中国贸促会专利商标事务所
CCPIT PATENT & TRADEMARK LAW OFFICE

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Newsletter

INTELLECTUAL PROPERTY

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News

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Honored as the Outstanding IP Law Firm 2023-24 by Asialaw Profiles

According to the Guide to the Asia-Pacific's Leading Regional and Domestic Law Firms revealed by Asialaw Profiles, our firm is recognized as the Outstanding IP law firm 2023-24 in China in the area of intellectual property. Asialaw Profiles provides law firm recommendations and editorial analysis of key practice areas and industry sectors across 23 jurisdictions. The rankings are based on three key criteria, namely, work evidence, client feedback and peer feedback and are divided into 4 categories: Outstanding, Highly recommended, Recommended and Notable. Being ranked as the Outstanding IP Law Firm reveals our firm's competence and professionalism in the area of intellectual property.

Legal 500 Asia Pacific 2024: CCPIT ranked in Tier 1 again

On November 15th, Legal 500 released its annual survey results of Legal 500 Asia Pacific 2024 ranking. CCPIT Patent and Trademark Law Office has been ranked in Tier 1 again in China in the intellectual property area, both in contentious and non-contentious. According to Legal 500, "The team's vast expertise encompasses advisory work, prosecutions, and administrative enforcement and litigation; and the group comprises specialists in patents, trademarks, copyright, domain names, and trade secrets. President of the firm, Chuanhong Long, is an expert in the prosecution, invalidation, enforcement and licensing of patents; Shaohui Yuan's vast patent practice covers applications, prosecutions, reexaminations, invalidations, and infringement litigation; Jianzhong Kang's track record includes handling approximately 1000 patent filings and prosecutions, several of which are patent reexamination cases; and Huiqing Wang's broad experience also includes IP litigation. Within the firm's associate ranks, Yingying Shen and Bo Li are the names to note."

A brief introduction of the latest practice of examination on partial design application in China

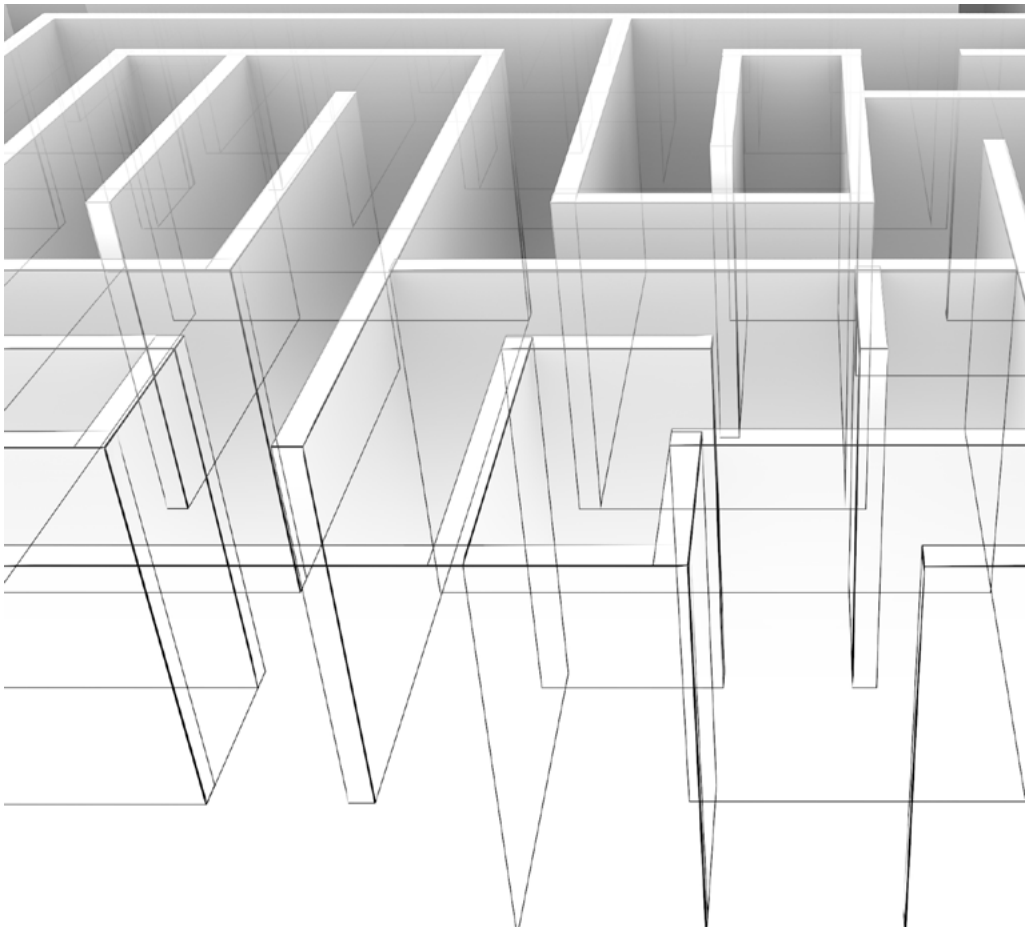
By Qiaobo Zhu

According to the fourth revision of the Patent Law of the People's Republic of China (herein below, called CPL), China began to allow partial design applications from June 1, 2021. Then, the China National Intellectual Property Administration (herein below, called CNIPA) issued the draft revision of the Guidelines for Patent Examination (herein below, called Guidelines) in August 2021, and again in October 2022, the CNIPA issued the re-draft revision of the Guidelines, where the regulations on protected object, product's name, brief description, drawings, judgment on similar designs and etc. for partial designs are subjected to public consultation.

Although the formal revision of the Guidelines has not yet been released, the CNIPA begins to examine partial design applications basically following related regulation of the draft/re-draft revision of the Guidelines from the first half of 2023, and some partial design applications have been patented. According to the latest examination practice, the author summarizes the examining focuses or common objection types unique to partial design applications, as well as application filing or responding strategies as follows:

I. Protected Object

According to the draft/re-draft revision of the Guidelines and the latest examination practice, the claimed portion should form a relatively independent area on the product or constitute a relatively complete design unit. For example, a transition line of a cup, or an arbitrary portion of screen such as shown below in Fig. 1 are not eligible objects for a partial design.



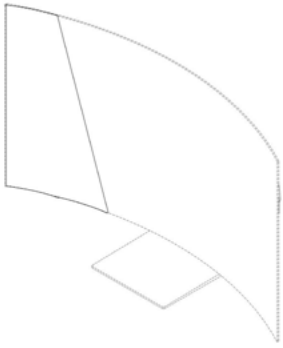
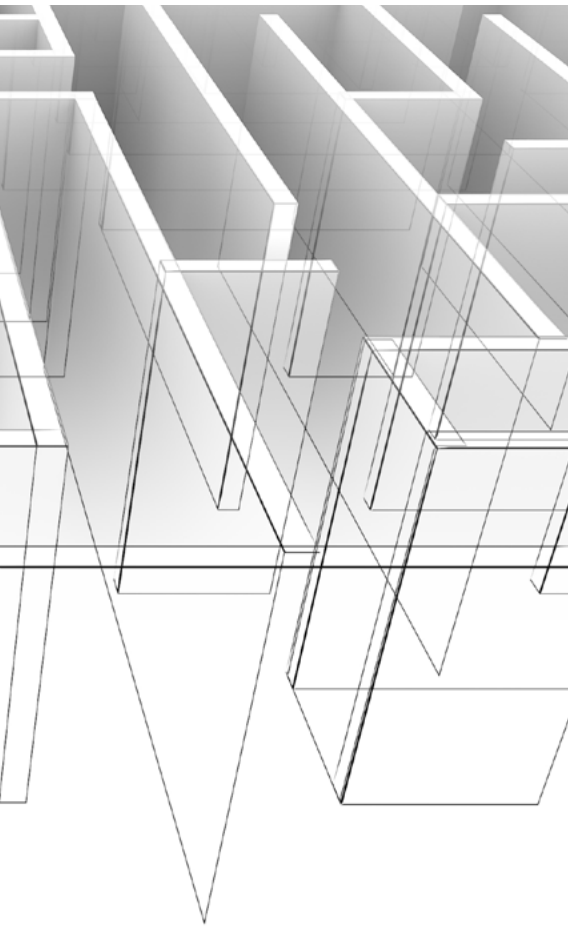


Fig. 1

In this regard, the common objection types are that the claimed portion(s) are arbitrarily divided, or that the claimed portion(s) cannot form an enclosed/complete area on the product. To overcome this kind of objection, some advisable responding strategies are as follows:

i. explaining that the claimed portion(s) are physically or visually separable from the remaining of the product, such as shown below in Fig. 2 (see CN308234853S);

Fig. 2



ii. if there is no structure line on the boundary, changing certain broken or solid line(s) into boundary line(s) which divide the claimed portion(s) from disclaimed portion(s), such as shown below in Fig. 3, or adding boundary lines;

iii. if there is structure line(s) on the boundary, converting certain broken line(s) into solid line(s), such as show below in Fig. 4, and vice versa to make the solid line(s) form an enclosed area;

iv. arguing that the discontinuity of solid line(s) is owing that part(s) of the claimed portions are covered by the disclaimed portion, and such covering is inevitable in use state of the product, such as shown below in Fig.5 (see CN308201028S).

