

Probe into Jurisprudence of “Essential Technical Features”

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Rule 20.2 concerning essential technical features of the Implementing Regulations of the Patent Law (hereinafter referred to as “the Implementing Regulations”), also known as the provision of “lack of essential technical features” in the IP community, is a statutory ground for rejection and invalidation of patents during examination procedures. Why is there such a provision? What are its legislative intent and function? China’s IP community has never paid enough attention to such an issue. In the examination practice, examiners tend to be rather arbitrary towards the application of the said provision. Although it is required in the Guidelines for Patent Examination that when judging on whether an independent claim lacks essential technical features, examiners should take the entire description into account and make determination in a manner as objective as possible according to the technical problems intended to be addressed, it is still hard for them to accurately grasp the gist of the said provision in practice. For instance, when the claims describe the protection scope thereof in general terms, instead of “repeating” the embodiments of the description, which provision should be taken as priority in the application, Article 26.4 or 22 of the Chinese Patent Law, or Rule 20.2¹ of the Implementing Regulations? Different examiners will make various choices. Opinions in this regard are varied even in the Patent Reexamination Board. Excess application of Rule 20.2 of the Implementing Regulations is apt to cause disputes in practice. This writer attempts to find a solution to the said issue on the basis of jurisprudential explorations with a combination of specific cases.

I. Legislative history of the “essential technical feature” provision

The “essential technical feature” provision has been existing in the Implementing Regulations of 1984, 1993, 2001 and 2010.

Rule 21.2 of the Implementing Regulations (1984) provides “an independent claim shall reflect the technical solution of an invention or utility model as a whole and recite essential technical features necessary for achieving the purpose of the invention or utility model”.

This provision remained unchanged in the Implementing Regulations (1993).

This provision still survived in the Implementing Regulations (2001) with some specific expressions amended as appropriate so as to accord with amendments to other provisions, wherein “for achieving the purpose of the invention or utility model” was amended to “for solving the technical problem thereof”, that is, “an independent claim shall reflect the technical solution of an invention or utility model as a whole and recite essential technical features necessary for solving the technical problem thereof”.

This provision was renumbered as Rule 20.2 in the Implementing Regulations (2010).

It is noteworthy that in the Implementing Regulations of 1984 and of 1993², the essential technical feature provision was not listed as a ground for rejection of the grant of patent right, not to say a ground for invalidation. Required by the examination practice, the State Intellectual Property Office adopted the Fourth Announcement of the Guidelines for Patent Examination, supplementing the said provision into the legal bases for rejection during substantive examination. The said provision was incorporated as a ground for rejection and a ground³ for invalidation at the time of the second revision to the Implementing Regulations of 2001.

II. Function of the “essential technical feature” provision

Viewing from the legislative system, Rule 20.2 regarding the “essential technical feature” is stipulated in the Chapter of “Application for Patents” in the Implementing Regulations,

wherein Rules 17 to 23 provide for the formality requirements for patent application documents, to be specific, Rule 17 is a provision regarding eight parts of the description; Rule 18 regarding drawings; Rules 19 and 20 regarding claims; Rule 21 regarding independent claims; Rule 22 regarding dependent claims; and Rule 23 regarding an abstract. Why is only Rule 20.2 considered as a ground for rejection and for invalidation? From the perspective of legislative techniques, Rule 20.2 of the Implementing Regulations should be treated as advocated norms⁴, which refer to norms that encourage or advocate people to perform or not to perform some acts under certain conditions, also known as encouraging norms or guiding norms. Professor Wang Yi also called advocated norms as “suggested norms”⁵, indicating that “suggested norms advocate and induce civil subjects to adopt a certain mode of conduct, and reduce or avoid the potential risks that civil subjects may come across during civil activities”. As for patent drafting, Rules 17 to 23 of the Implementing Regulations definitely function to guide the applicants to draft application documents in a standard manner, and particularly to remind the applicant, when drafting an independent claim, of “reflecting the technical solution of an invention or utility model as a whole and reciting the essential technical features necessary for solving the technical problem thereof”, that is to say, the content that is considered to be essential for an invention shall be included into an independent claim, whereas inessential technical features should not be included therein. Hence, on the premise that Rules 17 to 23 of the Implementing Regulations are all suggested norms, it is legislatively illogical to simply take Rule 20.2 as the ground for rejection that pertains to a compulsory norm, which can be further proved by the fact that the said provision was not regarded as the ground for rejection in the Implementing Regulations of 1984 and 1993.

