AIPLA

American Intellectual Property Law Association

September 21, 2021

China National Intellectual Property Administration
Department of Treaty and Law
Examination Policy Division
No. 6, Xitucheng Lu
Jimenqiao Haidian District
Beijing, People's Republic of China 100088

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

Re: Comments regarding the Draft Revision to the Chinese Patent Examination Guidelines (Draft for Solicitation of Comments)" (3 August 2021)

Dear Sir or Madam,

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to comment on the Draft Revision to the Chinese Patent Examination Guidelines (Draft for Solicitation of Comments)" (3 August 2021). A table of AIPLA comments is provided in the table attached.

AIPLA is a national bar association of approximately 8,500 members engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA commends the China National Intellectual Property Administration (CNIPA) on its efforts to improve examination of patent applications in China and appreciates the opportunity to provide comments to the Draft Patent Examination Guidelines. AIPLA would also welcome the opportunity to provide additional comments on any specific revisions to the language of the Draft Patent Examination Guidelines that may be drafted and proposed in response to this initial round of comments. AIPLA recommends that CNIPA provide the public with more time to review and submit comments, especially for major revisions or draft guidelines that are very long, for example this particular draft has 237 pages.

The absence of comments on any part does not reflect support or lack of support of this part by AIPLA.

AIPLA provides specific comments to the draft revisions in the table attached, with a brief summary as below:

- AIPLA welcomes allowing submission of color figures and suggests making this allowance general.

- AIPLA commends CNIPA's effort on introducing the practice of incorporation by reference, consistent with international norms; AIPLA seeks clarification whether figures are also allowed by incorporation by reference.

- AIPLA applauds the simplification of batch-recordation of multiple assignments; AIPLA seeks clarification of the recordal of a chain of assignments.

- AIPLA seeks clearer guidance on identification and handling of "bad faith" applications, echoing AIPLA's comments to the draft Implementation Rules in November 2020.

- AIPLA seeks clarification on how an examiner would determine that a utility model "apparently lacks inventiveness."

- AIPLA appreciates CNIPA confirming the ability to protect innovations in designs, including partial designs, of graphical user interfaces (GUIs).

- AIPLA appreciates CNIPA providing the ability to claim priority to various different types of domestic Chinese applications. Nonetheless, AIPLA has concerns regarding the circumstances in which priority is required to be "not granted", and that the priority document would be deemed withdrawn after priority is successfully claimed to a domestic Chinese design application.

- AIPLA commends the change that, after entering the Chinese national phase, certifying documents is no longer required for the change of applicant recorded at the international phase, except in exceptional cases; AIPLA suggests further clarification of these provisions.

- AIPLA supports the change that legalization is no longer required for evidence generated outside of China to be submitted in invalidation proceedings.

- AIPLA applauds removing the 15-day mail period for electronically transmitted notices issued by the CNIPA, which makes calculation of deadlines easier and clearer; AIPLA also proposes further suggestions.

- With respect to patent term extension due to unreasonable delay at CNIPA, drug patent term extension, and open license, AIPLA requests clarification of several provisions.

We appreciate the opportunity to provide these comments on Draft Revision to the Chinese Patent Examination Guidelines (Solicitation Draft, 2nd Batch), and we would be happy to answer any questions that our comments may raise.

Sincerely,

Joseph R. Re
President
American Intellectual Property Law Association

Current guideline	Draft revised guidelines	AIPLA comments
Part 1, Chapter 1, Section 4.3 Specification drawings shall be made in black ink with the aid of drafting instruments including computer. The line shall be uniformly thick and well defined, dark enough, and free from color and alterations. Engineering blueprints shall not be used.	Specification drawings shall be made ~~in black ink~~ with the aid of drafting instruments including computer. The line shall be uniformly thick and well defined, dark enough, and free from ~~color and~~ alterations. Engineering blueprints shall not be used. <u>Drawings are generally made in black in, while color drawings could be submitted when absolutely necessary to clearly describe the relevant technical contents of the patent application.</u>	AIPLA applauds allowing submission of colored figures. The draft guidelines provide for the submission of colored figures only "when absolutely necessary". AIPLA proposes making submission of colored figures allowable generally, in instances in which color drawings could help understanding the invention better. AIPLA also seeks clarification that, if colored figures are submitted and allowed, CNIPA would publish these figures in color.
Part 1, Chapter 1, Section 4.7.2	[New] According to Article 46(1) of the Implementation Rules of the Chinese Patent Law, patent application with missing or mistakenly submitted claims and parts of the specification *[Note: in Chinese, this could mean only the description]*, the original application date could be maintained by submitting the missing or the corrected parts via incorporation by reference.	AIPLA commends CNIPA's effort on introducing the practice of incorporation by reference in accordance with the international norms. It is unclear whether missing or mistakenly submitted figures may be incorporated by reference, as permitted by in PCT Rule 4.18. AIPLA suggests revising this section as below (additions underlined) to confirm that figures are also allowed to be incorporated by reference:

