multiple priorities.

## Chapter 6 Some Provisions Concerning the Examination of

### Utility Models in the Invalidation Procedure

#### **1.Introduction**

This Chapter is made pursuant to Articles 2.3,22.2 and 22.3.

Art.2.3

#### **2.Examination of Subject Matter as Patentable for Utility Model**

For examination in the invalidation procedure of a subject matter that may be granted for a utility model patent,Chapter 2, Section 6 of Part I shall apply.

Art.22.2

#### **3.Examination of Novelty for Utility Model**

In the examination of novelty for a utility model,all the technical features in a technical solution,including both composition features and process features,shall be taken into account.

For relevant aspects of examination of novelty for a utility model,including the concept of novelty,examination principles for novelty,the examination criteria,examination of priority,and examination of grace period,Chapter 3 of Part II shall apply.

Art.22.3

#### **4.Examination of Inventive Step for Utility Model**

In the examination of inventive step for a utility model,all the technical features in a technical solution,including both composition features and process features,shall be taken into account.

For relevant aspects of examination of inventive step for a utility model,including the concept of inventive step,examination principles for inventive step,the examination criteria,and the assessment of inventive step for various types of inventionscreations,

Chapter 4 of Part II shall apply.

However,according to Article 22.3,inventive step of an invention means that,as compared with the prior art,the invention has prominent substantive features and represents a notable progress; inventive step of a utility model means that,as compared with the prior art,the utility model has substantive features

and represents progress. Therefore, the requirement of inventive step for a utility model shall be lower than that for an invention.

The difference in requirement of inventive step for a utility model and for an invention is mainly indicated by whether there exists a technical teaching in the prior art. In determining whether there exists a technical teaching in the prior art, a utility model differs from an invention in the following two aspects.

(1) Field of prior art references

For an invention, the examiner shall consider not only the technical field to which the invention belongs, but also the proximate or relevant technical fields, and those other technical fields in which the problem to be solved by the invention would prompt a person skilled in the art to look for technical means.

For a utility model, the examiner will normally focus on the technical field to which the utility model belongs. Where there is a clear technical teaching, for example, where there is an explicit description in the prior art, to prompt a person skilled in the art to look for technical means in a proximate or relevant technical field, the proximate or relevant technical field may be considered.

(2) Number of prior art references

For an invention application, one, two or more prior art references may be cited to assess its inventive step.

For a utility model, normally one or two prior art references may be cited to assess its inventive step. Where the utility model is made just by juxtaposing some prior art means, the examiner may, according to the circumstance of the case, cite more than two prior art references to assess its inventive step.

# Chapter 7 Handling of Identical Inventions-Creations in the

## Invalidation Procedure

### **1.Introduction**

In accordance with Rule 65,inconformity with Article 9 is a cause for invalidating a granted patent right.

“Identical invention-creation” referred to in Article 9

means,for inventions or utility models,that the claimed inventions or utility models are identical,for principles of determination of which Chapter 3,Section 6.1 of Part II shall apply; and for designs,that the claimed designs of the product are identical or substantially identical,for the determination of which Chapter 5 of this Part shall apply.

Where any entity or individual requests for invalidation on the ground that an invention or utility model patent and another invention or utility model patent applied earlier constitute identical inventions-creations,failing to comply with Article 9,if the patent applied earlier has constituted the prior art or is a patent applied earlier and published later than the patent concerned that belongs to any entity or individual,the Patent Reexamination Board may examine in accordance with Article 22.

Where any entity or individual requests for invalidation on the ground that a design patent and another design patent applied earlier constitute identical inventions-creations,failing to comply with Article 9,if the patent applied earlier has constituted a prior design or is a patent applied earlier and published later than the patent concerned that belongs to any entity or individual, the Patent Reexamination Board may examine in accordance with Article 23.

### **2.By the Same Patentee**

#### **2.1 On Different Date of Announcement of Grant of Patent**

Where any entity or individual makes a request for invalidation of the patent granted earlier before the Patent Reexamination Board on the ground that the two patents with the same filing

date(or the priority date,where priority is claimed)that belong to the same patentee do not comply with Article 9.1,in case there are no other causes for invalidation or other causes are untenable,the Patent Reexamination Board shall maintain the validity of this patent.

