

Monthly Newsletter

June 2022



Highlights of the CNIPA 2021 Report

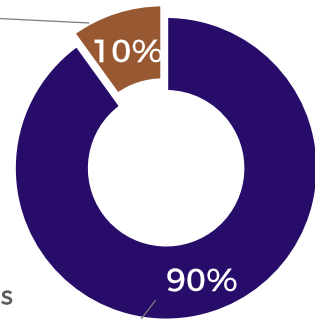
In June 2022, China National Intellectual Property Administration has published its annual report which highlights patent prosecution activities in China. We have selected some numbers which may be relevant to you

Patent prosecution in China

The administration has been speeding up the examination period for patent inventions from 20 months in 2020 to 18.5 months in 2021.

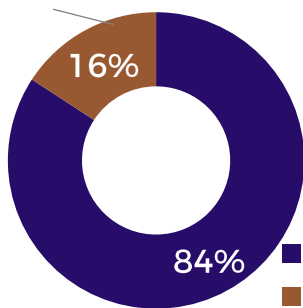
15,8000 foreign applications, a 3.6% increase comparing to 2020

■ Domestic
■ Foreign applicants



15,8000 foreign applications, a 3.6% increase comparing to 2020

586,000 inventions by local companies were authorized, a 23% increase comparing to 2020

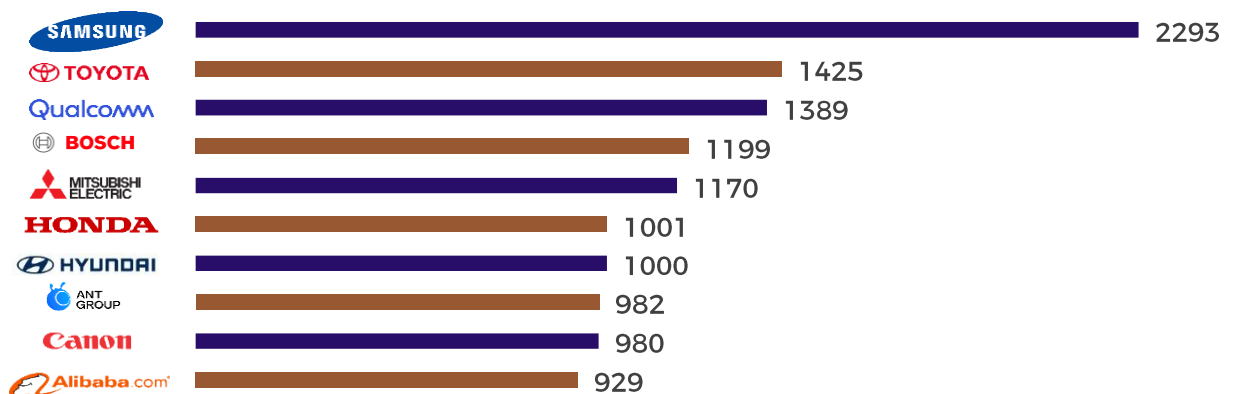


■ Domestic
■ Foreign applicants

1,428,000 domestic applications, a 6.2% increase comparing to 2020

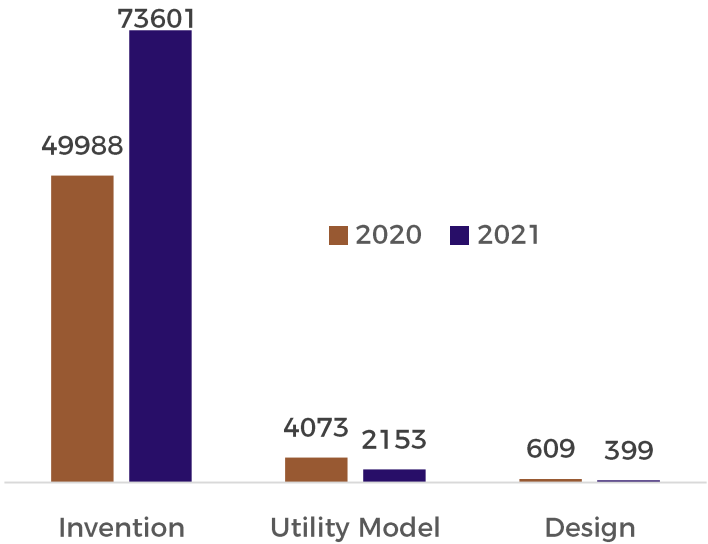
Patent authorization in China

Top 10 enterprises whose patents are authorized in China in 2021



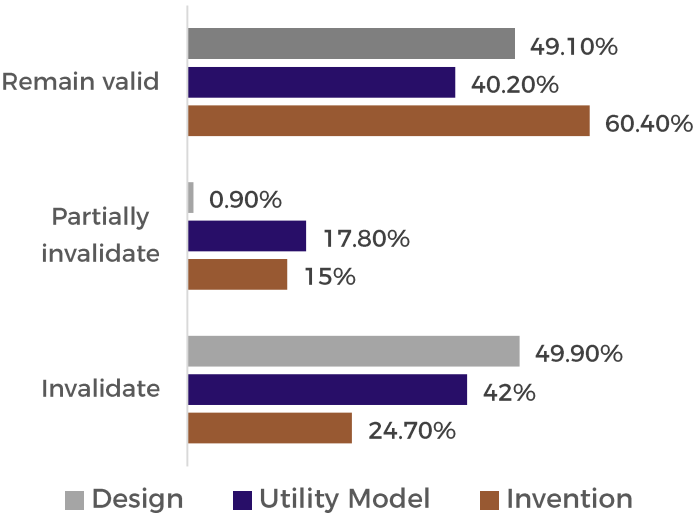
Patent re-examination requests

In 2021, there is a 39.2% increase in re-examination requests (a total of 76,000 requests). Most of the requests concerned invention patents. At the same time, 54,000 of re-examination cases have been closed in 2021, a 12.4% increase from 2020.