Current guideline	Draft revised guidelines	AIPLA comments
		According to Article 46(1) of the Implementation Rules of the Chinese Patent Law, patent application with missing or mistakenly submitted claims and parts of the specification, including figures, the original application date could be maintained by submitting the missing or the corrected parts via incorporation by reference.
Part 1, Chapter 1, Section 6.3 6.3.3 First disclosure at a prescribed academic conference or technical conference *[Note: for non-prejudice disclosure]* The prescribed academic conferences or technical conferences refer to the academic conferences or technical conferences organized by the relevant competent departments of the State Council or national academic organizations. ……	6.3.3 First disclosure at a prescribed academic conference or technical conference The prescribed academic conferences or technical conferences refer to the academic conferences or technical conferences organized by the relevant competent departments of the State Council or national academic organizations, and the academic conferences or technical conferences organized by international organizations and recognized by the Patent Administration Department of the State Council. ……	AIPLA commends that non-prejudice disclosure has been expanded to include first disclosure at academic conferences or technical conferences held by international organizations and recognized by CNIPA. It is unclear, however, which international academic or technical conferences are recognized, and whether there are geographical requirements for the venue of the conference. AIPLA requests clarification on these points . In particular, if CNIPA has recognized international organizations, AIPLA requests that CNIPA make this list publicly available.
Part 1, Chapter 1, Section 6.7.1.1		

Current guideline	Draft revised guidelines	AIPLA comments
Where any change in the bibliographic data is requested, it is required to submit the state for change in bibliographic data. Where several items of the bibliographic data of a patent application are to be changed at the same time, only one such statement is required to be submitted. Where the same item of the bibliographic data of one patent application is to be changed continuously, one statement for each of the changes is required to be submitted respectively. Where the same item of the bibliographic data of several patent application is to be changed, even if the contents to be changed are completely identical, one statement of change for each application is required to be submitted.	Where any change in the bibliographic data is requested, it is required to submit the state for change in bibliographic data. Where several items of the bibliographic data of a patent application are to be changed at the same time, only one such statement is required to be submitted. Where the same item of the bibliographic data of one patent application is to be changed continuously, one statement for each of the changes is required to be submitted respectively, while for a series of changes of patent application right (or patent right), the recordal should not be done in the form of continuous change. Where the same item of the bibliographic data of several patent application is to be changed, ~~even if~~ and the contents to be changed are completely identical, ~~one~~ batch statements of change ~~for each application is required to~~ could be submitted.	AIPLA applauds allowing batch recordation of assignments of number patents and/or applications. AIPLA notes that recordation should be at the owner's request and not mandatory. Otherwise, recordation may impose an undue burden on some patent owners, in particular owners of substantial portfolios. AIPLA would like clarity who has the burden of recording a transfer of patent rights. If an assignee (or the assignor) is not required to record a transfer of rights, what is the legal repercussion to the next purchaser, if any? Further, how can a bona fide subsequent purchaser rely on the record (where each transfer of rights does not have to be recorded)? AIPLA notes that, in some instances, the owner may desire record a full chain of title. It is AIPLA's understanding that, for sequential assignments, the draft guidelines do not require that each assignment in the chain of title be recorded. Rather, only the final assignment is recorded for the then-current assignee (e.g., in an assignment from A to B to C, only the assignment from C is recorded). AIPLA notes that the final assignment may not, in fact, be accurate if intervening assignments occurred.

Current guideline	Draft revised guidelines	AIPLA comments
		AIPLA suggest the following revision (with proposed deletions in strikethrough and additions underlined): Where any change in the bibliographic data is requested, it is required to submit the state for change in bibliographic data. Where several items of the bibliographic data of a patent application are to be changed at the same time, only one such statement is required to be submitted. Where the same item of the bibliographic data of one patent application is to be changed continuously, one statement for each of the changes is required to be submitted respectively~~, while for a series of changes of patent application right (or patent right), the recordal should not be done in the form of continuous change~~. Where the same item of the bibliographic data of several patent application is to be changed, ~~even if~~ and the contents to be changed are completely identical, ~~one~~ batch statements of change ~~for each application is required to~~ may be submitted.
Part 1, Chapter 1, Section 7.9	[New]	AIPLA is concerned that the draft guideline may be vague and not provide clear

Current guideline	Draft revised guidelines	AIPLA comments
	Circumstances which do not comply with the first paragraph of Article 20 of the Patent Law shall include fabricating, forging, plagiarizing, piecing together or any other obvious improper act.	guidance. AIPLA requests clarification what circumstances constitute an improper act or behaviors that might violate "good faith" efforts. For example, many inventions comprise combinations of known elements; this should not be considered to constitute "piecing together" in violation of Article 20 AIPLA submits that objective criteria are needed to clearly delineate the boundary of what might be considered "improper" or violative of "good faith" efforts.
Part 1, Chapter 2, Section 11 At the preliminary examination, the examiner examines whether a patent application for utility model is obviously lack of novelty. The examiner may examine whether a patent application for utility model apparently lacks novelty based on the information of related prior art or conflicting applications obtained. Where an abnormal application for utility model is involved, such as an application obviously plagiarizing prior at or repeated submissions of applications with substantially identical content, the examiner shall examine whether the utility	At the preliminary examination, the examiner examines whether a patent application for utility model is obviously lack of novelty <u>and inventiveness</u>. The examiner may examine whether a patent application for utility model apparently lacks novelty based on the information of related prior art or conflicting applications obtained. ~~Where an abnormal application for utility model is involved, such as an application obviously plagiarizing prior at or repeated submissions of applications with substantially identical content, the examiner shall examine whether the utility~~	AIPLA seeks clarification on how the examiner determines "inventiveness". The draft guidelines appear to indicate that the examiner may conduct a search "based on the information of related prior art or conflicting applications." Although this may require additional examiner resources to conduct searches, AIPLA notes that this approach may help limit the number of fraudulent, repeated, or plagiarized utility model applications.