Where any entity or individual makes a request for invalidation of the patent granted later before the Patent Reexamination Board on the ground that the two patents with the same filing date (or the priority date where priority is claimed)that belong to the same patentee do not comply with Article 9.1,the Reexamination Board shall declare the invalidation of this patent where it holds that the two constitute identical inventions-creations after the examination.

If the two patents mentioned above include a utility model patent and an invention patent applied by the same patentee on the same date(only the filing date),the patentee has made a statement in accordance with Rule 41.2 as filing the application and the utility model patent has not terminated when the invention patent is granted,in that case,the patentee may retain the invention patent requested to be declared invalid by abandoning the utility model patent granted earlier.

## **2.2 On the Same Date of Announcement of Grant of Patent**

Any entity or individual,who considers the same patentee's two patents with the same filing date (or the priority date where priority is claimed)and the same date of announcement of grant do not comply with Article 9.1,may request the Patent Reexamination

Board to declare one of the patent rights invalid.  
Where only one of the patent rights is requested to be invalidated, the Patent Reexamination Board shall declare the invalidation of the patent requested for invalidation if it holds that the two constitute identical inventions-creations after the examination.  
Where both of the patent rights are requested to be invalidated, the Patent Reexamination Board shall generally examine the requests jointly.Where the Patent Reexamination Board holds that the two constitute identical inventions-creations after the examination,it shall notify the patentee of its holding,and require the patentee to choose to retain one of the two patent rights.

Where the patentee chooses to retain only one of the two patent rights, in case there are no other causes for invalidation or other causes are untenable, the Patent Reexamination Board shall maintain the validity of this patent and declare the invalidation of the other one. Where the patentee does not make any choice, the Patent Reexamination Board shall declare the invalidation of both patent rights.

### **3.By Different Patentees**

Any entity or individual, who considers different patentees' two patent rights having the same filing date (or the priority date where priority is claimed) fail to comply with Article 9.1, may separately request the Patent Reexamination Board to declare both of the patent rights invalid.

Rule 41.1

Where both of the patent rights are requested to be invalidated, the Patent Reexamination Board shall in general examine the requests jointly. Where the Patent Reexamination Board holds that the two constitute identical inventions-creations after the examination, it shall notify the two patentees of its holding, and require the two patentees to choose to retain one of the two patent rights through consultation. Where the two patentees submit a joint written statement of retaining only one of the two patent rights through consultation, in case there are no other causes for invalidation or other causes are untenable, the Patent Reexamination Board shall maintain the validity of this patent right and declare the invalidation of the other one. Where the patentees cannot make any choice through consultation, the Patent Reexamination Board shall declare both of the patent rights invalid.

Where only one of the patent rights is requested to be invalidated, the Patent Reexamination Board shall notify both parties of its holding that the two constitute identical inventions-creations after the examination. The patentee of the patent requested for invalidation may request for invalidating the other patent right, and choose to retain one of the two patent rights through consultation with the patentee of the other patent right. Where the patentee requests for invalidating the other patent right, the Patent Reexamination Board shall handle it according to the provisions of the preceding paragraph. Where the patentee does not request for invalidating the other patent right, the Patent Reex-

amination Board shall declare the patent right requested to be  
invalidated invalid.



# Chapter 8 Provisions Concerning Issues of Evidence in the Invalidation Procedure

## **1.Introduction**

This Chapter is formulated pursuant to the relevant provisions of the Patent Law and its Implementing Regulations,in combination with the practice in the examination of invalidation cases.

For various issues of evidence in the invalidation procedure, the provisions of these Guidelines shall apply; where there are no provisions applicable in these Guidelines,the relevant provisions applied by the People's Court in civil procedures may be referred to.

## **2.Producing Evidence by the Party Concerned**

### **2.1 Allocation of the Burden of Proof**

The party concerned shall bear the burden of producing evidence for what he alleges to be facts on which his request for invalidation is based or on which his rebuttal to the request for invalidation is based.

Where the allocation of the burden of producing evidence cannot be determined in accordance with the preceding paragraph, the Board may determine the allocation of the burden of producing evidence in accordance with the principle of fairness and the principle of good faith,in combination with the parties' ability to produce evidence as well as the probability of occurrence of the facts to be proven,etc.

