

WHAT IS AN ALLOWABLE AMENDMENT

Patent Practice in Japan and China

Rules about amendments during patent examination are different among jurisdictions. This article compares the rules in Japanⁱ and in Chinaⁱⁱ, and intends to shed lights on drafting an effective patent application.

I. Allowable Rectification in the Japanese Patent Examination

Both the Japanese Patent Law and the Chinese Patent Law adopt the first-to-file rule, where some applicants may rush to file an application without careful drafting. Often, to obtain a patent right, it is necessary to rectify the specification, the claims and the drawings. Only the rectification would be allowed if no contents beyond the original description are added. Otherwise, the rectification cannot be accepted due to the violation of the first-to-file rule.

In Japan, Article 17.2 of the Japanese Patent Law prescribes the rectification timing and scope of the description, the claims and the drawings (hereinafter referred to as “description”).

1. Timing Requirements for Rectification

An applicant may make a rectification to the description according to the timings as shown in the items (1)-(6).

- (1) before delivery of patent granted copy since filing an application patent (except for receiving a Notification of First Rejection);
- (2) within the time limit prescribed in the Notification of First Rejection;
- (3) according to Article 48.7 after receiving the Notification of Rejection;
- (4) within the time limit prescribed in the final rejection;
- (5) at the same time when filing a request for a trial against the decision of the rejection; and
- (6) within the time limit prescribed in the Notification of Rejection during the trial procedure against the Decision of Rejection.

2. Substantive Requirements for Rectification

An applicant may make a rectification to the description without exceeding the extent of the substantive requirements that are different depending on timings as details below:

2.1 Before delivery of a Notification of the First Office Action

It is allowable to make a rectification to the prior to receiving a Notification of First Rejection issued by the examiner, which, however, is limited

only by not adding any new matter¹.

For example, a rectification A.

2.2 Within the time limit prescribed in a Notification of First Rejection

The examiner specifies a time limit within which the applicant could submit observations according to a Notification of Rejection. The specified time limit is usually 60 days for the applicant(s) who reside in Japan and 3 months for the applicant(s) who resides in foreign countries. It is allowable to make a rectification to the description within the above specified time limit.

At this time, the rectification is defined to narrow the claims or correct the obvious mistake of the description in order to overcome rejections, but not able to add any new matter or amend the special technical feature of the invention.

For example, rectifications A + B.

2.3 Within the time limit prescribed by Article 48.7 after receiving the Notification of First Rejection

It is required to record any identified document relating to the present invention in the description. Failure to meet the requirement, an examiner will issue a notice designating a time limit for submitting an observation. And it is allowable to make a rectification to the description within the specified time limit.

At this time, the rectification is limited to complement the information related to the invention in the description, but not add the new matter(s).

2.4 Within the time limit specified in the Notification of Final Rejection

The examiner may issue a Notification of Rejection marked with “Final”, where the examiner would designate a time limit for submitting an observation. It is allowable to make a rectification to the description within the time

¹ New matter is a matter that has not been recorded in the original description and claims or the drawings definitely, nor can be determined unambiguously from the original application documents, like the amendment(s) exceeding the original protection scope in China, but not completely the same.

limit.

However, at this time, a rectification to claims is further restricted expect for prohibiting addition of the new matters. That is, an allowable rectification to claims is only for following purpose:

- deletion of the claims
- narrowness of the claims, for example, rectification A+(narrowness of B)
- correction of the obvious mistake
- argument for unclear description designated in the Notification of Rejection

Further, the claims are narrowed such that the amended claims possess novelty and inventiveness (requirements for independent patentability).

It should be noted that the examiner will reject the following rectifications:

- the rectification of adding the new matter(s) into the description, the claims and the drawings;
- the rectification to the claims excluding the above purpose proposed;
- the rectification of taking narrowness of the claims for purpose but not satisfying the requirements for independent patentability.

Therefore, it is not allowable to make such rectification that the claims are broaden after receiving the Notification of Final Rejection. If such rectification is desired, the applicant should consider to file a divisional application.

2.5 At the same time when filing a request for a trial against the Decision of Rejection

It is allowable to make a rectification to the description while filing a request for a trial against the Decision of Rejection. But the rectification at this time is identical to the rectification made within the time limit specified in the Notification of Final Rejection, and also is restricted. Inappropriate rectification will be rejected by an examiner or a judge.

2.6 Within the time limit specified in the Notification of Rejection during the trial against the Decision of Rejection

In the trial against Decision of Rejection, it is possible to receive a Notification of Rejection issued by the judge or the examiner. It is allowable to make a rectification to the description within the time limit for submitting an observation. The Notification of Rejection may be the Notification of First Rejection, or the Notification of Final Rejection. Herein, the limitation to time limit of this rectification is the same as the limitation to the time limit specified by Notification of First or Final Rejection.