Current guideline	Draft revised guidelines	AIPLA comments
model apparently lacks novelty based on reference obtained through search or information obtained by other approaches. Regarding the examination on novelty, the provisions of Chapter 3 of Pat II of the Guidelines shall be referred to.	~~model apparently lacks novelty based on reference obtained through search or information obtained by other approaches.~~ Regarding the examination on novelty, the provisions of Chapter 3 of Pat II and Chapter 6, Section 3 of Part IV of the Guidelines shall be referred to. The examiner may examine whether a patent application for utility model apparently lacks inventiveness depending on the information of related prior art obtained. With regard to the examination on inventiveness, the provisions of Chapter 6, Section 4 of Part IV of the Guidelines shall be referred to.	
Part 1, Chapter 3, Section 4.5 4.4 Designs involving graphical user interface Product design involving graphical user interface refers to the design which essentials of the product design include the design of graphical user interface. 4.4.1 Product name The name of product design including graphical user interface shall indicate the main use of graphical user interface and the product to which it is applied. Generally, there shall be keyword such as	4.5 Designs involving graphical user interface Product design involving graphical user interface refers to the design which essentials of the product design include the design of graphical user interface. An applicant may file an application in the form of the whole design of the product or partial design. ~~4.4.1 Product name~~ The name of product design ~~including graphical user interface~~ shall meet the	AIPLA appreciates CNIPA confirming the ability to protect graphical user interfaces (GUIs), and partial designs of GUIs. AIPLA supports these revisions.

Current guideline	Draft revised guidelines	AIPLA comments
“graphical user interface”, and “product of dynamic graphical user interface shall have keyword such as “dynamic”. For example: “refrigerator with graphical user interface of temperature control”, “dynamic graphical user interface of weather forecast” and “display screen panel with graphical user interface of video on demand”. The name of “graphical user interface” shall not be generally used as the name of product, such as “graphical user interface of software” or “graphical user interface of operation”.	provisions of Chapter 3, Section 4.1.1 of this Part, ~~shall~~ and indicate the main use of graphical user interface and the product to which it is applied. Generally, there shall have keyword such as “graphical user interface”~~, and the name of product of dynamic graphical user interface shall have keyword such as “dynamic”~~. For example: “refrigerator with graphical user interface of temperature control”, “dynamic graphical user interface of ~~weather forecast~~ mobile payment of mobile phone” ~~and “display screen panel with graphical user interface of video on demand”~~. The name of “graphical user interface” shall not be generally used as the name of product, such as “graphical user interface of software” or “graphical user interface of operation”. Brief explanation shall meet the provisions of Chapter 3, Section 4.3 of this Part, clearly indicating the use of graphical user interface, and corresponding to the use reflected in the name of product. The essentials of design shall include graphical user interface. When necessary, the area, human-computer interaction mode and change process, and so on of the graphical user interface in the product shall be explained.	
Part 1, Chapter 3, Section 5.2.2.1	[New]	

Current guideline	Draft revised guidelines	AIPLA comments
	5.2.2 Claiming Domestic Priority 5.2.2.1 Previous Application and Subsequent Application Claiming Priority The previous application and the subsequent application claiming priority shall meet the following requirements: (1) the previous application shall be a patent application for invention or for utility model or for design, and it shall not be a divisional application; (2) no foreign or domestic priority has been claimed for the subject matter of the previous application, or though the foreign or domestic priority has been claimed but cannot enjoy priority; (3) no patent right has been granted for the subject matter of the previous application; and (4) the subsequent application which claims the right of priority has been submitted within six months from the filing date of the previous application. When the requirement referred to above in (3) is examined, the reference time shall be the filing date of the subsequent application claiming priority. When the requirement referred to above in (4) is examined, where multiple priorities are claimed, the reference time shall be the filing date of the earliest application, i.e.,	AIPLA appreciates CNIPA expanding the ability to claim priority to various different types of domestic Chinese applications. This revision may assist applicants in pursuing multiple alternative strategies to protect their innovations. AIPLA proposes that the “no patent right has been granted” requirement of sub-paragraph 3 is unnecessary and recommends deleting it.

Current guideline	Draft revised guidelines	AIPLA comments
	the subsequent application claiming priority shall be filed within six months from the filing date of the earliest application. Where any one of the above requirements is not complied with, the examiner shall, regarding the declaration claiming priority which is not in conformity with the requirements, issue the Notification that Claim to Priority Deemed Not to Have Been Made. When the right to claim priority is examined, if it is found that Decision to Grant have been sent by the Patent Office and the applicant has gone through formalities of registration, the examiner shall issue the Notification that Claim to Priority Deemed Not to Have Been Made to the subsequent application. During preliminary examination, the examiner shall only examine whether or not the subject matter of the subsequent application is obviously not related to that of the previous application, and the examiner shall not examine whether the subject matter of the previous application and that of the subsequent application are identical in substance. Where the subject matter of the previous application and that of the subsequent application are obviously not related with each other, the examiner shall issue the Notification that	

