

# Remedy for the Defect of Amendments to “Non-inventive Points” Going Beyond the Scope Based on SPC’s Judgment No. Xingtizi 21/2013

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## I. Case brief

During the substantive examination of the case involved in the Judgment No. Xingtizi 21/2013, the patentee amended “circular bolt bores” in claims 1 and 3 to “circular bores”, specified “substantially circular bore” in claim 6 as “a bore through which a connecting bolt extends”, and amended

“molding” in claim 2 to “pressing”. The Patent Reexamination Board (PRB) declared all the claims of the patent in suit invalid on the grounds that the above amendments extended beyond the scope of the original disclosure. In the verdict, the Supreme People’s Court (SPC) held that the amendment to “substantially circular bore” in claim 6 did not extend beyond the scope of disclosure contained in the original appli-

cation documents, thereby revoking the first- and second-instance judgments and the invalidation decision. The decisions in the verdict were made mainly based on the following three aspects:

### 1. The legislative intent of Article 33 of the Patent Law.

Article 33 of the Patent Law aims to balance the interests between the patent applicant and the public under the first-to-file system: on the one hand, the patent applicants are allowed to make amendments and modifications to the patent application documents to ensure that the patents can be granted for the invention-creations that are indeed inventive; on the other hand, the amendments that can be made by the patent applicants are confined to the technical information disclosed on the filing date to protect the public's reliance interest in the original patent application documents. In Article 33 of the Patent Law, the expression "the scope of disclosure contained in the original description and claims" shall be understood as all the information of the invention-creation indicated in the original description and claims, and a fixed collection of all the information of the invention-creation. This is not only the milestone of the first-to-file system but also an objective basis for the patent application to entry into the subsequent stages. The disclosure contained in the original description and claims can be particularly embodied as the content that is directly recited in words and figures in the original description, as well as its drawings and claims, and the content that can be determined by those skilled in the art according to the original description, as well as its drawings and claims.

### 2. The amendments to the patent in suit.

First, it was ruled that "circular bores" and "circular bolt bores" in the present case had different technical meanings, so the amendment from "circular bolt bores" to "circular bores" in claims 1 and 3 extended beyond the scope of original disclosure. However, in claim 6, the second connecting means 8b was in fact amended from "circular bore" in claim 1 to "circular bolt bore" which was used in the original application documents. Thus, the amendment to claim 6 would not lead those ordinarily skilled in the art into believing that the technical information indicated by the reference number 8b was different from the one as originally filed, so the amendment to claim 6 met the requirements of Article 33 of the Patent Law. Second, as regards the relationship between "molding" and "pressing", it was ruled that in the mechanical field, molding refers to the machining by means of molds or mold analogues during the pressure processing, whereas

pressing refers to the manufacturing by means of pressing, and the latter does not necessarily involve the use of molds and may include technical means such as forging or stamping. As far as those ordinarily skilled in the art are concerned, pressing is a generic concept of molding, and they have different technical meanings. The amendment from "molding" to "pressing" cannot be derived from the original application documents.

### 3. To distinguish the amendments to inventive points from those to non-inventive points.

It was ruled in the judgment that "the reason for granting an exclusive patent right to a technical solution is that it makes substantive contribution to the prior art. That the scope of the granted patent right matches the contributions made to the prior art by the technical solution is the basis for the reasonableness of the patent system." "As to the amendments to the patent application documents, Article 33 of the Patent Law does not adopt different criteria to distinguish the 'inventive points' from the 'non-inventive points'; however, one of the legislative intents of Article 33 is to try every means to guarantee that a patent is granted for an invention-creation possessing an inventive step to provide the patent applicant with the rights corresponding to his technical contributions. If the contributions made to the prior art by the whole invention-creation are disregarded just because the amendments to the 'non-inventive points' in the patent application documents extend beyond the scope of disclosure contained in the original description and claims, it may finally result in that the invention-creation possessing an inventive step is rendered unpatentable, and the interests gained by the patent applicant are obviously incompatible with the contributions the patent makes to the society, which is not only against the essence of fairness but also in violation of the legislative intent of Article 33 of the Patent Law and therefore is bad to innovation stimulation and scientific development. Hence, under the current legal framework and regime, SIPO shall actively seek for corresponding solutions and remedies to prevent patent applicants from gaining undue interests on account of the first-to-file system and meanwhile positively protect the invention-creations that are technically innovative." The judgment provided exemplary solutions to this issue, for instance, "account may be taken of setting up corresponding observations procedures during the administrative examination on patent grant and validation, and allowing patent applicants and patent holders to address such an issue by procedural routes, such as giving up the amendments

