

November , 2008

To: State Intellectual Property Office of the People's Republic of China

Japan Intellectual Property Association
Hirohiko Usui, President

Opinions on the Draft Revision of Your Patent Examination Guideline

We, the Japan Intellectual Property Association, are a private user organization established in Japan in 1938 for the purpose of promoting intellectual property protection, with about 900 major Japanese companies as members. One of our important activities is to submit our opinions on the intellectual property systems of other countries and propose improvements in the implementation thereof. This letter is to present our opinions on the draft revision captioned above.

Our opinions are presented as attached hereto. Your kind consideration would be highly appreciated.

If you have any questions, please do not hesitate to contact us. We would be more than happy to explain the basis of and reasons for our opinions.

Attached documents: Opinions on the draft revision of the Patent Examination Guideline of the People's Republic of China

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Opinions on the Draft Revision of the Patent Examination Guidelines
of the People's Republic of China

1. Article 1 (Part I, Chapter I, Section 4.1.4, Contact Point)

We have no comments on this provision.

2. Article 2 (Part II, Chapter VIII, Section 5.2.1, Request for Correction or Amendment)

Part II, Chapter VIII, Section 5.2.1 of the current Examination Guidelines specifies that, even if an amendment made in response to a notification of examiner's opinion does not comply with Article 51, paragraph 3 of the Implementing Regulations of the Patent Law (in other words, even if the amendment does not satisfy the request presented in the notification of examiner's opinion), the amendment shall be deemed to be in line with the request presented in the notification of examiner's opinion (in other words, deemed to be an amendment made in compliance with Article 51, paragraph 3 of the Implementing Regulations of the Patent Law) as long as the amendment satisfies the criterion specified in Article 33 of the Patent Law, remedies the defect in the application document, and makes the application patentable.

We are concerned that the revision of Part II, chapter VIII, Section 5.2.1 of the Examination Guidelines proposed in Article 2 of the draft would make any amendment made in response to a notification of examiner's opinion unacceptable unless the amendment is in line with the request presented in the notification.

In practice, it is common for an applicant to discover an error in an application document or to discover a prior art (existing technology) similar to the invention claimed in the application after filing a request for substantive examination. In a case where an applicant discovers an error or a prior art as mentioned above after three or more months have passed since the acceptance of a notification of the commencement of substantive examination or after the time limit for voluntary amendment specified in Article 51, paragraph 1 of the Implementing Regulations of the Patent Law has passed, even if such an error or a prior art is not pointed out in a notification of examiner's opinion sent to the applicant, the current Examination Guidelines permit the applicant, with examiner's permission, to make an amendment to correct the error or to reduce the scope of claims in order to differentiate the invention claimed in the application from the prior art. As mentioned in the Examination Guidelines, such an amendment has greatly contributed to the simplification of the examination procedure and has contributed to the enhancement of the quality of patents, which is one of the major purposes of this revision of your Patent Law.

However, according to the draft revision, in a case where an applicant discovers an error or a prior art, as mentioned above, after the expiration of the period for voluntary amendment as specified in Article 51, paragraph 1, of the Implementing Regulations of the Patent Law as

described earlier, if the examiner's notification sent to the applicant fails to point out the error or prior art, the applicant must ask the examiner to reissue a notification of examiner's opinion to point out the error or prior art or must correct the error or file a divisional application whose claims are designed to differentiate the invention claimed in the application from the prior art. We are concerned that the draft revision would make the examination procedure more complicated and increase the burden of examination shouldered by the State Intellectual Property Office. If an applicant failed to follow such a required procedure, the patent would be registered, though such an error and prior art could constitute a reason for invalidation of the patent. Any third party that is not aware of the existence of such a potential reason for invalidation could misunderstand that the patent is effective. This would not only hinder the economic development of your country, but also increase the number of requests for trials for invalidation (requests for declaration of invalidation) filed by third parties who have discovered the reason for invalidation.

None of other major countries has a provision that permits amendment of an application document after receiving a notification of examiner's opinion on the condition that the amendment be made on a matter pointed out in the notification.

On these grounds, we oppose to the revision of Part II, Chapter VIII, Section 5.2.1 of the Examination Guidelines and request that the current practice be maintained, so that any amendment made not in line with a request presented in a notification of examiner's opinion be deemed to be in compliance with Article 51, paragraph 3 of the Implementing Regulations of the Patent Law as long as the amendment satisfies conditions such as the fulfillment of the criterion specified in Article 33 of the Patent Law.