

Definition and Determination of Obvious Substantive Defects in Reexamination *ex officio*

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In recent years, patent applicants and examiners hold different views on the scope of examination in the reexamination phase, especially on the scope of examination *ex officio* of obvious substantive defects in patent applications. Lack of clear definition of “obviousness” of the “obvious substantive defects” in the reexamination phase in the Guidelines for Patent Examination results in too much discretion of examiners in their examination *ex officio* of obvious

substantive defects, which causes great debates

In a patent administrative case recently closed in 2013, the Beijing No. 1 Intermediate People's Court and the Beijing Higher People's Court, both concluding that the inventiveness ground the Patent Reexamination Board (PRB) introduced or cited during the reexamination fell outside the scope of “obvious substantive defects” subject to its examination *ex officio*, have addressed the issue in the two court

decisions, and developed their specific judicial opinions on the issue.

To date, it seems that absence of clear definition of the “obvious substantive defects” in the Guidelines for Patent Examination is likely to result in “loss of level of adjudication” for some cases. Regarding the matter, the writers will make recommendations on theoretical and practical terms under the Guidelines for Patent Examination as of 2010, the recent case law and relevant laws of the U.S. and EU, and in the light of relevant published works in an attempt to establish a workable standard for determining “obvious substantive defects”.

I. Basis of and issues with examination *ex officio* in patent reexamination procedure

It is provided in the Guidelines for Patent Examination that “in the reexamination procedure, the panel normally examines only the grounds and evidence on which a decision of rejection is based.

In addition to the grounds and evidence on which a decision of rejection is based, where the panel finds the text of the application being examined has one of the following defects, it may examine the grounds and evidence related to the defect, and if the panel confirms the existence of the defect after examination, it shall make a decision to uphold the rejection decision on the basis of said grounds and evidence:

(1) the defects for which it is sufficient to reject the application on the basis of other grounds and evidence of which the applicant has been notified before rejection; or

(2) the defects which are not indicated in the decision of rejection but are obvious and substantive, or of the same nature with those indicated in the decision of rejection.”¹

As the provision shows, the patent reexamination proceedings generally follow the principle to examine rejection grounds and evidence of decisions, the examination *ex officio* being an exception.

During examination *ex officio*, debates are rare on defects (1) and the latter circumstance of defects (2).

Debates are focused on the former circumstance of defects (2), namely on “the defects which are not indicated in the decision of rejection, but are obvious and substantive”. In practice, patent applicants often contend that new

grounds given by the PRB are not “obvious substantive defects”. In the Guidelines for Patent Examination, the “obvious substantive defects” are defined by virtual of the following example:

“For example, where the decision of rejection indicated that claim 1 did not involve an inventive step, and the panel, after examination, found that the claimed subject matter was obviously a perpetual motion machine, it shall make a reexamination decision to uphold the decision of rejection on the ground that the claim is not in conformity with Article 22, paragraph four, of the Patent Law.”²

In this example, the “practical applicability of perpetual motion machine” is viewed as “an obvious substantive defect”. But the Guidelines for Patent Examination does not cite in this Chapter any other sections as grounds on which “obvious substantive defects” are found. In practice, the PRB generally does not limit itself to the “practical applicability” provision, but conducts examination *ex officio* and cites the sections on inventiveness and description support as the grounds for rejecting applications in which “obvious substantive defects” are found, thus causing disagreement between the PRB and patent applicants.

