



Submission date: 21st April 2016

2016 – Study Question (Patents)

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Added matter: the standard for determining adequate support for amendments

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Date	21-04-2016

I. Current law and practice

You are reminded that a reference to patent in the following questions refers to both a granted patent and an application for a patent.

If your answer differs depending on the distinction between a granted patent and an application for a patent, please answer the questions for each, as applicable.

1) Under your Group's current law, are amendments to the description and/or figures of a patent possible?

In patent applications, amendments to the description and/or figures are allowed.

In granted patents, amendments to the description and/or figures are NOT allowed. In case of a misprint in editing/formatting and publishing, the State of Intellectual Property Office of China (SIPO) shall correct the misprint.

2) Under your Group's current law, are amendments to the claims of a patent possible?

Yes.

3) Further to your answers to questions 1) and 2), please indicate:

a) the standard for determining whether such amendments are permissible and indicate whether this standard exists in statutes, regulations, patent office guidelines, and/or in case law.

1. The overall principle is represented by Art. 33 of the Chinese Patent Law (CPL), which stipulates that:

“An Applicant may amend his or its application documents for a patent, but the amendment to the application for a patent for invention or utility model shall not go beyond the scope of the disclosure **recorded** in the initial description and claims, and the amendment to the application for a patent for design may not go beyond the scope of the disclosure as shown in the initial drawings or photographs.”

2. The “scope of the disclosure **recorded** in the initial description and claims” as stipulated in Art. 33 is specifically defined in the Chinese Guidelines for Patent Examination (CGPE):

“The scope of disclosure recorded in the initial description and claims includes the contents literally described in the initial description and claims, and the contents determined directly and unambiguously according to the contents literally described in the initial description and claims, and the drawings of the description.”

(Part II, Chapter 8, Section 5.2.1.1 of the CGPE)

3. CGPE provides further explanations and examples of impermissible amendments as follows:

3.1 Regarding a patent for utility model

If the Applicant, when amending the application documents, introduces any contents which cannot be directly and unambiguously determined by a person skilled in the art from the initial description and claims, such amendment shall be regarded as having gone beyond the scope recorded in the initial description and claims.

If the Applicant deletes one or more features from an application, it may also lead to go beyond the scope recorded in the initial description and claims.

If any technical feature which is included in the initial claims but not described in the initial description is introduced into the description and its contents are extended, such amendment shall be regarded as going beyond the scope recorded in the initial description and claims.

If any technical feature, which is not recorded in the initial description and claims and cannot be unambiguously determined by virtue of the contents represented by the initial drawings of the description, is introduced into the description, such amendment shall be regarded as going beyond the scope recorded in the initial description and claims.

It shall be noted that:

(1) the correction of obvious mistakes shall not be regarded as going beyond the scope recorded in the initial description and claims. "Obvious mistakes" means the incorrect contents which can be clearly judged from the context of the initial description and claims and without any possibility of other explanations or amendments; and

(2) any structure feature, which can be obviously seen from the drawings and has only one possible explanation, may be introduced into the description and included in the claims.

(Part I, Chapter 2, Section 8 of the CGPE)

3.2 Regarding a patent for invention

If, after the addition, change and/or deletion of part of the contents of the application, the information as seen by a person skilled in the art is different from those recorded in the initial application and such information cannot be directly or unambiguously determined from those recorded in the initial application, such amendment shall not be allowable. In this context, the contents of the application refer to contents recorded in the initial description (and the drawings) and claims, not including the contents of any priority documents.

(Part II, Chapter 8, Section 5.2.3 of CGPE)

Further, a variety of examples of impermissible addition, impermissible changes, and impermissible deletion are provided in Sections 5.2.3.1, 5.2.3.2, and 5.2.3.3 in Chapter 8, Part II of the CGPE, respectively.

3.3 In addition to the above substantive standard stipulated in Art. 33 of the CPL, there are further restrictions about the timing and manner for amending the application documents in different stages in the prosecution of the patent application and after grant of the patent. See answers to Question 4 for details.

b) whether there are the differences between the substantive standards for amendments under 1) and 2) above. If so, what?

No, there is no difference.

4) To the extent your answer to question 3) depends on timing (e.g. after filing but before examination, after allowance but before grant, and after grant), please explain how the standard changes and during which time periods.