Patent invalidation results

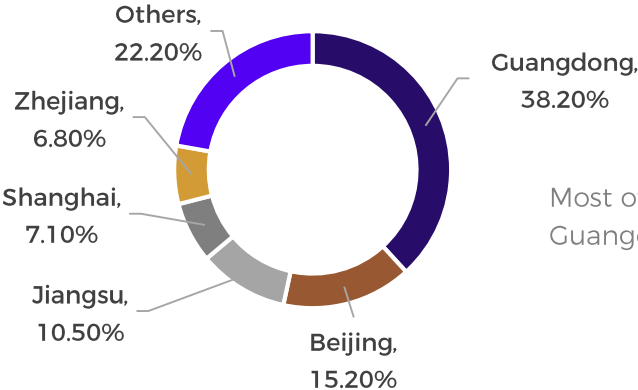
7,065 invalidation cases were closed in 2021. Based on the results, design patents and utility model patents have higher possibilities to be invalidated comparing to invention patents.



PCT applications

107,000

Applications through PCT to China, among them, 106,000 are invention patent



Most of the PCT applications happened in Guangdong province following by Beijing.

Inventive steps in the CNIPA patent applications

Inventors may find themselves confronting numerous challenges at the China National Intellectual Property Administration (CNIPA) examination. One of the key challenges would be the examination of inventive steps in inventions. It is noteworthy that the inventive steps in CNIPA's examination is substantially different from the USPTO. In this article, we will explain the inventive steps in Chinese patent prosecution in detail and strategies for successful patent applications in China.

What does inventive steps of an invention mean In China?

Applicant should prove that an invention has prominent substantive features and represents a notable progress when comparing to a prior art, so to demonstrate the inventive steps of the invention.

Prominent substantive features of an invention should be non-obvious to a person skilled in the art in view of the prior art; a notable progress of an invention means that the invention produces advantageous technical effects. For instance, the invention has overcome defects and deficiencies in an existing technology, or has provided a different technical solution to solve a certain technical problem, or represents a certain new trend of technical development.

How does CNIPA examiners determine if there are inventive steps in an invention?

CNIPA examiners adopt the “**three steps approach**” to determine whether a claimed invention is obvious as compared with the prior art.

- STEP 1: Determine the prior art which is most closely related to the claimed invention (closest prior art)
- STEP 2: Determine the distinguishing features of the invention and the technical problem actually solved by the invention
- STEP 3: Determine whether the claimed invention is obvious to a person skilled in the art

Applicants should pay more attention to the 2nd and 3rd steps given that these steps are different from the US patent examination.

In the 2nd step, the examiner analyzes and re-defines the technical problem actually solved by the invention. The technical problem may be different from the problem recited in the application by the applicant. For example, if the claimed distinguished feature and the technical problem the feature solved have been disclosed by prior arts, the examiner will re-define the technical problem actually solved by the distinguishing features.

In the 3rd step, the examiner determines an invention's obviousness depending on whether a person skilled in the art would have a motivation or incentive to make improvement based on the closest prior art.

Applicants are always confused with the three-step approach in China because in practice, the examiners often consider the distinguishing features as common technical knowledge and construe the motivation using common knowledge when applying the three-step approach, without providing evidences or specific reasons. Applicants should also be aware that the level of "the skilled person in the art" in China has a relatively high. That being said, examiners would first assume that the person skilled in the art is aware of the technical problems to be solved and has access to all the available technical solutions before the filing date to which the invention pertains.

As a result, applicants always find themselves having difficulties in passing the inventive step examination.

How to reply office action from CNIPA if the application failed due to lack of inventiveness?

According to Chinese practice, when arguing the inventiveness issue with CNIPA, we suggest to find out the distinguishing feature(s) of the claim by comparing with closest prior art.

Secondly, applicant may argue that the claimed invention is non-obvious for a person skilled in the art, the possible grounds are:

- The distinguishing features are not disclosed by the prior art, the Examiner may have misunderstood or over-explained the related features in the prior art.
- The features actually act differently in the prior art than the distinguishing feature(s) do in the claim.
- The distinguishing features do not belong to common technical knowledge of the art.
- The prior arts cannot be combined due to some technical obstacle, or there is conflict between the prior arts.
- The teaching or suggestion in the prior art is contrary to the purpose of the claimed invention.

Finally, do not forget to state the advantageous technical effects of the invention in the claim.

In addition, the arguments from other aspects may also be helpful, for example:

- it is hard for a person skilled in the art to create the same technical solution as to the claimed invention due to technical difficulties or prejudice, or misleading from common knowledge;
- the technical solutions will bring unexpected technical effects;
- the technical solutions will unexpected success in the market; or
- other similar situations, such as long-felt but unsolved needs.

We also recommend you to watch this on-demand webinar (click [here](#)) to learn more about the inventive steps in China and the U.S.

Purplevine News | Purplevine sponsored IPBC Global 2022 in Chicago

Purplevine was proud to support the IPBC Global 2022 event during 12-14 June in Chicago. IPBC Global is one of the leading IP industry events in the world. Purplevine's Chief IP Counsel (US) Ude Lu spoke at one of the panel discussions "The Global Litigation Landscape" with Alex Wilson (Partner of Powell Gilbert), Lucy Wojcik (Chief IP Counsel of Ocado Group), Naomi Voegtli (Chief IP Counsel of BorgWarner) and Otto Licks (Founding Partner of Licks Attorney). During the panel discussion, panelists shared their views on the litigation development in the US, Europe and Asia where Ude shared his insights of Chinese patent litigation.



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