II. Provisions of the Guidelines for Patent Examination relating to “substantive defects” and analysis thereof

1. It is provided in the part on preliminary examination of the Guidelines for Patent Examination as follows:

“(2) Examination of obvious substantive defects in application documents, including whether or not the application obviously falls into the scope prescribed in Article 5 or 25, or is not in conformity with the provisions of Article 18; or 19, paragraph one; or 20, paragraph one, or is obviously not in conformity with the provisions of Article 2, paragraph two; 26, paragraph five (1); 31, paragraph one; or 33 of the Patent Law, or Rule 17 or 19 of the Implementing Regulations of the Patent Law”³

In addition, provisions listed in the Guidelines for Patent Examination as to “obvious substantive defects” include Articles 2, paragraph two; 5; 20, paragraph one; 25; 31, paragraph one; and 33 of the Patent Law; and Rules 17 and 19 of the Implementing Regulations of the Patent Law.⁴

All the provisions concerning “obvious substantive de-

fects” mentioned above, (such as Articles 5 (on non-compliance); 25 (on subject matter); 2, paragraph two (on presence of technical solution); 26, paragraph five (on source of genetic resources); 31, paragraph one (on unity of invention); 33 (on amendment going beyond original scope of disclosure) of the Patent Law, and Rules 17 (on forms of drafted description); 19 (on forms of drafted claims) of the Implementing Regulations of the Patent Law are not related to prior art search, in-depth claim construction or comparison between claimed subject matter and scope of disclosure, except those on matters of procedure and qualification irrelevant to creation-inventions (e.g. Articles 18 on foreigners); 19, paragraph one (on foreign-related agents or agencies); 20, paragraph one (on examination as to confidentiality) of the Patent Law.

Besides, an interested scholar has interpreted the examination directed to “obvious substantive defects” made during the preliminary examination of applications for invention patent as follows:

“It needs to be pointed out that the preliminary examination, in principle, does not touch upon substantial matters; hence, said substantive defects should be limited to those that are “obvious”, by which it means that an examiner for preliminary examination can make determination upon reading the patent application and according to his expertise in law and the relevant technology with no need of making in-depth inquiry for support. Any other substantive defects are not necessarily to be dealt with during the preliminary examination, and can be left to be treated in the phase of the substantive examination.”⁵

This shows that the word “obvious” of the “obvious substantive defects” in the phase of preliminary examination should be embodied as determinable with no need for making an in-depth inquiry.

2. It is provided in the part on substantive examination of the Guidelines for Patent Examination as follows:

“Where no circumstances described in Rule 53 exist in the application; or although there are substantive defects falling into the circumstances described in Rule 53, the application has the prospect of being granted the patent right after making amendments, for the sake of economy in procedure, the examination of whether all the other provisions of the Patent Law and its Implementing Regulations are complied with shall be conducted by the examiner as well.”⁶

In it “substantive defects” are interpreted as being of the circumstances mentioned in Rule 53 of the Implementing

Regulations of the Patent Law.

Additionally, the Guidelines for Patent Examination also offers a concept of “serious substantive defects”:

“In order to accelerate the examination procedure, the Office Actions shall be as few as possible. Therefore, the comprehensive observations of the examiner, either on substantive or formal matters, shall be described in the first Office Action unless the application under examination has no prospect of being granted the patent right due to serious substantive defects (such as those circumstances described in Sections 4.3 and 4.8 of this Chapter) or the examiner intends to postpone the examination for lack of unity in the application.”⁷

In Sections 4.3 and 4.8, Chapter 8 of Part II of the Guidelines for Patent Examination cited here, the “serious substantive defects” are defined as specific “substantive defects”, referring particularly to 1) substantive defects detectable without the need for search⁸, or 2) those for which no patent should be granted whatever amendments are made thereto⁹, in which “without the need for search” means the circumstances where it is impossible for patenting even if they are new inventions, with no need for considering whether they are disclosed in the prior art. These circumstances include: invention-creations against the law, invention-creations relating to non-patentable subject matters, such as mental activities or method for medical treatment, invention-creations that are not technical solutions, invention-creations that lack practical applicability, such as perpetual motion machine, and completely unclear patent applications.