Additionally, in view of the hierarchy, it is rather rare in the legislative practice of various countries with regard to the patent law to take some provisions stipulated in the Implementing Regulations as substantive grounds for rejection, or in other words, to provide grounds for rejection in “the implementing regulations” or “rules”⁶ and it is also a manifestation of immaturity of legislative techniques. Viewing from the legislative history of the Chinese Patent Law, there is a tendency to reduce such an immature approach as much as possible. For instance, the Implementing Regulations of 1984 only provided that Rule 2 can be deemed as a ground for rejection; Rule 12.1 (namely, for any identical invention-

creation, only one patent right shall be granted) was added as the ground for rejection to the Implementing Regulations of 1993; Rule 20.1 regarding lack of clarity, Rule 21.2 and Rule 43.1⁷ were added to the Implementing Regulations of 2001; since Rules 2 and 13.1 of the Implementing Regulations (2001) have been incorporated into the amended Patent Law, only Rules 20.1 and 43.1 of the existing Implementing Regulations of 2010 still serve as the grounds for rejection. Such change shows that fewer and fewer provisions of the Implementing Regulations are used as grounds for rejection.

Some people might worry about whether the application short of essential technical features may be “indulged” if Rule 20.2 of the existing Implementing Regulations does not serve as the ground for rejection. This article intends to probe into the aforesaid issue from a comparative perspective.

III. Comparative study

Comparison is a good way to make a distinction between things. The patent laws of developed countries or regions all expressly stipulate that a claim should clearly indicate the scope sought for protection. However, no provisions in relation to essential technical features are set forth therein. The concept of essential technical features is at best mentioned when interpreting some provisions of the Patent Law in the Guidelines for Patent Examination.

1. U.S.

It is a popular view in the western patent system that a description is formed earlier than claims, which explains the reason that claims often occur after the description. 35. U.S.C. §112⁸ (which is named as “specification requirement”) is one of the grounds for rejection, wherein the first paragraph sets forth clear requirements for description and claim drafting, i.e., “the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention”;⁹ the second paragraph provides that “the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention”.

In the Manual of Patent Examining Procedure (MPEP),

Section 2164.08 entitled “Critical Feature Not Claimed” is expressed in a way much similar to the provision that “a claim lacks essential technical feature” in the Chinese Patent Law. It was provided at the very beginning that “a feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. 112”,¹⁰ “in determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical”,¹¹ and “limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended”.¹²

2. Europe

Article 84 of the European Patent Convention (EPC) provides that “the claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.” The Guidelines for Examination in the European Patent Office provides interpretation of the aforesaid article, that is, if the technical features essential for carrying out an invention, or indispensable to the solution to a technical problem are not recited in an independent claim, then the claim is unclear and noncompliant with the provision of Article 84 of the EPC. Thus, in the event that a claim lacks essential technical features, the claim is rejected under Article 84¹³ of the EPC for “lack of clarity in the claim”.

The book “Case Law” compiled by the European Patent Office introduces two cases T115/83 and T32/82, which indicated that Article 84 of the EPC should be interpreted in a meaningful manner that can not only comprehend the said claim from the technical point of view, but also define clearly the subject matter of the invention, that is, all technical features essential to the invention thereof should be recited. All technical features related to the technical problem the said invention is intended to solve should be regarded as “essential technical features”. Case T582/93 (HYMO) told us that an applicant can include non-essential technical features in the claims; and an applicant has the freedom to make a claim with a scope narrower than what is legally allowed.

