

Reflections on Several Issues of Claim Combination in Invalidation Proceedings

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Amendment by way of combination is an important means a patentee takes to keep a patent right valid in the invalidation proceedings. This article is meant to analyse and explore issues stemming from amendment by way of combination in the invalidation proceedings and make recommendations on the design of the system for making amendments by way of combination and on the amendment to the provisions of the Guidelines for Examination pertaining to the matter.

To ensure the stability of granted patents and certainty of claims published in the Patent Gazette to allow the general public and rightholders to reasonably expect, to an extent, the consequence of exploitation, use, licence and assignment of the patent right, patentees are stringently restricted in making amendments to documents published upon patent grant in the invalidation proceedings. That is, as is provided for in section 4.6, Chapter 3 of Part 4 of the Guidelines for Examination¹, the amendments are allowed only to delete or combine claims and delete technical solutions. For that reason, the amendment by way of combination has been

so preferred by more and more patentees that it turns into their strong shield to protect their patent against any invalidation allegation. In practice, however, it is often seen that patent examiners and judges handling such cases and interested parties hold widely different views on amendment by way of combination. This article is intended to look into the issues, one by one, arising from the amendment by way of combination and present our views and make recommendations with regard to the design of the future system in respect of amendment made to patent documents in the invalidation proceedings.

Amendment by way of combination: issues and analysis

1. Amendment by way of multiple combination

Under section 4.6.2, Chapter 3 of Part 4 of the Guidelines for Examination, two or more claims mutually irrelevant but belonging to one independent claim of the granted patent may be combined together. During the invalidation proceedings, if an allegedly invalid patent contains multiple dependent claims, the patentee often not only combines the dependent claims directly and indirectly referring to a deleted independent claim, but also re-organises the claims directly and indirectly referred to by way of combination thereof on the basis of the new independent claim. For example, the patentee first combines two dependent claims together to replace the original independent claim, then multiply combine the remaining claims, and re-organise the referential relations among the claims. Amendments made this way result in claims in a ladder distribution. This amendment by way of multiple combination affords a system of multiple protection absent in the original claims. This new framework is good to avert attack with grounds for invalidation, and allows the patentee to take an advantageous position to deal with potential invalidation requests and make future infringement claims.

Following are some cases to demonstrate this point.

Case 1

It was a method patent relating to a crystal of compound X. The description disclosed two types of crystals, type C and type D. Type-C crystal was derived from lower alcohol, the mixture of lower alcohol and water, or that of lower alkyl ketone and water. The published granted claims went as follows:

“1. A method for preparing crystal of compound X, comprising said crystal separated from compound X liquid in a solvent.

2. The method according to claim 1, wherein said solvent is a lower alcohol, the mixture of lower alcohol and water, or that of lower alkyl ketone and water.

3. The method according to claim 1, wherein said solvent is stirred at the temperature ranging from -5°C to 40°C.

4. The method according to claim 1, wherein the crystal seeds for crystallisation are added to said solvent.

5. The method according to claim 1, wherein the crystal is type - C crystal.

6. The method according to claim 1, wherein the crystal has roughly the following matrix interval:”

In the invalidation phase, the requester requested to invalidate claims 1 and 2 on the grounds that claim 1 did not possess inventiveness and that claim 2 was not clearly presented. In response, the patentee amended the claims by taking the original claim 5 as new independent claim 1 and correspondingly made changes in the order of the other claims and their referential relations. The amended claims went as follows:

“1. A method for preparing type-C crystal of compound X crystal, comprising said crystal separated from compound X liquid in a solvent.

2. The method according to claim 1, wherein the crystal has the roughly following matrix interval:

3. The method according to claim 1 or 2, wherein said solvent is a lower alcohol, the mixture of lower alcohol and water, or that of lower alkyl ketone and water.

4. The method according to claim 1 or 2, wherein said solvent is stirred at the temperature ranging from -5°C to 40°C.

5. The method according to claim 3, wherein said solvent is stirred at the temperature ranging from -5°C to 40°C.

6. The method according to claim 1 or 2, wherein the crystal seeds for crystallisation are added to said solvent.

7. The method according to claim 3, wherein the crystal seeds for crystallisation are added to said solvent.

8. The method according to claim 4, wherein the crystal seeds for crystallisation are added to said solvent.

9. The method according to claim 5, wherein the crystal seeds for crystallisation are added to said solvent.”

In the amended claims, two claims referred to multiple claims. Further combination may result in multiple claims referring to other multiple claims, namely, said claims 1, 2 and 3 would remain unchanged; claims 4 and 5 were combined to be claim 4; and claims 6-9 were combined to be claim 5.

