



## American Intellectual Property Law Association

June 29, 2018

Mr. Sun Hang  
The Supreme People's Court  
No. 27 Dong Jiao Min Xiang  
Dong Cheng District, Beijing  
P.R. China  
100745

孙航先生  
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*By Email to:* [spcpatent@163.com](mailto:spcpatent@163.com)

**Re: AIPLA Comments on Regulations of Supreme People's Court on Certain Issues in Hearing Administrative Cases of Patent Granting and Confirmation (Draft for Public Comments)**

主题：美国知识产权法律协会 (AIPLA) 对《最高人民法院关于审理专利授权确权行政案件若干问题的规定 (公开征求意见稿)》的意见

Dear Mr. Sun,

The American Intellectual Property Law Association ("AIPLA") welcomes this opportunity to submit comments on the draft Regulations of Supreme People's Court on Certain Issues in Hearing Administrative Cases of Patent Granting & Confirmation issued by the Office of the Anti-Monopoly Commission of the State Council of the People's Republic of China ("Proposed Regulations").

The American Intellectual Property Law Association is a national bar association of approximately 13,500 members who are primarily lawyers 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 global laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA Comments on Regulations of Supreme People's Court on Certain Issues in Hearing  
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AIPLA welcomes the Supreme People's Court's ("SPC") Proposed Regulations. AIPLA believes these regulations will be helpful to practitioners seeking review of decisions regarding patent granting or patent confirmation. Moreover, AIPLA appreciates the extent to which, when substantive issues are addressed, the proposed regulations are often consistent with international standards and, therefore supports international harmonization of the patent laws. AIPLA respectfully offers the following comments, hoping these will be useful in finalizing the Proposed Regulations.

AIPLA has not commented on every article in the Proposed Regulations. However, our decision not to comment on a particular article should not be interpreted as an agreement or acquiescence with the proposed article(s) or disagreement with the proposed provisions. In some articles, AIPLA believes further clarification is needed to provide predictable guidance to patentees, IP practitioners, courts and other IP organizations. In still other cases, AIPLA believes further consideration by the SPC is warranted in order to achieve or move towards a uniform international standard.

AIPLA appreciates the opportunity to provide these comments in response to the Proposed Regulations. Please contact us if you would like us to provide additional information on any issues discussed.

Sincerely Yours,  
此致



Myra H. McCormack  
President

American Intellectual Property Law Association  
美国知识产权法律协会会长

### **Article 1**

The administrative cases of patent granting mentioned herein mean the cases where the patent applicant files a suit with the people's court against the review decision of the patent administrative department of the State Council—Patent Reexamination Board (PRB) on the request for reexamination.

**AIPLA Comments:** The administrative cases of patent confirmation mentioned herein mean the cases where the patentee or invalidation requester files a suit with the people's court against the review decision of PRB on the request for invalidation. Scope of proceedings: appeals from denial of a patent by PRB; and from final decision of PRB in invalidation proceeding. The intent appears to be that final decisions are appealable. AIPLA respectfully suggests that the regulations specify that only final decisions of the PRB can be appealed to a People's Court.

### **Article 2**

The scope of the administrative cases of patent granting and confirmation to be heard by people's court generally should be delimited on the basis of the claims and reasons of the plaintiff. If the relevant identification of PRB is obviously inappropriate, but the plaintiff made no claim in the proceedings, the people's court may examine the relevant facts and give ruling after the parties made statement.

**AIPLA Comments:** Article 2 appears to express a preference that the issues to be considered by a People's Court be those identified by the plaintiff - "delimited." Yet, Article 2 continues and states that the Court may examine additional issues that were not raised by the plaintiff. This may be problematic if the parties do not have a full and fair opportunity to address the issues. In addition, it may negate the parties' decision not to raise certain issues.

If the Court is given the authority to raise issues not raised by any of the parties, AIPLA recommends that each party be given a full and fair opportunity to present the facts and arguments that are related to the new issues raised by the court and have not been presented before, as compared to simply being allowed to "make statements" prescribed in the original text.