Please be kindly noted that, in this regard, the examiner has a relatively large discretion, and different examiner may have different yards. It is strongly suggested to conduct a telephone interview with the examiner to dig out an acceptable responding solution. In addition, amendments

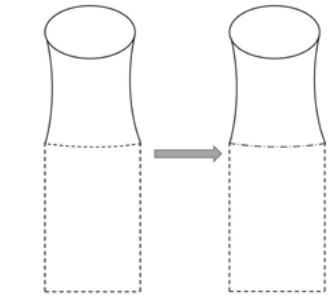


Fig. 3

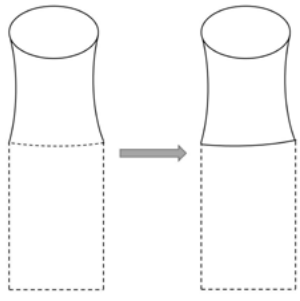


Fig. 4

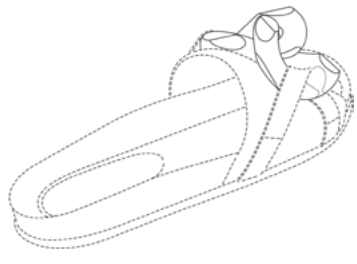


Fig. 5

to the drawings should not bring about new-matter issues.

II. Product's Name

The product's name for a partial design should reflect both the claimed portion(s) and the whole product to which the claimed portion(s) belongs.

In this regard, the common objection types are that the product's name is not suitable since only the whole product is reflected, or not all the claimed portions are reflected. To overcome this kind of objection, the product's name can be amended in the following four ways.

i. if there is a known name for the claimed portion(s), the deign can be named as "name of the product + name of the claimed portion", such as "the earshield of a headset" shown below in Fig. 6 (see CN308156581S);

ii. if there is no known name for the claimed portion(s) but the location of the claimed portions is definite, the partial deign can be named as "name of the whole product + the location of the claimed portion", such as "the front portion of an automobile" shown below in Fig. 7 (see CN308058536S);

iii. if the claimed portion(s) occupy a majority of the whole product, the partial deign can be named as "the name of the whole product + the main body", such as "the main body of an earphone" shown below in Fig. 8 (see CN308270396S);

iv. if there is no known name for the claimed portion(s) but the claimed portion(s) have

Fig. 6

Fig. 7

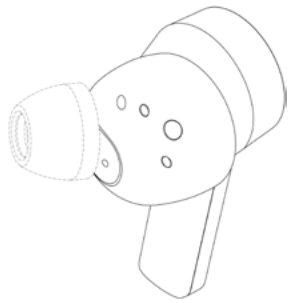


Fig. 8

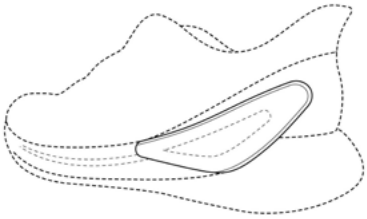


Fig. 9

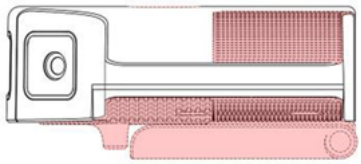


Fig. 10

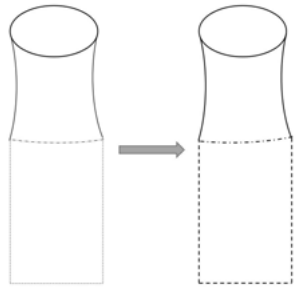


Fig. 11

certain function, the partial deign can be named as “the name of the whole product + XX function-portion”, such as “the decorating portion of a shoe” shown in Fig. 9 (see CN308253351S).

III. Ways to show claimed and disclaimed portions in the drawings

The partial design may use a combination of broken lines and solid lines, or cover portions of the product by translucent color or monochromatic color to indicate the claimed/disclaimed portions.

In this regard, the common objection types are that it is unable to distinguish the claimed portions from disclaimed portion owing to overlapping of broken lines and solid lines, or the structure of the claimed portion(s) is not clearly shown, or the thickness of the broken lines and solid lines is uneven. To overcome this kind of objection, some advisable responding strategies are as follows:

i. in the case of line drawings with broken and solid lines, the disclaimed portions can further be covered with translucent color or monochromatic color, as shown in Fig. 10 (see CN308186685S);

ii. adding reference view(s) in the responding observation to assist in illustrating the structure of the claimed portion(s);

iii. amending the broken lines and solid lines to keep a same thickness as shown in Fig. 11.

Please also be kindly noted that, in this regard, the examiner has a relatively large discretion, and different examiner may have different yards. It is strongly suggested to conduct a telephone interview with the examiner to dig out an acceptable responding solution. In addition, amendments to the drawings should not bring

about new-matter issues.

IV. Brief Description

The brief description of a partial design shall indicate the name of the product, the use of the product (if necessary, the use of the claimed portion(s) shall also be indicated and correspond to the use reflected in the product's name), the characteristic feature of the design, etc.

In this regard, the common objection types are that the product' s name does not reflect the claimed portion(s), the use of the claimed portion(s) is unclear. To overcome this kind of objection, it is suggested to accordingly amend the brief description.

V. Similar Designs

In terms of partial design, two similar designs shall direct to the same portion of a single whole product. The judgment on similarity is based on the claimed portions, and the whole product is used for determining the position and proportion of the claimed portion(s) in the whole product. Under normal circumstances, after an overall observation, if basic partial design and other partial design(s) have the same or similar design features, and the difference(s) therebetween lie in minor local changes, common design in the field, repeated arrangement of design units, conventional changes in the position and/or proportion of the claimed portion in the whole product, or changes in only the color, etc., these designs will generally be considered as similar designs. In addition, the design of whole product and the design(s) of any portion(s) of the whole product generally cannot be filed as similar designs in one application. For example, the following three designs shown in Fig. 12 generally will not be considered as similar designs.

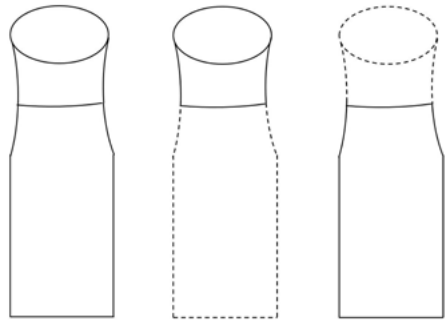


Fig. 12

In this regard, the common objection types are that the design of whole product and the designs of portions of the whole product are not similar designs and cannot be filed in one application, or that multiple designs of different portions of the same whole product are not similar with each other. To overcome this kind of objection, the objected designs should be removed, and divisional application(s) can be filed to claim protection for the removed designs.

VI. Partial Design of Graphical User Interface

For partial design applications of the graphical user interface (herein below, called GUI), the following types are acceptable:

i. a partial design with the whole GUI claimed and with a product (to which the GUI is applied) shown, wherein the applied product can be shown by broken lines or covered with translucent or monochromatic color, and the design can be named as "name of the applied product + XX function-GUI", such as"the pressure unit displaying GUI of a pressure sensor" shown below in Fig. 13 (see CN308178570S);

ii. a partial design with portion(s) of the GUI claimed and with a applied product shown, wherein the applied product and the disclaimed portion(s) of the GUI can be shown by broken lines or covered with translucent or monochromatic color, and the design can be named as "name of the applied product + XX function-GUI + XX function-portion", such as "the uploading and downloading module of the video and music managing GUI of a mobile phone" shown below in Fig. 14;

iii. a partial design with the whole GUI claimed and without a applied product, wherein there may be no broke lines or translucent color or monochromatic color in the drawings, the design can be named as "electronic device + XX function-GUI", such as "calendar GUI of an electronic device" shown in Fig. 15 (see CN308167687S);

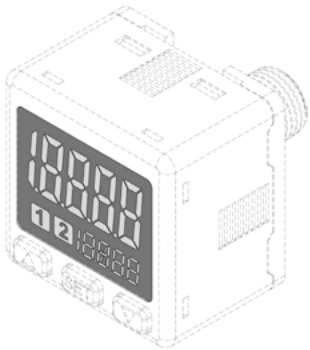


Fig. 13

Fig. 14

Fig. 15

Fig. 16

Fig. 17

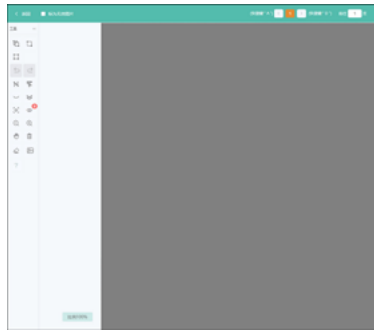


Fig. 18

vi. a partial design with portion(s) of the GUI claimed and without a applied product, wherein the disclaimed portion(s) of the GUI can be shown by broken lines or covered with translucent color or monochromatic color, and the design can be named as "electronic device + XX function-GUI + XX function-portion", such as "the information displaying bar of the information displaying GUI of an electronic device" shown in Fig. 16 (see CN308250665S).

In addition, the content of the picture in the GUI can be shown in the form of blank, or the sign "XX" as shown in Fig. 17 (see CN308167687S), or monochromatic color or translucent color coverage as shown in Fig. 18 (see CN308146479S), and the brief description indicates that related part(s) of the GUI are disclaimed portions.

VII. Divisional Applications

For partial design application, it is impossible to submit divisional application(s) except for unsimilar designs. In particular, if the former application claims protection for the overall product, it is not allowed to claim protection for portion(s) of the product via divisional application(s). For example, if the former application claims protection for an automobile, it is not allowed to claim protection for parts of the automobile via divisional application(s). On

the other hand, if the former application claims protection for portion(s) of a product, it is not allowed to claim protection for the whole product or other portion(s) of the product via divisional applications.

VIII. Timing for Amendments

Within two months since the filing of an application, the applicant may amend the scope of protection, i.e. convert the claimed scope from whole product into portions of the product and vice versa, or convert the broken lines into solid lines and vice versa, or increase or decrease or change the claimed portions and/or disclaimed portions. Except for this period, amendments may be allowed only in response to the office actions or to overcome obvious defects in the application documents.