Issue

The aforementioned amendments are ones made by way of combination under the Guidelines for Examination. By virtue of multiple combination and re-organisation of the original dependent claims, the patentee came up with a set of claims with the scope of protection in a ladder distribution, quite different from that of the patented claims. Besides, the number of the claims increased from 6 to 9. It might be sup-

posed that in the presence of tens or even a hundred of claims, the amendment in this way would exponentially increase the number of the amended claims. It needs to be pointed out that the Guidelines for Examination do not set forth any provision to prohibit increase in the number of claims after amendments are made to the claims in the invalidation proceedings.

In section 4.2 on examination of amended text in the reexamination phase, Chapter 2 of Part 4 of the Guidelines for Examination provides that it is usually contrary to the provision of Rule 60, paragraph one, of the Implementing Regulations of the Patent Law for a reexamination requester to “increase the number of the claims”. In other words, in the reexamination phase, it is not allowed to “increase the number of the claims”. As a rule, an interested party should not be given more freedom to amend his patent documents than he has in the reexamination proceedings. Accordingly, it is obviously unjustifiable for any amendment impermissible in the reexamination phase to be accepted in the invalidation proceedings.

Anyway, by playing the “game” of the above amendment by way of combination, the patentee can create such an extremely complicated maze of claims that it is difficult for any panel to see its structure without making tremendous efforts. In some cases, determination of claims upon amendment by way of multiple combination is difficult in the panel examination.

Analysis

The invalidation proceedings are created to rectify undue patent grant by the State Intellectual Property Office (SIPO). In this phase, the Patent Reexamination Board (PRB) functions mainly to determine whether a granted patent right is valid or not. Allowing a patentee to amend, by way of combination, the patent documents during the invalidation proceedings under the Guidelines for Examination is mainly for the purpose of keeping the stability of the patent right and striking a balance between the interests of the public and those of the patentee. However, if amendment by way of combination resulting in a new independent claim may be understood as a rectification of any error in a patent right grant, then, re-organising the original dependent claims to create a new “work of defence” and a system for the multiple laddered protection of the patent has undoubtedly deviated from the intended purpose of allowing a patentee to amend his patent documents during the invalidation proceedings. While from the perspective of protection and encouragement

of invention-creation, giving a patentee more opportunity and flexibility to amend his claims does not go against the legislative aim of the Patent Law, the patentee is also obliged to take the consequence of his or its erroneous disposal during the prosecution. Therefore, the opportunity should not be unlimited, but to the extent where the patentee would not abuse it.

To prevent and stop abuse of the amendment by way of combination, the writers would like to suggest, in the absence of express provisions in the Pertinent Law and the Guidelines for Examination², that the provisions pertaining to the substantive reexamination and invalidation proceedings² be referred to, and that restriction be imposed on the way of amendment by way of combination applicable to the extent that it is allowed for the sole purpose of rectifying the defects involved in the invalidation grounds. Meanwhile, as for combination of dependent claims that are not dependant on one another, it is necessary to take, as the precondition, deletion of the independent claim the dependent claims refer to; besides, combination is allowed only where the combined dependent claims are also deleted. In other words, any dependent claim complying with the provisions of the current Guidelines for Examination is allowed to be involved only once in the amendment by way of combination. The dependent claims that referred to the combined dependent claim in the original claims should be allowed to be amended in terms of referential relations since the claims referred to do not exist in the new claims any more.

2. Amendment by way of combination and addition of grounds for invalidation

section 4.2, Chapter 3 of Part 4 of the Guidelines for Examination provides: “where a requester gives more grounds for invalidation a month from the date on which he filed his request for the invalidation, the PRB will generally not consider them, except under the following circumstances:

(i) where more invalidation grounds are given, regarding claims the patentee has amended by way of combination, within the time limit specified by the PRB, and the added ground presented within the time limit are specifically specified; ...”

As the preceding provisions show, in respect of unamended claims, the requester has no opportunity to give more invalidation grounds in the invalidation proceedings. But in the practical examination process, if some claims are not amended and their dependent claims are new claims upon amendment by way of combination, then, under some

circumstances, when more invalidation grounds are presented in respect of these new dependent claims, it would unavoidably affect claims that are referred to but not amended.