### **Article 3**

When hearing an administrative case of patent granting, the people's court generally should define the terms in the claims using the ordinary meanings understood by the persons skilled in the art. If a claim uses self-defined terms and its description and attached drawings have clear definitions or explanations, such definitions shall apply.

When hearing an administrative case of patent confirmation, the people's court may define the terms in the claims through claims, descriptions and attached drawings. If the descriptions and attached drawings have special definitions of the terms in the claims, such definitions shall apply.

Patent examination files may be used to explain the terms in the claims. If the above methods still cannot provide definitions, then definitions may be obtained from the technical dictionaries, technical manuals, reference books, textbooks, technical standards of the state or the industry that are normally used by persons skilled in the art.

(Plan 2: The people's court generally should define the terms in the claims using the ordinary meanings understood by the persons skilled in the art. If a claim uses self-defined terms and its description and attached drawings have clear definitions or explanations, such definitions shall apply.)

#### **Article 4**

When determining the meanings of a term in a claim, the people's court may consult the statement made by the patentee about the claim in patent infringement proceedings.

**AIPLA Comments:** Article 4 empowers a People's Court to rely on statements made by the patentee during patent infringement proceedings. AIPLA respectfully submits that this is consistent with international norms to the extent that concessions, admission, or statements disavowing claim scope may be credited. Self-serving statements, however, are not credited or given any weight.

Specifically, statements that may amount to a disclaimer or disavowal of claim scope are generally credited. Self-serving statements by the patentee are not and are entitled to little or no weight. AIPLA respectfully submits that the article could be narrowed in accordance with this practice to more closely align with international norms of construction.

#### **Article 5**

If, there are obvious mistakes of grammar, words, numbers, punctuation, graphs and symbols in a claim and/or its descriptions and attached drawings, but the persons skilled in the art can get unique understanding by reading the claims and/or its descriptions and attached drawings, the people's court should base its identification on such unique understanding.

**AIPLA Comments:** AIPLA is of the opinion that it is reasonable to allow the Court to proceed when a unique meaning can be ascertained from the claim at issue even if the claim contains obvious errors or mistakes.

However, international norms of claim construction permit the patentee to seek correction of errors in the claims through the Patent Office and not through the Courts, provided the mistake or error is not material.

If the mistake or error is material, AIPLA respectfully requests that the patentee not be permitted to correct or amend the issued patent absent further substantive examination. Specifically, the

patentee would need to surrender the patent or otherwise reopen examination of the application and address any material error substantively through continued examination.

### **Article 6**

If there are evidences proving that a patent applicant or patentee has violated the principle of good faith through malicious forgery and alteration of the technical content, e.g. specific mode of use, data and graphs, in the descriptions and attached drawings, the people's court shall support the counterparty's assertion that the descriptions do not meet Article 26.3 of the Patent Law and the request for invalidation of the claim in question.

**AIPLA Comments:** AIPLA believes that this Article intends to address one specific type of inequitable conduct, that is, malicious forgery of content and data and proscribe corresponding penalty. For clarity, AIPLA recommends that the Article be directed to the type of violation of good faith principle through malicious forgery or alteration of the specification and graphs in a patent application. For example, consider replacing the comma between good faith principle and malicious forgery with the word "through" or "via." Other types of inequitable conduct do not fall under Patent Law Art 26.3.

### **Article 7**

If the particular technical content not disclosed fully in the descriptions and attached drawings makes it impossible for the persons skilled in the art to implement the technical solution defined in the claim or confirm that the technical solution defined in the claim can address the technical problem that the patent is intended to address after limited tests, the people's court should determine that the descriptions do not meet Article 26.3 of the Patent Law, unless the technical content not disclosed fully in the descriptions has no substantive relevance to the technical solution defined in the claim.

**AIPLA Comments:** To be consistent with the rest of the article, AIPLA suggests adding "and drawings" to the last sentence as follows:

"...unless the technical content not disclosed fully in the descriptions and drawings has no substantive relevance to the technical solution defined in the claim."