Current guideline	Draft revised guidelines	AIPLA comments
	Claim to Priority Deemed Not to Have Been Made.	
Part 1, Chapter 3, Section 5.2.2.5	**[New]** 5.2.2.5 Procedure of Previous Application Deemed to Have been Withdrawn Where the right of domestic priority is claimed, the previous application shall be deemed to have been withdrawn from the date on which the subsequent application is filed, except that the applicant of patent application for design claims the domestic priority to a patent application for invention or for utility model. Where any claim to the right of domestic priority made by the applicant is, after the preliminary examination, found to be in conformity with the provisions, if the previous application is a patent application for design, the examiner shall issue the Notification of Deemed Withdrawal to the previous application. Where two or more domestic priorities are claimed, if the claims are, after the preliminary examination, found to be in conformity with the provisions, if the previous applications include patent application for design, the examiner shall issue the Notification of Deemed Withdrawal to the relevant previous application for design.	AIPLA appreciates CNIPA providing the ability to claim priority to existing applications. AIPLA requests clarification of a partial design claiming priority to a complete design of which it is a part. Would the priority (complete) design application be deemed withdrawn? The same applies to the situation *vice versa*, i.e. a complete design claiming priority to a partial design, for example by converting the dotted lines to solid lines. AIPLA believes this would unduly limit applicant's rights and may lead to multiple design applications being filed at the same time to avoid loss of right, potentially creating a backlog of applications requiring review and examination. AIPLA suggests that, unless the subsequent application is identical to the priority application, the priority design applications not be deemed automatically withdrawn. Otherwise, applicants will lose rights to certain aspects of a design that were claimed in the priority application and not claimed in the subsequent application.

Current guideline	Draft revised guidelines	AIPLA comments
	Previous application that is deemed to have been withdrawn shall not be restored.	
Part 1, Chapter 3, Sections 10.1	[New] *10.1 Voluntary Amendment by the Applicant* …… However, for the following amendments, it is not considered to eliminate the defects in the original application documents, and Notification that Request Deemed Not to Have Been Submitted shall be issued on the grounds of exceeding the two-month voluntary amendment period: (1) modifying an overall design into a partial design; (2) modifying a partial design to an overall design; (3) modifying a partial design for a part of the overall product to a partial design for another part of the same overall product. ……	AIPLA suggests permitting the switching between complete and partial designs, and *vice versa*. The inability to switch between various embodiments may incentivize applicants to file multiple applications to circumvent this restriction.
Part 2, Chapter 9, Section 6.2, examples 6 and 7	[New] [Note: Please see annex.]	AIPLA appreciates CNIPA in taking an expansive approach to deeming innovations in software and artificial intelligence patent eligible.

Current guideline	Draft revised guidelines	AIPLA comments
		Article 27 of TRIPS Agreement provides that "patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application…" AIPLA supports eligibility consistent with the TRIPS Agreement. AIPLA believes that there should be relatively few limits on patent eligibility. AIPLA remains concerned that US and international courts' expansive application of judicial exceptions to patent eligibility, including those that pertain to innovations in software, are having an adverse impact on innovation. AIPLA is also concerned that different examiners may take different approaches to patent eligibility, burdening some applicants while not being consistently applied.
Part 3, Chapter 1, Section 5.10.1.2 Where a change is made under the item of "applicant" (entity only) as indicated in the *Notification of the Recording of a Change* (PCT/IB/306) transferred by the International Bureau, the applicant shall, at the time of entering the national phase, in accordance with Implementation Rule	~~Where a change is made under the item of "applicant" (entity only) as indicated in the Notification of the Recording of a Change (PCT/IB/306) transferred by the International Bureau, the applicant shall, at the time of entering the national phase, in accordance with Rule 104.1(6), submit the~~	This draft guideline appears to remove the requirement to certify documents in China after it has been recorded at the international phase, and the International Bureau has issued a corresponding Form PCT/IB/306, except in exceptional cases. One exception is an assignment from a

Current guideline	Draft revised guidelines	AIPLA comments
104.1(6) [of the Chinese Patent Law], submit the contract on the assignment or gift of the right to apply for a patent, the certifying document on the merger of the company provided by the administrative authority of industry and commerce, or other certifying document relating to transfer of right. The certifying documents may be the original or the copy certified by the public notary organ. The examiner shall examine the validity of the certifying documents. Where the certifying documents are not provided, the examiner shall issue the *Rectification Notification* to notify the applicant to supplement. If no documents are supplemented at the expiration of the time limit, the examiner shall issue the *Notification of Deemed Withdrawal*. Where, in the *Notification of the Recording of a Change* (PCT/IB/306) transferred by the International Bureau, the recorded change refers to the assignment of the right to apply for a patent by an entity or individual of Mainland China to a foreign individual, enterprise, or other type of organization the provision prescribed in Part 1, Chapter 1, Section 6.7.2.2(3) shall apply. ……	~~contract on the assignment or gift of the right to apply for a patent, the certifying document on the merger of the company provided by the administrative authority of industry and commerce, or other certifying document relating to transfer of right. The certifying documents may be the original or the copy certified by the public notary organ. The examiner shall examine the validity of the certifying documents.~~ According to Implementation Rule 1251.(6), where a change of applicant is made at the international phase to the International Bureau, when absolutely necessary the applicant should provide materials proving that the applicant after the change has the patent application right. For example, in the Notification of the Recording of a Change (PCT/IB/306) transferred by the International Bureau, the recorded change refers to the assignment of the right to apply for a patent by an entity or individual of Mainland China to a foreign individual, enterprise, or other type of organization the provision prescribed in Part 1, Chapter 1, Section 6.7.2.2(3) shall apply. Where the certifying documents are not provided, the examiner shall issue the Rectification Notification to notify the applicant to supplement. If no documents are supplemented at the expiration of the time	Chinese applicant to a foreign applicant. If this is the case, AIPLA commends this change. On the other hand, it is unclear that this is the case. Therefore, AIPLA suggests the following revision (deletions are in strikethrough and additions are underlined): According to Implementation Rule 1251.(6), where a change of applicant is made at the international phase to the International Bureau with the issuance of a Form PCT/IB/306 from the International Bureau, the applicant is not required to submit further certifying documents proving that the applicant after the change has the patent application right when entering the Chinese national phase except in special circumstances. ~~, when absolutely necessary the applicant should provide materials proving that the applicant after the change has the patent application right. For example, in the Notification of the Recording of a Change (PCT/IB/306) transferred by the International Bureau, the recorded change refers to~~ Examples of such special circumstances include the assignment of the right to apply for a patent by an entity or individual of Mainland China to a foreign