Case 2

The claims are substantially the same as those involved in case 1, so they are not elaborated here.

The requester requested to invalidate claim 1 of the patent on the ground that said claim did not possess inventiveness. After the patentee changed the original claim 5 into new independent claim 1 and got the new claims 2-9 upon re-ordering the other claims and changing the referential relations among them, the requester presented more invalidation grounds regarding the amended claims:

(i) the amended claim 1 was contrary to the provisions of Article 22, paragraphs two and three, and Article 26, paragraph four of the Patent Law;

(ii) the amended claim 2 was contrary to the provision of Rule 20, paragraph one, of the Implementing Regulations of the Patent Law; and

(iii) the amended claim 3 was contrary to the provisions of Article 22, paragraph three, of the Patent Law and Rule 20, paragraph one, of the Implementing Regulations of the Patent Law.

Case analysis

Since the amended claim 1 was claim 5 of the granted patent, the requester did not have any chance to present new ground in respect of it. That is, his added ground that said claim was contrary to the provisions of Article 22, paragraphs two and three, and Article 26, paragraph four, of the Patent Law should not be considered any more. However, since the amended claims 2-9 were those resulting from amendment by way of combination, the requester could present new grounds of invalidation; hence, the PRB should examine the requester's new invalidation grounds that claim 2 was contrary to Rule 20, paragraph one, of the Implementing Regulations of the Patent Law and claim 3 was contrary to the provisions of Article 22, paragraph three, of the Patent Law and Rule 20, paragraph one, of the Implementing Regulations of the Patent Law.

In examining whether claim 3 conformed to Article 22, paragraph three, of the Patent Law, if the panel held it did, then it was not logically problematic not to consider the ground that claim 1 was contrary to Article 22, paragraph three, of the Patent Law. However, if the panel held it questionable, and it was to be found out, whether claim 3 conformed to Article 22, paragraph three, of the Patent Law or

the panel held claim 3 contrary to Article 22, paragraph three, of the Patent Law, then the panel would have to find out *ex officio*, whether claim 1 was contrary to Article 22, paragraph three, of the Patent Law, which resulted in objectively giving the requester a chance to present a new invalidation ground in respect of the amended claim 1 (i.e. the original claim 5). This was contradictory with the provision of the Guidelines for Examination on the time limit for presenting more invalidation grounds and difficult to meet the policy requirement for expedited prosecution.

In addition, under this circumstance, the panel would be in a real dilemma:

(i) if the panel disregards the requester's new invalidation ground raised in respect of the new claim 1, then, in the oral hearing, the panel need, on the one hand, to notify the two parties that the requester's new invalidation ground raised in respect of the new claim 1 (including Articles 22, paragraphs two and three, and 26, paragraph four, of the Patent Law) for non-compliance with the provision on one-month time limit of the Guidelines for Examination, and, the panel, on the other, have to notify them again that it would investigate the matter, *ex officio*, of whether claim 1 conforms to Article 22, paragraphs three, of the Patent Law. Clearly, the two notifications appear to be questionable for only the patentee is disregarded.

(ii) if the panel consider the requester's new invalidation ground raised in respect of the new claim 1, it obviously goes against the provision of the Guidelines for Examination.

(iii) if the panel only consider compliance with Article 22, paragraph three, not Articles 22, paragraph two, and 26, paragraph four, of the Patent Law, then it seems logically problematic for the same claim to be treated differently on the basis of different invalidation grounds.

3. Amendment, made by way of combination on one's own initiative, to claims that are not involved in the invalidation grounds

A patentee is allowed to amend his patent documents for the purpose of rectifying defects of said patent as mentioned in, and in response to, invalidation grounds raised by an invalidation requester. In the practical examination process, however, a patentee, in addition to making corresponding amendments to the claims the invalidation grounds related to, often amends, by way of combination, to claims that are not involved in the grounds raised.