### **Article 8**

Under any one of the following circumstances, the people's court should determine that the claim does not meet the provisions concerning clear claims in Article 26.4 of the Patent Law:

- (1) The invention defined in the claim has a subject type that is not unique or clear;
- (2) The meaning of the technical features in the claim cannot be determined;

- (3) Obvious contradictions exist between technical features and cannot be explained reasonably.

### **Article 9**

If, after reading the descriptions and attached drawings, the persons skilled in the art cannot directly obtain or reasonably generalize the technical solution defined in a claim, the people's court should determine that the claim does not meet Article 26.4 of the Patent Law, which provides that claims should be based on descriptions.

If, after reading the descriptions and attached drawings, the persons skilled in the art cannot reasonably foresee that all the modes of exploitation covered in a claim can address the technical problems to be addressed as recorded in the descriptions, the people's court should determine that this is a case of impossible reasonable generalization described in the preceding paragraph.

### **Article 10**

If part of the specific modes of exploitation recorded in the descriptions cannot address the technical problems that the patent is intended to address, but the persons skilled in the art, after reading the descriptions and attached drawings, can reasonably foresee that all the other specific modes of exploitation covered in the claim can address the technical problems that the patent is intended to address on the day of application and reach the same technical effect without the need for excessive labor, the people's court generally should support the assertion of the litigant that the claims meets Article 26.4 of the Patent Law, which provides that claims should be based on descriptions.

### **Article 11**

If the technical content recorded in the descriptions is contradictory, thereby causing the persons skilled in the art to be unable to determine whether it can address the technical problems that the patent is intended to address, the people's court should not support the assertion made by the litigant on the basis of the technical content that the claim meets Article 26.4 of the Patent Law.

### **Article 12**

For the technical features defined by function or effect in a claim, if the descriptions and/or attached drawings failure to record any specific mode of exploitation for achieving the function or effect and the persons skilled in the art cannot determine its meaning merely on the basis of the claims, the descriptions and the attached drawings, the people's court should support the assertion made by the litigant that the claim does not meet Article 26.4 of the Patent Law.

### **Article 13**

The people's court generally should make examination if the applicant or patentee of a chemical invention patent submits test data after the application date, which are used to further prove that the technical effect recorded in the descriptions has already been disclosed fully and can be confirmed by the persons skilled in the art on the application date on the basis of the descriptions, the attached drawings and common general knowledge.

The people's court generally should make examination if the applicant or patentee of a chemical invention patent submits test data after the application date, which are used to prove that the patent application or the patent has a technical effect different from that in the comparative document and the technical effect can be confirmed directly and undoubtedly by the persons skilled in the art on the application date from the content disclosed in the application documents of the patent.

### **Article 14**

If a litigant submits test data, the people's court may require him/her to provide evidences that prove the source and formation process of the test data, including the factors that are sufficient to influence the truthfulness thereof, e.g. experimental raw materials and the source thereof, experimental steps, conditions or parameters, experimenters and site.

If a litigant challenge the truthfulness of the test data, the people's court may entrust the appraisal thereof to a qualified organization according to law.

### **Article 15**

If the revision of the descriptions and/or the attached drawings made by the patent applicant is clearly recorded in the original descriptions, the attached drawings or claims, or belongs to the content that the persons skilled in the art can determine directly and undoubtedly, the people's court should determine that the revision meets Article 33 of the Patent Law.

### **Article 16**

If the claim revised by the patent applicant meets Article 26.4 of the Patent Law about being "based on descriptions", the people's court should determine that the revision meets Article 33 of the Patent Law.

**AIPLA Comments:** Art. 26.4 of the Patent Law states: "The written claim shall, based on the written description, contain a clear and concise definition of the proposed scope of patent protection."

Article 33 of the Patent Law states: "An applicant may amend his patent application documents, provided that the amendment to the invention or utility model patent application documents does not exceed the scope specified in the original written descriptions and claims, or that the

amendment to the design patent application documents does not exceed the scope shown in the original drawings or pictures.”

