



## Featured Article

# Changes in the Patent Invalidation Procedures after the Amendments to the Implementing Rules of the Patent Law and the Patent Examination Guidelines

Changes in the Patent Invalidation Procedures after the Amendments to the Implementing Rules of the Patent Law and the Patent Examination Guidelines.

### I. Violation of "the principle of good faith" as a ground for invalidation

In accordance with the relevant provisions of the new article 11 of the amended Rules and paragraph 2 of the amended article 69:

*"Article 11 Patent applications shall be made in accordance with the principle of good faith. The filing of all kinds of patent applications shall be based on real*

*invention and creation activities, and shall not be falsified."*

*"Article 69, paragraph 2 The grounds for the invalidation request referred to in the preceding paragraph refer to ..... or the provisions of Article 11, Article 23, paragraph 2, and Article 49, paragraph 1 of these Rules, or belonging to the circumstances stipulated in Article 5 and Article 25 of the Patent Law, or in accordance with the provisions of Article 9 of the Patent Law cannot be obtained a*

*patent right."*

Meanwhile, Section 4.1 "Scope of Examination of Invalidation Requests" in Chapter 3 of Part IV of the amended Guidelines is added: "*The panel may examine ex officio in the following cases: (1) If the acquisition of the patent right is obviously in violation of the principle of good faith, the panel may introduce the reasons for invalidation in accordance with Article 11 of the Implementing Rules of the Patent Law for examination.*"

From the above, it can be seen that the "principle of good faith" has been incorporated into the entire patent life cycle, from the patent application proceeding to the post-grant invalidation proceedings, and also provides a new ground for invalidation for the invalidation petitioner (hereinafter referred to as the "Petitioner").

In the following, the author will analyze whether a patent (patent application) "violates the principle of good faith" from the perspective of invalidation proceedings, specifically:

First of all, as the petitioner, according to the newly added Article 11 of the Rules on the "principle of good faith", the petitioner can provide evidence that the applicant of the patent involved in the case has violated the "principle of good faith" in the application process. Since this provision is a principle-based provision, the burden of proof on the petitioner is very strict,

requiring the petitioner to make comprehensive, full and uncontested disclosure of evidence, in order to achieve the purpose of proof, to persuade the panel to accept. In addition, from a practical point of view, the invalid reason "violation of the principle of good faith" can generally be considered as an "auxiliary role" to influence the panel's judgment.

Secondly, the amended Guidelines incorporate "violation of the principle of good faith" into the circumstances of "ex officio examination" by the panel, but it is worth noting that the expression here is "the acquisition of patent rights is obviously in violation of the principle of good faith .....". That is to say, if the patent involved in the case has obvious integrity problems, such as similarity of experimental data, fabrication and other issues, the panel is obliged to take the initiative to examine. However, considering that the overall direction of the panel's work is to conduct examination based on the grounds of invalidation, only "obvious" violation of the principle of good faith may trigger the panel's initiative "ex officio examination". Therefore, when filing a request for invalidation of the target patent, if the petitioner has evidence of "violation of the principle of good faith", he should take the initiative to fully provide evidence and reasoning, and incorporate "violation of the principle of good faith" into the grounds for invalidation.

Regarding whether a patent application "violates the principle of good faith", the

examiner has already examined this issue in the examination procedure in the previous examination practice, especially when there are problems such as similarity of experimental data or fabrication in the patent application, the examiner will question this issue in the office actions, but *based on* other laws and regulations. After the amendment of the Rules, such examination opinions will be supported by this new legal provision.

With the entry into force of the amended Rules, it is expected that there will be cases of invalidation on the ground that the patent involved in cases "violates the principle of good faith" in invalidation procedure.

## II. Amendments and application of "Novelty" Provisions

Throughout the many published invalidation decisions of invalidation procedure, the key points of the decisions are made mostly based on novelty and creativity as the main legal basis. This time, the Guidelines in Part II, Chapter 3, "Novelty" chapter mainly amended the "disclosure by publications" and "disclosure by use" part, and added new provisions. This will have a corresponding impact on the scope of proof and evidence in invalidation procedure.

### 1. Provisions on "information existing on

### the Internet or other online databases"

The amended Guidelines define "*information existing on the Internet or other online databases*" as follows: "*Information existing on the Internet or other online databases refers to information in the form of data stored in the form of text, pictures, audio and video, etc., and disseminated through the Internet*", and clarify the means of access to such information as follows: "*Information existing on the Internet or other online databases shall be obtained through legal means, and the obtaining of the information is irrelevant to whether passwords or fees are required, or whether the information has been read by anyone.*"

It is worth noting that the petitioner of an invalidation procedure often needs to access specific databases or websites, such as extraterritorial databases or websites that need to be accessed by means of a VPN, etc., in order to obtain evidence of the corresponding prior disclosure or prior use. The revision of the Guidelines clarifies that such evidence should be obtained through legal means. In concrete practice, for evidence obtained through extraterritorial databases or websites, it is necessary to have the corresponding forms of evidence to prove the legitimacy of the evidence.