In summary, although formal revision of Guidelines has not yet been issued, the examination criteria for partial designs are basically clear. The CNIPA starts to examine partial design applications before the formal revision of Guidelines is issued, and listens to the arguments or explanations from the applicants widely. Based on which, the Guidelines can be further revised, which is conducive to formulating the Guidelines more objectively, fairly and realistically, and improving the quality of partial design patents in China.

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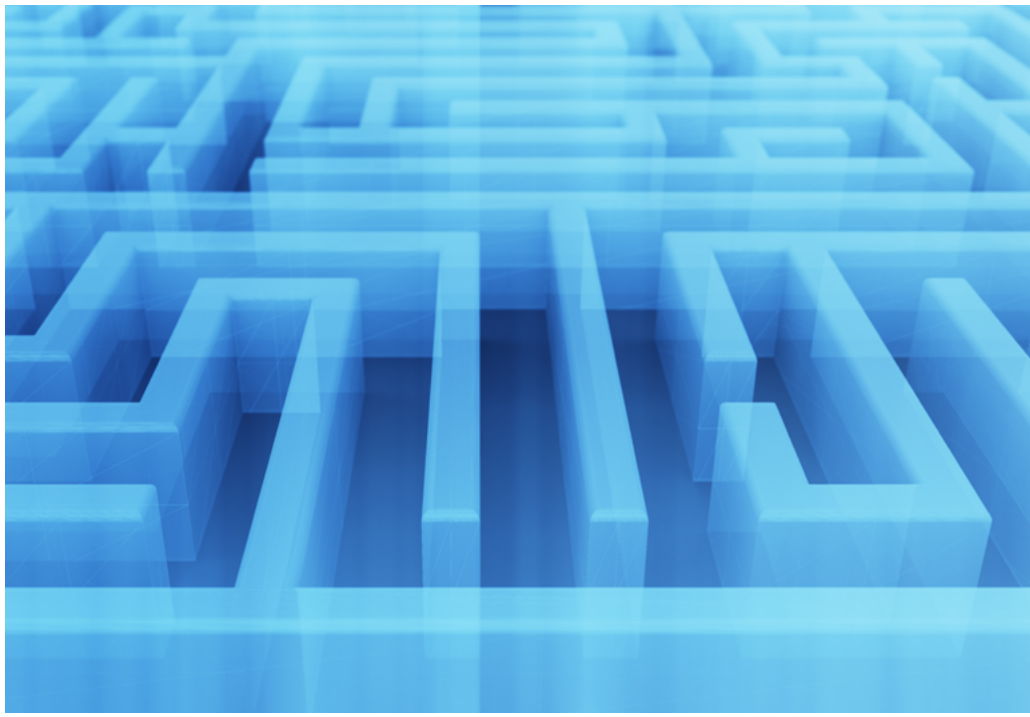
Patenting medical use inventions in China

By Chengda Li

A medical use of a product may relate to i) the use of a new drug to treat a disease ("first medical use"); ii) the use of a known drug to treat a new disease ("second medical use"); or iii) the use of a known drug to treat a known disease using a new administration method ("second medical use relied on new dosage regimen or new administration mode"). Over the past few years, a number of significant cases have affected prosecution strategies of medical use patent applications in China. In this article, we highlight some of the most important issues that should be considered when building a patent prosecution strategy for medical use inventions



before China National Intellectual Property Administration (CNIPA).

1. Proper language for a medical use claim in China

The first issue to be noted is that, claims in the format “use of product X in the treatment of disease Y” and “use of product X as a medicament for the treatment of disease Y” are not allowed as CNIPA consider that such claims relate to a method of treatment and such methods are excluded from patentability in China. Claims in the format "Product X for use in the treatment of disease Y” is not recommended for medical use inventions, because this format of claim is deemed as a product claim instead of a use claim in China and the use recited is considered as having no limiting effect on the product. Proper claims should be in the format of a so-called “Swiss-style claims”: use of product X for the manufacture/preparation of a medicament for the treatment of disease Y.

2. Patenting second medical uses

A second medical use may encompass the use of a known drug to treat a new disease. It may also encompass the treatment of the same disease by a new therapeutic method, for example a new dosage regime or a new administration mode. Claims relating to such new dosing or administration features may take the following form:

“Use of product X for the manufacture/preparation of a medicament for the treatment of disease Y, wherein product X is [new feature].”

For a new dosage regime, the above claim could specify that, for example, the product is administered three times daily or administered at a dose of Z mg/kg, or administered in a specific discontinuous administration

pattern. For a new mode of administration, the above claim could specify that product X is "administered topically" or "administered subcutaneously", for example.

3. Novelty of a second medical use relied on new dosage regimen or new administration mode

The next important question to ask is whether the above claims relating to new dosing or administration features have novelty over prior art medical use claims. In practice, the CNIPA generally holds that a dosage regimen is closely related to doctor's treatment behaviors, only embodied in the process of treating diseases by administration of drugs and has no direct connection with the manufacture of drugs. Accordingly, when the inventive feature in a medical use claim in the Swiss format is only a new dosage regimen or a new administration mode, it usually cannot render the claimed use novel according to the practice before the CNIPA. However, if the dosage/administration feature implies a change in procedure of manufacture of a pharmaceutical, novelty may be established.

For instance, if the technical feature regarding"administration dose" can be embodied in a form of a unit dose, it may be patentable, because unit dose is generally recognized as a technical feature in procedure of manufacture of a pharmaceutical. For example, the technical feature "unit dose is about 0.05-1.0mg" defined in a Swiss-type claim is generally recognized as having limiting effect on the claim.

However, if the novel feature lies merely in dosage regimen which does not change the composition of the medicament, for example, in the circumstance where the only novel feature of a known drug to treat a known disease is administering the drug "once per day prior to sleep", the invention will not be patentable due to lack of novelty.

4. Case study

According to the regulations of the Guidelines for Examination in China, distinguishing features that are merely present in the course of administration do not enable the use to possess novelty. Under some circumstances, the dosing regimen feature can be converted/redrafted into a technical feature that reflects a new structure of the medicament. The new structure of the medicament can be a new dosage form, a new unit dose, a single dosage form comprising a new amount of active ingredient, a new kit comprising several unit doses suitable for dosing regimen, a combination comprising two or several unit doses, etc. Applicant may obtain inspiration from the following cases that we handled.

Case I

Case I involves the technical feature "the pharmaceutical composition is formulated as a single dose form and the single dose form comprises Compound X in the amount of 5 mg to 250 mg". Case I was granted during the substantive examination but challenged during an invalidation procedure on the ground that this feature adds no restriction to the scope of the claim because "5 mg to 250 mg" is a dosage feature that

merely present in the course of administration.

The panel of the Re-examination Board holds that "single dose form" is a structural feature that defines the form of the pharmaceutical composition that is suitable for one-time administration to patients. It distinguishes the product from a multi-dose product comprising multiple unit doses of the same compound for multiple administrations. The feature "single dose form" is not equal to "daily dose". The latter is related to a doctor's treatment behavior while the former implies that the pharmaceutical composition is adapted for administration to the patient in one time and has restriction to the scope of the claim.

It is noteworthy that the term "single dose form" is different from "unit dose" and "administration dose". For example, the Supreme People's Court (SPC) discriminated "unit dose" from "administration dose" in a retrial ruling (Administrative Ruling (2012) ZhiXingZhongZi No.75) directed to the patent invalidation case of Cubist Pharmaceuticals, Inc. The SPC held that unit dose is an amount of drug in a single unit of drug, which depends on the drug added during the preparation of the drug. Administration dose is an amount administered to patients per dose or per day, that is, the amount of use of drug, and can be determined by the users, and belongs to the methods for using drugs. Administration dose does not have a limiting effect on the Swiss type claim unless it can be embodied in the procedure of manufacture of a pharmaceutical.

Case II

Case II involves the technical feature "a vaccine for treating …, which is formulated for being administered subcutaneously in a first dose, orally in a second dose…". The claim was challenged during an invalidation procedure on the ground that this feature belongs to "administration characteristics" and has no limiting effect on the claim.

The panel of the Re-examination Board applies the same examination standard and holds the opinion that features merely relating to use of the medicament that will not change the structure and component of the product do not contribute to the novelty. However, if the administration features do change the composition of the product, these features shall be considered when examining the novelty.

The feature "formulated for being administered subcutaneously in a first dose, orally in a second dose" implies that the vaccine is formulated as a combinational product comprising two different forms of preparations, one for

subcutaneous injection and the other for oral administration. This differs from a vaccine product where only one form of formulation is included, but with one part for subcutaneous injection and the other part for orally administration. Therefore, the feature essentially defines a new form of combinational product and contributes to novelty of the claim.

Conclusion

Under the current China Patent Law and its practice, although it is difficult to claim a medical use of a known substance for a known disease characterized by a dosing regimen/administration feature, it may be possible to get such a claim allowed, if the dosing regimen/administration feature is converted into a technical feature that reflects a new structure of the medicament or different composition of the formulation. The new structure can be a new dosage form/unit dose, a single dosage form comprising a new amount of active ingredient, a new kit comprising several unit doses suitable for dosing regimen, a combination comprising two or several unit doses, etc. These technical features can usually change the manufacturing process of the product, and therefore Chinese examiners are expected to recognize that these features have a limiting effect on medical use claims.