Although there are no provisions in the EPC dealing

with the circumstance that an independent claim lacks essential technical features, such a defect has been classified into the category of “lack of clarity in the claim”.

3. Patent Cooperation Treaty (PCT)

Article 6 of the PCT provides “the claim or claims shall define the matter for which protection is sought. Claims shall be clear and concise. They shall be fully supported by the description.” Rule 6.3a of the Implementing Regulations of the PCT¹⁴ stipulates that the definition of the matter for which protection is sought shall be in terms of the technical features of the invention. As for Article 6 of the PCT, paragraph 5.33 of the PCT International Search and Preliminary Examination Guidelines sets forth the provision that an independent claim should clearly specify all of the essential features needed to define the invention,¹⁵ and if such a requirement cannot be met, the said claim shall be rejected on the ground of non-compliance with the provision of lack of clarity as stipulated in Article 6 of the PCT.¹⁶

As can be seen, the provisions of the PCT are substantially identical to the approaches adopted in Europe, that is, the issue of lack of essential technical features shall be treated as the issue of whether the claim is clear.

4. Japan

Article 36(6) of the Japanese Patent Act provides¹⁷:

The statement of the scope of claims as provided in paragraph (2) shall comply with each of the following items:

- (i) the invention for which a patent is sought is stated in the detailed explanation of the invention;
- (ii) the invention for which a patent is sought is clear;
- (iii) the statement for each claim is concise; and
- (iv) the statement is composed in accordance with Ordinance of the Ministry of Economy, Trade and Industry¹⁸.

If claims are under examination in Japan, an applicant should state clearly the essential contents of the invention sought for protection; the determination of the protection scope of a patented invention should be concluded on the basis of the “statements of the scope of claims”; the determination of whether the contents stated in the claims are essential or sufficient for the invention sought for protection shall depend on its/his own will. For those reasons, it is not appropriate that an examiner considers the contents essential to the invention as recited by the applicant in the claims to be inessential; or it is also improper to conclude that some other necessary contents should be added further in case the applicant thinks the claims of the invention sought for protection have been sufficiently defined. “Due to such a

reason, the Japanese Patent Act does not take that as a basis for making a decision on rejection, raising an objection or filing a request for patent invalidation.”¹⁹

5. Taiwan, China

No provisions regarding essential technical features are found in the Taiwan Patent Law. The Second Chapter of the Implementing Regulations of the Patent Law of Taiwan is titled “Application and Examination of a Patent for Invention”, inclusive of 27 provisions ranging from Rules 13 to 39, wherein Rules 17 to 23²⁰ substantially correspond to Rule 17 to 23 of the Implementing Regulations of the Patent Law of China. Paragraph two²¹ of Rule 18 of the Implementing Regulations of the Patent Law of Taiwan provides that “an independent claim shall recite clearly the designation of the subject matter of a patent application, as well as essential technical features for an invention”. The aforesaid provision is further interpreted²² as follows in the Guidelines for Patent Examination in Taiwan:

“The scope of a patent application for invention shall be expressed by more than one independent claim; and the number thereof shall serve the purpose of being compatible with the contents of the invention. Independent claims must clearly recite the designation of the subject matter of a patent application, as well as essential technical features for an invention so as to present holistic technical features of the invention. Essential technical features are those indispensable to the solution to the problem that is intended to be solved by the invention applied for patent, constitute as a whole technical means of the invention and serve as a basis for comparison between the present invention and prior art. Technical features are structural features, elements or components, etc. for a product invention, and are conditions or steps for a process invention.”