Regarding a patentee's amendment to patent documents made on his own initiative in the invalidation phase,

the Patent Law does not set forth any pertinent provisions. But regarding an applicant's amendment to his application documents made on his own initiative in the reexamination phase, Rule 60, paragraph one, of the Implementing Regulations of the Patent Law provides: "the person making the request may amend his or its application However, the amendments shall be allowed only to remove the defects as pointed out in the decision of rejection of the application, or in the notification of reexamination". In other words, if an applicant amends the claims that the rejection decision or reexamination notification does not pertain to, the amendment will be deemed to be unacceptable for non-compliance with the provision of Rule 60, paragraph one, of the Implementing Regulations of the Patent Law. A patentee's own amendment by way of combination to the claims which does not pertain to and which is not to rectify the defects mentioned in said invalidation ground, nor to resolve dispute with the requester. To be precise, he is making use of amendment by way of combination to build a "work of defence". This seems, to an extent, to deviate from the original aim of allowing a patentee to amend his patent documents in the invalidation proceedings. Besides, it seems logically unjustifiable for an amendment unallowable in the reexamination proceedings to become acceptable in the invalidation phase.

4. Combination of technical solutions

It is provided in section 4.6.2, Chapter 3 of Part 4 of the Guidelines for Examination that "by combination of claims is meant that two or more claims not dependent on each other but dependent on the same independent claim in the published text of the granted patent are combined together. Under this circumstance, all the technical features of the dependent claims are combined together to constitute a new claim. The new claim shall contain each and every the technical feature of the dependent claims combined. The dependent claims dependent on the same independent claim shall not be allowed to be combined together where the independent claim is not amended".

As regards claims drafted with complicated reference involved, any amendment by way of combination made in the invalidation phase often interweaves with deletion of some claims or technical solutions (referred to as amendment by way of deletion in the following sections). In case like this, amendment by way of combination is not combination of claims in a strict sense. To be precise, it should be referred to as combination of technical solutions.

Case 3

The involved claims went as follows:

1. A weedicide composition, characterised in that it comprises component A as active ingredient and component X as a carrier.
2. The composition according to claim 1, characterised in that it also comprises component B.
3. The composition according to claim 1 or 2, characterised in that it also comprises component C.
4. The composition according to claim 1 or 2, characterised in that it also comprises component D.
5. The composition according to claim 4, characterised in that it also comprises component E.
6. A method according to claim 1 for preparing composition 3, characterised in that it mixes the components with the carrier."

In the invalidation phase, the requester argued that claims 1-6 of the patent did not possess inventiveness, and requested to declare the entire patent invalid. The patentee amended the claims by deleting claim 1 and using claim 2 as a new independent claim, combining claims 3 and 4, and also changing the reference of claim 5. The amended claims went as follows:

"1. A weedicide composition, characterised in that it comprises components A and B as active ingredient and component X as a carrier.

1. The composition according to claim 1, characterised in that it also comprises components C and D.
2. The composition according to claim 1 or 2, characterised in that it also comprises component E.
4. A method according to claim 1 for preparing a composition, characterised in that it mixes the components with the carrier."

Analysis

As shown in the analysis of the technical features of the claims before and after the amendment (for the sake of convenience, carrier X is deleted here) was made, the amended claim 1 is equivalent to the original claim 2; the amended claim 2 to the combination of the technical solution of the original claim 2 the original claims 3 and 4 refer to; the amended claim 3 comprises two technical solutions, of which technical solution 2 is equivalent to the combination of the technical solution of claim 2 the original claim 3 refers to and that of the original claim 5.

Given that the Guidelines for Examination do not prohibit use of all the three ways of amendment together, a combination of the technical solutions should, therefore, be construed

as a special amendment by way of combination of claims under the Guidelines for Examination, namely an allowable way of amendment within the framework of the current Guidelines for Examination.

5. New claims arising from amendment of referential relations

A new claim arising when amendment by way of combination is made to some claims, the amendment made only to the referential relations of other claims, may be, or may not be, a combination of claims. As in the case in the preceding case 3, the amended claim 3 includes solutions 1 and 2, of which solution 2, comprising components A, B, C, D and E, is equivalent to the combination of the technical solution of claim 2 the original 3 refers to and that of the original claim 5; but solution 1, merely a simple combination of the additional technical features of the original claims 2 and 5, comprises only components A, B and E, and does not comprise all the technical features of the original claims 2 and 5; hence it is not an amendment by way of combination under the Guidelines for Examination.