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Brief introduction to Special Approval Procedure on Innovative Medical Device and related IP issues

By Yanqi Jiang

The medical device industry in China has entered a rapid development period. From 2017 to 2022, the market scale of the medical device industry in China has been continuously increased from 440.3 million yuan to 957.3 million yuan. In 2023, the market scale is expected to reach 1056.4 million yuan, and the industry development will take a new step. In spite of the fast development, the middle to low-end market still occupies a larger proportion, and the innovation level of the high-end market is somewhat low. In order to encourage the research and innovation of medical device, promote the popularization and application of new technologies of the medical device and promote the development of the medical device industry, National Medical Products Administration (former China Food and Drug Administration, (CFDA)) formulates and issues a plurality of procedures to promote

the healthy, rapid and high-quality development of the domestic medical device, wherein the Special Approval Procedure on China's Innovative Medical Device issued in February 07, 2014 is an important measure proposed for promoting the innovative development of the medical device.

I. Brief introduction of accelerated approval procedure of medical device

An objective of the Special Approval Procedure on Innovative Medical Device is to accelerate the approval process of highly innovative medical device. Before a detailed introduction thereof, we will draw an overview of the current accelerated approval ways for the registration of a domestic medical device:

1. The Emergency Approval Procedure on medical device

The Emergency Approval Procedure was issued in August 2009. The core purpose of the procedure is to effectively prevent, control and eliminate the harm of public health emergency in time, and to ensure that the medical device required for the public health emergency are approved as soon as possible. It endows CFDA with the right to determine the time for starting and stopping the procedure according to the situations and the changes of the public health emergency. The procedure is suitable for approval of domestic third-class medical device, imported second-class and third-class medical device. It is required that no similar domestic products are on the market or the product supply cannot meet the emergency treatment requirement of public health emergency although the domestic products are on the market. The detection products of a plurality of companies in the novel coronavirus epidemic situation were registered within a few days through this procedure.

2. The Priority Approval Procedure on Medical Device

The Priority Approval Procedure on Medical Device was issued in January 2017 to accelerate the approval of the corresponding medical device meeting the conditions. A priority approval channel is separately arranged for the medical device.

The requirements for the Priority Approval Procedure on Medical Device are as follows:

(I) a medical device matching to one of the following conditions:

a) diagnosing or treating rare diseases and having obvious clinical advantages;

b) diagnosing or treating malignant tumor, and having obvious clinical advantages;

c) diagnosing or treating the unique and multiple diseases of the old, and no effective diagnosis or treatment means exists at present;
d) specially being used for children and having obvious clinical advantages;
e) the clinical application is urgently needed, and no medical device of the same variety has been approved and registered in China;
(II) listed in the Major National Science and Technology Projects or the National Key R&D Program of China;
(III) other medical devices which should be preferentially approved.

To apply the Priority Approval Procedure on Medical Device, the applicant should submit the medical device priority application form together with the registration application. In addition, the registered application items that have been approved according to the Emergency Approval Procedure on Medical Device are not subjected or applicable to the Priority Approval Procedure on Medical Device any more.

3. The Guidelines for Conditional Approval Marketing on Medical Device

The Guidelines for Conditional Approval Marketing on Medical Device was issued in December 2019, and initially constructed a framework for approving medical device for diseases which are seriously life-threatening and have no effective treatment means. For Conditional Marketing Approval, the medical device registrant should complete the requirements of the incidental conditions of marketing approval specified in the remark column of the medical device registration certificate within the specified time limit, and the validity period of the conditional approval medical device registration certificate coincides with the time limit of the incidental conditions specified by the registration certificate. In addition, Conditional Approval Marketing Procedure is not in conflict with other acceleration ways, e.g., the regulations in Guangdong province for the prevention and control of new coronaviruses make it clear that Emergency Approval Procedure can be used in tandem with

Conditional Approval Marketing Procedure.

4. The Special Approval Procedure on Innovative Medical Device

The Special Approval Procedure on Innovative Medical Device was issued in February 2014, the core of this procedure is to encourage research and innovation of medical device, to promote the popularization and application of new medical device technologies, and to promote the development of the medical device industry.

Thus, compared with the other three procedures, the Special Approval Procedure pays more attention to quantitative indexes of innovation, and only the medical device meeting the following requirements is applicable to the program: (I) patent support; (II), finalized product; and (III) product innovation.

Compared with the other three procedures, one great characteristic of the Special Approval Procedure is that the importance of intellectual property in the medical device registration application is firstly emphasized and is put into a very important position of the innovation index. The Special Approval Procedure aims at the medical device with the conditions of the core technical invention patents, international leadership, domestic initiatives, remarkable clinical application value and the like.

II. Introduction of the Special Approval Procedure on Innovative Medical Device

The Special Approval Procedure on Innovative Medical Device is the first approval way specially set for innovative medical device in China. It aims to accelerate the approval speed of the innovative medical device on the premise of ensuring the safety and effectiveness of

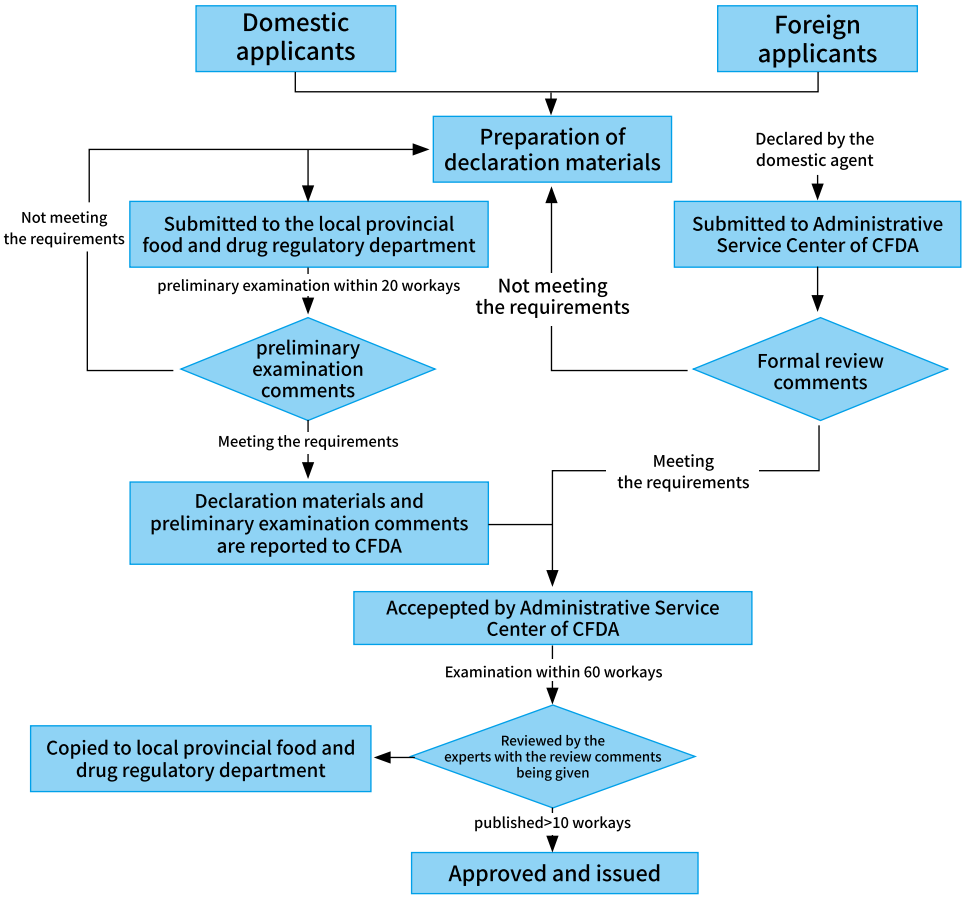
medical device on the market.

The medical device technical evaluation center of CFDA has an innovative medical device approval office. Related experts may be organized to examine the application of the Special Approval Procedure.

The advantages of the Special Approval Procedure for the accelerated approval of medical device are as follows:

1. The medical device detection mechanism should preferentially perform medical device registration detection after receiving the sample and issue a detection report;
2. The medical device technical evaluation center of CFDA shall preferentially perform the technical evaluation for the medical device of which the application of the Special Approval Procedure has been accepted; after the technical evaluation is finished, CFDA should preferentially perform administrative approval after the technical evaluation;
3. The local food and drug administration department of the applicant shall designate a specially-assigned person and provide guidance in time. After receiving the application of checking (examining) the quality management system of the applicant, the quality management system should be handled preferentially.

The basic flow of the application of the Special Approval Procedure is shown as below:



As can be seen from the above flowchart, taking the application of domestic innovative device as an example, the provincial food and drug regulatory department completed the preliminary examination in 20 workdays; Subsequently, the CFDA must issue the review comments within 40 workdays. From the submission of the application to the approval of the CFDA, it only takes up to 60 workdays, and after that, the shortest publicity period of 10 workdays can be entered. Overall, it takes about 15 weeks from application to registration.

Of course, one premise of the great acceleration of approval time is that the procedure has very strict requirements on innovation. The Special Approval Procedure was issued in March 2014, the CFDA further revised the procedure in November 2018 introducing more strict requirements on intellectual property: the application date of the procedure should be no more than 5 years from the date of announcement of grant of the corresponding patent right; the patent shall accompany a search report made by the Search and Consultation Center of China National Intellectual Property Administration (CNIPA), which should state that the core technical solution of the product possesses novelty and inventiveness.

Statistically, the passing rate of such application is only about 23%. The reason of the low passing rate is that the patents themselves or submitted patent data do not meet corresponding regulations. This also could verify the extremely high requirements on patents and innovation in the Special Approval Procedure.

According to the provisions of the Special Approval Procedure, only the medical device conforming to the following conditions is applicable to the procedure:

(I) The applicant has the patent right of the core technology of the product through the leading technical innovation activity in China, or obtains the patent right of the invention or the use right thereof through assignment, and the application date of the procedure should be no more than 5 years from the date of announcement of grant of patent right; or the patent application of the core technology is disclosed by the Patent Administration Department of the State Council, and a search report should be issued by the Search and Consultation Center of China National Intellectual Property

Administration (CNIPA) which should state that core technical solution of the product has novelty, inventiveness and the like.