However, it is provided in Article 46 regarding “non-patentability” and Article 71 regarding “invalidation” of the Taiwan Patent Law that no provisions of the Implementing Regulations of the Patent Law shall serve as grounds for rejection and invalidation. In that case, paragraph two of Rule 18 of the Implementing Regulations of the Patent Law can only be considered as “an examination tool”.

IV. Necessity of the “essential technical feature” provision by a method of systematic interpretation

1. Patent law should be a sophisticated and harmonic system

Patent law is a systematically sophisticated infrastructure, including both substantive provisions and procedural provisions, and covering both patent application and examination and protection of patent rights. The provisions with different functions are in close association with each other and mutually supported, which all together form an organically connected system. Thus, to study the necessity of the provision of “essential technical feature” by a method of systematic interpretation is a basic study method.

Article 59 of the Chinese Patent Law provides that “the protection scope of the patent right for invention or utility model shall be determined by the terms of the claims. The description and the appended drawings may be used to interpret the claims.” The main part of a claim consists of technical features, thus the description and the drawings have to be used as a reference in determining whether a claim lacks essential technical features. That is because “a claim formed of literal expressions describes and reflects the technical solution of an invention by means of essential technical features essential for addressing the technical problem, so as to define the scope sought for protection in a clear and concise manner. A language can only be understood in a particular context. Meanwhile, limitations of literal expressions and restrictions on text length make it impossible to present in the claims all problems to be solved by an invention, so that the description becomes necessary for specifying the technical solution to be protected in its sections of the technical field, background art, summary of the invention, brief description of the drawings and detailed description of preferred embodiments. In that regard, the Patent Law expressly stipulates the relationship between the claims and description, requiring that the description should disclose the technical solution of an invention to such a sufficient extent that a person skilled in the art can carry it out; and the claims shall be supported by the description, and define the scope sought for protection in a clear and concise manner. As required by the provisions of the patent law, the above sections of the description are indispensable to correct comprehension of the claims. The description is closely associated with claims in the sense of law. The contents of the description provide the language environment or context to the claims. The claims can only be accurately comprehended with the help of the description. It is usually impossible to comprehend the claims and terms thereof correctly and accurately simply by

reading the claims without making reference to the description and appended drawings. Claim construction is a process of comprehension and confirmation of the meanings conveyed by the claims, during the process of which the description and appended drawings should be used as a reference in order to comprehend the claims correctly.”²³

Based on the above analysis, whether an independent claim lacks essential technical features is in nature a matter of claim construction. And claim construction should not depart from the description and appended drawings. The relationship between Articles 26.3 & 26.4 and lack of essential technical features will be discussed as follows on the basis of the intimate relationship between the claims and description.

2. Relationship between Articles 26.3 & 26.4 and lack of essential technical features

Article 26.3 of the Patent Law stipulates, as the first sentence, that “the description shall set forth the invention or utility model in a manner sufficiently clear and complete so as to enable a person skilled in the relevant field of technology to carry it out; where necessary, drawings are required.”

Article 26.3 of the Patent Law is known as a “sufficient disclosure” requirement in theory. The “sufficient disclosure” requirement and “first-to-file principle” are honoured as two milestones of the patent law. The “mansion” of the patent law cannot stand firmly without those milestones. Specifically, three properties of patents, i.e. the three statutory requirements for the grant of patent right as stipulated in the Patent Law shall only be examined when the requirement of sufficient disclosure is met. In other words, an ideal patent examination goes as follows: an examiner should comprehend the details of an application, for instance, where does the invention originate from (prior art), where will the invention head for (the object of the invention), what are the technical solutions or technical means for achieving the object of the invention? Can those technical means realize the object of the invention claimed? It is only after those fundamental issues have been clarified can an examiner, by putting the claims therein under examination, turn to conduct examination on whether a technical solution “in legal clothing” is patentable in contrast to the prior art. The issue of whether a claim lacks essential technical features is in fact the issue of whether the technical solution specified in the claim is complete and clear based on the premise that the said invention has been sufficiently disclosed. The way to find out whether a claim lacks essential technical features cannot be separat-

ed from the issue whether the description is sufficiently disclosed.