Inappropriate correction will be rejected by an examiner or a judge.

3. Rejection against Rectification

An examiner will reject the rectification (Article 53.1 of the Patent Law) if it is made inappropriately..

In a case that the rectification to a Notification of Final Rejection is not allowed, the examiner will make a Notification of Rejection due to this inappropriate rectification, a further rectification will be required.

The following rectifications will be rejected:

- (1) the rectification of adding the new manner(s) (contrary to Article 17.2 (3));
- (2) the rectification of verifying the special technical feature of the invention (contrary to Article 17.2 (4));
- (3) amendment made not for the purpose proposed (contrary to Article 17.2. (5)); and
- (4) amendment against requirements for independent patentability (contrary to Article 17.2 (6)).

3.1 The rectification of adding new matter(s) (contrary to Article 17.2 (3).

The rectification to "Notification of Final Rejection" in the following items (1) or (2) will be considered to be "the rectification of adding new manner(s)", to be rejected.

- (1) the rectification introducing new manner(s);
- (2) the rectification containing the new manner(s) as designated in the "Notification of Final Rejection".

3.2 The rectification of changing special technical feature(s) of the invention (contrary to Article 17.2 (4))

The rectification to "Notification of Final Rejection" in the following cases (1) or (2) will be considered as a "Rectification of Changing the Special Technical Feature(s) of the invention", to be rejected.

- (1) the rectification of adding an invention of changing the special technical feature(s);
- (2) the rectification of containing the invention that changes the special technical features as indicated in the "Notification of Final Rejection".

3.3 The rectification made not for the above purpose proposed (contrary to Article 17.2 (5))

The rectification expect for the following cases (1)-(4) will be considered to be the "amendment made not for the purpose proposed", so as to be rejected.

- (1) deletion of the claims;

- (2) narrowness of the claims;
- (3) correction of the obvious mistake;
- (4) argument for unclear description designated in the Notification of Rejection.

3.4 The rectification against the requirements for independent patentability (contrary to Article 17.2 (6))

The rectification to the “Notification of Final Rejection” according to the following cases (1) or (2) will be considered as the “Rectification against Requirements for Independent Patentability”, so as to be rejected.

(1) The rectification of claims eliminates the grounds of rejection, but for the invention including the rectified claims, the new grounds for rejection will be found based on the following regulations.

(2) As for the rectified claims, the circumstances are not still eliminated based on the grounds of rejection as indicated in the “Notification of Final Rejection”.

As for the provisions adapted to judge whether the related invention can be granted a patent right, the details are provided as follows:

- a) appropriateness of the invention and availability of the industry (see Article 29.1 main paragraph);
- b) novelty (see Article 29.1);
- c) inventiveness (see Article 29.2);
- d) boarding the earlier application (see Article 29.2, similar to conflict application in China);
- e) circumstances for which no patent right shall be granted (see Article 32);
- f) description requirement (see Article 36.4 (1) and Article 36.6 (1)-(3), similar to Article 26.4 of the Chinese Patent Law)

4. Example

A Japanese application is taken for an example to explain the circumstance of receiving a Rejection against Rectification.

In a response to the final rejection, the applicant amended the phrase “display the link” in independent claim 1 to recite “display in a manner of link quotation”. The examiner issued a Rejection against Rectification, and concluded that the rectification, while failed to narrow claims, does not comply with the provisions of items 1, 2, 3 and 4 of Article 17.2 (5) of the Japanese Patent Law, i.e., the rectification made not for the above purpose proposed.

A Decision of Rejection was issued along with the Rejection against Rectification. In the Decision of Rejection, it is concluded that the present

application will be rejected based on the reasons of the Notification of Rejection issued on July 29, 2016. It should be noted that no evidence is provided to overcome the grounds for rejection after analyzing the applicant’s arguments. In addition, Rejection against Rectification to the formation of November 2, 2016 was issued together. That is, the rectification for the Notification of Rejection will be rejected, and the application documents prior to this rectification will be examined.

II. Allowable Amendments in the Chinese Patent Examination

In practice, the Guidelines for Patent Examination provide that “before making the Decision of Rejection, the examiner shall give the applicant at least one opportunity to make observations and/or amend the application documents” and “the petitioner may amend the application at the time of submitting the request for reexamination, responding to Notification of Reexamination (including Notification of Oral Proceedings for Request for Reexamination), or appearing in oral proceedings”. Moreover, an Office Action through the substantive examination in China is different from that in Japan to include a Notification of First Rejection and a Notification of Final Rejection.

Accordingly, a general concept for allowable amendments both in China and in Japan are substantially the same, but the limitation to the timing requirements and the substantive requirements in the Japanese patent examination are stricter and more complicated with respect to the Chinese patent examination.