that are incompliant with Article 33 of the Patent Law in order to resume the patent application documents and the patent granted documents to be those as originally filed at the filing date, such that the invention-creation possessing an inventive step can be prevented from losing its deserved patent that is compatible with the contributions made to the prior art just because the amendments to ‘non-inventive points’ go beyond the scope of disclosure contained in the original description and claims, which is aimed to stimulate scientific progress and innovation, and boost the economic and social development by scientific and technological support to the maximum extent”.

## II. Case analysis

In recent years, Article 33 of the Patent Law has always been a provision that is quite controversial in the intellectual property field, and the SPC alone has presented, in many cases, its opinions on such matters as the legislative intent, meaning and interpretation of Article 33 of the Patent Law. Judging from relevant decisions, even within the SPC there is no consensus reached on which criteria are applicable to judge whether the amendments go beyond the scope of original disclosure. For instance, in the judgments No. Zhixingzi 17/2011, 62/2011, 85/2011 and 54/2011, the SPC approved of the use of the examination rule of “being directly and unambiguously determined” as stipulated in the Guidelines for Patent Examination, whereas in the judgment No. Zhixingzi 53/2010, the SPC put forward the rule of “being directly and unambiguously derivable and obvious”, and further in the year of 2013, although the rule of “being directly and unambiguously determined” was re-adopted in the judgment No. Xingtizi 21/2013, the theory of distinguishing the amendments to the “inventive points” from those to the “non-inventive points” is required simultaneously.

In comprehensive consideration of the relevant views presented in above judgments, the writer held that the following aspects need to be considered upon judging whether the amendments go beyond the scope of the original disclosure or not: (1) the legislative intent or purpose of Article 33 of the Patent Law; (2) the understanding of “the scope contained in the original description and claims”, namely, the feasibility of the “determinative theory” and the “supportive theory” in theory and in practice on the basis of the judging criteria for whether the amendments go beyond the scope; (3) whether it is viable to distinguish the amendments to “in-

ventive points” from those to “non-inventive points” on the basis of the judging criteria for whether the amendments go beyond the scope, or whether there are any problems in doing so; and (4) whether it is necessary to set up a special “observations procedure” in relation to the amendments to the granted “non-inventive points” so as to remedy the loss of rights resulting from drafting or observations errors.

### 1. The legislative intent of Article 33 of the Patent Law

As stated above, the SPC has clearly expounded the legislative intent of Article 33 of the Patent Law, over which there is no dispute in the intellectual property field. What is really controversial is the understanding of the sentence that “the amendment shall not extend beyond the scope of disclosure contained in the original description and claims” as stipulated in Article 33 of the Patent Law.

### 2. The understanding of “the scope contained in the original description and claims”

The SPC expressed different views on the understanding of “the scope contained in the original description and claims” in two judgments, wherein in the judgment No. Zhixingzi 53/2010, the SPC held that “the scope contained in the original description and claims shall include the following content: one is the content that is explicitly indicated in words and figures in the original description, as well as its drawings and claims, and the other is the content that can be directly and definitely derived by those skilled in the art from the original description, as well as its drawings and claims. It can be determined that the derived content falls within the scope of disclosure contained in the original description and claims insofar as they are obvious to those skilled in the art.” However, in the judgment No. Xingtizi 21/2013, the SPC stated that “the scope of disclosure contained in the original description and claims shall be understood as all the information of the invention-creation indicated in the original description and claims, and a fixed collection of all the information of the invention-creation. This is not only the milestone of the first-to-file system but also an objective basis for the patent application to entry into the subsequent stages”, and “‘the scope of disclosure contained in the original description and claims’ can be specifically represented by the content that is explicitly indicated in words and figures in the original description, as well as its drawings and claims, and the content that can be determined by those skilled in the art from the original description, as well as its drawings and claims”.