AIPLA welcomes the confirmation that the claims *can* be amended under Article 33 of the Patent Law, whereas Art. 33 only refers more generally to amendment of “patent application documents.”

AIPLA suggests that SPC clarify whether this article can be interpreted to override Patent Law Article 33 which requires that claim amendment does not exceed the scope of the original disclosure. Or is this article only applicable to claim amendments requested by the applicant during the appeal of PRB's decision at the court?

### **Article 17**

The background art recorded in the descriptions generally is not deemed as the prior art mentioned in Article 22.2 of the Patent Law, unless there are evidences proving that it has been disclosed before the application date.

The content disclosed in a reference document includes the technical content that is recorded clearly therein and the technical content that can be determined directly and undoubtedly by the persons skilled in the art.

### **Article 18**

The people's court generally should determine the field of art by relying on the content of a claim, the subject name of the patent, the technical functions and uses achieved by the technical solution, while making reference to the lowest position of the patent in the international patent classification.

**AIPLA Comments:** It seems that this article will be rarely invoked. In those rare instances in which the article is invoked, how much weight does “making reference to” put on the court? What if more than one international patent classification applies to the claimed invention? What authority designates the international patent classification?

### **Article 19**

The people's court should decide the technical problems actually addressed by a claim by relying on the technical effect created by the distinctive technical feature of the claim recorded in the descriptions and attached drawings as compared with the nearest prior art and on the overall understanding of the persons skilled in the art about the patent technical solution. If the descriptions and attached drawings contain no clear record of the technical effect created by the distinctive technical feature, the decision may be based on the common general knowledge in the field, the relationship between the distinctive technical feature and other technical features, the role played by the distinctive technical feature in the technical solution of the patent.



If the technical problem actually addressed by a claim is to provide an alternative solution for the prior art, the claim may be exempted from the requirement to have better technical effect than that of the prior art.

**AIPLA Comments:** AIPLA supports this Article, and particularly commends the last paragraph of Art. 19, as it provides helpful guidance to the judges of the people's courts.

## **Article 20**

If the prior art has provided technological inspiration on the whole in relation to the technical problem actually addressed by a claim, the people's court should determine that the claim does not meet Article 22.3 of the Patent Law.

Under any one of the following circumstances, the people's court may find that the technological inspiration mentioned in the preceding paragraph exists:

- (1) The prior art has disclosed the distinctive technical feature (of the patent at issue) and the technical problem that the distinctive technical feature can address and the claim actually addresses;
- (2) The distinctive technical feature falls within the common general knowledge of the field, unless there are contrary evidences proving that it is difficult for the persons skilled in the art to think of applying the common general knowledge to the nearest prior art;
- (3) The part not explicitly mentioned in the prior art is selected purposefully from the scope disclosed in the prior art, but, however, although not explicitly mentioned in the prior art, the part selected purposefully from the scope disclosed in the prior art does not have unexpected technical effect.

## **Article 21**

When deciding the level of knowledge and perceptibility of general consumers for appearance design, the people's court generally should consider the design space of the products of a design patent.

For purpose of the finding on the design space mentioned in the preceding paragraph, the people's court may give comprehensive considerations to the following factors:

- (1) Functions and uses of the product;
- (2) Density degree of existing design;
- (3) Customary design;
- (4) Mandatory provisions of laws and administrative regulations;
- (5) Technical standards of the state and the industry.

**AIPLA Comments:** AIPLA finds the term "design space" unclear and so defers further comment.

## **Article 22**

A design feature decided only by technical functions generally has no impact on the overall visual effect of design patent, excluding the position relation between the design feature and other design features. The design feature includes:

- (1) the only or unselectable design feature that achieves the technical function;

the design feature that achieves the technical function is not the only or unselectable one, but the selection and change between them are not based on visual effect.