Superficially, “a minimal meaning unit” in a claim is deemed as a technical feature. The fewer the number of technical features is, the broader the protection scope defined will be. Thus, an applicant’s “impulse” of reducing the number of technical features in pursuit of a broader protection scope should be prevented. However, if the disclosure of the technical solutions in a description is not sufficient enough to address the technical problem, then the solutions in the claims are unlikely to be clear and complete. If the claims still lack essential technical features in the event of sufficiency of disclosure of the description, it is in essence a matter of “the claims being not supported by the description”. An easily comprehensive view is that if the claims lack essential technical features as a result of insufficiency of disclosure of the description, it is called “the substantive defect of lack of features”, whereas if the claims lack essential technical features even if the description is sufficiently disclosed, it is called “the formality defect of lack of features”. Apparently, “the substantive defect of lack of features” is an issue of “sufficient disclosure” under Article 26.3 of the Patent Law; and “the formality defect of lack of features” is an issue that “the claims are not supported by the description” under Article 26.4 of the Patent Law, which show that the provisions of Article 26.3 or 26.4 of the Patent Law are repetitive with the provision regarding essential technical features of Rule 20.2 of the Implementing Regulations. It is worthy of discussion whether it is necessary to take Rule 20.2 of the Implementing Regulations as the grounds for rejection and invalidation.

3. The nature of the “essential technical features” provision as “an examination tool”

For this writer, although Rule 20.2 of the Implementing Regulations concurs with Article 26.3 or 26.4 of the Patent Law to some extent, it does not mean there is no value for their existence. As can be seen from the abovementioned comparative analysis, although the provision of “essential technical feature” has never been mentioned in the patent law of various countries, it occurs in the Guidelines for Examination, namely, the existence of the provision of “essential technical feature” as “an examination tool” is still of necessity in the stage of patent examination. The provision, as “a suggested norm”, guides an applicant to include the technical features that are essential in its/his view in the claims, and meanwhile reminds the applicant that non-essential technical features should not be included in the inde-

pendent claims “indiscriminately”. The Guidelines for Examination in the European Patent Office give us such an example that there is no need to mention the presence of wheels in a claim concerning a “bicycle”. A similar example of camera can also be found in the Guidelines for Examination of China, that is, there is no need to mention the presence of a camera frame in a claim concerning an improvement of a shutter. Being treated as an examination tool means an examiner may question an applicant according to Rule 20.2 of the Implementing Regulations when encountering a defect that the claims lack essential technical features. If an applicant is capable of making amendments or giving a reasonable explanation to the above issue, an examiner can proceed with the examination on that basis. Of course, an examiner may judge whether the defect of lack of essential technical features is “a substantive defect” or “a formality defect” based on his full comprehension of the description²⁴ namely, making a judgment based on Rule 20.2 of the Implementing Regulations and then coming to a conclusion under Article 26.3 or 26.4 of the Patent Law.

The practical significance of understanding the nature of Rule 20.2 of the Implementing Regulations as an examination tool is to thoroughly give up the principle of superfluity establishment, and cut off the link between Rule 20.2 and the aforesaid principle, so that Rule 20.2 will simply be confined to such a “cage” as examination stage. Once a patent application is granted and goes beyond the examination stage, the examination tool will lose its function. As for granted claims, it is presumable that every technical feature thereof is essential on the ground that the protection scope of granted claims should be “based on the contents thereof”. Hence, there is no need to consider any technical feature as inessential. The Supreme People’s Court definitely indicated in the case of Dalian Xinyi that “it should be concluded that any technical feature that is recited by a patentee into an independent claim shall be deemed as an essential technical feature and, rather than be neglected, should be included in the list of technical features to be compared. The Supreme People’s Court is not in favour of rash application of the so-called principle of superfluity establishment.”