The above two statements, though being slightly differ-

ent in expression, reflected two completely dissimilar opinions and value orientations in view of the details in the two cases, wherein the judgment No. Zhixingzi 53/2010 abides by the “supportive theory” (hereinafter referred to as the first view), namely, the allowable scope of amendments covers the content that can be “directly and unambiguously derived” by those skilled in the art on the basis of the original application documents; whereas the judgment No. Xingtizi 21/2013 abides by the “technical information determinative theory” (hereinafter referred to as the second view), namely, the allowable scope of amendments covers the content that can be “determined” by those skilled in the art on the basis of the original application documents. The similarities and dissimilarities of the two views can be simply explained by the following case.

Suppose the original application documents recite three alternative manners a1, a2 and a3 for the same technical feature, the examiner pointed out during the examination phase that the feature a3 was ambiguous. For this reason, the applicant only amended the feature a3 with the rest features unchanged. The amendments were shown in the following table:

The original description	The original claims	Amendments (amendments to claims only)	The first view	The second view
a1, a2 and a3	a1, a2 and a3	Amendment 1: A	√	×
		Amendment 2: a1, a2 and a4	√	×
		Amendment 3: a1, a2 and a3'	√	√
Note 1: suppose A in the amendment 1 is the generic concept of a1, a2 and a3; a4 in the amendment 2 is the features equivalent to a1, a2 and a3; the amendments to A and a4 are the content that can be directly and unambiguously derived from the original application documents; it is obvious that all the narrow manners (including a4) included in the generic concept A can solve the corresponding technical problems; and a3' in the amendment 3 is the content implied in the original application documents. Note 2: √ represents “allowed”, × represents “not allowed”.				

As shown in the above table, the first view and the second view are exactly the same in terms of the amendments to the content implicitly disclosed in the original application documents, with the difference lying in that the first view allows the amendments to be any equivalents that are obvious at the filing date, whereas the second view does not. The difference in fact shows the attitude towards the following two questions: (1) whether the equivalents that are obvious at the

filing date can be interpreted into the protection scope of the patent? and (2) who will bear the consequences of the drafting errors made by an applicant?

Theoretically speaking, the doctrine of equivalents is to address the problem that the emerging obvious equivalents as a result of scientific development after the filing date may render the patented invention filed at the filing date short of effective protection, and is not to rectify the errors made by the applicant when drafting the application documents. In principle, the applicant, when drafting the application documents, is expected to have solid knowledge of equivalents that are obvious before the filing date and then incorporate these obvious equivalents into the protection scope of the patent by way of exemplifying them in the application documents, in particular generalization. If the applicant knows or shall know the presence of these obvious equivalents before the filing date without explicitly reciting them in the application documents, it means that the applicant does not intend to put them under protection subjectively, in which case the public dedication rule should apply to assume that these obvious equivalents are contributed by the applicant to the mankind, just like in the case where the applicant recites some technical solution in the description, instead of the claims. This is a mainstream view regarding the application of the doctrine of equivalents in the IP field, that is to say, in determining whether infringement has occurred, equivalents that are obvious before the filing date cannot be included in the protection scope by taking advantage of the doctrine of equivalents. It also means that the applicant who erred in drafting the application documents shall bear the adverse consequences, rather than the errors after the grant of the patent by means of the doctrine of equivalents.

Under the framework of that theory, according to the rule of the first view, those solutions that should not have been protected due to the drafting errors will be incorporated into the protection scope by amending the patent documents, and in light of the rule of the second view, the applicant will bear the risk and adverse consequences brought by drafting errors.

Of course, that theory sets extremely high requirements for the drafting of the application documents. The patent system has been implemented in China for just three decades. Although in recent years, the general public's consciousness of patent protection has been increased with the promotion of the National Intellectual Property Strategy Outline, the contradiction between enhanced protection consciousness and

relatively deficient protection capabilities is increasingly intensified especially when there is great room for improvement on applicants or patent attorneys' drafting capabilities and skills. It often occurs that invention-creations cannot be protected owing to drafting errors. Under this background, the strict application of that theory may influence the realization of the aim of "encouraging invention-creations" of the patent law. The primary issue that needs to be considered at present may be how to make a reasonable compromise and variation through coordination between administrative authorities and judicial authorities without violating the basic legal principles.

The first view is indeed a route for addressing this issue as it provides the applicant with an opportunity to incorporate those equivalents that are obvious before the filing date but not recited in the application documents into the protection scope. However, there may arise two problems: one is that the equivalent infringement may change to literal infringement through amendments to patent application documents; and the other is that if the doctrine of equivalents is applicable to the amended technical features during the infringement determination, it might lead to over-protection of patent rights.