## **Article 23**

If the pictures and photos of a design patent are contradictory or blurry, thereby causing general consumers to be unable to determine the appearance design to be protected on the basis of the pictures, photos and brief descriptions, the people's court should determine that it does not meet Article 27.2 of the Patent Law.

**AIPLA Comments:** AIPLA commends that this article properly defines the situation for Article 27.2 of Patent Law.

## **Article 24**

If a design patent that is compared with the existing design of the products of a same or similar category has a visual effect that is identical or substantively identical despite the nuances, the people's court should determine that it constitutes the "existing design" prescribed in Article 22.1 of the Patent Law.

If the differences between a design patent and an existing design of the products of a same or similar category that it is compared with have no significant impact on the overall visual effect, the people's court should determine that it has no "obvious distinction" prescribed in Article 22.2 of the Patent Law when it is compared with the existing design.

**AIPLA Comments:** AIPLA respectfully suggests that, consistent with Article 21, it is expressly clarified that the design space "should" be considered under Articles 24-27. For example, Article 28 may be revised to additionally include references to Articles 24-26, and provide that "When deciding the overall visual effects under Articles 24 to 26 and the unique visual effect under Article 27, the people's court should give comprehensive consideration to the following factors" (人民法院在认定本规定第二十四至二十六条所称的整体视觉效果或第二十七条所称的独特视觉效果时, 应当可以综合考虑下列因素").

Alternatively, each of Articles 24-26 may be revised to additionally and expressly provide that “When determining the overall visual effect and whether a difference between the designs is minute/has a substantial impact under this Article, the people’s court should consider the design space as provided in Article 21” (“人民法院在认定本条所称的整体视觉效果以及设计差别是否仅具有细微区别/具有显著影响时，应当考虑本规定第二十一条所称设计空间”).

### **Article 25**

If a design patent that is compared with another design patent of same-day application of the products of a same category has a visual effect that is identical or substantively identical despite the nuances, the people’s court should determine that it does not meet Article 9 of the Patent Law, which provides that “one patent shall be granted to one invention.”

**AIPLA Comments:** See comments in Article 24.

### **Article 26**

If a design patent compared with the documents of a design patent that is filed before and announced after the application date and belongs to the products of a same or similar category has an overall visual effect that is identical or substantively identical despite the nuances, the people’s court should determine that it constitutes an “identical design” prescribed in Article 22.1 of the Patent Law.

**AIPLA Comments:** See comments in Article 24.

### **Article 27**

If general consumers can easily think of the diversion, piecing together or replacement of a design feature based on the overall design inspiration given by the existing design to obtain an appearance design with an overall visual effect that is identical or has only nuances, but with no unique visual effect, the people’s court should determine that the design patent is not obviously different from the combination of existing design features.

Under any one of the following circumstances, the people’s court may find that the design inspiration mentioned in the preceding paragraph exists:

- (1) the feature of a single natural object is diverted directly to the products of a design patent;
- (2) an existing design has disclosed the diversion of the design features of the products of a particular category to patented products;
- (3) the design features of different parts of the products of the same category are pieced together or replaced simply;

- (4) an existing design has disclosed the simple combination of the appearance design features of the products of a particular category;
- (5) an existing single pattern is used directly on the products of a design patent.

### **Article 28**

When deciding the unique visual effect mentioned in Article 27 hereof, the people's court may give comprehensive considerations to the following factors:

- (1) overall status of existing design;
- (2) design space;
- (3) correlation of product category;
- (4) quantity and difficulty of combined design features;
- (5) impact of diversion, piecing-together and replacement on product functions;
- (6) whether there exists any difficulty hard to overcome.

### **Article 29**

The legal rights mentioned in Article 23.3 of the Patent Law include the rights to works, trademarks, geographical indications (GI), enterprise names, trade names, portraits, unique names of well-known commodities, packing or decoration of well-known commodities.

If the evidence submitted by an invalidation requester can prove the existence of the conflict of rights prescribed in Article 23.3 of the Patent Law, the people's court should not support the patentee's assertion that the requester has no right to request invalidation made on the ground that the requester is not the holder of a prior legal right or an interested party.