(II) The applicant has already completed the preliminary research of the product and has basic fixed products, real and controlled research process and complete and traceable research data.

(III) The main working principle or action mechanism of the product is domestic initiative or pioneer, the product performance or safety is fundamentally improved compared with similar products, the technology is at the international leading level, and the product has obvious clinical application value.

The first of these requirements clearly stipulates the importance of intellectual property, and then CFDA issued "Guidelines for Preparation of Application Materials for the Special Approval Procedure on China's Innovative Medical Devices" in August 2018, in which the requirements for intellectual property are further enforced and refined.

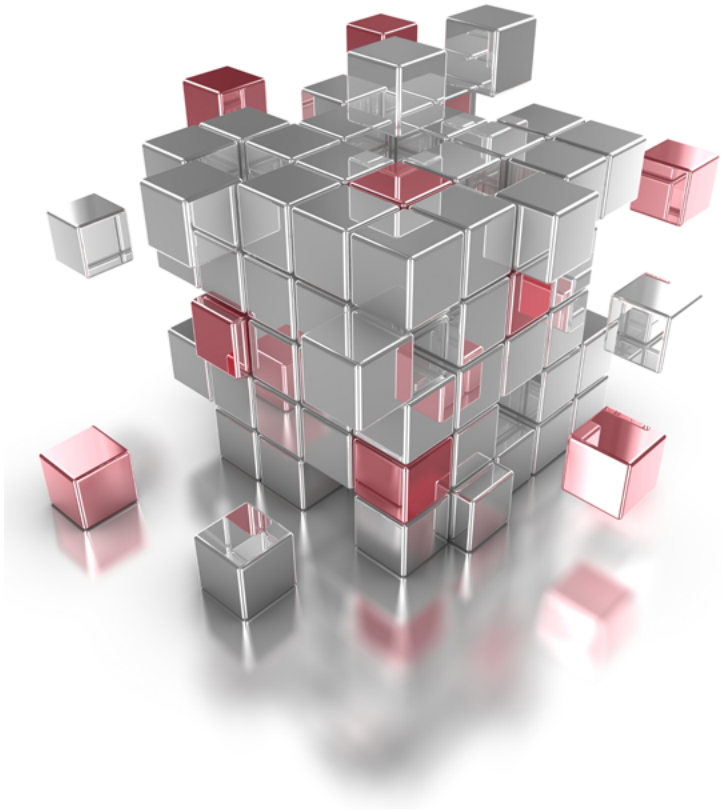
(III) Intellectual property condition and certificate of product

1. The description of the intellectual property of the core technology of the product should be provided. If there are several invention patents, it is recommended to display the title, patentee, patent status and so on of the invention patents in a list.

2. The supporting documents of relevant intellectual property should be provided

(1) Where the applicant has obtained the Chinese patent right for invention, he/she shall provide a copy of the patent authorization certificate signed and sealed by the applicant, the claims, the specifications, and the original copy of the patent register issued by the patent authority. The application date for the Special Approval Procedure of innovative medical devices shall not exceed 5 years from the date of announcement of grant of patent right.

(2) Where the applicant obtains the use right of an invention patent in China through assignment in accordance with the law, in addition to a copy of the patent authorization certificate, the claims, the specifications, and the original copy of the patent register held by the patentee,



the applicant shall also provide the original Record of License Contract for Patent Exploitation issued by the patent authority. The application date for the Special Approval Procedure of innovative medical devices shall not exceed 5 years from the date of announcement of grant of patent right.

(3) Where the invention patent application has been published by the patent administration department under the State Council but has not been granted, a copy of the documents certifying that the invention patent has been published (such as Notification of Publication of the Application for Invention, Notification of Publication and Entering the Substantive Examination Procedure of the Application for Invention, Notification of Entering the Substantive Examination Procedure of the Application for Invention, etc.) signed and sealed by the applicant, and a copy of the published version of the claims and specifications shall be provided. A search report should be issued by the Patent Search and Consulting Center of the State Intellectual Property Office, which indicates that the product's core technical solution is novel and inventive. In the process of examination, where the claims and the specifications are amended at the request of the patent examination department, the amended version shall be submitted; Where the patentee is changed, the supporting documents issued by the patent authority, such as a copy of the Notification of Passing the Examination on Formalities, shall be submitted.

The details of the intellectual property related matters in

the above stipulations will be analyzed and discussed later herein.

III. IP issues in the Special Approval Procedure on Innovative Medical Device

1. Only the invention patent in China is applicable to the Special Approval Procedure.

In the Special Approval Procedure, the aim of the invention patent is not only to prove the innovativeness of the registered products, but also is a legal document for guaranteeing the independent intellectual property of the enterprise's products, and is the basis for protecting the intellectual property of the innovative medical device. The patent protection itself is regional, and the patent protection granted in a country or a region is valid only in the scope of that country or region, and is invalid and not confirmed in other countries or regions. Thus, for example, U.S. patents or PCT patents that do not enter China are not applicable to the Special Approval Procedure because they can not provide legal support and protection for the innovative medical device in China. For Chinese patents, in addition to patents directly filed in China, patents entering China through PCT or Paris Convention are also included.

The Chinese patent includes three types: invention patent, utility model patent and design patent. Only the invention patent in the above three types meets the requirements of Special Approval Procedure. According to Chinese legal practice, the invention patent requires substantial examination, which requires prominent substantial features and notable progress with respect to the prior art, while the utility model patent only performs formal examination, and it only requires substantial features and progress with respect to the prior art, so that its innovativeness is lower than that of the invention patent and is not verified. The design patent is different from the invention patent and the utility model patent both, it only protects the shape, pattern, color or combination thereof of the product, belongs to the protection of the external visual effect of the product, and is not directed to the technical improvement of the product. Thus, the design patent can not be used for proving the novelty of the product.

2. The invention patent is not limited to a granted patent, a patent application can also be used for applying for Special Approval Procedure.

The patent application must be published, and a search report issued by the Search and Consultation Center of China

National Intellectual Property Administration (CNIPA) which states that core technical solution of the product has novelty, inventiveness and the like should be provided.

Regarding the department which issues the search reports, the "Special Approval Procedure on Innovative Medical Device (revision manuscript)" published in November 2018 further strictly limits it to the Search and Consultation Center of China National Intellectual Property Administration (CNIPA) from the original information search institution in China or patent search institution, improves the authority of search reports, requires that the patent application should be high-quality patent application, and further improves the threshold of Special Approval Procedure.

Generally, the application of Special Approval Procedure based on the granted patent is a relatively conventional strategy, and the window period given to the applicant by this strategy is relatively long, no more than 5 years from the date of announcement of grant of patent right, and the applicant has enough time to evaluate the application and to prepare the corresponding file.

However, some companies may have other considerations (such as seizing the market) and need to make an application as soon as possible, while the time between publication and authorization of domestic patents may vary from 2 to 5 years. The patent examination period is too long for the companies that need to seize the market. Thus the companies need to choose to make an application for the Special Approval Procedure based on the published but yet unpatented patents, and at this time application time needs to be carefully considered. In this situation, the company may directly request a search report after the patent is published. The search report normally could be obtained within 1-2 months. The innovative medical device application can be directly filed after the search report with positive opinions is obtained. Generally, after the publication of the patent, the examination will enter into the substantial examination stage, and it will normally take several months (usually more than 2-3 months) from entering into the substantial examination stage to receiving the first Office Action. One reason for rapidly proposing the innovative medical device application immediately after receiving the search report is that according to the Chinese legal practice, the novelty/inventiveness of the invention patent will normally be challenged in the first Office

Action, the possible negative opinions of the first Office Action may still have certain negative impact on the judgment of related experts of Special Approval Procedure. Even if the applicant makes a cogent argument, it will take further several months to reconsider the novelty/ inventiveness.In case of amending the claims, the applicant will also need to submit the amended claims which increased the workload of the applicant. Since the approval cycle of Special Approval Procedure is usually 2 to 3 months, if an application is made immediately after a search report with positive opinions, it may avoid the issuance of the first Office Action, the passing probability may be increased.

3. The patentee(s) need to be fully in line with the applicant(s) for the Special Approval Procedure.

For example, in the case of an initial company or some person becomes the shareholder through the patent transfer, sometimes the patent right is not under the company's name but under the name of a company originator, an enterprise legal person, or a technical developer. In this situation, the assignment of the patent right must be completed first as it is not acceptable to submit only a shareholding certification, an employee in-service certification, or the like. In addition to patents derived from independent development, patents derived from assignments are also in compliance with the provisions of Special Approval Procedure, the assignment includes transfer and license, which in turn includes exclusive license, sole license, simple license, sub-license, and cross-license. Currently the Special Approval Procedure do not limit the assignment way, but generally transfer and exclusive license are preferred.

4. The patent documents provided by the applicant to the corresponding department of food and drug administration should be a complete set of documents.

Specifically, 1. for the granted patent, copies of the patent certification, claims and specification, and an original copy of the patent register are required; 2. for the patents obtained by assignment, in addition to the above-mentioned documents, the original of Record of License Contract for Patent Exploitation is required; 3. for published and un-patented patents, patent publications, claims, descriptions, and search reports are required. Therefore, unlike communications with the patent office, which

sometimes only provides the patent application number, the officials in the corresponding department of food and drug administration which are responsible for the examination may not be familiar with patent searching and the downloading of corresponding documents, a complete set of documents could reduce the workload of the officials

5. The quality of the patent and the association between the patent and the medical device are more important than the number of patents.