Also, to be pursuant to Art. 33 of the CPL, the amendments should meet the following requirements in different stages:

1. After submission but before examination

a) Patent application for invention: the Applicant may voluntarily amend the application documents when filing the request for examination, and within three months from receiving the Notification of Entry into the Examination (Rule 51(1) and Rule 112(2) of the Implementing Regulations of the CPL), and for a PCT application, when entering the application into the national phase in China (PCT Art. 28 or 41);

b) Patent application for utility model: the Applicant may voluntarily amend the application documents within two months from the date of filing (Rule 51(2) of the Implementing Regulations of the CPL), or for an international application, within two months from the date of entry (Rule 112(1) of the Implementing Regulations of the CPL).

2. During the examination

The amendments should be directed to the defects pointed out in the Notification.

(Rule 51(3) of the Implementing Regulations of the CPL)

It is impermissible to broaden the protection scope of a claim on the Applicant's own initiative; to take the technical content which is only described in the description and lacks unity with the initial claimed subject matter as the subject matter of the revised claim on the Applicant's own initiative; or to add a new claim on the Applicant's own initiative.

(Part II, Chapter 8, Section 5.2.1.3 of the CGPE)

3. After allowance but before grant

There is no opportunity provided for the Applicant to amend the application documents during this period.

4. After grant

4.1 Only the claims can be amended and only in an invalidation proceeding can the claims be amended.

"In the course of the examination of the request for invalidation, the Patentee for the patent for invention or utility model concerned may amend its or his claims, but may not broaden the scope of patent protection.

The Patentee for the patent for invention or utility model concerned may not amend its or his description or drawings. The Patentee for the patent for design concerned may not amend its or his drawings, photographs or the brief explanation of the design."

(Rule 69 of the Implementing Regulations of the CPL)

4.2 Principles for the amendment: (1) the title of the subject matter of a claim cannot be changed; (2) the extent of protection cannot be extended as compared with that in the granted patent; (3) the amendment shall not go beyond the scope of disclosure recorded in the initial description and claims; and (4) addition of technical features not included in the claims as granted is generally not allowed.

(Part IV, Chapter 3, Section 4.6.1 of the CGPE)

4.3 Manners of amendment: the specific manners of amendment are generally limited to deletion of a claim, combination of claims, and deletion of a technical solution.

(Part IV, Chapter 3, Section 4.6.2 of the CGPE)

5) Further to your answer to question 3), if impermissible added matter is a ground for refusing an amendment, please explain how impermissible added matter is defined.

Briefly, "impermissible added matter" can be understood as the contents which are neither literally described in the initial description or claims, nor can be determined directly and unambiguously

according to the contents literally described in the initial description and claims, and the drawings of the description.

In particular, “impermissible added matter” may comprise:

- (1) The technical features which cannot be directly and definitely confirmed from the initial description (and the drawings) and/or claims;
- (2) The information which cannot be directly and unambiguously determined from the initial description (and the drawings) and/or claims;
- (3) Technical features relating to the parameter of size obtained by measuring the drawings;
- (4) Additional component which is not mentioned in the initial application documents and the addition of which will lead to special technical effects which do not exist in the initial application;
- (5) The useful effects which cannot be directly derived from the initial application by a person skilled in the art;
- (6) Experimental data added to illustrate the advantageous effects of the invention, and/or embodiments or examples added to prove that the invention can be carried out in the extent of protection claimed in the claims;
- (7) Drawings that are not mentioned in the initial application, unless the drawing is from the background art, or is a drawing of the closest prior art for replacing a drawing of the well-known art contained in the initial drawings.

(Part II, Chapter 8, Section 5.2.3.1 of the CGPE)

6) In any assessment of impermissible added matter under your Group's current law, please explain:

a) how the patent application as filed is interpreted;

The patent application as filed means the claims, description and the drawings of the description in Chinese filed by the Applicant with the SIPO at the filing date. The contents of the application documents in a foreign language and the priority documents submitted by the Applicant to the SIPO shall not be taken as the basis to judge whether the amendment to the application documents meet the requirements of Art. 33, except for the originally filed application documents in a foreign language of an international application entering into the national phase in China, which application documents in a foreign language have legal effect and can be used as the basis for any amendment to the application documents in Chinese.

(Part II, Chapter 8, Section 5.2.1.1 of the CGPE)

(Part III, Chapter 2, Section 3.3 of the CGPE)

The patent application as filed is interpreted as the combination of the contents literally described in the initial description and claims, and the contents determined directly and unambiguously according to the contents literally described in the initial description and claims, and the drawings of the description.

