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中國專利局
收緊實用新型專利審查

Chinese Patent Office
Tightens Examination on Utility Model Patents

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1 BRIEF INTRODUCTION OF UTILITY MODEL PATENTS IN CHINA

The utility model patent system is an important component of the Chinese patent system. The purpose of utility model patents is to protect the so-called "minor inventions", or "small innovations", as compared to those inventions protected by invention patents. The utility model patent system of China is generally similar to those of most countries in the world. Subject matters protected by utility models patents in China are limited to new technical solutions relating to the shape or structure of a product, apparatus or device, in order to facilitate determination of the protection scopes, judgment of infringement, and execution of the patent rights. Utility model patent applications in China are subject to preliminary examination, which is more stringent than the formality examination adopted by most countries in that obvious substantive defects are also examined. The requirement for novelty of utility model patents in China is the same as the requirement for novelty of invention patents, which is higher than the requirement in many of the countries issuing utility model patents. Similar to most countries, the requirement of inventive step for utility models is lower than that for invention patents. Utility model patents in China have a shorter protection duration (ten years) than that of invention patents (twenty years), which is also similar to most of the countries issuing utility model patents.

2 MEASURES TAKEN BY THE CHINESE PATENT OFFICE TO TIGHTEN THE EXAMINATION ON UTILITY MODEL PATENT APPLICATIONS

Before 2012, the grant rate for utility model patent application in China was close to 100%. Since 2012, as an effort to improve the quality of utility model patents, the Chinese Patent Office (CPO) has taken a series of measures to tighten the examination on utility model patent applications.

(1) According to a report published on the website of CPO[1], the utility model examination division of CPO amended its internal examination regulations in early 2012, and broadened the scope of examination on obvious novelty defects, such that the examiner was allowed to examine the novelty of a utility model application as long as a reference document is available, whereas the examiner used to be restricted from examining the novelty of a utility model application based on information obtained through search.

(2) On 16 September 2013, CPO amended the Patent Examination Guidelines[2].

Before this amendment, Section 11 of Chapter 2 of Part I of the Guidelines reads:

"11. Examination in Accordance with Article 22.2

In the preliminary examination, the examiner generally **does not determine on search** whether a utility model is obviously lack of novelty, but may determine on the information of related prior art or conflicting applications obtained **not through search**."

After the amendment, this section reads:

"11. Examination in Accordance with Article 22.2

In the preliminary examination, the examiner **shall determine** whether a utility model is obviously lack of novelty. The examiner may determine on the information obtained of related prior art or conflicting applications."

Similar amendments are also made to Section 13 of Chapter 2 of Part I of the Guidelines. Before the amendment, this section reads:

"13. Examination in Accordance with Article 9

In accordance with Article 9.1, for any identical invention-creation, only one patent right shall be granted. In accordance with Article 9.2, where two or more applicants file applications for patent for the identical invention-creation, the patent right shall be granted to the applicant whose application was filed first.

In the preliminary examination, whether or not a patent application for utility model may obtain a patent right according to Article 9 **shall not be examined through search in general**. However, if the examiner knows that there is an applicant who has filed a patent application for the identical invention-creation, he shall conduct the examination."

After the amendment, this section reads:

"13. Examination in Accordance with Article 9

In accordance with Article 9.1, for any identical invention-creation, only one patent right shall be granted. In accordance with Article 9.2, where two or more applicants file applications for patent for the identical invention-creation, the patent right shall be granted to the applicant whose application was filed first.

In the preliminary examination, whether or not a patent application for utility model may obtain a patent right according to Article 9 **shall be examined**. The examiner may determine on the patents or patent applications obtained of the identical invention-creation."

As can be seen, these amendments removed the restriction that the information used to determine whether a utility model is obviously lack of novelty, or whether a utility model is an identical invention-creation to another application, should not be obtained through search. In other words, the examiner is now allowed, and even encouraged, to determine whether a utility model is obviously lack of novelty, or whether a utility model is an identical invention-creation to another application, using information obtained through search. As the examiner can obtain much more information through search, these amendments to the Examination Guidelines render utility model patent applications much more likely to be rejected for the reason of being obviously lack of novelty, or being an identical invention-creation to another application.