The above shows that in the phase of substantive examination, “substantive defects” refer to the provisions that render a patent application rejectable, while “serious substantive defects” refer to the “substantive defects” that meet the above specified conditions or requirements, namely a specific concept of “substantive defects”, corresponding to a part of provisions likely to render patent application rejectable. Furthermore, the circumstance in which determination of “serious substantive defects” is made is similar to that of “obvious substantive defects” in the phase of preliminary examination, that is, decision may directly be made, requiring no in-depth inquiry and construction of the technical solution and the claims.”

III. Courts’ opinions

The above views held in the Guidelines for Patent Ex-

amination and by some scholars are also reflected in the decision made by the Beijing No. 1 Intermediate People's Court¹⁰ mentioned at the beginning of this article. In the case, the Patent Office rejected the application on the ground of "amendment going beyond the disclosure", and the PRB sustained the rejection decision by changing the ground into "lack of inventiveness". The patent applicant argued, in the administrative litigation, that "the substantive examination did not involve the issue of inventiveness, nor did the Patent Office examine the inventiveness-related matters, such as technical problem, technical motivation, and technical effect, who did not make explanation and determination in relation to the common knowledge." Additionally, the patent applicant, based on the definition of "obvious substantive defects" in the Part on Preliminary Examination of the Guidelines for Patent Examination, submitted that the inventiveness examination did not involve "obvious substantive defects". The court of trial agreed, upon hearing the case, with the applicant that the provisions of the Guidelines for Patent Examination relating to "obvious substantive defects" in the phase of preliminary examination did not apply to the inventiveness examination, and concluded that the PRB's view that the inventiveness issue fell within the "obvious substantive defects" lacks legal ground. What's more, the trial court found that the PRB's claim, made on the grounds for saving the interested parties' time and avoiding repeated examination in the phases of substantive examination and reexamination, that its reexamination lacks legal ground, either. In the end, the trial court pointed out that while Section 2.4, Chapter 1 of Part IV of the Guidelines for Patent Examination provided that the PRB could examine a case *ex officio*, subject to no limitation in terms of grounds or evidence from an interested party, this did not mean that the PRB could conduct examination *ex officio* within a scope subject to no limitation under any law and regulations. It was on this ground that the court ruled to have reversed the reexamination decision and remanded the case.

In the appeal, the Beijing Higher People's Court upheld the first instance judgment¹¹. While confirming the ground on which the first instance judgment was made by the court of trial, the Beijing Higher People's Court further interpreted the scope of "obvious substantive defects" in the reexamination phase, concluding that while the Guidelines for Patent Examination did not clearly define the "obvious substantive defects", it was somewhat improper to refer only to the definition made in the part on preliminary examination. The Beijing

Higher People's Court pointed out that the circumstances under which patent applications should be rejected during the substantive examination had been provided for in Rule 53 of the Implementing Regulations of the Patent Law, but it was improper for the PRB to have defined, as it wished, the scope of "examination of obvious substantive defects" simply under this provision. Rather, the PRB should stringently confine the application of the "examination of obvious substantive defects" on a case-by-case basis following the basic principles of avoiding loss of level of adjudication and acting on the request of interested parties, and taking the examination *ex officio* as an exception, so as to safeguard the legitimate rights and interests of patent applicants and ensure the essential character of the reexamination proceedings. In the case, the PRB submitted clearly that the (former) rejection ground was overcome, but the rejection decision was sustained on the inventiveness ground, which was not a matter the PRB had to refer to when reviewing the rejection decision, nor an issue that could be derived without in-depth inquiry and verification according to the knowledge of those skilled in the art; therefore, the inventiveness issue directly introduced by the PRB in the case fell outside the scope of "obvious substantive defects". Accordingly, the court of appeal ruled to have upheld the trial court decision.

While the decision made by the court of appeal did not clearly define the "obvious substantive defects" in the phase of substantive examination as that in the preliminary examination phase, it shows that the Beijing Higher People's Court defines the substantive defects that are verifiable according to the knowledge of those skilled in the art without the need for making in-depth inquiry as "obvious substantive defects". This standard is consistent with the aforementioned interpretation of the provisions related to the preliminary examination.