V. Conclusion—suggestions on Rule 20.2 of the Implementing Regulations

This writer took a view that judging from the underlying theories of the Legislation Law, the Patent Law and the Im-

plementing Regulations are at different levels of the hierarchy of legislation and have their own functions. In short, the provisions regarding “essential technical features” in the Patent Law should not appear in the Implementing Regulations. In view of the patent laws in the countries/regions all over the world, the grounds for rejection and invalidation are all, without exception, stipulated in the Patent Law. The provisions in the Implementing Regulations should not serve as the grounds for rejection and invalidation. Moreover, which provisions can serve as grounds for rejection and invalidation shall be stipulated in the Patent Law, rather than the Implementing Regulations.

As mentioned above, the objects regulated by Rule 20.2 of the Implementing Regulations are “the substantive defect of lack of features” and “the formality defect of lack of features”, which are correspondingly stipulated in the relevant provisions of the Patent Law. Thus, Rule 20.2 of the Implementing Regulations should not take over the position of the relevant provisions of the Patent Law. The return of the said provision to its original function as an examination tool is irreversible. In view of that, the writer contemplates that it is urgent to give up using Rule 20.2 of the Implementing Regulations as the grounds for rejection and invalidation at the opportunity of Fourth Revision to the Patent Law. It may render the Patent Law more systematically harmonized if Rule 53 concerning grounds for rejection and Rule 65 concerning grounds for invalidation of the existing Implementing Regulations are incorporated directly into the Patent Law. ■

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¹ Rule 20.2 of the Implementing Regulations concurs with Articles 26.3 & 26.4 of the Patent Law to some extent, which will be discussed in detail later.

² Rule 53 of the Implementing Regulations of 1993 provides:

In accordance with the provisions of the Patent Law and the Implementing Regulations, the circumstances where an application for a patent for invention shall be rejected are as follows:

(1) where the application does not comply with the provisions of Rule 2.1 of these Implementing Regulations;

(2) where the application falls under the provisions of Article 5 or 25 of the Patent Law, or it does not comply with the provisions of Arti-

cle 22 of the Patent Law or of Rule 12.1 of these Implementing Regulations, or the applicant is not entitled to a patent right in accordance with the provisions of Article 9 of the Patent Law;

(3) where the application does not comply with the provisions of Articles 26.3, 26.4, 26.5, or of Article 31.1 of the Patent Law or Rule 20.2 of the Implementing Regulations;

(4) where the amendment to the application, or the divisional application extends beyond the scope of the disclosure contained in the original description and claims.

³ Rule 64.2 of the Implementing Regulations of 2001 provides:

The grounds on which the request for invalidation is based, referred to in the preceding paragraph, mean that the invention-creation for which the patent right is granted does not comply with the provisions of Article 22, Article 23, or of Article 26.3 or 26.4, or of Article 33 of the Patent Law, or of Rule 2, or of Rule 13.1, or of Rule 20.1, or of Rule 21.2 of these Implementing Regulations; or the invention-creation falls under the provisions of Articles 5 or 25 of the Patent Law; or the applicant is not entitled to be granted the patent right in accordance with the provisions of Article 9 of the Patent Law.

⁴ In the community of jurisprudence, legal norms are usually divided into compulsory norms and arbitrary norms according to the strength or rigidity of the effect of the legal norms. Such division of legal norms neglects the presence and importance of advocated norms in reality. In fact, advocated norms are present in the Constitution, Civil Law and Economic Law. Especially in the Economic Law, there is a large number of advocated norms and that number tends to rise gradually.

⁵ Wang Yi. Preliminary thoughts on the Chinese academic road to civil law. Retrieved from <http://www.romanlaw.cn/subm-6.htm> on 14 June 2015.

⁶ The Patent Law is undergoing the fourth revision. It is suggested that the grounds for rejection/invalidation should be limited to relevant provisions of the Patent Law, rather than those of the Implementing Regulations.