Current guideline	Draft revised guidelines	AIPLA comments
	limit, the examiner shall issue the Notification of Deemed Withdrawal. ~~Where, in the Notification of the Recording of a Change (PCT/IB/306) transferred by the International Bureau, the recorded change refers to the assignment of the right to apply for a patent by an entity or individual of Mainland China to a foreign individual, enterprise, or other type of organization the provision prescribed in Part 1, Chapter 1, Section 6.7.2.2(3) shall apply~~ ……	individual, enterprise, or other type of organization the provision prescribed in Part 1, Chapter 1, Section 6.7.2.2(3) shall apply. Where the certifying documents are not provided, the examiner shall issue the Rectification Notification to notify the applicant to supplement. If no documents are supplemented at the expiration of the time limit, the examiner shall issue the Notification of Deemed Withdrawal.
Part 4, Chapter 8, Section 2.2.2 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 that country, or shall be subject to any verification formalities provide in treaty between China and the country. For evidence submitted by the concerned party to the Patent Re-examination Board that is formed in Hong Kong, Macau, and Taiwan, the relevant verification formalities shall be done.	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 that country~~, or shall be subject to any verification formalities provide in treaty between China and the country. For evidence submitted by the concerned party ~~to the Patent Re-examination Board~~ that is formed in Hong Kong, Macau, and Taiwan, the relevant verification formalities shall be done.	AIPLA commends the revision to eliminate requirements for legalization of evidence originating outside of China to be submitted at invalidation proceedings. AIPLA requests confirmation on whether such legalization requirement is indeed no longer required. If so, AIPLA strongly supports this change.

Current guideline	Draft revised guidelines	AIPLA comments
However, in any of the following three circumstances, the party concerned may skip the relevant verification formalities in the invalidation procedure for the two kinds of evidence mentioned above: (1) The evidence can be obtained via domestic publica channels (Hong Kong, Macao, Taiwan excluded), for example, 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. (3) The authenticity of the evidence is acknowledged by the opposing party.	However, in any of the following three circumstances, the party concerned may skip the relevant verification formalities in the invalidation procedure for the two kinds of evidence mentioned above: (1) The evidence can be obtained via domestic publica channels (Hong Kong, Macao, Taiwan excluded), for example, 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.~~ (~~3~~2)The authenticity of the evidence is acknowledged by the opposing party. (3) The evidence is affirmed by a valid People's Court decision, administrative authority decision, or arbitration institution. (4) The authenticity of the evidence can be sufficiently supported by other evidence.	
Part 5, Chapter 6, Section 2.3.1		

Current guideline	Draft revised guidelines	AIPLA comments
Where a notification or decision is delivered by post, in person or by electronic means, the 16th day from the date of issuance is deemed to be the date on which the party concerned presumably receives the notification or decision. For the notification or decision delivered by post, where the party concerned submits evidence proving that the actual date of receipt is later than the presumed date of receipt, the actual date of receipt shall be the date of delivery.	Where a notification or decision is delivered by post, or in person ~~or by electronic means~~, the 16th day from the date of issuance is deemed to be the date on which the party concerned presumably receives the notification or decision. For the notification or decision delivered by post, where the party concerned submits evidence proving that the actual date of receipt is later than the presumed date of receipt, the actual date of receipt shall be the date of receipt. Where the notification or decision is delivered by electronic means, the date of issuance shall be the date of receipt.	AIPLA applauds this sensible change, which makes calculation of deadlines for responding to notifications issued by the CNIPA easier and clearer for applicants. AIPLA notes that this change would significantly reduce the time to handle re-examination notices issued by the Re-examination and Invalidation Department (1 month to respond), and office actions after the first office action issued by the Examination Division (2 months to respond). This reduction may be problematic for foreign applicants, who require additional time for translation. AIPLA suggests that if this change to remove the 15-days mail period for electronically transmitted notifications is to be implemented, the deadlines to respond to re-examination notices and office actions after the first office action be increased to 3 months. Alternatively, AIPLA suggests retaining the 15-days mail period for foreign applicants. Further, in real-life experience, when a notification or decision is served electronically, the notification or decision does not always arrive at the recipient server at the same time of issuance, but there may be delays or system failures that prevent timely delivery.