The party that bears the burden of proof shall bear the unfavorable consequence where the evidence cannot be produced or the evidence produced is not sufficient to support his allegations.

### **2.2 Presenting Evidences**

For presentation of evidence,in addition to the provisions of this Chapter,Chapter 3,Section 4.3 of this Part shall apply.

### **2.2.1 Presenting Evidence in a Foreign Language**

Where the party concerned submits a piece of evidence in a foreign language, he shall also submit the Chinese translation thereof. If he fails to submit the Chinese translation for the evidence within the time limit, the foreign language evidence shall be deemed not to have been submitted.

The party concerned shall submit the Chinese translation in written form. If he fails to submit the Chinese translation in written form, said Chinese translation shall be deemed not to have been submitted.

The party concerned may submit the Chinese translation only for part of the foreign language evidence. Other parts of the foreign language evidence without Chinese translation being submitted shall not be taken as evidence, unless the Chinese translation for the other parts are subsequently submitted at the demand of the Patent Reexamination Board.

If the opposite party has objection to the contents of the Chinese translation, he shall submit the Chinese translation for the disputed parts within a specified time limit. Failure to submit the Chinese translation shall be deemed as having no objection to the translation.

Where there is a dispute over the Chinese translation, if the both parties have reached an agreement as to the translation, the agreed translation shall be used; if the both parties cannot reach an agreement as to the translation, the Patent Reexamination Board may entrust a translator to translate if necessary.

Where the both parties have reached an agreement on the translator, the Patent Reexamination Board may entrust the translator as agreed on by the both parties to translate, for the full text, the part to be used, or the part in dispute. Where the both parties cannot reach an agreement on the translator, the Patent Reexamination Board may entrust ex officio a professional translation agency to translate. The both parties shall respectively bear 50% of the translation fee for the entrusted translation. The party refusing to pay the translation fee shall be deemed to acknowledge that the Chinese translation submitted by the other party is correct.

### **2.2.2 Verification Formalities for Evidence Formed Abroad or in Hong Kong, Macao, or Taiwan**

Evidence formed abroad means the evidence formed beyond the territory of the People's Republic of China. The evidence shall be notarized by the notary organs in the country concerned and verified by the Chinese Embassy or Consulate to the country, or shall be subject to any verification formalities provided in a treaty between China and the country.

For evidence formed in Hong Kong, Macao or Taiwan, the relevant verification formalities shall also be gone through.

However, in any of the following circumstances, the party concerned may not go through the relevant verification formalities in the invalidation procedure for the two kinds of evidence mentioned above:

- (1) the evidence can be obtained via domestic public channels (Hong Kong, Macao and Taiwan excluded), e.g., foreign patent documents obtained from the Patent Office, or foreign literature obtained from a public library;
- (2) the authenticity of the evidence can be sufficiently supported by other evidence; or
- (3) the authenticity of the evidence is acknowledged by the opposite party.

### **2.2.3 Presenting Physical Evidence**

The party concerned shall submit physical evidence to the Board within the time limit for producing evidence specified in Chapter 3, Section 4.3 of this Part. Where the party concerned submits physical evidence, he shall at the same time submit photographs or written description sufficient to demonstrate the objective situation of the physical evidence, and explain specifically the facts to be proved based on the physical evidence.

Where either party fails to present physical evidence within the time limit for producing evidence with due reasons, he may within the time limit, request in written form the extension of the time limit, and shall still, within the time limit, submit photographs or written description sufficient to demonstrate the objective situation of the physical evidence and explain specifically the facts to be proved based on the physical evidence. The party concerned shall submit physical evidence no later than the closure

of the oral proceedings.

For the physical evidence which has been sealed and notarized by the notary organ, the party may only submit the notarial document rather than submit said physical evidence within the time limit for producing evidence, but shall submit said physical evidence no later than the closure of the oral proceedings.

### **3. Investigation and Collection of Evidence by the Patent**

#### **Reexamination Board**

The Patent Reexamination Board normally does not take the initiative to conduct investigation or collect evidence for the examination of a case. For evidence that cannot be collected by the party concerned or its representative in its own effort due to objective reasons, the Patent Reexamination Board may investigate and collect the evidence if the party concerned has made such a request within the time limit for producing evidence and the Patent Reexamination Board considers necessary.