The Special Approval Procedure emphasizes the invention patents which could reflect the product's core technology. The most concerning matters are whether the product has the invention patent and whether the invention patent is the core technology of the product. Therefore, for the application of the Special Approval Procedure, there is no need to list all invention patents of the company, only the core invention patents fully related to the product are suggested. Otherwise, too many irrelevant patents may be distracting, and dilute the innovation point of the product. In addition, the quality requirement for the invention patent is very high. It required that the core technology described in the invention patent should be used for the first time in domestic products in China, and the performance of the products is remarkably improved due to the use of the core technology.

Compared with other industries, the medical device industry is characterized by complex technology, long research and development period, great importance to the protection of intellectual property, frequent lawsuits, and the like. The importance of intellectual property protection in the medical device industry is further emphasized by the Special Approval Procedure. The medical device industry in China is undergoing vigorous development at present, and the initiative of actively embracing intellectual property protection is obviously beneficial to companies under the condition that the current national policy increasingly supports intellectual property protection, in terms of not only accelerating approval, but also improving market share, protecting products, avoiding lawsuits and the like.

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The registration and protection of 3D marks in China

By Ling Zhao

Three-dimensional trademarks belong to a category of non-traditional trademarks, and the term non-traditional trademark was first proposed in the Singapore Treaty on the Law of Trademarks (STLT) to refer to trademark types other than traditional textual and graphic trademarks.

Three-dimensional trademarks, especially those composed of the shapes of the products or packages or containers, are usually considered non-distinctive. This is because these shape marks are likely to be taken as the products themselves, rather than as trademarks.

Public identification is key

In a final judgment issued by the Beijing High Court on an appeal to review the refusal of a three-dimensional trademark used on shoes and boots (as shown below) the court ruled against the

applicant.

It rejected the trademark application on the grounds that the trademark, which is composed of yellow stitching around the edge of the shoe upper, is not an essential component of footwear products.

The court also found that the mark's proportion of the footwear product is relatively small, meaning that it is unlikely to catch the attention of the relevant public.

In other words, the yellow stitching around the edge of the shoe upper is not likely to be identified by the relevant public as a trademark. Thus, this trademark was rejected for registration for its lack of distinctive character.

(The applied trademark No. 31447132)

The court emphasised that the edge stitching shown in the trademark application is one of the components of the footwear. Due to the marked position and the characteristics of the designated goods, it is even more difficult to prove obtained distinctiveness when compared to normal three-dimensional marked shapes of packages or containers.

No special impact

The applicant needed to provide evidence proving that the relevant public's understanding of the edge stitching part on the footwear deviated from the inherent concept of product components and stands out as a source identifier.

The promotional reports, sales documents, and other evidence submitted by the applicant in this case contained multiple types of footwear products sold.

But they did not distinguish or highlight the special impact of the applied

trademark on changing relevant public perception habits to associate the edge stitching of the footwear, which are not rarely seen in the industry, to and solely to the applicant.

The evidence in the case is not yet sufficient to prove that the relevant public can identify the applied three-dimensional trademark as a symbol of the origin of the goods designated for use on shoes, short boots, and mid length boots. As a result, the claimed acquired distinctiveness of the applied mark was not supported by the court.

Strong evidence

Undoubtedly, the evidence threshold for proving acquired distinctiveness of 3D marks is rather high. To prove the secondary meaning of a 3D mark, we need evidence to show the use of the mark in the market for at least three or five years prior to the filing date of the application, or by time of the examination, and the strong reputation of the mark. One of the most famous 3D marks with successful registration is the J'adore perfume 3D mark, as shown below:

(IR No. 1221382)

The China National Intellectual Property Administration (CNIPA) followed a final ruling of the Supreme People's Court in favour of the applicant, Parfums Christian Dior by issuing a decision pointing to evidence that supported its registration.

This evidence submitted by the applicant during the second-instance trial proved that since J'adore entered the Chinese market, the applicant carried out extensive publicity and vigorously promoted the applied trademark to form a fixed association with the applicant.

The applied-for trademark obtained distinctive characteristics through use on perfume, which can play a role in distinguishing the source of goods. The court also refers to the principle of consistency, as the applicant has a prior registration for J'adore perfume bottle in China, as shown below. The SPC points out that the issue of consistency in law enforcement standards cannot be ignored on the grounds of individual case review.

(Reg. No. 7505828)

In theory, the criteria of examination on distinctiveness of a 2D mark and a non-traditional trademark, such as a 3D mark composed of the shape of product or package or container thereof, should not be different. The same principle should apply to the examination criteria on the secondary meaning, regardless of the trademark types.

Factors at play

According to the Guidelines on Trademark Examination and Review issued by the CNIPA on January 1 2022, the following factors can be taken into account by the CNIPA and the court to decide if a non-traditional trademark has acquired secondary meaning by long-term use:

i. The public's awareness of the mark;
ii. The actual duration of use, means of use, and use of similar signs in the same industry on designated goods or services;
iii. The sales volume, revenue, and market share of the goods or services using the mark;
iv. The advertisement and coverage of the mark;
v. Other factors showing the distinctive characters of the mark.

According to statistics, the success rate in obtaining registration of a 3D mark in China was about 55% in 2021, and 48.7% in 2020. For those 3D marks that fail to obtain trademark registration, but are widely known to the relevant public, the alternative solution is to seek for protection under the anti-unfair competition law, as package or decoration of the famous product.

And a court decision in favour of the applicant, where the reputation of the mark is confirmed, will also be helpful to prove the acquired distinctiveness of the mark.

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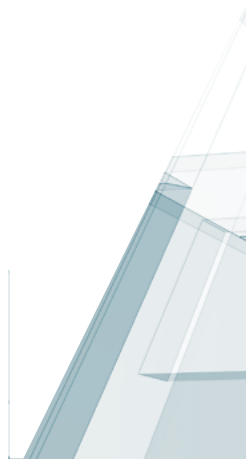
CNIPA issued Guidance for Same-Day Trademark Applications

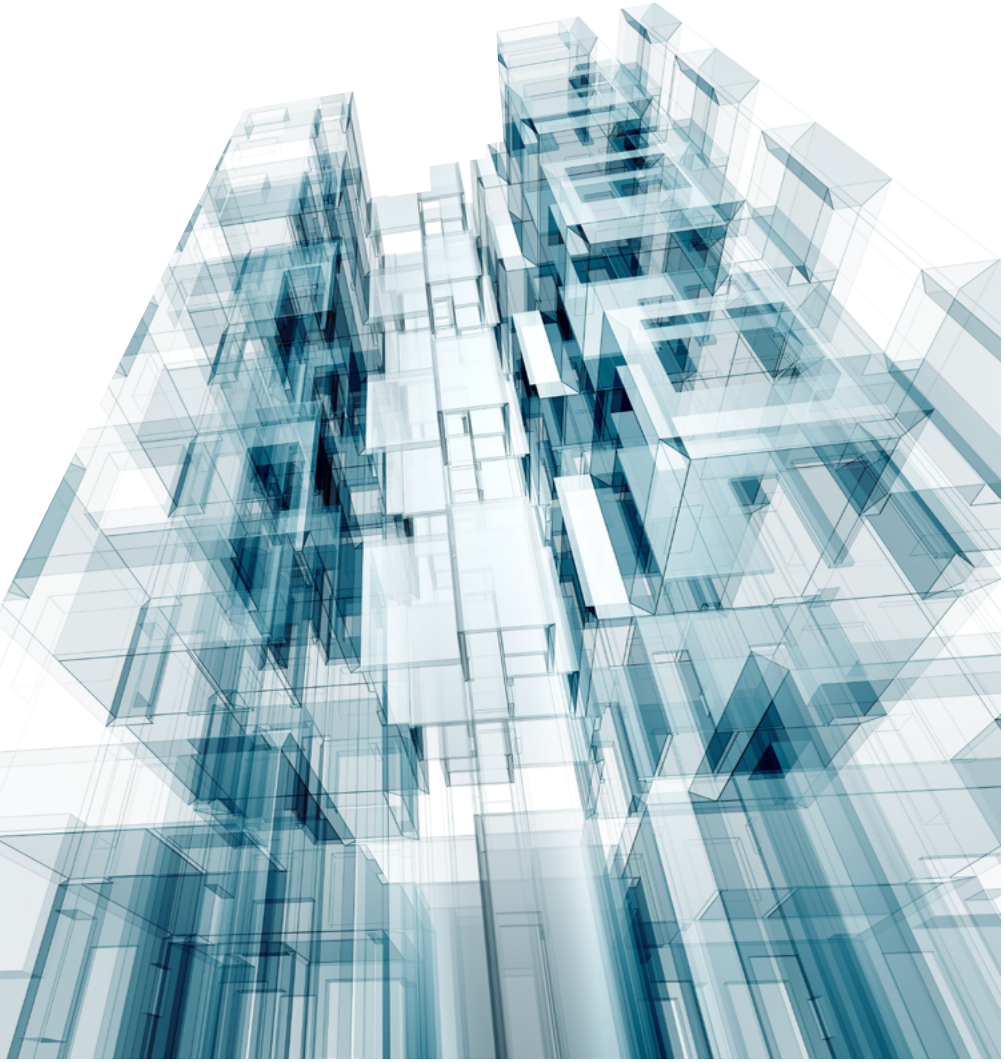
By Shufang Zhang



On September 20, 2023, the CNIPA issued Guidance for Same-Day Trademark Applications (hereafter referred to as the Guidance). The Guidance was made to help trademark applicants in understanding the rules and procedures of same-day trademark applications.

https://sbj.cnipa.gov.cn/sbj/zcwj/202309/t20230927_30990.html

China follows the "first-to-file" principle for trademark registration, supplemented by the "first-to-use" principle. When two or more applicants apply for identical or similar trademarks on the same day for the same or similar goods or services, the prior-used trademark will be preliminarily approved and published. The procedure of Same-Day Trademark Applications examination determines the rights of application for trademark.



