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Amendment Requirements of Chinese Patent Applications Compared with Those of Japanese Patent Applications - Based on the Seiko Epson Ink Cartridge Decision -

In the examination of Chinese applications, amendment requirements are judged relatively strictly. Amendments that are permitted in the USA or Japan are often not allowed by Chinese examiners. Therefore, it is essential for applicants to bear this amendment restriction in mind when preparing application documents and to make a voluntary amendment prior to issuance of an Office Action. However, in recent years the Supreme Court has rendered successive decisions that relax the amendment content restriction and the trend of the decisions has been attracting attention.

1. Judgment Standard of Amendment Requirements in Japan and China

(1) General rule

With reference to the amendment requirements, Article 17^{bis} (3) of the Patent Law of Japan sets out that “... any amendment of the description, scope of claims or drawings ... shall be made within the scope of the matters stated in the description, scope of claims or drawings originally attached to the application ...” In addition, the Examination Guidelines explain that the “matters stated in the originally attached description, etc.” refer to technical matters introduced to a person

skilled in the art by totalizing the whole statement in the originally attached description, etc. If, therefore, an amendment does not introduce new technical matters in connection with the technical matters introduced in this way, it can be said that the amendment shall be made within a scope of “matters stated in the originally filed description, etc.” (Reference: A request for cancellation of trial decision, Decision by the Intellectual Property High Court, Grand Panel, May 30, Heisei 20 (2008), (Heisei 18 (2006) (Gyo-Ke) No. 10563) “Solder-resist”). On the other hand, regarding amendment requirements, Article 33 of the Chinese Patent Law provides that “an applicant may amend his or its application for a patent, but the amendment to the application for a patent for an invention or utility model may not go beyond the scope of the disclosure contained in the initial description and claims” and appears to specify the same requirements as those of Article 17^{bis} (3) of the Japanese Patent Law. However, the Examination Guidelines explain that the “scope described in the initial description and claims” represents the “literal content of the initial description and claims, and the content that can be directly and unambiguously determined from the literal content of the initial description and claims, and drawings.”

In Chinese examination practice, the phrase “can be directly and unambiguously determined” is strictly interpreted. According to the “examination internal operation rules” referred to by examiners, the judgment standard is specified as “the content that can be uniquely determined from the literal content of the initial description and claims, and drawings.” Therefore, in general examination, basically, nothing other than the content unchanged from the text of the initial description and claims or the text to which a minor

change in expression was added is permitted. In this respect, whether an amendment is permissible or not in China appears to be examined based on a judgment standard different from that of Japanese examination practice.

(2) Judgment example

The Examination Guidelines on the Japanese amendment requirements provide the following examples to illustrate what kind of amendment is permitted or not permitted. An English translation of the Examination Guidelines is available at http://www.jpo.go.jp/tetuzuki_e/t_tokyo_e/Guidelines/3.pdf.

[Example 1] Amendment for changing the matters used to specify the invention (example of prohibited amendment)

Amendment for changing the phrase “when control means are not executed normally” in claims to the phrase “based on a negation signal in case control means are not executed normally” is intended to be made. If the originally attached description, etc. merely states that, when the control means are not executed normally, the absence of a positive signal lasts for a predetermined period of time and a resetting signal occurs, the amendment is not permitted. This amendment adds a case of occurrence of the resetting signal based on “a negation signal,” which is different from the no signal state, and which is not, however, stated in the originally attached description, etc. (Reference: A request for cancellation of decision of cancellation, Decision by the Tokyo High Court, November 6, Heisei 13 (2001) (Heisei 12 (2000) (Gyo-Ke) No. 221)

[Example 2] Amendment for limiting part of the matters used to specify the invention (example of permitted amendment)

