

# How to Clear up Examiners' Doubt about Excessive Amendments to Patent Applications

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How to understand the Patent Law provision relating to amendments going beyond the initial scope of an application (the “excessive amendments” for short) has long been a difficult issue drawing incessant debate in the IP community. Responding to an examiner's excessive amendment doubt or challenge, a patent attorney normally makes a simple reply by trying only to seek support from the initial description and claims. Considering that the State Intellectual Property Office (SIPO) has been more stringently abide by the relevant standards, perhaps it would be very difficult for any simple counter-claim or defence made in response to an Office Action to be accepted by an examiner.

This article will start with an interpretation of the law provision relevant to excessive amendment, to develop a new line of thinking to clear up examiners' doubt about excessive patent amendments through comprehensively analysing the technical solution presented in the description.

## Introduction

Article 33 of the Patent Law provides that an applicant has the right to amend his patent application, and also limits the content and scope of the amendment: the amendment to the patent application should not go beyond the scope of

disclosure contained in the initial description and claims (that is, the amendment should not exceed the initial scope).

How to apply Article 33 of the Patent Law in the substantive examination is further elaborated in Section 5.2.1.1, Chapter 8 of Part 2 of the Guidelines for Patent Examination as of 2010:

“When examining the amended documents submitted by the applicant, the examiner must strictly abide by the provisions of Article 33. Whether the applicant amends the application on his own initiative or in direction to the defects indicated in the Office Action, the amendment to the application shall not go beyond the scope of disclosure contained in the initial description and claims.”

The impact of this provision is that examiners are nearly harsh or relentless in their observance of the “excessive amendment” standard. No matter when and how (by way of addition of any feature, combination of claims, or even deletion of any feature) an amendment is made, so long as the amended feature literally differs from that presented in the initial application, an examiner would invariably find the amendment contrary to Article 33 of the Patent Law, issue an Office Action requiring the applicant to make further amendment, or even decide to reject the application. In practice, overstepping the substantive patenting requirements related to novelty and inventiveness, Article 33 of the Patent Law has become the provision recited most frequently in the patent prosecution and the most important one on the basis of which patent rejection decisions are made. Consequently many abnormal phenomena have emerged: examiners reject applications on the ground that an amendment an applicant has made on his own initiative is contrary to Article 33 of the Patent Law even before examining the patent application as to the substance in relation to novelty and inventiveness; while they examine the patent application as to the substance in relation to novelty and inventiveness, if an applicant makes amendment to his application in response to an examiner's opinion to render the application novel or inventive, the examiner concludes, upon making another examination, that the amendment is contrary to Article 33 of the Patent Law, and issues another Office Action or decides to reject it.

Making amendment is the commonest means applicants use in the period of patent examination to secure the patent right, and the cases are rare where inventions are patented without any amendment made thereto. Considering the legal consequences of excessive amendment, at any rate, applicants would try to keep their amendment from go-

ing beyond the initial scope. Nevertheless, as mentioned above, in the phase of patent examination, it is a rather common phenomenon for amendment made to patent applications to be found excessive. Let's make a comparison with the patent examination practice in the United States. While the US Patent Act has also set forth provisions limiting patent amendments similar to Article 33 of the Chinese Patent Law, it only disallows addition of “new matter”, and excessive amendment cases are rare in the patent examination practice there.

Evidently, the issue of excessive amendment has become a focal issue of debate in the patent community in China mostly for the reason of gravely different understanding of the relevant law provisions and technical solution.

## Interpretation of law provisions relevant to excessive amendment

As shown in Article 33 of the Patent Law, there are two essential standards for finding excessive amendment: (1) presence of literal presentation in the initial description and claims; and (2) possibility to directly and undoubtedly identify what is literally presented in the initial description and claims.

Usually, in the Office Action it is also first directly determined that the feature is not clearly mentioned in the initial description and claims, and then direct concluded that the amended feature cannot be directly and undoubtedly derived from the disclosure of them.

Standard (1), very direct and definite, causes no controversy among patent practitioners.

By contrast, standard (2) is understood and viewed entirely differently in the community, and observance and application of the standard is always a focal issue of debate among applicants, patent attorneys and examiners.

In practice, it is often the case that clearing up excessive amendment doubt or challenge proceed around standard (2). Unfortunately, in most situations, applicants and patent attorneys are used to seeking literal support in the initial description and claims, and invariably consider presence of literal errors in their response to Office Actions. Faced with an examiner's challenge, an applicant can do nothing but assert that his amendment is directly and undoubtedly identifiable from the initial description and claims, without making a more detailed analysis. It is perceivably hard for his reply to

be accepted by the examiner.