The Guidance explains the three stages in the examination of Same-Day Trademark Applications:

· First stage: submission of evidence of use

The primary purpose of this stage is to assess which mark is used earlier. The party that can prove prior use obtains the rights of trademark application. If none of the applicants submits evidence of use or the evidence submitted is insufficient to prove prior use, the trademark enters the next stage of examination.

For same-day trademark applications, the CNIPA issues a "Notice to Submit Evidence of Use for Same-Day Trademark Application" to all applicants, which should submit evidence of prior use within 30 days of receiving the notice. Failure to submit evidence or submitting ineffective evidence is considered as non-use.

If only one applicant submits genuine and effective evidence of use within the deadline, that applicant obtains trademark application rights, and the applications of other non-using applicants for the same or similar goods or services are rejected.
If all applicants provide genuine and effective evidence within the deadline, and the usage dates differ, the applicant with prior use gains trademark application rights, and the application of the later user is rejected.

Same-day applicants who reach an agreement during the evidence

submission stage or voluntarily give up the entire or part of the registration application for certain goods or services, which no longer conflict with the applications of other parties, may not be further notified for negotiation.

· Second stage: negotiation

If no applicant can prove prior use or the prior use cannot be determined, the applicants can reach an agreement through negotiation. The applicant agreed upon in the negotiation obtains trademark application rights. If negotiation fails, the trademark application proceeds to the next phase.

Applicants who have used the mark on the same day or have not used the mark can negotiate the ownership of trademark application rights within 30 days of receiving the "Notice of Negotiation for Same-Day Trademark Application." If a written agreement is not submitted within the specified period or the agreement is invalid, negotiation is considered unsuccessful.

Applicants who reach consensus through negotiation and submit written agreement within the deadline will be granted trademark application rights based on the agreed-upon terms. The applications of other parties for the same or similar goods or services are either rejected or withdrawn.

· Third stage: drawing lots

For applicants who are unwilling to negotiate or fail to reach an agreement, the drawing lots process is used to determine trademark application rights. Applicants must participate in the drawing lots according to the specified method, time, and location mentioned in the "Notice of Drawing Lots for Same-Day Trademark Application." Failure to participate is considered as waiver of the application.

If only one applicant participates in the drawing lots within the stipulated time, that applicant gains trademark application rights, and the applications of other parties for the same or similar goods or services are rejected. If all parties participate in the drawing lots within the stipulated time, the applicant drawn gains trademark application rights, and the applications of other parties are rejected. If no party participates in the drawing lots within the specified time, the applications of all parties for the same or similar goods or services are rejected.

If, before the issuance of the "Notice of Drawing Lots for Same-Day Trademark Application", the reasons for the examination of the same-day trademark applications no longer exist due to transfer of the trademarks to the same entity, withdrawal of the application,

or reduction of goods, the examination process is terminated. After the issuance of the notice, failure to participate in the drawing lots, even if the reasons for the examination of same-day trademark applications no longer exist, is considered as waiver of the application. The examination of same-day trademark applications proceeds based on the drawing lots results.

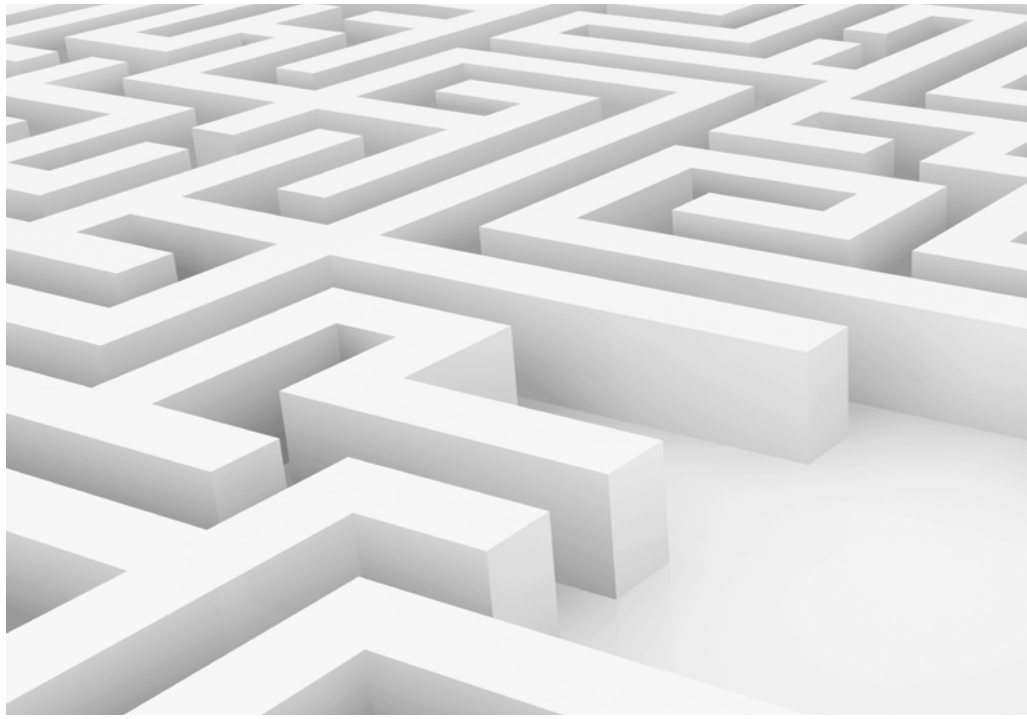
The CNIPA further lists exceptions to the examination on Same-Day Trademark Applications, which include:

· Existence of a stable prior registered trademark:

If a third party, other than the same-day applicants, has already obtained registration for an identical trademark in conflicting goods or service classes, and the rights of that prior registered trademark are not under cancellation, revocation, or invalidation procedures during the examination of same-day trademark application, it directly leads to partial or complete rejection of the same-day applications.

· Violation of Article 19(4) of the Trademark Law:

If a trademark agency applies for trademark covering goods or services outside its service scope, the mark is directly rejected based on Article 19(4) of the Trademark Law.



· Violation of Article 4 of the Trademark Law:

If the same-day registration application is identified as a malicious application not intended for use, it is directly rejected based on Article 4 of the Trademark Law.

· Other situations

The CNIPA lists several exceptions to the examination on Same-Day Trademark Applications

For instances, in the case of "Bing Duan Duan" trademark hijacking, two companies from Shenzhen and Henan engaged in the registration of the "Bing Duan Duan" trademark in Class 3 for products such as facial cleansers, resulting in a same-day trademark registration application. The Beijing Organizing Committee for the 2022 Winter Olympics and Paralympics had previously applied for the registration of the "Bing Duan Duan" trademark for all goods in Class 3. The "Bing Duan Duan" applications of the two companies were directly rejected.

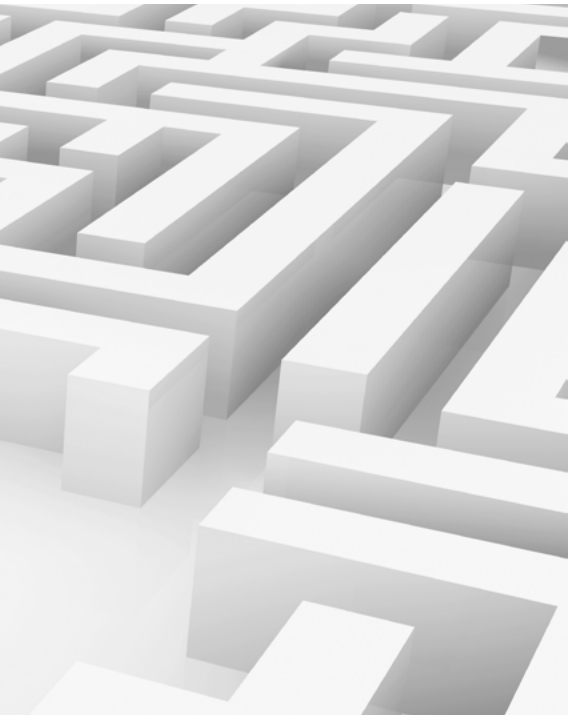
The CNIPA further outlined considerations in the Same-Day Trademark Application Procedure, specifically:

· Principle of good faith

Applicants should follow the principle of good faith in the Same-Day Trademark Application procedures, which requires responding to notifications in accordance with the requirements specified in the notification letter, providing truthful and valid evidence materials, and submitting negotiation documents that meet the genuine intentions of both parties.

· About evidence of trademark use

The evidence of use submitted by the applicant should be genuine and effective. The evidence shall be formed prior to the filing date



of the particular application, showing the goods the application covers, and showing the mark sample applied for. The evidence of use submitted should show the actual user of the trademark is the applicant or its licensee. The evidence of use shall be submitted within the required term.

· About negotiation

The negotiation agreement shall clearly record trademark information like the application number, mark name, designated goods or services, etc. All parties to the same-day application execute the negotiation agreement and indicate the date of execution. The negotiation agreement shall clearly specify which party obtains trademark application right and harm the legitimate rights of others. Trademark negotiation agreement shall be submitted within 30 days since the receipt of the "Notice of Negotiation for Same-Day Trademark Registration."

· About drawing lots

The participants in the drawing shall be representatives or agents entrusted by the trademark applicants. The same representative should not represent both sides (or different parties) of the same group of applicants in the drawing.

The same-day trademark registration procedure involves different stages and is time consuming. The CNIPA encourages the applicants to actively cooperate with the same-day trademark registration examination and try to avoid filing same-day trademark applications with affiliated companies.

The CNIPA has been exerting great efforts in providing guidance on the specific trademark application procedures and facilitating the applicants.