Amendment changing “a recording or reproducing apparatus” in claims to “a disc recording or reproducing apparatus” is intended to be made. What is stated in the originally attached description, etc. as an example is a reproducing apparatus intended for CD-ROMs. However, if it is extremely clear that the amendment is applicable not only to a reproducing apparatus intended for CD-ROMs but also to any disk recording and/or

reproducing apparatus in view of another statement in the description (the statement of technology, etc. for reducing battery power consumption by adjusting the power supply when the recording and/or reproducing apparatus receives no operation command), the amendment is permitted. (Reference: A request for cancellation of decision of cancellation, Decision by the Tokyo High Court, February 19, Heisei 14 (2002) (Heisei 10 (1998) (Gyo-Ke) No. 298)

The Examination Guidelines of Japan relating to amendments was revised in 2003, and on that occasion the judgment standard on the scope within which amendment can be made was changed from the matters “directly and unambiguously” deduced by a person skilled in the art from the disclosures of the description or drawings to “obvious matters from the disclosures of the originally attached description, etc.” The current Examination Guidelines were created by the revision of the Examination Guidelines in 2010.

On the other hand, a typical example of the violation of Article 33 of the Patent Law in the Chinese examination practice is as follows.

[Example 1] Concretization of publicly known technology
According to the above “examination internal operation rules,” if the originally attached description and claims set forth that “members A and B are coupled in a commonly used method” and the coupling method commonly used in the present field includes soldering, fastening with a rivet, inlay, fastening with a nail and fastening with a bolt, each of the following three amendments is deemed to violate Article 33 of the Patent Law. Referring to the disclosures of the originally attached description, the content added by these amendments can be presumed to be included in a plurality of choices based on publicly known common sense, but since there are other possible choices, they cannot be said to correspond to the scope that can be “uniquely” and “directly and unambiguously” determined.

/1/ The members A and B are coupled in a commonly used method, such as soldering, fastening with a rivet and fastening with a bolt.

- /2/ The members A and B are coupled by soldering.
/3/ The coupling method of the members A and B is one of soldering, fastening with a rivet, inlay, fastening with a nail and fastening with a bolt.

[Example 2] More generic idea

If the description sets forth “a reproducing apparatus intended for CD-ROMs,” the amendment changing “a recording or reproducing apparatus” in claims to “a disc recording or reproducing apparatus” is deemed to “fulfill amendment requirements” according to the Japanese examination guidelines, since “it is extremely clear that the invention is applicable not only to a reproducing apparatus intended for CD-ROMs but also to any disk recording and/or reproducing apparatus in view of another statement in the description (the statement of technology, etc. for reducing battery power consumption by adjusting the power supply when the recording and/or reproducing apparatus receives no operation command).” However, in the Chinese examination practice, it is highly likely that the amendment is deemed to violate Article 33 of the Patent Law. Since the term “disc recording or reproducing apparatus” is not directly described in the originally attached description, etc. and the term “a recording or reproducing apparatus” can include apparatuses other than the “disc recording or reproducing apparatus,” the amendment cannot be said to be the “only” one that can be “directly and unambiguously” determined from the originally attached description, etc.

(3) Sub-conclusion

As can be understood from the foregoing, in Japan the times of the “direct and unequivocal” standard have long gone, but in China, such a standard appears to remain.

In the judgment of Article 33 of the Chinese Patent Law, the “scope described in the initial description and claims” is the “only scope that can be determined” from the disclosures of the initial description, and this scope is clearly narrower than the “scope that can be logically determined” by a person skilled in the art from the disclosures of the initial description based on his/her common general technical knowledge.

However, will the Examination Guidelines also be changed in China based on court decisions, as the Examination Guidelines were revised in Japan based on court decisions? Regarding the following decision, a number of commentaries have been already offered by Chinese lawyers, but this paper reviews the decision from the standpoint of comparison with Japan.

2. Chinese Precedent Regarding the Judgment of Amendment Requirements (Decision Rendered by the Supreme Court on December 25, 2010)

In recent years the Supreme Court has rendered decisions that relax the existing Chinese Examination Guidelines relating to amendment requirement, and these decisions have been attracting attention.

