



Investigation Into Some Sorts of Amendments in China and Europe

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In the patent (invention or utility model) application process, in order to overcome the problems pointed out by the examiner or to obtain the desired scope of protection, the applicant may amend the application documents, usually the claims. The restrictions imposed on these amendments vary from country to country. Among them, China and Europe use the strictest criteria for determining whether an amendment goes beyond the scope of the original disclosure. This article will explore some of the various sorts of amendments in China and Europe.

Some sorts of amendments in China

Article 33 of the Chinese Patent Law stipulates that the amendment to the patent application documents cannot exceed the scope of the original specification and claims. There was a time when the Chinese examiners were so strict about the amendments to patent applications for invention that they frequently pointed out the problem of amendment going beyond the original scope. In dealing with such problem, the applicant was often forced to incorporate some of the statements in the specification into the claims without the slightest change.

However, in recent years, Chinese examiners have gradually loosened the examination criteria for some sorts of amendments. Please see the examples below.

Example 1

Basis for amendment:

Features A, B, and C appear in the same sentence in the original application documents (specification or claims).



Amendment:

Feature A is incorporated into claim 1 while Features B and C are not.

Result:

There is a possibility that it will be accepted by the examiner. Some examiners may raise an objection that the amendment is beyond the original scope on the grounds that Features B and C associated with Feature A are not incorporated into claim 1. However, the possibility of the examiners raising the above objection is lower than in the past.

Example 2

Basis for amendment:

Feature A is disclosed in a specific embodiment in the specification, and Features a1, a2, and a3 which further define Feature A are also disclosed.

Amendment:

Feature A is incorporated into claim 1 while Features a1, a2, and a3 are not.

Result:

This amendment is more likely to be accepted by the examiner.

Example 3

Basis for amendment:

Features A, B, and C are defined in a claim. The original application document (the specification or the claims) discloses that the subordinate features of A are selected from a1, a2 and a3, the subordinate features of B are selected from b1, b2 and b3, and the subordinate features of C are selected from c1, c2 and c3.

Amendment:

A, B and C are further defined in the claims, thereby forming a specific combination of the subordinate features of A, B and C. For example, the combined features (a1, b1, c1) or (a2, b3, c1) and the like are incorporated into the claims.

Result:

When Features A, B, C and their specific subordinate features are mechanical or electrical features, the



specific combinations of the subordinate features are usually accepted by the examiner. When the Features A, B, C and their specific subordinate features relate to chemical substances, the above amendment is also very likely to be accepted by the examiner. This also applies to the case where A, B, and C are the three elements of the same Markush formula.

The aforementioned are some sorts of amendments that may be accepted by the examiner. The author thinks it feasible for the applicant to amend the application document in the application process by using the aforementioned methods. However, there is no guarantee that the aforementioned amendment methods will inevitably be accepted by all examiners. After all, Chinese examiners have certain discretion over the standards in the determination of whether an amendment exceeds the original scope, and some examiners may adopt a cautious attitude towards the abovementioned amendment methods.

In addition, it should be noted that the following amendment methods are still difficult to be accepted by Chinese examiners.

Example 4

Basis for amendment:

Original Feature a

Amendment:

The Feature a is amended as Feature A of its superordinate concept. For example, a is the phase difference of the signal, the substitute Feature A is the error, and A is the superordinate concept of a.

Result:

The added Feature A is easily rejected for going beyond the original scope.

Example 5

Basis for amendment:

The specific embodiment 1 has the Features A and B, and the specific embodiment 2 has the Features C and D. The original application document does not have a clear description of how the features of the embodiments 1 and 2 are combined.



Amendment:

The features in the different embodiments are combined to increase a combined feature (A+D), (A+C+D) or (B+C).

Result:

It is easy to be rejected for going beyond the original scope.

The noteworthy point is that in the specification, statements like that “the technical solution of the present application may be any combination of different embodiments/technical solutions” are generally not recognized by the examiner as the basis for the amendment. In order to cope with the above situation, it is necessary to clearly specify in the application documents the specific combination of the features of the different embodiments.

Some sorts of amendments in EuropeThe European counterpart of Article 33 of the Chinese Patent Law is Article 123(2) EPC, where it is stipulated that the amendment shall not exceed the scope of the disclosure in the original application documents. From the provisions of the law, it is difficult to draw the difference between China and Europe in the examination criteria of determining whether an amendment goes beyond the original scope. Usually, applicants tend to think that China holds the most stringent examination criteria in determining whether an amendment goes beyond the original scope in this world. However, in fact, in terms of the determination of whether an amendment goes beyond the original scope, the European Patent Office (hereinafter referred to as “EPO”) currently applies stricter examination standards in some respects than the China National Intellectual Property Administration (hereinafter referred to as “CNIPA”).

For example, the amendment of the Example 3 relating to the selection of combinations, in particular the amendment of the chemical substances (including the Markush claims), is not easily accepted by the EPO.

Further, in the case of the amendment of the Example 1, when it cannot be sufficiently explained that the Feature A to be incorporated has no correlation with the Features B and C, only incorporating Feature A into the claim is easily rejected by the EPO for going beyond the original scope. With regard to the amendment of Example 2, incorporating only the Feature A into claim 1 is also easily rejected by the EPO for going beyond the original scope.

In view of the strict examination on the amendment of the EPO, it is recommended that applicants



recite the specific subordinate features in the application documents in advance.

For example, regarding Example 3, it is suggested to clearly specify the specific combined features (a1, b1, c1), (a2, b3, c1), etc. in the application documents.

For Example 1, it is advisable to explain in the application documents that there is no close relevance between Feature A and Features B and C, and to supplement the description of the technology only related to Feature A. For Example 2, the technical solution involving only Feature A and that involving Feature (A, a1, a2, and a3) are separately defined.

However, the amendments of Examples 4 and 5 are difficult to be approved by the EPO and CNIPA since their examination standards are basically the same for these sorts of amendments. It is found that multiple dependency is often used in the claims of European application documents to save costs and to achieve as many combinations of different features as possible.

Conclusion

In summary, the author preliminarily explores whether some sorts of amendments could be recognized by the examiners in China and Europe. For patent applications that will both enter China and Europe, it is advisable to draft the application documents in accordance with the most stringent amendment examination standards of CNIPA and EPO so that they can be fully prepared for possible amendments in the future application phase.