



Inventive Step Evaluation of Business Method Patent Applications



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With the continuous development of information technology, especially mobile Internet, Internet of Things, big data, artificial intelligence, blockchain, cloud computing, etc., a large number of business models have emerged, which have significantly promoted the development of social economy. Therefore, how to protect the Intellectual Property Rights of inventive achievements of these business models has become one of the important issues.

On February 1st, 2020, the newly amended Guidelines of Patent Examination (hereinafter referred to as “the Guidelines”) was implemented, in which Section 6 was added to Chapter 9, Part II, which comprehensively stipulates the provisions for

determining business method patents.

Inventive step is one of the important substantive requirements for determining whether an invention can be granted patent right. Based on characteristics

of business method patents, the added Section 6 of the Guidelines states the criterion for determining the inventive step of business method patents and emphasizes the principle of overall consideration among business rule and method features and technical features.

In accordance with 6.1.3, Chapter 9, Part II of the Guidelines: “When performing the examination of inventive step of an invention patent application containing both technical features and algorithm features or business rule and method features, the algorithm features or business rule and method features and the technical features that functionally supportive and interactive to each other shall be considered as a whole. ‘Functionally supportive and interactive to each other’ refers to the algorithm features or business rule and method features closely combine with the technical features and jointly constitute a technical means which solves a certain technical problem and obtains corresponding technical effect.”

However, the Guidelines does not state specific operations on how to “be considered as a whole”. In the book entitled *Analysis of Heatedly Discussed Cases Involving Invention Patent Applications in New Fields and New Forms of Business* (Xiao Guangting & Wang Jingxia & Zou Bin, 2020), it introduces “three-step method” for determining inventive step of business method patents. In accordance with 3.2.1.1, Chapter 4, Part II of the Guidelines, normal criterion for determining inventive step includes the following three steps:

Step 1: Determining the closet prior art;

Step 2: Determining the distinguishing technical features of the invention and the technical problem actually solved by the invention;

Step 3: Determining whether or not the claimed invention is obvious to a person skilled in the art.

Regarding the criterion for determining inventive step of business method patents, steps are as same

as above-mentioned Step 1 and Step 3 in common field, except that the determination of Step 2 can be divided into three different situations.

1. If the distinguishing technical features include only technical features, the obviousness of the invention shall be determined in accordance with normal criterion for determining inventive step.

2. If the distinguishing technical features include only business rule and method features (and/or algorithm features) which are non-technical features, those non-technical features shall be analyzed whether relating to the technical problem to be solved by the invention or whether relating to other technical features in the solution. If they are relevant, the technical problem to be actually solved by the invention shall be determined holistically according to the relation and the obviousness of the invention shall be further determined; if they are not relevant, it means that the non-technical features would not bring technical effects; thus the problem to be solved by the invention belongs to non-technical problem, therefore, the solution does not involve an inventive step.

3. If the distinguishing technical features both include business rule and method features (and/or algorithm features) which are non-technical features and technical features, those non-technical features shall be analyzed whether relating to the technical problem to be solved by the invention or whether relating to other distinguishing technical features. If they are relevant, the distinguishing technical features shall be considered as a whole to determine the technical problem to be actually solved by the invention and the obviousness of the invention shall be further determined; if they are not relevant, it means that the problem to be solved by these non-technical features belongs to non-technical problems, therefore, the solution does not involve an inventive step.

In responding to Office Actions relating inventive step of business method patent applications, the relation between non-technical features such as

business rule and method features and/or algorithm features and the technical problem to be solved shall be emphasized, also the relation between the non-technical features and other technical features shall be emphasized, which enables the examiner to

take into consideration the non-technical features and the other technical features as a whole, increasing chance of success in responding to the Office Actions relating inventive step.

Reference:

Xiao Guangting & Wang Jingxia & Zou Bin, (2020), Analysis of Heatedly Discussed Cases Involving Invention Patent Applications in New Fields and New Forms of Business.

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