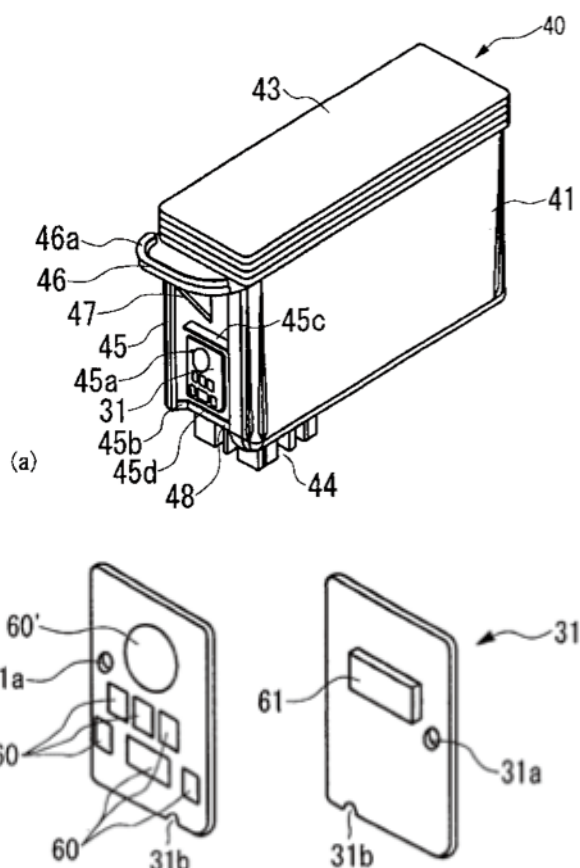
The case concerns a request for cancellation of an invalidation trial decision relating to Chinese Patent No. 00131800.4, which is owned by Seiko Epson Corporation and whose title of invention is “ink cartridge.” Claim 1 and relevant drawings at the time of granting the patent are as follows (The parenthesized drawing numbers in the claims were added by the author.)

[Claim 1]

An ink cartridge (40) mountable on a carriage of an inkjet printer to supply ink to a recording head of the inkjet printer through an ink supply needle, the ink cartridge comprising:

- a plurality of walls;
- an ink supply port (44) formed on a first wall of the plurality of walls and configured to receive said ink supply needle and;
- a memory device (61) supported by said ink cartridge and storing ink-related information;
- a circuit board (31) attached to a second wall crossing the first wall of said plurality of walls, and located on the midline of said ink supply port; and
- a plurality of points of contact (60) formed on an external surface of said circuit board, said points of contact being a plurality of points of contact configured to bring said memory device in contact

with the inkjet printer and forming a plurality of columns.



During the examination of the present patent, the applicant amended a “semiconductor memory device” in claim 1, etc. to the “memory device.” The relevant disclosure of the description is found in the Background Art section and reads as follows. “Although a result by such technical development can be applied to a newly manufactured ink-jet recording apparatus, the application to a recording apparatus already shipped from a manufacturer would be practically impossible when taking into consideration the cost, labor, and other factors. This is because the recording apparatus has to be carried to the manufacturer and memory means in which control data is recorded must be exchanged.”

The Example section of the description discloses only the “semiconductor memory device 61” corresponding to the component 61 in the drawing.

Regarding this patent, a request for an invalidation trial was made and the patent re-examination committee rendered an invalidation trial decision on the grounds that the above amendment violates Article 33 of the

Patent Law. The grounds of the trial decision were that the entirety of the description including the Examples discloses only the “semiconductor memory device,” and that the “memory device” disclosed in the “background art” represents that of the background art and does not represent a component of the invention of the present application.

In an administrative lawsuit against this trial decision, the first-instance court rendered a decision that upholds the grounds and the conclusion of the invalidation trial decision. However, the second-instance court ruled that the amendment did not violate Article 33 of the Patent Law and dismissed the invalidation trial decision and rendered a decision by which the present patent reverted to the examination stage. The grounds of the second-instance decision were that “since in the description of the present case, the ‘memory device’ could be interpreted to be used as an abbreviation of the ‘semiconductor memory device,’ the amendment did not correspond to the addition of a new matter.”