The adoption of the second view does not necessarily mean that the patent applicants will be severely punished for the drafting errors they make, as worried by some people. To the contrary, the biggest advantage of the second view lies in that the amended application documents remain consistent with the technical information contained in the original application documents; on that basis, if the application of the doctrine of equivalents is extended from obvious equivalents as a result of scientific development after the filing date to equivalents irrespective of whether they are before or after the filing date, it is still possible to avoid the loss of rights due to improper drafting. In addition, such a variation will not interfere with the basic legal principles to render the technical solutions that should have constituted equivalent infringement at the risk of literal infringement; and there is no need in practice to distinguish the equivalents before the filing date from the new equivalents after the filing date, which is more concise for both right holders and judges.

Judging from the above analysis, the writer opines that the second view in which "the scope of disclosure contained in the original description and claims" is understood as all the information of the invention-creation indicated in the original description and claims seems more reasonable both in

theory and in practice.

### 3. To distinguish the amendments to "inventive points" from those to "non-inventive points"

As stated in the SPC's judgment No. Xingtizi 21/2013, "generally speaking, one technical solution contains a plurality of technical features, wherein those technical features made by the invention-creation contributed to the prior art are often called 'inventive points', and 'inventive points' render the invention-creation novel and inventive over the prior art, and are considered as the basis and rudimental reasons for the patentability of the invention-creation." In practice, the applicant may make amendments to "inventive points", as well as "non-inventive points". If the same criterion is used to judge whether the amendments to "inventive points" and to "non-inventive points" go beyond the scope or not, it might ostensibly render the whole invention-creation unpatentable on the grounds that the amendments to "non-inventive points" in the patent application documents go beyond the scope of original disclosure, in such a case that the profits gained by the patent applicant seem to be non-compatible with the contributions he makes to the society, which is against the essence of fairness. The writer, however, would emphasize that there exist, in theory and in practice, great barriers and difficulties in distinguishing "inventive points" from "non-inventive points" by the criterion for judging whether amendments go beyond the scope or not, and deliberate distinction will finally lead to unfairness to a larger extent.

First, the so-called "inventive points" and "non-inventive points" are named with respect to the closest prior art, and the re-determination of the closest prior art will result in variation or transfer between "inventive points" and "non-inventive points". On the one hand, the prior art on which the invention created by the applicant is made is not necessarily the genuine closest prior art, such that the "inventive points" in the eyes of the applicant are not necessarily the authentic "inventive points"; on the other hand, prior art searching can never be exhaustive, and chances are that the closest prior art searched by an examiner during the substantive examination phase may totally be overturned in the invalidation proceeding, thereby causing a great change in "inventive points" at different phases. In such a case, if different criteria for judging whether the amendments go beyond the scope are used to distinguish "inventive points" and "non-inventive points", it is very likely that the amendments once allowed are prohibited due to the change of the closest prior art, or

the amendments once disallowed shall be permitted due to the appearance of the new closest prior art. The uncertainty will lead to complexity in determination of the “fact” that the amendments go beyond the scope.

Second, “the scope of disclosure contained in the original description and claims” shall be understood as all the information of the invention-creation indicated in the original description and claims as stated above, and those ordinarily skilled in the art must make a judgment on these information based on the full picture thereof in combination with their grasped common knowledge in the art, rather than mechanically based on the content recited in the original application documents. The drafting errors in “non-inventive points” can be remedied by adjusting the application rules of the doctrine of equivalents, and those obvious equivalents that are not recited in the application documents can be remedied through the application of the doctrine of equivalents.

Hence, it is meaningless to distinguish “inventive points” from “non-inventive points” when judging whether the amendments go beyond the scope of the original disclosure, and if doing so, things get much complicated and the final judgment turns out to be more subjective.

#### **4. Remedial procedure for errors made in amending “non-inventive points” after the grant of the patent**

In regard to the amendments to “non-inventive points” that go beyond the scope of original disclosure, the SPC suggested in the judgment No. Xingtizi 21/2013 that “account may be taken of setting up a corresponding observations procedure during the examination on patent grant and validation, and allowing patent applicants and patent holders to address such an issue by procedural routes, such as giving up the amendments that are incompliant with Article 33 of the Patent Law in order to resume the patent application documents and the patent granted documents to be those as originally filed at the filing date”.