The Patent Law is a harmonious, coherent whole, with the Articles set forth therein inherently interrelated. Article 59 of the Patent Law provides that “... the description and appended drawings may be used to interpret the claims ...”, which helps us further understand the exact meaning of “directly and undoubtedly identify” in Article 33 of the Patent Law. Guided by the principle set forth in Article 59 of the Patent Law, we may conclude that determining whether an amendment to the application, in particular to the claims<sup>1</sup>, has gone beyond the scope of the initial description and claims requires more attention to be paid to the technical solution as presented in the description, especially the role of the technical problems and technical means in interpreting the claims.

For technical solutions *per se*, all new technical solutions are generated or developed against a certain background and under certain conditions. When we need to improve the prior art, a person of skill in the art faces a practical technical problem to be solved. For this reason, all problems requiring no solution or non-essential technical features are often part of his knowledge. Whether it is mentioned in the description or not, any addition to, or further definition of, such information is directly and undoubtedly identifiable. For example, in the case of “camera” cited in the Guidelines for Patent Examination, the substance of the invention lies in the improved cloth curtain shutter of camera, and it is OK just to mention that “a camera, comprising a cloth curtain shutter ...” in the preamble portion of the claims, without the need for mentioning in the portion all other common features, such as the lens and viewfinder or any other parts of the camera. As taught by the Guidelines for Patent Examination, a person of skill in the art also knows that to be brief in the description and to enable a person of skill in the art to quickly see the point of invention, it is quite unnecessary to mention elements, such as the lens and viewfinder or any other parts in the description of an invention essentially relating to the cloth curtain shutter of a camera because there is no camera without lens and viewfinder. But if the description of the invention is amended by mentioning the lens and viewfinder, a person of skill in the art would not think the amendment has gone beyond the initial description and claims as these features are known to us all.

According to this analysis, this write would like to suggest that the following three steps be taken depending on the circumstances when responding to an Office Action rais-

ing the excessive amendment issue:

(1) Interpreting, in detail, the technical solution;

(2) Analysing specifically how a person of skill in the art can “directly and undoubtedly identify it” on the basis of his general technical knowledge and understanding of the technical solution; and

(3) Considering the need for duly amending the application after making the technical solution clear.

If a technical solution is too long, it is better to break it into parts, and “interpreting them one by one”. Besides, if it is possible to find an example in the real world for illustration, we can achieve twice the result for half the effort.

While step (2) is doubtlessly the kernel, consistently-used means to respond to Office Actions of the kind, it is also indispensable, to interpret, in detail, the technical solution based on the practical circumstance and properly amend the application, as it facilitates the patent prosecution.

Briefly put, how to dispel an examiner's excessive amendment doubt and make it possible for him to accept the fact that an amendment is not excessive requires a patent attorney's comprehensively clarifying the technical solution, making careful reasoning and analysis, laboriously explaining why the amendment to the application conforms to Article 33 of the Patent Law. This is where a patent attorney can show his real professional skill and where his value lies.

Let's start with a case study focused on the technical solution to discuss how to respond to Office Actions with excessive amendment doubt.

The case: A patent application relating to recharging method

1) Overview of the history of amendment and Office Action

The applicant added five new dependent claims 13-17 in the main period for amendment.

It was concluded in the first Office Action that the technical solution of the added claims 13-17 was not literally presented in the initial description and claims, nor could they be directly and undoubtedly derived from the disclosure contained in the initial description and claims and the appended drawings; hence claims 13-17 were excessive amendments.

2) Applicant's reply

Step 1: Interpreting the technical solution

In the part on the Background of Technology of the description was disclosed that there is flaw in the way to recharging battery in the prior art; the prior charger was not flexible enough, and not efficient.

Hence, one of the objectives of the present invention was to provide a more flexible battery charging method and system.

To this end, the technical solution of the invention was to provide a restrictive means for adjusting electric current, by testing the input current voltage from the power source and changing electric current from said power source to keep the maximum power (voltage times electric current) from exceeding the maximum power received from said power source. To be more specific, a detailed explanation of the technical solution could be found from line 32 on page 3 to line 17 on page 4 of the description.

To be brief, the technical solution of the present invention was: changing the electric current restriction according to the tested voltage, so as to change the voltage, and changing the electric current restriction according to the changed voltage, so as to change the voltage again ..., with the action repeating again and again until the maximum electric current restriction value was achieved.