In response to this, the demandant for the invalidation trial filed an appeal with the Supreme People's Court for a retrial of his case. In the retrial, while the Supreme People's Court pointed out errors in the grounds of the decision of the High Court, in conclusion it upheld the second-instance decision. The essential points of the decision were as follows.

“The judgment of the second-instance court to the effect that the ‘memory device’ in the claims was an abbreviation of the ‘semiconductor memory device’ is erroneous. The ‘memory device’ in the description is used as a generic idea of the ‘semiconductor memory device.’ However, from the disclosures of the description, drawings and claims of the present case, a person skilled in the art could easily conceive of using other memory devices and replacing the ‘semiconductor memory device’ with them, and could deduce that the invention of the present case can be applied to the ink cartridge using a non-semiconductor memory device in the same way. Hence, the amendment does not exceed the scope described in the initial description, etc.”

In addition, the decision explains the general judgment standard on Article 33 of the Patent Law as follows.

“The scope described in the initial description and

claims should include the content clearly expressed literally and graphically in the initial description and attached drawings, and claims, and the content directly and clearly deduced by a person skilled in the art from all of the initial description and attached drawings, and claims, and as long as the deduced content is clear to a person skilled in the art, the content should be found to be included in the scope described in the initial description and claims.”

This judgment made by the Supreme Court is significant, since it indicates a tendency to widen the “scope described in the initial description and claims” in the judgment of Article 33 of the Patent Law from the “only scope that can be determined” to a “scope that can be reasonably determined” based on the disclosures of the initial description, etc. Almost simultaneously with the case, a similar judgment was also made public in the case of “amlodipine irbesartan compound preparation” (ruled by the Supreme People’s Court on October 8, 2011).

3. Study

In Japan, on the basis of a decision of the Intellectual Property High Court on May 30, Heisei 20 (2008), the Patent Office announced that “consistency with the Grand Panel decision will be made without changing the examination practice based on the existing Examination Guidelines.”

It remains doubtful whether or not the concrete amendment examination practice at the Japanese Patent Office conforms to the court practice concerning the amendment in court. In fact, even after the revision of the Examination Guidelines, in the lawsuits for cancellation of trial decisions in court, there are examples in which the trial decisions on the amendments made by the Patent Office were cancelled.

However, it can be said that in Japan, the standard of the Grand Panel decision of the Intellectual Property High Court was promptly adopted in the Examination Guidelines, at least formally. In Japan, courts and the Patent Office are different organizations in the judiciary and administration, but the courts can exert influence over the practice of the Patent Office by

passing judgment on the trial decisions made by the Patent Office in the lawsuits for cancellation of trial decisions.

On the other hand, independence of the Intellectual Property Office from courts is relatively high in China, and in general, even a decision by the Supreme Court is not readily reflected in the Guidelines for Examination. Hence, it can hardly be said that the above decision rendered by the Supreme Court is readily reflected in the examination practice. However, it is well known that the courts have demonstrated the tendency to relax the judgment standard of Article 33 of the Patent Law. If in the process of obtaining Chinese patent protection, an applicant faces the problem of unavoidable violation of amendment requirements, it is worth remembering that there is a chance that the way will be opened up if s/he directly contacts the examiner by phone and consults him on an acceptable amendment and cites the above court view in a written argument. In the invalidation trials, the number of cases in which the trial decision is invalidated on the grounds of the violation of Article 33 of the Patent Law is still high. However, we would like to add that if the applicant files an administrative lawsuit and the case is reviewed in a second-instance trial or further retrial, there is a chance that the judgment of the trial decision may be overturned.

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*This article was provided in cooperation with Shangcheng & Partners, in Beijing, China. She used to be a member of our firm and currently works for the Chinese patent firm.

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