IV. Relevant European and U.S. Provisions

The U.S. law does not define the scope of new grounds that may be introduced during the reexamination, that is, it is possible to add any rejection ground in the reexamination period. But when an applicant amends the claims or presents new evidence, that is, once the facts of a case change, it is imperative to send the application back to the substantive examination department to be examined again to fully

ensure the applicant's procedural rights¹².

In Europe, the scope of reexamination is, in principle, limited to the ground on which a former decision was made, so as to ensure the applicant's procedural rights¹³.

V. Following the hearing principle during reexamination should not be viewed as non-loss of level of adjudication

Provisions on “the principle of avoidance of loss of level of adjudication” in the reexamination proceedings were set forth as early as in the Guidelines for Patent Examination as of 2001 to prevent the PRB from making reexamination beyond the prescribed scope thereof under the Guidelines for Patent Examination to such an extent as to bypass the substantive examination department to directly examine any new rejection ground as this would otherwise cause procedural loss on the part of the applicant. To address the fuzzy relations between “the principle of avoidance of loss of level of adjudication” and the “principle of procedural economy”, the provision on “the principle of avoidance of loss of level of adjudication” has been removed or deleted from the 2006 version and the later versions of the Guidelines for Patent Examination.

Absence of “the principle of avoidance of loss of level of adjudication” in the Guidelines for Patent Examination does not mean that the principle is no longer applicable. During the reexamination, the PRB often raises new rejection ground and requires a patent applicant to make defence in response, and the applicant is compelled to make defence within the time limit therefor to make sure that his application would not “be deemed to be withdrawn”. In the subsequent procedure, the PRB then notes that since the patent applicant has been given an opportunity to make defence directed to the new ground, upholding the rejection decision on the new ground does not result in an applicant's actual loss of right. The view has been implicitly affirmed by the court in the judicial practice.

The writers deem that, this view has mixed the “hearing principle” up with “the principle of avoidance of loss of level of adjudication”. In other words, the view only means that the reexamination decision has followed the “hearing principle”. That is, the PRB has, during the reexamination, given a patent applicant an opportunity to make defence for the new ground. In spite of this, there is still loss of level of adjudica-

tion for lack of examination of the new ground by the SIPO during the substantive examination, nor an opportunity given to a patent applicant to make observations directed to the new ground. Under the provisions of the Guidelines for Patent Examination¹⁴, during the substantive examination and reexamination, examiners must, or are required to, notify an interested party and give him an opportunity to make observations and amendments. In other words, a rejection ground goes through two phases: rejection and reexamination, and in each phase, a patent applicant is given at least one opportunity to be heard. For this reason, the view that loss of level of adjudication has been prevented on the ground that an opportunity for hearing has been given during the reexamination is obviously not based on the Guidelines for Patent Examination.

Furthermore, only one month is allowed for an applicant to make defence during the reexamination, which is half the time, namely two months, given for the same purpose during the substantive examination.

Besides the less time for making defence during the reexamination, there are fewer ways for a patent applicant to amend his application. Under the provisions of the Guidelines for Patent Examination, the limitations on ways of amendment are more stringent during reexamination than those in the substantive examination¹⁵.

Therefore, giving the applicants only one opportunity for making defence and amendment during the reexamination would not make up for the time sufficient for making defence and choice of amendment that should otherwise be given or allowed during the substantive examination. For these reasons, excessive determination of “obvious substantive defects” made *ex officio* actually deprives an applicant of the procedural rights he is entitled to.