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Application of case guidance system in intellectual property litigations

By Xiao Jin

As a country with written statute laws, China enjoys the inherent advantages of them, such as complete structure and rigorous logic. However, these laws have their own limitations, which are partly reflected in the gap between the universal enforceability of the laws and the diversity of individual cases. In addition, the legislation is a result of social changes that inevitably have a hysteresis quality.

In this regard, the case guidance system can play a role to a certain extent in bridging between the broad extension of legal rules and various specific cases. It can respond in a timely and effective way to all kinds of emerging social conflicts with authority, as only the Supreme People's Court can select and issue any guiding cases.

It is clear that case guidance can play an important role in unifying the application of laws across the country, especially in response

to new social developments accompanying by complicated disputes.

This article takes some specific cases handled by the author as examples of how to use the case guidance system in intellectual property (IP) litigation.

Legal basis

It is believed that the Supreme People's Court initially started to explore the possibility of introducing a precedent case system in 2005. In the following 10 years, the apex court continued this effort and issued several regulations on guiding cases.

Nowadays, the cases cited by interested parties can be taken into account by all levels of courts across the country. Some of these cases must be considered if they are guiding cases issued by the Supreme People's Court. Four categories of precedent cases can be used as guiding cases in the trial, including:

(1) The guiding cases issued by the Supreme People' s Court;
(2) The typical cases published by the Supreme People's Court and the effective judgments made by the Supreme People's Court;
(3) The reference cases issued by the higher courts within the jurisdiction and the effective judgments made by the higher courts; and
(4) The effective judgments made by the relevant court or the appellate court.

The guiding cases issued by the Supreme People's Court have the highest priority and must be taken into consideration by the court. The court must explain the reason why it concurs with the guiding case or not in its sentence if a category 1 case is cited by the interested party in the trial. For other categories of guiding cases, the court may or may not refer to the guiding case without any limitation to explanation of doing so.

Ip litigation

Although a relatively complete IP system has been established in China, large-scale IP litigation has only appeared in the past decade. Compared with traditional civilian and commercial disputes, IP litigation is still a new type of lawsuit. Therefore, it is common to see new types of disputes as well as controversial issues in IP litigation, which in turn tends to cause differences in the application of laws.

Moreover, IP litigation includes a considerable number of technical cases as technology constantly advances. The challenges brought about by these new technologies to social and legal systems are becoming more and more obvious.

The advantage of the case

guidance system lies in bridging the broad scope of the legal rules and the ever-changing details in individual cases by using prior cases. Guiding cases help to achieve uniformity in the application of laws across the country.

In IP cases, distilling the apparent and onerous facts into legal points and making factual and legal preparation for each of the points are always necessary processes.

However, is it necessary to carry out the search for precedents for all the factual and legal aspects? This article holds that the answer is clearly no.

China is a country with statute laws. Therefore, in the case that the exact and suitable rules can be located in the existing laws and regulations, there is no need to search for precedents, and the case can proceed based on the relevant laws and regulations.

The precedent is better used in complicated and controversial aspects of a case.

Although the need to search for precedents has been identified, the search is still an issue worthy of careful study. Real-world disputes are complex, and reflecting them in words can be complex and even open to interpretation. One or two keywords may not give the best result.

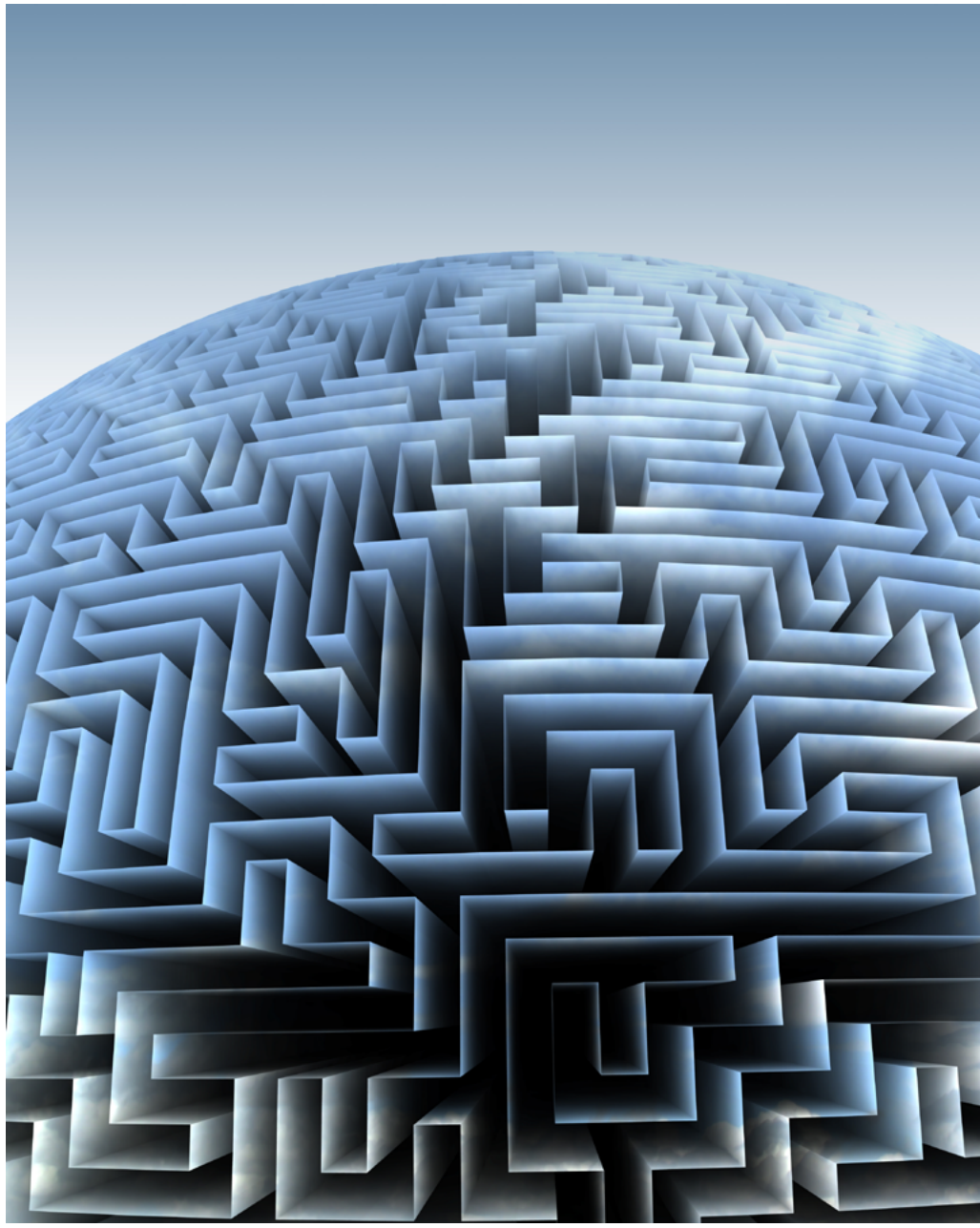
This puts higher demands on the comprehension of the litigation team, especially in a country with such a huge number of laws and regulations, and where many attorneys are not accustomed to case searching.

The core of a search lies in accurately grasping the relevant legal points under the ever-changing apparent facts. Taking a case handled by the author as an example, the aim of the search was the doctrine of equivalence when applying to numerical features of a claim.

The precedent the author's team finally locked onto was a Supreme People's Court case in which the guiding point summarised

officially by the court was how to solve a partial overlap between the protection scope of an independent claim and its dependent claims in the trial – nothing to do with the doctrine of equivalence.

In this case, the equivalence of the numerical ranges in the independent claim had been addressed and explained, so this case was cited by the team as a relevant precedent. It can be seen from the above-mentioned case that precedent searching makes higher demands of an attorney's comprehension of the essence of the facts. And of course, being familiar with the guiding cases issued by the Supreme People's



Court is also important.

Use of precedent

After the appropriate precedent case has been retrieved, it needs to be used correctly. Some studies have shown that in actual IP litigation, there are many irregularities in submitting precedents, such as submitting cases from unknown sources, cases with ineffective judgments, irrelevant cases, etc.

In this regard, this article holds that the attorney should first indicate the source and effectiveness of a precedent before going into any details.

A variety of techniques can be used in the detailed analysis. For example, a Chinese attorney may refer to the common law system and use precedent by comparing the facts, pointing out the applicable laws, and asserting the outcome step by step.

The attorney may also go straight to the core of the case and match it with the key points of the decision in precedent cases to have the current case approach a preferable result.

In addition, an analogical argument can be used. In another case handled by the author, the

key fact was that a selected range of numerical parameters can produce unexpected technical effects in a patent application. In contrast, a reference document disclosed a different numerical range without showing any unexpected effect.

However, the patent application was rejected as lacking inventive steps with respect to the reference because the examiner held that the numeric range was conventional and could be changed without paying any inventive effort when one skilled person had noticed a similar range in prior examples.

A precedent retrieved by the author's team showed that even if a selected parameter range of a patent application falls within the range disclosed by a prior reference, the patent application is still patentable if the selected numerical range can result in unexpected technical effects.

Based on the above-mentioned precedent, the team asserted that if the patent application in the precedent is patentable when its parameter range is included in the parameter range of the prior art reference, but can result in unexpected technical effects, the patent application is naturally patentable.

This is because the parameter range that leads to these effects was not previously disclosed, yet it still can produce unexpected results. It was argumentum a maiore ad minus (from the larger-scale argument to the smaller one). The facts and the outcome become very clear, thanks to the precedent case the team found. The adverse verdict on the patent application was then reversed.

Conclusion

The case guidance system has been proven to play an important role in refining general rules, unifying judgment standards, forming judicial accumulation, promoting dispute settlement, and limiting improper judgments. The system is also of great significance for parties or agents to better safeguard their rights and interests in practice.

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