Under the Guidelines for Examination, the fate of the above technical solution is entirely different. But, without considering whether the amendment has gone beyond the disclosure contained in the original application (that is, suppose that all the amendments are found to be based on the original application), strictly speaking, be it a combination of the claims or technical solutions, or simple combination of the technical features shown in the above case 1, the two amendments are substantially the same as shown below. First, the two amendments meet the four amendment rules under section 4.6.1 of Part 4 of the Guidelines for Examination, which should be the basic principles followed in amending patent documents in the invalidation proceedings; and second, the two amendments have generated a new technical solution absent in the granted claims from the recombination of the original features of the claims, which could be protected by the original patented claims through amended referential relations in the prosecution (for example, claim 5 of the granted claims may be written as claim 2 or 4). Besides, it has the same role in the invalidation proceedings. With the amendment rules of the Guidelines for Examination met, it seems not justifiable for any different treatment to arise just because the two amendments are not the general amendment provided for in the Guidelines for Examination.

6. Circumstances where amendment by way of combi-

nation is not allowable

In practical examination, there are many circumstances where amendments by way of combination are not allowable.

Case 4

The granted patent related to a method for preparing product A, comprising two steps of hydration and isomerisation, wherein hydration takes place in the presence of Reney Ni catalyst, the mole ration between H_2 and reactant is 2.0-3.0:1, the hydration temperature can be 30-100°C, preferably 40-60°C. The part of the claims as published was as follows:

“1. A method for preparing product A, comprising step (a) hydration and step (b) isomerisation.

2. The method according claim 1, wherein hydration takes place at 30-100°C in the presence of Reney Ni catalyst.

3. The method according claim 1, wherein hydration takes place at 40-60°C and the mole ration between H_2 and reactant is 2.0-3.0:1.”

In the invalidation phase, the patent amended the claims in the following two ways:

Amendment 1:

“1. A method for preparing product A, comprising step (a) hydration and step (b) isomerisation, wherein hydration takes place at 30-100°C or 40-60°C in the presence of Reney Ni catalyst and the mole ration between H_2 and reactant is 2.0-3.0:1.”

Amendment 2:

“1. A method for preparing product A, comprising step (a) hydration and step (b) isomerisation, wherein hydration takes place at 40-60°C in the presence of Reney Ni catalyst and the mole ration between H_2 and reactant is 2.0-3.0:1.”

Analysis

While amendments 1 and 2 are both based on the original application, they do not contain all the technical features of the original claims 2 and 3, so they are not amendment by way of combination. Under the current Guidelines for Examination, they are not allowable. In this case, if the hydration temperature, catalyst, and the mole ration between H_2 and reactant are all technical features necessary to work said invention and the requester's request for invalidation on the ground that claims 1 to 3 lack these technical features, contrary to Rule 21, paragraph two, of Implementing Regulations of the Patent Law, then, it is impossible for the patentee to amend the invention by way of amendment to the claims.

Thus, while amendment by way of combination provided for in the Guidelines for Examination is to give an applicant a

chance to correct errors in the drafted patent application, when the claim falls under the circumstance of the above case 2, i.e. the claims dependent on one independent claim defines different extent of protection of the same technical feature, it is impossible for the patentee to make an amendment by way of combination, in the sense of the Guidelines for Examination, to said dependent claim since all the technical features of the dependent claims, however piled up, cannot make the new claim include all the technical features of the combined dependent claims. But, for inventions of the chemical-pharmaceutical field, be they process or product claims, this is a common way to draft claims; hence, one should be very careful if he amends his claims by way of combination in the field.

Recommendations on system

In conclusion, amendment by way of combination is an innovative measure introduced when the Guidelines for Examination were under amendment to seek balance between the interests of the patentees and those of the public at large. But as the practical examination of some cases show, implementation of the provisions of the Guidelines for Examination concerning amendment by way of combination have brought about various problems and puzzlement.

The European opposition proceedings are equivalent to the invalidation proceedings in China. The EPC 123 (2) and (3) have provided for the principle underlying amendment. That is, any amendment made in the opposition proceedings should not go beyond the original application, and amendment to the claims should not broaden the extent of protection. This principle has been elaborated in Chapter 4 of Part 4 of the Guidelines for Examination under EPC, in which it is provided that amendment should proceed according to the grounds on which opposition is raised³.

The U.S. Re-examination proceedings, equivalent to the invalidation proceedings in China, are divided into *ex parte* and *inter parte* procedures, in which a patentee may amend the claims, specifications and appended drawings. But, such amendments made should not bring in any new content, nor broaden the extent of the claims (except amendments made to the claims through certificate re-issue procedure within two years from the patent grant); new claims may be added, but any subject matter surrendered in the previous proceedings cannot be reclaimed in subsequent proceedings by way of amendment.