The Patent Reexamination Board may investigate and collect the relevant evidence in situ, or entrust a local intellectual property administrative authority or other relevant authority to investigate and collect the relevant evidence.

Where the investigation and collection of evidence is conducted at the request of a party concerned, the cost shall be borne by either the party concerned or the Patent Reexamination Board. Where the Patent Reexamination Board decides to investigate and collect evidence ex officio, the cost shall be borne by the Patent Reexamination Board.

### **4. Cross-examination, Examination and Verification of Evidence**

#### **4.1 Cross-Examination of Evidence**

Evidence shall be cross-examined by the parties concerned and those without cross-examination shall not be taken as the basis for deciding the facts of the case.

In the cross-examination of evidence, focusing on the relevance, legitimacy and authenticity of the evidence, the parties concerned shall conduct their inquiry, explanation and argument with respect to the probative force of evidence.

## **4.2 Examination of Evidence**

The panel shall examine the evidence submitted by the parties one by one and examine all the evidence items comprehensively.

The panel shall clarify the probative relationship between the evidence and the facts of the case and rule out the evidence items without relevance.

The panel shall take into account the specific circumstance of the case and examine the legitimacy of the evidence from the following aspects:

(1)whether the evidence meets the formal requirements prescribed by law;

(2)whether the acquirement of the evidence is in conformity with the provisions of laws and regulations;

(3)whether there is any other illegal circumstance that will prejudice the effectiveness of the evidence.

The panel shall take into account the specific circumstance of the case and examine the authenticity of evidence from the following aspects:

(1)whether the evidence is an original; whether a photocopy or duplicate matches the original;

(2)whether the provider of the evidence has interests in the party concerned;

(3)objective environment where the evidence is collected;

(4)causes and means in formation of the evidence;

(5)contents of the evidence; and

(6)other factors which may affect the authenticity of the evidence.

## **4.3 Determination of Evidence**

Where,as to the evidence submitted by one party,the other party has acknowledged it or his counterevidence is insufficient to rebut it,the Board shall determine the probative force of the evidence.

Where,for the evidence submitted by one party,the other party has objection and has submitted counterevidence,and the one party has acknowledged the counterevidence,the Board may determine the probative force of the counterevidence.

Where,both parties have submitted evidence to the contrary against the same fact but neither of them provides sufficient basis to deny the evidence of the other party,the panel shall take into account the specific circumstance of the case and make a judgment whether the probative force of the evidence submitted by one party is obviously greater than that of the one submitted by the other party,and affirm the evidence with greater probative force.

Where,due to the failure in judgment of the probative force of the evidence,it is difficult to determine the fact in dispute, the Board shall make a judgment in accordance with the rules concerning allocation of the burden of producing evidence.

#### **4.3.1 Testimony of Witness**

A witness shall state the specific facts that he has experienced in person.Inference,conjecture,or observations made by the witness based on his experience shall not be taken as the basis for deciding the facts of the case.

In taking the testimony of a witness,the Patent Reexamination Board may make a judgment by analyzing comprehensively the witness' interest in the case,mental health,moral character, knowledge,experience,legal awareness,professional competence, etc.,of the witness.

Witness shall appear and be inquired in the oral proceedings. Written testimony made by a witness not appear in oral proceedings shall not be taken independently as the basis for deciding the case,unless the witness does have difficulties in appearing in the oral proceedings.Where a witness does have difficulties in appearing in oral proceedings,the Patent Reexamination Board shall take his written testimony according to the rules in the preceding paragraph.

#### **4.3.2 Acknowledgement and Admission**

In the invalidation procedure,evidence of a party clearly acknowledged by the opposite party shall be taken by the Patent Reexamination Board,unless the evidence are obviously inconsistent with facts,or detrimental to national interest or public interest, or taken back by the party concerned with sufficient counterevidence to overturn it.