The above suggestions are reasonable to some extent. However, considerations shall be given to many factors when designing the remedial procedure, such as its purpose, details, a link to other relevant procedures, influence on the entire examination and approval procedure. Moreover, the differences in the remedial procedure before and after the grant of the patent shall also be taken into account.

##### **(1) Feasibility of setting up the “observations procedure” before the grant of the patent**

A patent application might go through preliminary examination, or preliminary and substantive examination, some-

times even re-examination before being granted. If the amendments to the application documents made by the applicant are deemed as going beyond the scope of disclosure contained in the original application documents, an examiner will issue a notice of office action irrespective of whether the amendments are made to “inventive points” or “non-inventive points”. Pursuant to the relevant provisions of the current Guidelines for Patent Examination, the applicant is provided with at least two opportunities to make the observations and/or another opportunity to make amendments to the application documents during the preliminary and/or the substantive examination; even though during the re-examination procedure, the applicant still has at least two opportunities to make further amendments to the application documents at the time of filing a re-examination request and making observations in response to the notice of re-examination issued by the collegial panel so as to overcome the defect that the amendments go beyond the scope of original disclosure.

Patent examination and approval is a procedure that an administrative authority exerts its administrative functions with the authorization of a country. Balancing fairness and efficiency must be taken into consideration when the administrative authority conducts specific administrative acts. Efficiency cannot be sacrificed for the sake of fairness, and vice versa. It is stipulated in the Guidelines for Patent Examination that generally speaking, the party concerned is provided with at least two opportunities to make observations for the same defect before the Decision on Rejection is issued for the sake of the tradeoffs between fairness and efficiency. Under the circumstances that the applicant is clearly informed by the notice of office action of the fact that some amended features cannot be determined from the original application documents with sufficiently justified reasons, in addition to the above four opportunities to make amendments or observations, if a further “observations procedure” is set up for addressing the defect of the amendments to “non-inventive points” going beyond the scope of the original disclosure seems, on the one hand, the procedure becomes redundant as being repetitive with the preliminary and/or the substantive examination procedures, and on the other hand, it may mislead the applicants into believing that the observations in response to the notice of office action or re-examination are not important, which objectively prolongs the entire examination and approval procedure and reduces the examination and approval efficiency. In addition, if the case indeed has the prospect of patentability, the abovementioned issue can



be solved by issuing a further notice of office action or accepting the amendments to “non-inventive points” initiated by the party concerned, and the so-called “observations procedure” would not be necessary in this case.

Thus, there is no need to set up the “observations procedure” for the pending patent applications to remedy the defect that the amendments to “non-inventive points” go beyond the scope. In practice, examiners shall make analysis on a case-by-case basis under the guidance of examination policies to achieve the balance between “promotion of scientific and technological progress and innovations” and administrative efficiency.

(2) Feasibility of setting up the “observations procedure” after the grant of the patent

In China, patent applications for invention are subject to substantive examination, and patent applications for utility model and design are subject to preliminary examination. Once a patent is granted, anyone (including patent holders) who thinks that the grant of the patent is incompliant with the provisions of the patent law can only rectify the improper grant by initiating the invalidation proceeding. If the granted patent has the defect of the amendments going beyond the scope of the original disclosure, the only thing to do is initiate the invalidation proceeding no matter it is the amendments to “inventive points” or “non-inventive points” that go beyond the scope, and accordingly there is only one result, that is, the patent is declared invalid.

In fact, it does not mean only the amendments to “non-inventive points” will come across this issue, other substantive grant conditions, including over-generalization of the claims, lack of clarity, or even novelty and inventive step matters, will also encounter the same embarrassment. For instance, as for patent applications for utility model which only undergo a preliminary examination, the applicant will not be challenged on inventive step and novelty matters during the examination. But if the patent is granted, suppose the patent holder files a request with the Patent Office for a patentability evaluation report and receives the conclusion that some of the claims lack novelty or inventive step, or have the defect of the amendments going beyond the scope of the original disclosure, the only thing the patent holder can do is actively initiate the invalidation proceeding or passively await others to initiate the invalidation proceeding in order to amend the claims and therefore solve the problem of the improper grant. Even if this is the case, there are many restrictions on the amendments to the granted patent documents, and there

is a limited range of remedies relevant to drafting errors, so the results mostly turn out to be disadvantageous to patent holders. Thus, how to remedy the errors made by patent holders in diversified manners through a procedure design is the key issue that needs to be considered when designing the patent system.