- b) if interpreted as the notional skilled person would understand the patent application as filed, what is the relevant date of knowledge of the notional skilled person?

The scope of disclosure recorded in the initial description and claims includes two sets of contents: the first set of contents are those literally described in the initial description and claims, and the second set of contents are those determined directly and unambiguously (by a person skilled in the art) according to the contents literally described in the initial description and claims, and the drawings of the description.

The relevant date of knowledge of the notional skilled person should be the filing date, or the priority date when priority is claimed.

- 7) If an amendment that was made to a patent application prior to grant is later reviewed by your patent office or a court in a post-grant proceeding and determined to contain impermissible added matter, is there a mechanism for the patentee to remedy the defect, for example by removing portions of the amendment found to be impermissible?

no

Please explain:

Basically, there is no mechanism for the Patentee to remedy the defect.

After grant, the description and drawings can no longer be amended, and the claims can only be amended in an invalidation proceeding via specific manners consisting essentially of deletion of a claim, combination of claims, and deletion of a technical solution.

If the “impermissible added matter” constitutes a complete technical solution or a claim, the defect may be removed by deleting the “impermissible added matter” itself.

If the “impermissible added matter” only constitutes part of a claim, the defect may be removed by deleting the entire claim, but not by simply deleting the “impermissible added matter” itself.

II. Policy considerations and possible improvements to your current law

- 8) How does your Group's current law strike a balance between allowing a patent applicant to make appropriate amendments during the examination process and preventing the applicant from adding impermissible matter?

Using Art. 33 of the CPL as the basis and principle, the SIPO allows the Applicant to properly amend the application documents during the prosecution of the application and meanwhile, prohibits the introduction of any new matters that may affect the filing date of the application.

Similar to the European Patent Office, in order to protect public interest, the SIPO requires the Examiner to **strictly abide by** the provisions of Art. 33 when examining the amended documents submitted by the Applicant.

9) Are there aspects of these laws that could be improved?

yes

Please explain:

Some of the collected suggestions are summarized as follows:

(1) Applicants and patent attorneys generally feel that there are relatively too many restrictions on the amendments to the application documents in the guidelines for examination, and in practice, the examination according to Art. 33 is very strict and somehow more focused on the literally described contents in the application without fully considering the knowledge and cognitive competence of a person skilled in the art;

(2) Some of the stipulations may be detailed and/or legal precedents may be introduced to make the execution of Art. 33 by different Examiners more consistent and simpler;

(3) Applicants may be allowed to submit a legal declaration to prove that the amendment is to remove an error but not to add any new matter;

(4) Addition of contents of common knowledge may be allowed if the added contents do not constitute the inventive gist;

(5) Addition of contents reasonably summarized based on the original description and claims may be allowed.

10) Does your Group's current law allow amendments post grant? If so, how does your Group's current law strike a balance between allowing a patentee to make appropriate amendments to a granted patent (such as amendments necessary to sustain its validity) and preventing the patentee adding impermissible matter?

The CPL allows amendments post grant, but adopts a stricter standard than in the examination process.

In CGPE, strict confinements are provided concerning the timing (only in an invalidation proceeding), the scope (only the claims), the principle (the title of the subject matter of a claim cannot be changed; the extent of protection cannot be extended as compared with that in the granted patent; the amendment shall not go beyond the scope of disclosure recorded in the initial description and claims; and addition of technical features not included in the claims as granted is generally not allowed) and the manners (deletion of a claim, combination of claims, and deletion of a technical solution) for the amendment after grant.

See Item 4 in answers to Question 4 for details.

11) Are there aspects of these laws that could be improved?

yes

Please explain:

Some of the collected suggestions are summarized as follows:

- (1) After-allowance-but-before-grant and/or after-grant opportunities may be provided to the Applicant/Patentee.
- (2) Using the experience of other countries for reference, a post-grant revision procedure may be set to allow the Patentee to narrow the protection scope of a patent to benefit the validity and stability of the patent.
- (3) In particular, the Patentee should be allowed to correct an obvious typo or error in the claims of a granted patent.
- (4) Amendment to the description may be allowed.
- (5) Addition of limiting features recorded in the initial description to the granted claims may be allowed.

In general, it is hoped that the requirements concerning the timing, scope, principle and manners for post-grant amendments can be slightly reduced to an appropriate extent not prejudicial to public interest (i.e., not introducing a new matter or broadening the protection scope of a patent).