In the invalidation procedure, the facts stated by a party and clearly admitted by the opposite party shall be taken by the Patent Reexamination Board, unless the evidence are obviously inconsistent with facts, or detrimental to national interest or public interest, or taken back by the party concerned with sufficient counterevidence to overturn it. Where the opposite party neither admits nor denies an alleged fact and, after the panel makes adequate explanation and inquires of it, still refuses to clearly express its admission or denial, it shall be deemed as admitting said fact.

Where a party concerned appoints an agent to appear in the invalidation procedure, admission by the agent shall be deemed as admission by the party itself, provided that admission by the agent without special authorization does not directly lead to the admission of the request for invalidation of the opposite party. If the party concerned is present and does not deny the admission by its agent, the admission shall be deemed as admission by the party itself.

Where the party concerned takes back its admission prior to the closure of oral proceedings or, for cases without oral proceedings, prior to the decision of invalidation being made, subject to the approval by the opposite party, the Patent Reexamination Board will not recognize the legal effect of the admission. Where there is sufficient evidence to prove that the admission was made under coercion or due to serious misunderstanding and was inconsistent with facts, the Patent Reexamination Board will not recognize the legal effect of the admission.

In the invalidation procedure, acknowledgement of facts by a party concerned for reaching a mediation agreement or a compromise shall not be taken as adverse evidence against it in the subsequent proceedings of the invalidation procedure.

#### **4.3.3 Common Knowledge**

The party concerned alleging that certain technical means is common knowledge in the art shall bear the burden of proof for its allegation. If the party concerned cannot produce evidence or cannot adequately explain that the technical means is common knowledge in the art, and the allegation is not acknowledged by the opposite party, the panel shall not support the allegation.

The party concerned may prove that certain technical means is common knowledge in the art with reference to the technical contents recorded in a reference book such as a textbook, a technical dictionary, or a technical manual.

#### **4.3.4 Notarial Document**

Where a party concerned submits a notarial document as evidence, the facts attested in a valid notarial document shall be taken as the basis for deciding the facts of the case, unless there is counterevidence to overturn the attestation of the notarial document. If the notarial document has serious defections in its form, e.g., lack of seal of the notary, it shall not be taken as the basis for deciding the facts of the case.

If the conclusion of the notarial document obviously lacks grounds or there is self-contradiction in its contents, the corresponding contents shall not be taken as the basis for deciding the facts of the case. For example, where a notarial document concludes that the content of the statement of a witness is real merely on the basis of the witness's statement, the conclusion of the notarial document shall not be taken as the basis for deciding the facts of the case.

### **5. Others**

#### **5.1 Publication Time of Evidence on Internet**

The earliest time when the public can find the information on the Internet is the publication time of the information, usually the issuance time of the information on the Internet is deemed as the publication time of the information.

#### **5.2 Public Use or Oral Disclosure as Evidenced by Documentary**

##### **Recordation after the Application Date**

Documentary evidence recording contents of public use or oral disclosure formed on or after the application date or evidence of other forms can be used to prove public use or oral disclosure of the patent before the application date.

In determining the probative force of the evidence mentioned above, evidence formed before or on the patent publication



date shall prevail over those formed after the patent publication date.

### **5.3 Consultation and Evaluation on Technical Contents or Issues**

The Patent Reexamination Board may, if need be, invite the relevant organizations or experts to provide consultation opinions on the technical contents or issues involved in a case. If necessary, it may entrust a relevant organization to provide expert opinions, and the cost shall be borne by the Patent Reexamination

Board or the party concerned depending on the specific circumstance of the case.

### **5.4 Handling of Articles such as Samples Submitted by the Party**

#### **Concerned but not Used as Evidence**

In the invalidation procedure, at the time of submitting articles such as samples not used as evidence, the party concerned is entitled to request in written form to take back the articles after the case is decided.

For request of the party concerned to take back articles, the panel shall, taking into account the needs of examination and the subsequent proceedings, decide when to allow the articles to be taken back. Where it is decided to allow the articles to be taken back, the Patent Reexamination Board shall notify the party concerned submitting the articles of the decision, and the party concerned shall take back the articles within three months from the date of receipt of the notification. If the articles are not taken back within the time limit, or the party concerned does not request to take back at the time of submitting them, the Patent Reexamination Board shall have the right to dispose of these articles.