Current guideline	Draft revised guidelines	AIPLA comments
		Therefore, AIPLA suggests the following revisions (deletions in strikethrough and additions are underlined): Where a notification or decision is delivered by post, the applicant is a foreigner, or in person ~~or by electronic means~~, the 16th day from the date of issuance is deemed to be the date on which the party concerned presumably receives the notification or decision. ~~For the notification or decision delivered by post, where the party concerned submits evidence proving that the actual date of receipt is later than the presumed date of receipt, the actual date of receipt shall be the date of receipt.~~ Where the notification or decision is delivered by electronic means, the date of issuance shall be the date of receipt. Where the party concerned submits evidence proving that the actual date of receipt is later than the issuance date or the presumed date of receipt, the actual date of receipt shall be the date of receipt.
Part 5, Chapter 9, Section 2	**[New]**	

Current guideline	Draft revised guidelines	AIPLA comments
	2. Compensation for Patent Prosecution Term According to the provisions of Article 42.2 of the Patent, where an invention patent right is granted for an invention patent application 4 years since the date of filing and 3 years since the date of the request for substantive examination, the Patent Office shall, at the request of the patentee, grant a compensation for patent term for the unreasonable delay in the prosecution process of the invention patent, except that the unreasonable deferral is caused by the applicant. Where the same applicant applies for both utility model patent and invention patent for the same invention-creation on the same day and the utility model patent application has been granted with a patent right, the patent prosecution term shall not be compensated for the invention patent. 2.1 Submission of the Request A request for compensation for patent prosecution term shall be submitted by the patentee. The patentee who requests for compensation for patent prosecution term shall submit the request within 3 months from the date of publication of the grant of the patent and pay corresponding fees.	The Draft Guidelines stipulate that, if a patent is not granted within a certain timeframe, any additional days will be considered "unreasonable delay" by the Patent Office. The rules further specify what does not constitute unreasonable delay (suspension, preservation, and administrative litigation; not responding to OA in time (no extension); delay for examination requested; incorporation by reference invoked; restoration requested; early PCT national phase into China with no accelerated handling requested). AIPLA seeks clarification regarding all other delays by the Patent Office. Would other delays by the Patent Office be considered unreasonable, and compensated? AIPLA suggests that the Guidelines expressly recite what is considered "unreasonable delay by the Patent Office." AIPLA further suggests including at least one example of how the patent term compensation is calculated. The Draft Guidelines require that an applicant request Patent Term Compensation together with payment of a

Current guideline	Draft revised guidelines	AIPLA comments
	Where the patent right is shared by multiple patentees, the request for compensation for patent prosecution term shall be submitted by a representative of the patentees. Where a patent agency is entrusted, the request for compensation for patent prosecution term shall be submitted by the patent agency. 2.2 Determination of the Term of Compensation Where a compensation for patent term is granted, the patent term shall be compensated according to the number of days actually delayed. The number of days actually delayed refers to the unreasonable delay at the prosecution of the invention patent minus the unreasonable deferral time caused by the applicant. 2.2.1 Unreasonable Deferral Time in the Prosecution Process The unreasonable delay at the prosecution process refers to the date of publication of the grant of the patent minus the date of four years since the date of filing of the invention patent and the date of three years from the date of the request for substantive examination. The delays caused by the following circumstances do	fee. AIPLA believes that the addition of this extra step and cost hurts individual inventors and smaller companies. AIPLA suggests that the CNIPA automatically grant PTC upon the allowance of a patent application. This is consistent with the USPTO, which automatically grants PTC but a fee is only required if the applicant requests reconsideration of the PTC calculation. AIPLA suggests that CNIPA adopt a similar approach, charging a fee only if an applicant wishes to contest CNIPA's calculation of PTC. Draft Section 2.2.1 specifies that "The date of the request for substantive examination refers to the effective date of the request for substantive examination, and the effective date of the request for substantive examination is the issuance date of the notification of the invention patent application entering substantive examination phase." This is inconsistent with the date of the request for substantive examination specified in Article 42.2 of the Patent Law. Typically, there is a delay between the date of request for examination, and the issuance date of the notification (the notification) of the invention patent application entering

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	not belong to the unreasonable delay at the prosecution: suspension procedures, preservation measures, administrative litigation procedures, and reexamination procedures where the patent right is granted after the patent application documents were amended in accordance with Article 66 of the Implementation Rules of the Patent Law. The date of filing of the patent here refers to the date of filing specified in Article 28 of the Patent Law. For an international application, it refers to the date of entering the Chinese national phase. For a divisional application, it refers to the date of filing of the divisional application. The date of the request for substantive examination refers to the effective date of the request for substantive examination, and the effective date of the request for substantive examination is the issuance date of the notification of the invention patent application entering substantive examination phase. 2.2.2 Unreasonable Delay Caused By the Applicant Below are delays caused by the applicant: (1) Delay caused by no response to a notification issued by the Patent Office within the specified time limit, the delay is from the expiration date of the specified	substantive examination phase, which will only be issued when a request for examination has been filed, and the application has been published. For example, if a request for examination was filed together with the application with no priority claimed, the notification would only be issued about 18 months later, after the application has been published. AIPLA suggest clarifying this to "the date when the request for examination" is filed to conform with Article 42.2 of the Patent Law. Draft section 2.2.1 stipulates that "reexamination procedures where the patent right is granted after the patent application documents were amended in accordance with Article 66 of the Implementation Rules of the Patent Law" refers to a circumstance in which the applicant amended the claims during the reexamination procedure, but exclude the circumstance in which the applicant did ***not*** amend the claims during the reexamination procedure. It is unclear to AIPLA that, if applicant has not amended claims at the reexamination stage, the delay will be considered unreasonable and eligible for compensation. AIPLA proposes that, regardless whether or not the claims