VI. Comprehensive analysis

The examination on grant of a patent right is a complicated multi-level process, in which examination of substantive defects requires constructing the technical features of the claims, interpreting terms used in the claims, and comparing the claims with prior art or the claimed subject matter with the disclosure in the description, to mention just a few. For example, in assessing novelty and inventiveness, an examiner is required to construe the claimed subject matter, then read reference(s), understand the technical solution disclosed and the technical motivation in the reference and even the

technical effect of the reference; as for support by the description, an examiner is required not only to construe the protection scope of the claims, but also to go over all the specific embodiments disclosed in the description, and comprehensively determine whether the claims are supported by the description according to the information reasonably derived from the description. Examinations of the type all involve substantial determination of the claimed protection scope, and to this end, in-depth inquiry and verification are required. It is very difficult to consider the rejection grounds concerning this information to be “obviously” verifiable substantive defects.

Determination may be made of some other substantive defects defined in the provisions, such as inventions against law, devoid of practical applicability, and relating to non-patentable subject matter, and it does not require identifying the claimed protection scope and reading references, and not to grant the patent may even be decided only by looking at the title of the invention, as is the case with “perpetual motion machine”, “gambling machine”, and “method of medical treatment”, to name just a few. Relative to the previous inventiveness ground, these grounds are viewed as being relatively “obvious”.

This shows that it is possible to divide substantive defects into two types: “obvious” substantive defects and “non-obvious” substantive defects. For the former type, if they are not commented during the substantive examination, they may be directly examined *ex officio* by a panel during the reexamination; as for the latter, they may be left for the substantive examination department to deal with as they involve construction of the specific technical solution, and fall outside the scope of preliminary examination.

Following is a further analysis of the determination of “obvious substantive defects” during the reexamination on the theoretical and practical levels.

1. Theoretical level

On the theoretical level, “obvious substantive defects” should be understood according to the direct literal meaning, that is, they are readily visible”. For each rejection ground, there are circumstances that are easy to be found. For example, where an application is rejected on account of inventiveness matter, while the wording of “unclear” is used in the rejection ground, the PRB, after the defect of lack of clarity is overcome, finds that the clarified claims are only slightly different from the prior art as described in the background technology portion of the description, or almost identical with the technical solution disclosed in the application examined the day before in an extreme case. Take for another example, where an application is rejected on account of description support matter, while the ground is “unclear”, there still exist, in the clarified claims, total non-correspondences with the description (e.g. a table vs. a chair) or opposite technical solutions (e.g. eastward vs. westward) during the reexamination. All these are circumstances based on which we can easily draw a conclusion without the need for making in-depth inquiry.

Therefore, in finding “obvious substantive defects”, there is no reason to rule out some rejection provision from the scope of applicability, rather the obvious defects identified in each rejection ground should be determined again on a case-by-case basis and by an express standard. The standard should be set by following the general principle of determination without the need for in-depth inquiry for a skilled person, and directed to each rejection provision to separately define “the obvious”. For example, as for the matter of support by the description, only when the claims are not consistent with the description in terms of the subject matter of the invention (e.g. a table vs. a chair), is it not necessary to make an in-depth inquiry; hence the defects are “obvious”; or only when the defining feature that is obviously opposite to what is disclosed in the description (e.g. eastward vs. westward) is found, the defect is “obvious”. As for inventiveness, only if the difference between the claims and the reference has been recognised as prior art in the portion on background technology of the description, the defect can be found to be “obvious” without the need for making an in-depth inquiry. By the same token, it is necessary to put in place the most rational standard of “obviousness” in direction to each rejection provision to attain an ideal definition of the “obvious substantive defects”.

2. Practical level

On the practical level, however, it is relatively difficult, in practice, to put in place a detailed standard for determining “obviousness” for each provision, and very difficult to be 100% precise or accurate. To be specific, when putting in place a standard for determining “obviousness” for each ground, besides analysing all the circumstances of it according to the legislative aim of all the law provisions and the examination practice, its relations with law provisions under which rejection is decided should also be considered. For example, when a rejection decision is sustained also on the inventiveness ground, if in the rejection decision the same

reference is cited for the rejection on account of novelty, then relative to the circumstance of merely using the ground of “amendment going beyond the disclosure” in the rejection decision, it is more likely for the defect to be found “obvious”. For another example, determination of common knowledge is very much related to the personal experience and dependence on the determination standard of an examiner. Therefore, it is very difficult for all the detailed standard of every law provision to be 100% precise or accurate.