1. Timing for Amendments

An applicant may amend the description in following items (1)-(3).

- (1) made on the applicant’s initiative
- (2) when responding to an Office Action
- (3) when filing a request for reexamination and responding to a Notification of Reexamination or appearing in an oral proceeding.

2. Limitation to Amendments

Amendments made on the applicant’s own initiative

Rule 51.1 regulates the timing to making amendments on his own initiative:

When filing a request for substantive examination;

Within three months from the receipt of the Notification of Entering the Substantive Examination Stage of the Application for Invention issued by the Patent Office;

Note: it is not allowable to make amendments on his own initiative while responding to an Office Action issued by the Patent Office.

Amendments made while responding an Office Action

The amendments in the substantive examination must satisfy following:

Article 33 of the Chinese Patent Law

Article 33 provides the content and scope of the amendments, that is, the applicant could amend the application documents, but any amendment for the invention or the utility model shall not go beyond the scope of the original description and claims.

Rule 51.3 of the Implementing Regulations of the Chinese Patent Law

Rule 51.3 provides the way of making amendments for responding to the Office Action, that is, the applicant should amend the defects as pointed out in the notification after receiving the Office Action issued by the Patent Office.

To sum up, it is allowable that an amendment is made to overcome an objection or rejection and does not exceed the scope of disclosures of the original application.

2.3 Amendments made while filing a request for reexamination and responding to a Notification of Reexamination or appearing in an oral proceeding

Similar to the substantive examination, it is allowable that the amendments made while filing a request for reexamination and responding to a Notification of Reexamination or appearing in an oral proceeding shall satisfy the following provisions:

(1) Article 33 of the Chinese Patent Law

Article 33 provides the contents and scope of the amendments, that is, the applicant could amend the application documents, but any amendment for the invention or the utility model shall not go beyond the scope of the original description and claims.

(2) Rule 61.1 of the Implementing Regulations of the Chinese Patent Law

According to the provisions of Rule 61.1, the petitioner amends the application documents only to eliminate the Decision of Rejection or the defects as indicated by the panel.

For example, the following are not allowable:

(1) the amended claims broadening the protection scope with respect to the claims based on which the Decision of Rejection was issued;

(2) the technical solution lacking for unity with respect to the technical solution as defined by the claims in the Decision of Rejection is taken as the amended claims;

(3) to change type of the claims or add the claims;

(4) to amend the claims or the description according to the defects as indicated in the Decision of Rejection, but in addition to the circumstances of amending the obvious literal mistake or amending the defects as same as the defects as indicated in the Decision of Rejection.

3. Non-allowable Amendments

Similar to the practice in Japan, any amendment that does not comply with the provisions will not be accepted. The examiner or the panel will expound the reasons why the amended documents cannot be accepted, or notice the applicant that the amended documents cannot be accepted in a written or telephone notification manner, and also continue to examine the acceptable text.

4. Example

A Chinese application is taken for an example to explain the circumstance that the amendments are not in conformity with the provisions of Rule 51.3 of the Implementing Regulations of the Chinese Patent Law.

In a First Office Action, the examiner only indicated that none of claims 1-16 possess inventiveness prescribed by Article 22.3 of the Chinese Patent Law.

In the observations, as for the problem of inventiveness, the applicant did not make any amendment but only state the reasons why claims 1-16 possess inventiveness, and, the applicant added a new claim 17 according to the disclosures of the description.

After examination, the examiner accepted the applicant's arguments for inventiveness, but issued a Telephone Notification, informing that the claim 17 was added not based on the comments of the Office Action, thereby being not in conformity with the provisions of Rule 51.3 of the Implementing Regulations of the Chinese Patent Law, and suggesting to delete the claim 17

ⁱ Japanese patent system can be said to begin with Patent Monopoly Ordinance that entered into force as of 1885. The current Japanese Patent Law was promulgated in 1959, and entered into force as of 1960.

ⁱⁱ Chinese Patent Law was promulgated in 1984, and entered into force as of 1985.



The newsletter is not intended to constitute legal advice. Special legal advice should be taken before acting on any of the topics addressed here.

For further information, please contact the attorney listed below. General e-mail messages may be sent using LTBJ@lungtin.com which also can be found at www.lungtin.com

Hui JIN, Patent Attorney: LTBJ@lungtin.com



Hui JIN
(Patent Attorney)

Ms. Jin is a patent attorney at Lung Tin. She focuses on patent matters in the fields of machinery, materials and telecommunications.

Being familiar with patent practices in both China and Japan, Ms. Jin is experienced in patent prosecution in representing Japanese clients for their patent applications in China and Chinese clients' applications in Japan. She has handled hundreds of patent applications and responding OA, etc.