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	time limit to the actual filing date of the response. (2) Where a request for deferred examination has been filed, the delay is the time of the examination actually deferred. (3) Delay caused by incorporation by reference, the delay is that in accordance with Implementation Rule 45 or 46(1) of the Chinese Patent Law. (4) Delay caused by a request for restoration of rights, the delay is from the expiration date of the original time limit to the date of issuance of the notification of approval of the request for restoration, except where it can be proven that the delay was caused by the Patent Office. (5) Delay caused by the applicant who did not request for accelerated processing of an international application which entered the Chinese national phase within 30 months since the priority day, the delay is from the date of entering the Chinese national phase to the date since 30 months from the priority date. 2.3 Approval of the Request for Compensation for Patent Prosecution Term Where the request for compensation for patent prosecution term is considered after examination as not meeting the term	are amended in reexamination, the delay should qualify as unreasonable in this section 2.2.1. The vast majority of applicants objectively do not "upgrade" the application to reexamination. The reexamination procedure is a reasonable extension of substantive examination in prosecuting a patent application. In considering the above, AIPLA suggests deleting the phrase: *"reexamination procedures where the patent right is granted after the patent application documents were amended in accordance with Article 66 of the Implementation Rules of the Patent Law"* from section 2.2.1. Draft Section 2.2.2. does not explicitly provide reinstatement for delay caused by reasons out of applicant's control. For example, the delay might be related to natural disasters and/or unforeseeable economic difficulties. AIPLA suggests that CNIPA affirmatively provide a reinstatement mechanism, for example, in Draft Section 2.3. AIPLA suggests making reinstatement available when delay occurs "in spite of all due care," comparable to U.S. practice (see, e.g., 37 CFR 1.705(c) and MPEP 2734).

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	compensation condition, the Patent Office shall give at least one opportunity to the petitioner to present opinions and/or correction documents. For which still does not meet the term compensation condition, the Patent Office shall make a decision to not grant the term compensation. Where the request for compensation for the term of patent prosecution is considered after examination as meeting the term compensation condition, the Patent Office shall make a decision to grant the term compensation notifying the number of days for the term compensation. 2.4 Register and Announcement After making the decision to grant the term compensation, the Patent Office shall record the related matters in the Patent Register and announce in the Patent Gazette.	
Part 5, Chapter 9, Sections 3.1 and 3.5	**[New]** **3.1 Compensation conditions** The following conditions shall be met when requesting compensation for drug patent term: (1) The date when grant of the patent is announced shall be earlier than the	AIPLA applauds the addition of draft guidelines making drug patents eligible for patent term extension. AIPLA is concerned, however, that the draft guidelines are subject to multiple, inconsistent exceptions and recommends that these be clarified.

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	date when the approval for drug marketing is passed; (2) The patent is valid at the time when the compensation request is made; (3) The patent has not been compensated for drug patent term; (4) Relevant technical solution of the new drug which has been approved for marketing should fall within protection scope of the patent; (5) If there are multiple patents related to one drug, only one patent can be requested to be compensated for drug patent term; (6) If one patent involves multiple drugs, the patent can be requested to be compensated for drug patent term against only one drug. **3.5 Determination of whether the drug falls within protection scope of the patent** The determination of the technical solution of a new drug shall be based on the structure, composition and amount, as well as the approved production process and indications of the new drug approved by	AIPLA commends the requirement that the drug patent at issue should be in force when applying for patent term extension (PTE) for drug patents, and the patent in issue cover the drug. AIPLA requests that, if CNIPA determines that the patent in issue does not cover the drug, notification be issued and the applicant be given an opportunity to respond. AIPLA seeks clarification on the following regarding this notification: • Whether this notification is to be issued by an examiner of the Substantive Examination Division? • Whether there is limit on the number of issuance of this notification? • If the response to the notification was ultimately rejected, whether this notification can be appealed, and, if so to whom? AIPLA also notes that new Section 3.5 provides that the protection scope of the drug patent with PTE is limited to the new drug approved for marketing by NMPA. AIPLA requests clarification whether such limitation is directed to specific claims in the drug patent in issue.