12) If your Group's current law uses, at least in part, the notional person skilled in the art to determine the permissibility of amendments, is this approach effective? Are there aspects of this that could be improved?

Yes, it is effective but there is still space for the operability of this approach to be improved.

For example, although the scope of disclosure recorded in the initial description and claims includes “the contents determined directly and unambiguously”, the characteristics of the subject who makes this determination are not specifically defined in the CGPE.

In practice, the knowledge and capability of one skilled in the art at the time of filing cannot be accurately defined. Although it is generally accepted that common knowledge or conventional technical means in the art, well-known facts, natural laws, and daily experiences and rules should be taken into consideration when it is needed to decide if a content can be determined directly and unambiguously on the basis of contents specifically recorded in the originally filed application documents, different Examiners will arrive at different conclusions concerning the level of knowledge and cognitive competence of a person skilled in the art who is notional and does not exist in the real world. In order to strictly abide by Art. 33, most Examiners tend to restrict the scope of disclosure recorded in the initial description and claims to the contents literally described in the initial description and claims without considering the comprehension of the disclosure by a person skilled in the art. And the content “determined directly and unambiguously” tends to be interpreted as the one and only content that can be determined (not one that can be reasonably derived).

It might be a good idea to further specify the attributes of the notional person skilled in the art who would be used to decide whether the contents are determined directly and unambiguously or not.

In addition, considering that contents other than the inventive gist can be easily understood by a person skilled in the art, standards adopted in examining the amendments related to non-inventive

contents may be lowered.

III. Proposals for harmonisation

13) Is harmonisation of the definition of impermissible added matter desirable?

If yes, please respond to the following questions without regard to your Group's current law. Even if no, please address the following questions to the extent your Group considers your Group's laws could be improved.

yes

Please explain:

Among the collected responses, 47% expressed a desire for harmonization; 37% did not think it is necessary, and 16% declined to answer.

14) If yes, please propose a definition of impermissible added matter that you believe is appropriate.

If the addition of a matter leads to a technical solution not supported by the disclosure of the initial application documents, the addition of such matter shall not be allowed.

The disclosure of the initial application documents comprises the contents literally described in the initial description and claims and the contents clearly represented by the drawings of the description, and also the contents reasonably determined by one skilled in the art according to the initial description, claims and the drawings of the description in combination with the prior art and common knowledge.

15) Should this definition depend on when an amendment is made (for example, after filing but before examination, after allowance but before grant, and after grant)?

no

Please explain:

The definition should be the same to ensure consistency in the examination of a patent.

16) Should rules against impermissible added matter prohibit the addition of claims per se, as opposed to adding limitations to claims?

For a claim or a limitation, the addition thereof should be prohibited as long as the addition of the claim or the limitation introduces impermissible added matter.

17) Should rules against impermissible added matter prohibit the removal of claims per se, as opposed to removing limitations from claims?

no

Please explain:

For a claim or a limitation, the deletion thereof should be allowed as long as the deletion of the claim or the limitation can overcome the defect related to impermissible added matter.

18) Should the definition of impermissible added matter be the same when applied by a patent office as when applied by a court?

yes

Please explain:

The definition should be the same to ensure consistency.

19) If your proposed definition refers to the notional skilled person, what should be the relevant date of knowledge for the notional skilled person in evaluating the permissibility of an amendment?

The relevant date of knowledge of the notional skilled person should be the filing date, or the priority date when priority is claimed.

20) If the deletion of impermissible added matter by amendment would result in an impermissible extension of scope, how should the impermissible added matter defect be remedied in these circumstances?

Before grant, other relevant features that have basis in the originally filed application documents can be used to replace the impermissible added matter.

After grant, there is currently no mechanism to remedy such a defect. Unless like the US, reissue may be allowed, so the patent can be further amended, prosecuted and then published.

21) Please comment on any additional issues concerning any aspect of impermissible added matter you consider relevant to this Study Question.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Summary

In Chinese current patent law, the Applicant is allowed to amend the claims, the description and the drawings with the proviso that the amendment shall not go beyond the scope of the disclosure recorded in the initial description and claims, which scope comprises both the contents literally described in the initial description and claims, and the contents determined directly and unambiguously according to the contents literally described in the initial description and claims in combination with the drawings of the description. After grant, only in an invalidation case can the Patentee amend the claims in a few possible manners with the same proviso. In this context, any matter that does not fall within the scope of the contents mentioned above belongs to impermissible added matters.