The Japanese Patent Law provides that after a patent is granted, the patent documents may be amended through correction and invalidation proceedings. Under Articles 126, paragraphs three to five, and 134bis, paragraph five, of the Japanese Patent Law, in the two proceedings, the correction should not go beyond the disclosure contained in the original application, nor substantially broaden or alter the scope, and an invention including the special matters presented in the amended claims is independently patentable at the time of patent application. To be specific, the amendments are limited to: (1) narrowing down the scope of the claims; (2) correcting errors or mistranslations; and (3) clarifying unclear matters.

The requirements concerning amendment of granted patent documents in the three nations are relatively more lax and flexible than those in China. In the current practical situation in China, however, especially in the major field of technology (as in the field of pharmaceutical chemistry) having a bearing on people's life, it is now not ripe to take the similar lax policy of those nations in treating amendments made to granted patent documents. For that reason, it is the writers' hope that, with the current legislative framework remaining unchanged, the series of issues brought about by the amendment by way of combination will be addressed by amending the principles and ways of amendment in the Guidelines for Examination.

On the basis of this, the writers would like to make the following recommendations.

Recommendation 1:

Within the current legislative framework, the Guidelines for Examination is to be revised by doing away with the specific limitation of the mode of amendment by way of combination, that is, it is no longer provided that a patentee's amendments made in the invalidation proceedings "are limited to deletion or combination of the claims and deletion of technical solutions". Besides, the principle of amendment to patent documents in the invalidation proceedings in section 4.6, Chapter 3 of Part 4 of the Guidelines for Examination is to be changed into the following:

"Amendment to invention or utility model patent documents shall be limited to the claims, with the following principles followed:

(i) it shall not go beyond the scope of the disclosure contained in the original description and claims; and not broaden the scope of protection of the original patent compared with the granted claims;

(ii) it shall not change the title of the subject matter of the original claims;

(iii) it shall generally not add any technical feature that is absent in the granted claims;

(iv) it is to rectify the flaws pointed out in invalidation grounds; or

(iv)' it shall be directed to deletion of technical solution or any other amendment made to the claims involved in the invalidation grounds, with exception to amendment by way of combinations that results in changed extent of protection since such claims refer to each other."

The above (iv) and (iv)' are something added thereto, and both are presented here for one to choose from. Besides, the order of the "four principles" are changed. Technical features existing in the claims are allowed to be incorporated in the amended claims. But, the primary examination principle is that amendment must be made according to the application documents, with strict limitation on the applicability of amendments by way of combination. Now, some panels focus too much on determination of amendment by way of combination, and simplistically believe that if amendment by way of combination is tenable, it naturally meets the requirements of the four principles under the Guidelines for Examination. This is a practice of attending to trifles to the neglect of essentials. The practice of cancellation of amendment restrictions and strict application of amendment will make it more possible for patentees to remedy their patent right, and help protect invention-creations, maintain the stability of the patent right, and prohibit misuse of amendment.

Recommendation 2:

With the requirements of the Guidelines for Examination concerning the ways of making amendment remaining unchanged, adding limitation to amendment (mainly to the amendment by way of combination) is here suggested, which is at least good for addressing the issue of misuse of amendment by way of combination. To be specific, it is suggested changing the first paragraph of section 4.6.2, Chapter 3 of Part 4 of the Guidelines for Examination into the following:

With the preceding amendment principles met, amendment made shall be limited to the claims involved in the invalidation grounds, with exception to amendment by way of combination that results in changed extent of protection since such claims refer to each other. Amendment made to the claims still be limited to deletion or combination of claims and deletion of technical solution." ■

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¹ With special reference, the Guidelines for Examination mentioned in the article refer to the Guidelines for Examination as of 2006.

² The Guidelines for Examination should also provide that matters that are not expressly provided for in the invalidation proceedings, reference may be made to provisions in other parts of the Guidelines for Examination. This principle is mentioned in several places in the Guidelines for Examination, which avert the dilemma of lack of applicable provisions.

³ Section 5.3, Chapter IV of Part D of the EPC Examination Guidelines.

References:

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The U.S. Patent Act and Guidelines for Examination.

The EPC and Part D of the Guidelines for Examination in the EPO.

The Japanese Patent Law and Guidelines for Examination.