(Plan 2 of paragraph 2: If the evidence submitted by an invalidation requester cannot prove that he/she is the holder of a prior legal right or an interested party prescribed in Article 23.3 of the Patent Law, the people's court should support the assertion that the requester has no right to request invalidation made by the patentee on this ground.)

**AIPLA Comments:** This article provides a definition of "legal rights" mentioned in Article 23.3 of the Patent Law. So defined, it is unclear why and when the legal rights in Article 23.3 of the Patent Law will be in such conflict with design patent rights as to prevent a design patent from being allowed or issued.

As to the two alternatives presented, AIPLA is of the opinion that the first alternative is too broad because it allows any invalidation requester to proceed if the requester can prove the existence of certain conflict rights even though the requester has no interest in the case or has no standing to bring the invalidation proceeding. The second alternative is closer to international standard of requiring legitimate standing to bring legal proceeding.

In general, AIPLA supports the requirement of a plaintiff or a petitioner having standing in order to raise a challenge.

### **Article 30**

The people's court should support the assertion made by a litigant to PRB that the following circumstances belong to "violation of the legal procedure" prescribed in Article 70.3 of the Administrative Procedure Law:

- (1) The omission of the facts and causes presented by a litigant have produced substantive impact on the rights of litigant;
- (2) In the same procedure of reexamination or invalidation request, the members of the collegiate group were not informed and found through investigation to have failed to withdraw when there indeed existed matters calling for their withdrawal;
- (3) An eligible party who was not notified to attend the same procedure of reexamination or invalidation request raised objection explicitly.

**AIPLA Comments:** AIPLA is concerned that this article does not provide sufficient guidance for rulings on improper procedures. The three examples listed in the article are atypical. It is unclear whether the article is only applicable to the three scenarios listed here or whether the three examples are listed merely for illustration purposes. In all other allegations of procedural violations not listed here, can it be inferred that the court should not "support" the petitioner?

### **Article 31**

If PRB conducted hearing beyond the facts and causes asserted by a requester of invalidation or reexamination in a circumstance that does not warrant law-based ex officio examination, the people's court should support the assertion made by the litigant that the examination constitutes a case of "overstepping powers" prescribed in Article 70.4 of the Administrative Procedure Law.

### **Article 32**

Under either of the following circumstances, the people's court may rule to revoke the wrong part of a decision made by PRB under Article 70 of the Administrative Procedure Law:

- (1) The decision is wrong in its identification of some claims, but correct in the identification of the rest;
- (2) The decision is wrong in its identification of some appearance designs in a design patent application prescribed in Article 31.2 of the Patent Law, but is correct in the identification of the rest.

**AIPLA Comments:** This article provides that a court can affirm, reverse, and remand a PRB's decision in whole or in part. AIPLA applauds such move towards international standard practice.

### **Article 33**

If PRB decided to invalidate a patent right after examining all the reasons and evidences for invalidation thereof involved in the case, but the people's court holds that none of the reasons for identifying the patent right as invalid in the decision is tenable, the people's court should rule to revoke the decision rather than rule that PRB should make a decision again. If the patentee transfers, pledges and licenses the patent right after the above decision or judgment that has taken effect is served upon him/her, the people's court should not support the assertion of the litigant that the act has no foundation of rights.

**AIPLA Comments:** This article provides that a people's court can reverse a PRB's decision, without remanding the case to the PRB, which conforms to the international standard practice. This article also provides that a court should not support a litigant's assertion that a patentee's action e.g., transferring, pledging, or licensing a patent, is invalid because the patent has been invalidated. AIPLA commends the SPC for this approach and also recommends that in the event of transfer, the court may bring the new assignee, as a real party in interest, to the proceeding.

### **Article 34**

If a judgment of the people's court that has taken effect has made a clear decision on the relevant facts and the application of laws, but a litigant disobeys the decision made again by PRB on the basis of the judgment and files a suit again, the people's court shall rule not to accept the complaint or to dismiss the suit according to law if it has been accepted.