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	NMPA. If the technical solution of a new drug does not fall into the protection scope of the specified patent claim, no compensation for drug patent term shall be granted. During the compensation for drug patent term, the protection scope of the patent shall be limited to the new drug approved for marketing by NMPA and the technical solution related to the approved indications of the new drug. The protection scope of a product claim shall be limited to the marketed new drug for the approved indication, the protection scope of a medical use claim shall be limited to the approved indication of the marketed new drug, and the protection scope of a preparation method claim shall be limited to the production process of the marketed new drug for the approved indication filed with NMPA.	
Part 5, Chapter 9, Section 3.4	**[New]** **3.4 Applicable scope** According to Article 42.3 of the Patent Law and Rule 81 of Implementing Regulations of the Patent Law, for innovative drugs and improved new drugs conforming to the relevant provisions in this chapter,	The NMPA classification system effective since 1 July 2020 provides ***only*** improved new drugs belonging to the following drug classifications are allowed to obtain PTE: a) Chemical drug

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	compensation for drug patent term may be granted to product patents of active pharmaceutical ingredient (API), preparation method patents or medical use patents. The meanings of innovative drugs and improved new drugs shall be determined in accordance with relevant laws and regulations and with reference to the relevant provisions of NMPA. The improved new drugs that can be compensated for drug patent term are limited to the improved new drugs recorded in the following categories in the drug registration certificate issued by NMPA: (1) drugs involving the ester of a known active ingredient or the salt of a known active ingredient in Class 2.1 of chemical drug; (2) drugs with new indications containing known active ingredients in Class 2.4 of chemical drug; (3) vaccines with improved strains in Class 2.2 of biological products for prevention; (4) biological products with new indications in Class 2.2 of therapeutic biological products;	• 2.1 Chemical drugs that contain esterified known active ingredients, or salt of known active ingredients • 2.4 Chemical drugs for new indications that contain known active ingredients. b) Preventive biological drugs class 2.2, vaccine with strain improvement c) Therapeutic biological drugs class 2.2, for new indications of improved already marketed products. d) Chinese medicine class 2.3, for new indications of Chinese medicine. Thus, the following classes of improved new drugs of chemical drugs and biological products appear to be ***excluded*** from obtaining PTE: • Chemical drugs • 2.1 Drugs that contain an optical isomer of known active ingredients obtained by resolution or synthesis, or change in acid group, basic group, or metallic element of known active ingredients of salt, or formation of other non-covalent bond

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	(5) Chinese medicine with new functions and indications in Class 2.3 of Chinese medicine.	derivatives (e.g., complex, chelate or clathrate), and have significant clinical advantages. • 2.2 Drugs that contain known active ingredients with new dosage form (including new drug delivery system), new formulation process or new route of administration, and have significant clinical advantages. • 2.3 New compound preparations that contain known active ingredients and have significant clinical advantages. • ***All*** biological products ***other*** than b) and c) above. AIPLA requests clarification that innovative drugs can obtain PTE. Specifically, AIPLA requests that CNIPA provide that drugs that have not been marketed in China or overseas, including chemical drugs class 1, innovative vaccines class 1, and innovative biological products class 1 be eligible for extension. For improved new drugs, AIPLA requests removing the above restrictions so that PTE is available to all drugs patents for improved new drugs. Even for drugs that

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		have been marketed overseas or in China with known dosage and indications, patents may be granted for improvements to known drugs. We note that there is ***no*** restriction on the type of drugs that could obtain PTE in the Chinese Patent Law (2020), and the UN-CN trade agreements (2020). Therefore this Draft Guideline may not be in conformity with these requirements of international law. Therefore, AIPLA strongly suggests removing this entire section from the Draft Guidelines. Finally, even if this section is to be retained, AIPLA recommends the terms "innovative drugs" and "improved new drugs" should be defined to include drugs or improvements that are new to China when calculating PTE. While this Section articulates that PTE covers improvements to drugs such as new dosage forms, routes of administration, and indications, AIPLA recommends that this Section state that "improved new drugs" include new dosage forms, routes of administration, and indications. Furthermore, the definition of "product patents" should be clarified to include polymorphs, salts, formulations and combination patents.
Part 5, Chapter 10, Sections 2.1 and 2.3	[New]	

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	2.1 The Subject and Opportunity of a Request for Evaluation Report of Patent After the decision to grant a patent right for utility model or design is announced, the patentee, the interested party or the potential alleged infringer may request the CNIPA to make an evaluation report of patent. *The patent applicant may also request the CNIPA to make an evaluation report of patent when handling patent right registration procedures. [Note: this could allow the patentee to obtain the report earlier.]* Where the patent right for utility model or design is shared by multiple patentees, the petitioner can be some of the patentees. The interested party refers to a person who has the right to file a complaint at the People's Court or request the patent administrative department to handle patent infringement disputes in accordance with the provisions of Article 65 of the Patent Law. The potential alleged infringer refers to any entity or individual that may become an alleged infringer.	AIPLA applauds the change to allow even potential alleged infringer to obtain the patentability evaluation report (the report) for utility models or design patents. AIPLA suggests also allowing potential licensee to obtain an evaluation report. A potential licensee could have a substantial interest in the relevant utility model or design patents. AIPLA notes that section 2.3 stipulates that in order for a potential alleged infringer to obtain an evaluation report, a "lawyer's letter" is required. AIPLA suggest further clarifying what is meant by a "lawyer's letter." For example, would a cease and desist letter from the patentee's lawyers, and/or letter from the potential alleged infringer's own lawyer advising that there may be risk of infringement be sufficient? AIPLA also suggests expanding "lawyer" from only licensed attorneys to include a patent attorneys.

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	Where the above requirements are not met, the request for the evaluation report of patent shall be deemed to have not been submitted. **2.3 Request for Evaluation Report of Patent** …… (3) Where the petitioner is a potential alleged infringer, supporting documents including a lawyer's letter shall be submitted. ……	