Additionally, the operability of the provisions of the Guidelines for Patent Examination is also very important. Take the “obvious substantive defects” in the preliminary examination part or the “serious substantive defects” in the substantive examination part as an example, it is impossible to cover all possible circumstances by theoretical analysis of the provisions. To make it possible for the requirements of these provisions to embrace the most circumstances and remain operable, in the Guidelines for Patent Examination the method of listing the specific provisions is used when defining the “obvious substantive defects” during the preliminary examination and “serious substantive defects” during the substantive examination. Therefore, we might as well consider using the same method for examination of “obvious substantive defects” during the reexamination on the practical level.

To be specific, on the practical level, it is still possible to consider to follow the general principle of “no need for in-depth inquiry”, and select some of the rejection provisions for ruling out (defects), say the inventiveness defects. It is possible to refer to the standards of the “obvious substantive defects” during the preliminary examination and “serious substantive defects” during the substantive examination, that is, it is not necessary to work on the claim construction, nor to compare the claims with reference (including understanding of the reference (s)), nor to compare between the claimed protection scope and the scope of disclosure, nor even to consider the protection scope of the claims. On this basis, at least the most controversial law provisions in relation to novelty, inventiveness and support by the description should be ruled out. Further, lack of essential technical features is generally not an “obvious” problem as it involves analysis of the object of technology and integrity of technical solution; nor is the matter of clarity, which is likely to involve use of the description to construe the claims. As discussed above, while making the division is likely to leave out some “obvious” circumstances, normally the extreme circum-

stances of “obviousness” will not be left out in the rejection decision, and would not cause burden on the examination before the Patent Office even when they are sent back as they are rare to happen. By contrast, this division can ensure that patent applicants will not suffer from loss of level of adjudication, and better protect their legitimate rights and interests.

VII. Conclusion

To conclude, under the provisions of the Guidelines for Patent Examination, the grounds on which a rejection decision has been made should serve as the general principles in patent reexamination procedure, with the examination of new grounds introduced *ex officio* taken as an exception. As a circumstance of examination conducted *ex officio*, the PRB may introduce and examine “obvious substantive defects that are not pointed out in a rejection decision”, and introduce new grounds to sustain a rejection decision. However, absence of express definition of “obvious substantive defects” during the reexamination in the Patent Law and its associated Implementing Regulations, and presence of some definition of “obvious substantive defects” during preliminary examination and substantive examination in the Guidelines for Patent Examination cause doubts by patent applicants on what are the “obvious substantive defects” during the reexamination in particular cases. If the PRB examines, *ex officio*, “obvious substantive defects that are not pointed out in a rejection decision”, and makes its reexamination decision to sustain a rejection decision on the new ground(s), which substantially is (are) not “obvious substantive defects”, then the PRB’s examination made *ex officio* would, without any doubt, result in “loss of level of adjudication” the patent applicant is entitled to, and is likely to have impact on their procedural and statutory rights. Based on the analysis made in this article, the writers would like to recommend duly defining the examination of “obvious substantive defects” made *ex officio* in patent reexamination procedure. To be specific, it is recommended that the “grounds that are derivable according to the knowledge of a person skilled in the art without the need for making in-depth inquiry” may be taken as the general standard for determining “obvious substantive defects”; and then, for example “being unnecessary to determine the claimed protection scope” may be taken as the specific standard, and some specific rejection provisions may be chosen from all such rejection provisions with refer-

ence to the scope of the provision on rejection during the preliminary examination and substantive examination to serve as the basis for determining or identifying “obvious substantive defects”. It would therefore be unnecessary for the PRB to refer to or cite provisions other than those within the above scope as new grounds on which to make examination *ex officio*. While improving the operability of the “obvious substantive defects” examination *ex officio*, the examination made this way, will safeguard the legitimate rights and interests of patent applicants and ensure the essential character of the reexamination proceedings. ■

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¹ Section 4.1, Chapter 2 of Part IV of the Guidelines for Patent Examination as of 2010.