(3) According to a notice of the utility model examination division of CPO[3] issued on 30 July 2013, the examiners are encouraged to reject a utility model application for the reason of not being a "new" technical solution as prescribed in Article 2.3 of the Chinese Patent Law, without citing reference documents, if the technical solution of the application is merely a simple combination of prior art and does not produce

new technical effects, or if it is merely change of relations between elements and produces the same or similar technical effects as prior art. Although inventiveness of a utility model is not examined in the preliminary examination, such rejections for not being a new technical solution as prescribed in Article 2.3 of the Chinese Patent Law are somewhat similar to rejections for not having inventiveness.

The above measures taken by CPO have resulted in increased difficulty to obtain a utility model patent, and have significantly lowered the grant rate of utility model patent applications. In fact, according to the above mentioned notice of the utility model examination division of CPO[3], it is their objective to reduce the grant rate of utility model patent applications to lower than 90% by the end of the year of 2013.

3 STRATEGIES IN RESPONSE TO THE TIGHTENING

In view of the above mentioned circumstances, it is important for inventors and applicants to understand that it can no longer be guaranteed that their product will be granted a utility model patent as long as the application has no formality defects. In addition, in order to improve the chances of a utility model application being granted a patent right, it may be advisable to handle utility model applications in a manner more similar to invention applications. In particular, when drafting the specification of a utility model application, it may be beneficial to provide more explanations on the positive technical effects of the utility model. Such explanations on the positive technical effects might be useful in arguing with the examiner on objections that the utility model is merely a simple combination of prior art or change of relations between elements. The positive technical effects can help in persuading the examiner that the utility model is indeed a "new" invention-creation. Furthermore, it is also preferable to provide more detailed embodiments in the specification, including more detailed drawings. The advantage of doing this is that if the examiner rejects all the claims for lacking novelty, additional technical features can be added into the claims without going beyond the scope of initial disclosure. Finally, it is also beneficial to draft multiple groups of claims with different subject matters, for example, components, mechanisms, devices, machines, systems, and so on, which will cover a larger protection scope, and provid multiple "lines of defense" in potential future disputes.

To sum up, due to the measures taken by the CPO, the grant rate of utility model patent applications in China has been significantly lowered. Therefore, in order to ensure your utility model application to be granted a patent right, it is advisable that inventors and/or applicants work closely with patent agents to prepare and file a specification of higher quality, which will also improve the stability of the patent right, if granted.

References:

[1] http://www.sipo.gov.cn/wqyz/dsj/201301/t20130130_784704.html
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中國專利局收緊實用新型專利審查

1 中國實用新型專利簡介

實用新型專利制度是中國專利制度的重要組成部分。與發明專利相比，實用新型專利更著重於保護小發明、小創造。中國的實用新型專利制度總體上與世界上大多數國家的實用新型專利制度相似。中國實用新型專利的保護客體限於產品、裝置或設備的形狀、構造方面的發明創造，以便於保護範圍的確認、侵權的判斷及權利的行使。中國對實用新型專利申請採取初步審查制，除了形式缺陷審查之外，還進行明顯實質性缺陷審查，較大多數國家採取的形式審查制更為嚴格。中國實用新型專利在新穎性判定中的現有技術標準與發明專利相同，該標準與大多數國家相比較高；而對實用新型專利創造性的要求則比對發明專利創造性的要求較低，與大多數國家一致。與發明專利的保護年限（二十年）相比，中國實用新型專利的保護年限（十年）較短，這一點與大多數具有實用新型專利制度的國家也是一致的。

2 中國專利局為收緊對實用新型專利申請的審查而採取的措施

在2012年之前，中國實用新型申請的授權率接近100%。從2012年開始，為了提高實用新型專利的質量，中國專利局採取了一系列措施以收緊對實用新型專利申請的審查。

（1）根據中國專利局網站上公佈的一份報告[1]，2012年初，中國專利局實用新型審查部修改了其內部審查操作規程，擴大了明顯新穎性缺陷審查的範圍，只要存在新穎性對比文件，審查員就可以進行新穎性審查。而在此次修改之前，是不允許審查員基於通過檢索獲得的信息對實用新型申請的新穎性進行審查的。

（2）2013年9月16日，中國專利局修改了《專利審查指南》（以下簡稱“指南”）[2]。在此次修改之前，指南的第一部分第二章第11節的規定如下：

“11. 根據專利法第二十二條第二款的審查

初步審查中，審查員一般不通過檢索來判斷實用新型是否明顯不具備新穎性。審查員可以根據未經其檢索獲得的有關現有技術或抵觸申請的信息判斷實用新型是否明顯不具備新穎性。”