**AIPLA Comments:** This article provides that a court shall refuse to accept the case if a litigant is not satisfied with the PRB's second decision based on the court's judgement after the court has remanded the case to the PRB. It is unclear from the wording of the article whether the litigant is not allowed to appeal the PRB's decision after remand or not allowed to bring a second lawsuit against the PRB's second decision. If the former, the international norm is to accept the appeal by the court. If the latter, the international norm is to reject as stated in this article.

### **Article 35**

If a decision of PRB is wrong in identification of facts or application of laws, but correct in the conclusion about the validity of patent right, people's court may rule to dismiss the plaintiff's claim without cancelling the decision according to Article 69 of the Administrative Procedure Law.

### **Article 36**

When hearing an administrative case of patent granting and affirmation, the people's court may set the time limit for the litigants to submit evidences on the basis of their claims and case hearing conditions. The people's court should order a litigant who submits evidences beyond the time limit

to give a reason and should not accept the evidences if the litigant refuses to give a reason or the reason given is untenable.

**AIPLA Comments:** AIPLA recommends adding the following clause to avoid unfairness due to one party's undue delay:

*In deciding whether to accept the evidences beyond the time limit, the people's court may consider whether doing so might cause cognizable detriment to any individual, or to the public interest, and whether that detriment outweighs any tenable reason given by the litigant.*

Given the short time frames for response, it seems unlikely there would be any cognizable detriment. However, if the belated submission of evidence was extensive and there were intervening circumstances, such as another party making a business decision based upon the reasonable assumption that no evidence would be submitted, the court might be justified in refusing to accept a tenable excuse for the belated submission of evidence.

### **Article 37**

If a litigant asserts that the relevant technical content is the common general knowledge of the field or the relevant design feature is the customary design of the products of a design patent, the people's court should require him/her to submit evidences or make adequate explanations

**AIPLA Comments:** AIPLA is of the opinion that if a litigant is permitted to rely upon common general knowledge of the field, or customary design of the products, it seems appropriate to require the litigant to submit evidence or to make adequate explanations, to rule out broad unsupported assertions, especially since there is no definition of what does and does not serve as common general knowledge or customary design, either here or in the Patent Law. AIPLA commends the SPC for this article.

### **Article 38**

If PRB introduces common general knowledge or customary design ex officio into a patent granting procedure and listens to the litigant's opinions on the common general knowledge or customary design, the people's court generally should not support the litigant's assertion that the introduction is a violation of legal procedure.

If PRB actively introduces the common general knowledge or customary design not mentioned by the litigant into a patent affirmation procedure without hearing, the people's court generally should support the litigant's assertion that the introduction is a violation of legal procedure.

**AIPLA Comments:** AIPLA commends the SPC for moving towards the international standard practice.

### **Article 39**

If the new evidences submitted by the patentee in the procedure of hearing an administrative case of patent affirmation are used to prove that a claim invalidated by PRB should remain valid, the people's court generally should examine such evidences.

If the new evidences submitted by the invalidation requester in the procedure of hearing an administrative case of patent affirmation are used to prove that the patent right should be invalidated, the people's court generally should not accept such evidences, unless the evidences are used to:

- (1) prove the common general knowledge or customary design already asserted in the request for invalidation;
- (2) prove the level of knowledge and perceptibility of general consumers in related to the products of a design patent;
- (3) strengthen the probative force of the evidences already accepted by PRB;
- (4) refute the new evidences submitted by the patentee in the preceding paragraph.

**AIPLA Comments:** AIPLA believes that Article 39 seems designed to prioritize patent validity, which seems appropriate.

### **Article 40**

These Regulations shall apply to the first-instance and second-instance cases being heard by the people's court after the implementation thereof.

These Regulations do not apply to the cases that have been closed before the implementation thereof and cases that are heard again as requested by litigants or as required by laws after the implementation thereof.

**AIPLA Comments:** AIPLA believes that this Article is appropriate and adequate.