⁷ Rule 43 of the Implementing Regulations of 2001 provides “a divisional application filed in accordance with the provisions of Rule 42 of the Implementing Regulations shall be entitled to the filing date and, if priority is claimed, the priority date of the original application, provided that the divisional application does not go beyond the scope of disclosure contained in the original application”, which is a provision regarding a divisional application. However, the requirement of “not going beyond the scope of disclosure contained in the original application” has been contained in Article 33 of the Patent Law and should not be regarded as a ground for rejection owing to lack of rigorosity.

⁸ The U.S. has its statutory patent law found under Title 35 of the U.S. Code, so 35 U.S.C. is the U.S. Patent Law. For instance, 35 U.S.C. §112 refers to Article 112 of the U.S. Patent Law.

⁹ The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

¹⁰ A feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. §112.

¹¹ In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical.

¹² Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended.

¹³ It is noteworthy that Section 5, Chapter III, Part D of the Guidelines for Examination in the European Patent Office stipulates Article 84 of the EPC is not a statutory ground for opposition, which means Article 84 of the EPC can only be used as a ground for rejection. Once an invention is granted, it cannot be opposed on the ground of the claims being unclear and not concise (the opposition procedure in Europe is similar in nature to the invalidation procedure in China, both of which are remedy procedures after being granted).

¹⁴ 6.3 Manner of Claiming:

(a) The definition of the matter for which protection is sought shall be in terms of the technical features of the invention.

¹⁵ An independent claim should clearly specify all of the essential features needed to define the invention……

¹⁶ Lack of clarity in the claim.

¹⁷ Article 36(6) of the Japanese Patent Act provides that:

第二項の特許請求の範囲の記載は、次の各号に適合するものでなければならない。

一 特許を受けようとする発明が発明の詳細な説明に記載したものであること。

二 特許を受けようとする発明が明確であること。

三 請求項ごとの記載が簡潔であること。

四 その他経済産業省令で定めるところにより記載されていること。

¹⁸ “Ordinance of the Ministry of Economy, Trade and Industry” refers to Rule 24.6 of the Implementing Regulations of the Patent Law in Japan, namely, a provision regarding the formality requirements of the claims.

¹⁹ See “Report on Monographic Study of Amendments to Implementing

Regulations of the Patent Law” (1st edition, June, 2008). Intellectual Property Press, p. 567.

²⁰ Brief description of Rules 17 to 23 of the Implementing Regulations of the Patent Law in Taiwan: Rule 17, the description; Rule 18, the scope of patent application (corresponding to “the claims”); Rule 19, technical features; Rule 20, independent claims (corresponding to “independent claims”); Rule 21, consistency of the terms in the description, scope of patent application and abstract; and Rule 22, drawings.

²¹ Article 54 of the Legislation Law of the PRC provides:

Where necessary as required by its content, a law may adopt a structure consisting of Parts, Chapters, Sections, Articles, Paragraphs, Items, and Sub-items.

The number for a Part, Chapter, Section, or Article shall be in Chinese character in numerical order, and Paragraphs shall not be numbered, the number for an item shall be a Chinese number in parenthesis

in numerical order, and the number for a sub-item shall be an Arabic number in numerical order.

²² Section 2.3.1.1, Chapter 1, Part II of the Guidelines for Patent Examination in Taiwan.

²³ Quoted from the Supreme People’s Court’s administrative ruling No. Zhixing 53-1/2010.

²⁴ The writer holds that the “substantive defect of lack of features” cannot be overcome by amending the claims, whereas the “formality defect of lack of features” can be overcome by amending the claims. Pursuant to the current examination rules, it is required to examine whether the amended claims “go beyond the scope of the original disclosure”. Suppose the amended contents can be supported by the description, there should not be a dispute over whether the amendments go beyond the scope of the original disclosure. It is a pity that examiners are still too mechanical in current examination practice.