而修改後，該節的規定如下：

“11. 根據專利法第二十二條第二款的審查
初步審查中，審查員對於實用新型專利申請是否明顯不具備新穎性進行審查。審查員可以根據其獲得的有關現有技術或者抵觸申請的信息，審查實用新型專利申請是否明顯不具備新穎性。”

對指南第一部分第二章第13節也進行了類似的修改。修改前，該節的規定如下：

“13. 根據專利法第九條的審查
專利法第九條第一款規定，同樣的發明創造只能授予一項專利權。專利法第九條第二款規定，兩個以上的申請人分別就同樣的發明創造申請專利的，專利權授予最先申請的人。
初步審查中，對於實用新型專利申請依照專利法第九條的規定是否能取得專利權，一般不通過檢索進行審查。但審查員已經得知有申請人就同樣的發明創造申請了專利的，應當進行審查。”

而修改後，該節的規定如下：

“13. 根據專利法第九條的審查
專利法第九條第一款規定，同樣的發明創造只能授予一項專利權。專利法第九條第二款規定，兩個以上的申請人分別就同樣的發明創造申請專利的，專利權授予最先申請的人。
初步審查中，審查員對於實用新型專利申請是否符合專利法第九條的規定進行審查。審查員可以根據其獲得的同樣的發明創造的專利申請或專利，審查實用新型專利申請是否符合專利法第九條的規定。”

可見，在此次修改之前，審查員不應當使用通過檢索獲得的信息來判斷一個實用新型是否明顯不具備新穎性，或者一個實用新型是否與另一個申請是同樣的發明創造。而此次修改則取消了這一限制。換言之，修改後的指南允許甚至鼓勵審查員使用通過檢索獲得的信息來判斷一個實用新型是否明顯不具備新穎性，或者一個實用新型是否與另一個申請是同樣的發明創造。由於審查員通過檢索可以獲得更多的信息，此次修改使得實用新型專利申請更容易以明顯缺乏新穎性或與另一個申請是同樣的發明創造為由而被駁回。

（3）根據中國專利局實用新型審查部2013年7月30日的一份文件[3]，如果一個實用新型專利申請的技術方案是已知技術的簡單組合並且沒有產生新的技術效果，或僅僅是要素關係變更並且所產生的技術效果與現有技術相同或相似，審查員可以不用對比文件，直接以“明顯不是新的技術方案”為由，認定為不符合專利法第2條第3款的規定。雖然在初步審查中對實用新型的創造性不作審查，但此種認定一個實用新型不是專利法第2條第3款規

定的新的技術方案的審查意見在某種程度上與質疑創造性的審查意見是相似的。

中國專利局採取的以上措施提高了獲得實用新型專利的難度，使得實用新型專利申請的授權率顯著下降。根據中國專利局實用新型審查部的上述文件[3]，該部的目標是在2013年底前使實用新型專利申請的授權率降低到90%以下。

3 審查收緊後的應對策略

鑑於以上所述的情況，發明人和申請人必須意識到，即使他們的實用新型專利申請沒有任何形式缺陷，也不再能保證一定可以獲得授權。此外，為了提高實用新型專利申請獲得授權的機率，以更接近於發明專利申請的方式來處理實用新型專利申請可能是一種有效的方法。具體來說，在撰寫實用新型專利申請的說明書時，可提供更多的關於該實用新型所帶來的積極技術效果的說明。假如在審查過程中審查員提出了認為該實用新型僅僅是現有技術的簡單組合或要素關係的變更之類的審查意見，這種關於積極技術效果的說明便有可能在爭辯中發揮作用，因為有益的技術效果有助於使審查員相信該實用新型確實是一個新的發明創造。此外，可以在說明書中提供更多的具體實施例，包括更多的附圖。這樣做的好處是，假如審查員以缺乏新穎性為由駁回了所有的權利要求，申請人還可以將說明書中記載的其他技術特徵加入到權利要求中去而不會有修改超範圍的問題。最後，還可以使權利要求書包括多個主題，例如：零部件、機構、機器、系統等。這樣做的好處是使得保護範圍更為全面，以在將來可能出現的爭議中提供多道“防線”。

總結而言，由於中國專利局採取的一系列措施，中國實用新型專利申請的授權率已顯著降低。因此，我們認為，發明人和/或申請人及其專利代理人應當相應地提高申請文件的質量，以確保實用新型專利申請成功獲得授權，同時提高獲得的專利權的穩定性。

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[1] http://www.sipo.gov.cn/wqyz/dsj/201301/t20130130_784704.html
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