

Strap: Jurisdiction report: China

Headline: Rebutting objections to inventiveness

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Since early 2015, patent examiners at the State Intellectual Property Office of China have been increasingly focusing on patentability issues, especially inventiveness. For instance, with respect to apparently broad claims, examiners used to raise objections that the claims were not supported by the description under article 26.4 of the Patent Law. Nowadays, in similar scenarios, examiners raise inventiveness objections under article 22.3 on the grounds that not all the technical solutions encompassed in the claims are inventive over the prior art.

Also, in raising objections to inventiveness, examiners usually emphasise obviousness of the claims. This trend poses new challenges to patent attorneys and applicants. To address inventiveness objections, practitioners may consider using the following strategies.

Formulating arguments highlighting non-obviousness

In rebutting inventiveness objections, it is important that the arguments highlight the non-obviousness of the claims, in addition to the superior technical effects disclosed in the description.

For instance, applicants may prove that the two or more references cited by the examiner are mutually exclusive in terms of working principles, and accordingly cannot remedy each other or be combined—a fact proving that the references would not prompt those skilled in the art to arrive at the claimed invention.

Submitting prior art evidence or further experimental data

To support the claims, applicants may consider submitting prior art evidence, provided that the evidence would not be detrimental to the claims. For instance, if examiners raise inventiveness objections on the grounds that not all the technical solutions encompassed in the claims are inventive over the prior art, applicants may submit prior art showing that all the claimed embodiments are supported by the same theory and are expected to produce the intended technical effect, thus proving that all the claims cover embodiments that are inventive over the cited prior art.

In addition, applicants may consider submitting further experimental data to support the claims in terms of inventiveness. It must be noted that examiners usually do not consider further experimental data intended to support the claims in terms of protection scope, and the data to be submitted is preferably collected by repeating the experiments disclosed in the applicant's description with the technical solution of the prior art.

For instance, in an application directed to a medicament, if the description recites an experiment where a medicament is used to treat a patient and produces an unexpected

effect, such data are preferably collected by repeating the experiment with a medicament specifically disclosed in the cited prior art and is considered the closest to the claims.

It is expected that the medicament specifically disclosed in the cited prior art produces an effect inferior to that produced by the inventive medicament, thus proving the inventiveness of the claimed invention in an indirect and roundabout way.

Amending the claims

If the above two strategies do not work for lack of prior art or further experimental data (as mentioned, examiners usually do not consider further experimental data intended to support the claims in terms of protection scope)—or because the line of argument based on the submitted prior art will negatively affect the claims in terms of patentability—applicants may consider narrowing the scope of the claims.

This strategy applies especially to applications where examiners object that not all the technical solutions encompassed in the claims are inventive over the prior art—in essence, such an objection amounts to the former objection that the claims were not supported by the description under article 26.4 of the Patent Law. By doing so, the claims are amended to include a technical solution which is inventive over the cited prior art.

Understandably, in view of the specific circumstances surrounding the claims, the above strategies may be used in combination.

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