In addition, the determination of the date of disclosure of "publications disclosed on the Internet without a clear record of the time of disclosure" has always been a controversial issue in invalidation proceedings. The amended Guidelines

have made clear provisions on this issue: *"For information on the web pages where the publication date is not clearly stated or the publication date is doubtful, the date of publication and modification recorded in the log file, the date of indexing given by the search engine, the date displayed by the Internet Archive service, the time-stamped information, or the date of publication of the reproduced information displayed on the mirror website, etc., can be referred to for determining the date of publication."*

As for the publication date of "publications disclosed on the Internet without a clear record of the time of disclosure", the amended Guide adopts the enumeration method and the expression "....., etc.". Therefore, in practice, if the parties can prove the publication date based on the evidence in the enumeration method or other reasonable methods, it is expected to be accepted by the panel.

## 2. Addition of "tendering and bidding" as a "disclosure by use" provisions

The amended Guide specifies "tendering and bidding" as a type of "disclosure by use". According to the relevant provisions on bidding and tendering, information such as pre-qualification notices, bidding notices, public notices of successful candidates and public notices of successful bidding results of tendering projects shall be disclosed in accordance with the principles of public service, openness and transparency, high efficiency and

convenience, and centralized sharing, except for the information that is required to be kept confidential in accordance with the law, or that involves commercial secrets.

It can be seen that, in addition to the original provisions of the Guidelines that enable the public to know the technical content of the manufacture, use, sale, import, exchange, gift, demonstration, exhibition and other means, if the bidding and tendering information contains a specific technical solution, it may also become a powerful evidence of disclosure by use. Therefore, in practice, the author suggests that one can fully search from the bidding and tendering operation platform or website, sort out possible evidence clues, and then follow the clues to find out the strong evidence of disclosure by use.

### III. Amendments and application of "Inventive Step" Provisions

In invalidation procedure, lack of inventive step is one of the common grounds for invalidation, and the amended Guidelines have refined and supplemented the aspects of "determining the closest prior art" and "determining the technical problem actually solved by the invention" in the part of "Inventive Step", which are very important guidelines for invalidation procedure.

## 1. Amendments of "Determining the closest prior art"

In the amended Guide, in Part II, Chapter 4, "Inventive Step", an important addition has been made to the subsection on "Determining the closest prior art" by adding the following underlined text: "..... *It should be noted that, when determining the closest prior art, account shall be first taken of the prior art in the same or similar technical fields, with priority given to prior art that is related to the technical problem to be solved by the invention.*"

In patent application examination procedures and invalidation procedures, when selecting the closest prior art, sometimes the standard of "the number of shared technical features" is taken, ignoring whether the technical problems of the prior art are related to the technical problems to be solved by the invention, which leads to bias in the assessment of inventive step. The amended Guide clarifies for the first time that priority should normally be given to prior art in the same or similar technical field as the patent application and whose technical problems are also related to the technical problems to be solved by the patent application as the closest prior art.

According to the definition of inventiveness in Article 22(3) of the Patent Law, *"Inventiveness means that, as compared with the technology existing before the date of filing, the invention has prominent substantive features and*

*represents a notable progress and the utility model has substantive features and represents progress."*

The inventiveness of an invention can be derived either from the "solution of technical problems" or the "proposal of technical problems". For an invention, the inventor often puts in a lot of effort in the research and development work, discovers the technical problems existing in the prior art, and then proposes corresponding solutions. In this process, the "proposal of a technical problem" gives the patent (patent application) "outstanding substantive features" in the sense of the Patent Law as compared to the prior art.

Regarding the requirement of "*giving priority to prior art that is related to the technical problem to be solved by the invention*" in the amended Guidelines, the author's opinion is that this is a stricter requirement for "the closest prior art" in the invalidation procedure. As a petitioner, it is necessary to pay attention to whether the technical problem to be solved in "the closest prior art" and the technical problem to be solved in the target patent are "related", and to make detailed discussion.

It is worth noting that the amended Guidelines do not require that the technical problem to be solved by "the closest prior art" and the technical problem to be solved by the target patent be the same or consistent, but require that they be "related". The "related" is that the technical problem to be solved in the "closest prior

art" also exists in the technical program of the target patent. If the technical problems to be solved in "the closest prior art" do not exist in the technical program of the target patent, or the technical problems to be solved in the two belong to different subdivided technical directions, then the "relevance" between the two is weak. If, after analysis, "the closest prior art" initially selected belongs to this kind of weak "relevance", the petitioner should consider it carefully and suggest further searching until "the closest prior art" with high relevance is found.