Step 2: Making adequate reasoning (including, among other things, giving examples and separating the features)

[Claim 13]

After elaborating on the technical solution of the patent application, the applicant made the following analysis of claim 13:

Claim 13 goes like this:

"13 The method according to claim 11, wherein said plurality of electric current restriction values comprise the initiate electric current restriction value, one or more intermediate electric current restriction values and the final electric current restriction value, the electric circuit disposed said electric current restriction comprising ..."

It is disclosed in lines 12-17 on P4 of the description that "if said voltage is lower than the expected value, then the current restriction can be reduced and said voltage be monitored until said voltage is increased to said expected value ..., the current restriction can be progressively reduced until the input voltage of adjuster is increased to the expected input voltage value". According to said technical feature and the technical solution of the present invention, a person of skill in the art could understand that several attempts should be made, with constant adjustment and feedback of the current restriction to gradually enable the voltage increase to the expected value. Therefore, besides the initial and final values, there possibly existed a plurality of transition values in between. This is very easy to understand: for ex-

ample, when a carpenter tries to make a piece of wood smooth, he needs to do it while calibrating the smoothness, especially so when he is about to get to the final size of it. The repeated comparison helps achieve the accurate size of the wood.

To conclude, a person of skill in the art can directly and undoubtedly identify from the initial disclosure that "said plurality of electric current restriction values comprise the initiate electric current restriction value, one or more intermediate electric current restriction values and the final electric current restriction value". For this reason, the technical feature does not go beyond the scope of the initial disclosure.

[Claim 14]

14 Said method according to claim 13, the initial current restriction value is lower than said maximum electric current of said external power source, and one or more intermediate electric current restriction values are the current restriction value progressively increased.

To make things convenient for the examination, the applicant divided the feature of claim 14 into the following two parts:

(1) The initial current restriction value is lower than said maximum electric current of said external power source; and

(2) One or more intermediate electric current restriction values are progressively increased to the current restriction value.

Part (1) is clearly mentioned in line 18 on P4 of the description: setting the current restriction to the initial level of the maximum electric current from the electric source"

For part (2), as mentioned above, "one or more intermediate electric current restriction values" can be directly and undoubtedly identified in the initial disclosure. The feature can be directly and undoubtedly identified according to the feature disclosed in line 25 on P4 of the description that "the current restriction can be progressively increased until the input voltage of adjuster is increased to the expected input voltage value.

Step 3: Making proper amendment

In this case, the applicant did not amend claims 1-14; instead, he deleted claims 15-17.

## Conclusion

Patent examination, involving combination of natural science with social science, is a process of according right to invention-creations made in the former by means of the lat-

ter. In the course of patent examination, the key is to understand the kernel subject matter of an invention, and flexibly apply the law provision to each patent application. When one reads a patent application, it is important to keep in mind the legislative aim, understand the essence of an invention from the technical perspective, rather than pay attention only to the literal meaning, and mechanically apply the law, or even turn the examination into a word game.

A patent attorney is required to correctly understand the legislative aim of each law provision, and, even more importantly, the technical solution of an invention. His own failure to deeply understand the implication and substance of an invention, with attention paid only to the literally expressed content of an application, would make it impossible to protect the inventor's lawful rights and interests, nor show his value as an attorney. Therefore, starting from the technical solution and responding and clearing up any excessive amendment challenge by way of construction of the technical solution *per se* is one of the important professional skills of all patent attorneys.

A patent examiner should also review the excessive amendment issue from the perspective of protection of the patentees' lawful rights and interests<sup>2</sup>. Whether an amendment made to a patent application is allowable or not should be determined with account taken of whether the interests of the rightholder and those of the public are knocked out of balance and whether the first-to-file system is observed. For

this reason, during the examination procedure, he, finding it hard to make a choice when faced with an applicant's amendment, may consider the matter in line with the legislative aim. That is, is it possible for the applicant to be given some extra benefits or interests, or to impair the public interests if an amendment is found permissible? And is it possible to keep the interests of the rightholder and those of the public in balance? When the amended content of an application is not directly, literally expressed in the initial description and claims, the examiner may specifically analyse the matter along the line of thinking elaborated in this article, and should not determine, in a simplistic manner, that the content of the amendment can not be directly and undoubtedly identified.



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<sup>1</sup> In practice, most amendments are made to the claims, and rarely to the description.

<sup>2</sup> As Yang Tiejun, Vice-Commissioner of the SIPO especially emphasised, in a recently published article entitled Correctly Understanding Legislative Aim and Nurturing Patent Examination Culture, that "it is biased and undue to understand the law provision by deviating from the legislative aim thereof as this will result in mechanical and one-sided application of it."