² Ibid.

³ Section 1, Chapter 1 of Part I of the Guidelines for Patent Examination.

⁴ Section 7, Chapter 1 of Part I of the Guidelines for Patent Examination.

⁵ Yin Xintian, A Detail Explanation of the Patent Law, the Publishing House of Intellectual Property, 2011, P.446.

⁶ Section 4.7, Chapter 8 of Part II of the Guidelines for Patent Examination.

⁷ Section 4.10.1, Chapter 8 of Part II of the Guidelines for Patent Examination.

⁸ Section 4.3, Chapter 8 of Part II of the Guidelines for Patent Examination:

“4.3 Where all the subject matters of an application obviously fall into the circumstances described in Chapter 7, Section 10 of this Part, the examiner may issue the first Office Action without making any search.”

Section 10, Chapter 7 of Part II

Subject matters for Which Search is Not Required

It is not necessary for the examiner to make the search if all the subject matters of an application fall into one of the following circumstances;

(1) falling into the circumstances mentioned in Articles 5 and 25 according to which no patent right shall be granted for the application;

(2) contravening Article 2.2;

(3) lacking practical applicability;

(4) the description and claims fails to set forth clearly and completely the subject matters of the application so that a person skilled in the art cannot carry it out.”

⁹ Section 4.8, Chapter 8 of Part II of the Guidelines for Patent Examination:

Usually, for the sake of procedural economy, the comprehensive examination shall be performed for an invention application in accordance with Section 4.7 of this Chapter.

However, where there exists a serious defect in the application which is not in conformity with the provisions of the Patent Law and its Implementing Regulations, i.e., when there exist defects falling into the circumstances listed in Rule 53, and that it is impossible to grant the patent right to said application, the examiner may not conduct the comprehensive examination on said application. He only needs to indicate the substantive defects which lead to the conclusion of examination in the Office Action, at this time, it is of no sense pointing out the less important substantive defect and/or formal defect in the application.

¹⁰ The Beijing No. 1 Intermediate People’s Court’s Administrative Judgment No. Yizhongzhixingchuzi 2876/2011.

¹¹ The Beijing Higher People’s Court’s Administrative Judgment No. Gaoxingzhongzhi 1486/2012.

¹² Section 1213.02 of the U.S. Manual of Patent Examining Procedure (MPEP) on Patent Appeals and New Rejection Grounds of the Intervention Board.

¹³ The Boards of Appeals of the EPO pointed out in Section E. Appeal procedure in Chapter 7. Proceedings before the EPO of Case Law of the Boards of Appeal that:

1. Legal character of appeal procedure

These characteristics of the appeals procedure not only serve as criteria when assessing whether a provision may be applied analogously in individual cases; they also have general legal consequences in many respects. It follows from the characteristics set out by the Enlarged Board that the general principles of court procedure, such as the entitlement of parties to direct the course of the proceedings themselves (“principle of party disposition”), also apply to appeals (see G 2/91, OJ 1992, 206; G 8/91, G 8/93, OJ 1994, 887; G 9/92 and G 4/93), that a review of the decision taken by the department of first instance can, in principle, only be based on the reasons already submitted before that department (G 9/91, G 10/91).

¹⁴ Section 2.2, Chapter 8 of Part II of the Guidelines for Patent Examination; Section 2.5, Chapter 1 of Part IV of the Guidelines for Patent Examination.

¹⁵ See Section 4.2, Chapter 2 of Part IV of the Guidelines for Patent Examination on Limitation on Amendment during Reexamination, and Section 5.2, Chapter 8 of Part II on Limitation on Amendment during Substantive Examination.