## 2. Amendments of "Determining the technical problem actually solved by the invention"

The amended Guidelines have added the following to the provisions of Part II, Chapter 4 on "Inventive Step" on "Determining the technical problem actually solved by the invention": ".....  
*Exceptionally, when all technical effects of the invention are comparable to the closest prior art, the technical problem to be redefined is to provide an alternative technical solution to the closest prior art.*

*The technical problem that is redefined should match the technical effect that the distinguishing feature can achieve in the invention, and should not be identified with the distinguishing feature itself, nor should it contain guidelines or hints as to the distinguishing feature.*

The amendment of "determining the technical problem actually solved by the invention" is mainly reflected in the following two aspects, which the author explains by way of examples.

The first is to add "alternative technical solutions" as a special case of redefined technical problems. This special case is more common in actual R&D and innovation activities. For example, in the "design around" process in the R&D work, in order to circumvent the patent of a competing company, an "alternative technical solution" is provided, which often solves the same technical problem as the patent of the competing company.

The second is to emphasize that the technical problem actually solved by the invention should be determined "reasonably", neither too "generalized" nor too "narrow". Based on the technical effect that the distinguishing feature can achieve in the invention, the technical problem to be re-determined should be matched with the technical effect; and we should also be careful to prevent the technical problem actually solved with "the technical means proposed by the invention for solving the technical problem".

A case has been added to the amended Guidelines on how to "reasonably" determine the technical problem actually solved by the invention:

| Present application   | The closest prior art  |
|---|--|
| <p>Claims:<br/>A consumer electronic device comprising a biometric authentication unit for account authorization of a user, the authentication unit being based on a combination of a fingerprint and at least one authentication method selected from palm prints, iris, fundus of the eye, and facial features.</p> <p>Specification:<br/>User accounts can be made more secure through at least two types of authentication.</p> | <p>A consumer electronic device is disclosed that performs authentication based only on fingerprint information.</p> |

In particular, for the "technical problem actually solved" in "the application" above, if it is identified as either of the following two cases, it is considered wrong.

Case 1: The technical problem solved in this application is "how to add at least **one biometric authentication method** such as palm print";

Case 2: The technical problem solved in this application is "how to realize the

security of consumer electronic devices **by adding authentication methods**".

It is not reasonable to include distinguishing feature itself and contain guidelines or hints as to the distinguishing feature in the above two cases. If the above determination is adopted, it may lead to the misunderstanding that the technical problem actually solved is "with the technical means proposed by the invention for solving the technical problem", which makes the "distinguishing feature" become "obvious" and thus lowers the patent (patent application).

The amended Guidelines make it clear that when "determining the technical problem actually solved by the invention", it should be "objective" and "reasonable". The "determination of the technical problem actually solved by the invention" is a very crucial step in invalidation procedure. Some petitioners may try to "confuse the public" by framing the "technical problem actually solved" of the target patent in a very broad manner, or directly introducing "distinguishing features" into the "technical problem actually solved", aiming at lowering the inventiveness of the target patent. The amended Guidelines have made it clear that the above two situations are "unreasonable", and this provision provides the patentee with an effective means to defend the inventive step, and can argue the "inventiveness" of the target patent from the source of the "technical problem actually solved".

For the patentees, when arguing the "technical problem actually solved by the invention" of the target patent, in order to be accepted by the panel, it is advisable to consider starting from "the redefined technical problem should match the technical effect that the distinguishing feature can achieve in the invention", objectively and reasonably comment on the technical problem actually to be solved by the target patent. At the same time, this also puts forward corresponding requirements for the drafting of patent application documents, that is, the core or important technical features in the technical solution need to be described and deduced in detail and comprehensively in the patent application documents, which will be useful for the invalidation

procedure.

To sum up, this article mainly analyzes and interprets the substantive provisions related to invalidation procedure in the amended Rules and Guidelines. Among them, "the principle of good faith" is included in the grounds for invalidation for the first time, and runs through the whole life cycle of the patent; the part of "novelty" has refined the provisions on the evidence of "information existing on the Internet or other online databases", and the provision of "tendering and bidding" for "disclosure by use" has been added; the "inventive step" part has been refined and supplemented in the parts of "determining the closest prior art" and "determining the technical problem actually solved by the invention".

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MS. Zhu has strong skills in Intellectual Property prosecution and litigation, such as patent FTO, infringement analysis, patent invalidity, public opinions, patent application and legal opinions, and has in-depth legal, technical and commercial research in many technical fields such as display technology, new energy battery, new energy photovoltaic, semiconductor field and communication technology; Meanwhile, Ms. Zhu is good at enterprise intellectual property management of large transnational enterprises, and is good at formulating and implementing intellectual property strategies, as well as refining the whole process management of IP. Ms. Zhu joined Lung Tin in October 2022.