There is a tendency that the patent post-grant procedure is diversified in many countries. For instance, to alleviate judicial pressure, the U.S. is constantly adjusting the patent post-grant procedure. The current procedure mainly consists of correction, reissuance, ex parte re-examination, inter partes re-examination, and post-grant review proceeding for commercial use, and the like. These different procedures undertake dissimilar tasks respectively and provide various types of the parties concerned with diversified administrative rights. Whenever a mistake of a clerical or typographical nature, or of minor character appears in a patent, the patentee or patent assignee may request, or the Patent and Trademark Office may initiate the correction procedure to correct the non-substantial errors in the patent<sup>1</sup>; when claims that are likely to be invalidated or some errors in substantial appear in a patent, the patentee may make a disclaimer<sup>2</sup> or reissue<sup>3</sup>; and anyone (including patent holders) can initiate ex parte re-examination procedure<sup>4</sup>, by citing prior art consisting of patents or printed publications to challenge novelty or inventive step, or the general public (excluding patent holders) can request post-grant review<sup>5</sup> or inter partes review<sup>6</sup> at different post-grant phases to challenge the patentability of a patent from all aspects.

The patent post-grant procedures in Japan are of great variety, which mainly consist of trial for correction<sup>7</sup>, opposition<sup>8</sup> and a trial for invalidation<sup>9</sup>, wherein the trial for correction is a procedure for a patentee to remedy errors made for a granted patent on its own initiatives, which is filed by the patentee for narrowing the scope of claims, correcting errors or incorrect translation in the granted text, clarifying ambiguous statements in the claims and interpreting the dependencies of the claims; opposition is a procedure for the general public to challenge patents that are incompliant with conditions of patentability in order to determine the stability of patents as early as possible, and anyone who deems that a patent is not patentable may file a request with the examination division of the Japanese Patent Office within six months from the date of the announcement of the grant of the patent right; correspondingly, a patent invalidation proceeding is filed by an interested party and tried by the judging division of the

Japanese Patent Office as a “quasi-judicial” procedure in order to resolve the disputes over the patentability between the parties concerned.

The invalidation proceeding in China simultaneously undertakes multiple tasks of correcting improper grant, amending claims and resolving disputes over patentability between both parties concerned, etc., and has been subject to criticism that should not have been made in recent years. Under this background, especially when the patents for utility model and design are only required to pass preliminary examination, a procedure specially designed to rectify improper grant so as to provide the patentee with an opportunity to initiate a simple and effective self-correction procedure will stimulate the patentee’s enthusiasm to enhance the stability of a patent, which not only resolves the imbalances of interests as a result of the amendments to “non-inventive points” going beyond the scope, but also plays an active role in alleviating the pressure on the invalidation proceeding and satisfying needs of different types of the parties concerned.

### 5. Conclusion

All in all, concerning the examination on whether the amendments go beyond the scope of the original disclosure, the writer holds the following views:

(1) The legislative intent of Article 33 of the Patent Law is to balance the interests between the patent applicant and the public, and on the one hand, the patent applicants are allowed to make amendments and modifications to the patent application documents to ensure that the invention-creations that are indeed inventive shall be granted and are subject to patent protection; on the other hand, the applicant is prevented from gaining undue interests from the content that is not disclosed by the filing date, and the public’s reliance on the original patent application documents can be protected.

(2) As to the understanding of “the scope contained in the original description and claims”, there are two views that are existent in the intellectual property field, namely, the “supportive theory” and the “technical information determinative theory”. Although the “supportive theory” can indeed partially remedy the drafting errors in the application documents, the “technical information determinative theory” in contrast will not interfere with the basic legal principles, and there is no need in practice to distinguish the equivalents before the filing date from the new equivalents appearing after the filing date, which is more concise for both right holders and judges. The understanding of “the scope of disclosure contained in the original description and claims” as all the in-

formation of the invention-creation indicated in the original description and claims seems more reasonable both in theory and in practice.

(3) There exist, in theory and in practice, great barriers and difficulties in distinguishing “inventive points” from “non-inventive points” by the criterion for judging whether amendments go beyond the scope or not, and deliberate distinction will finally lead to unfairness to a larger extent.

(4) It would not be necessary to set up the “observations procedure” for the pending patent applications to remedy the defect that the amendments to “non-inventive points” go beyond the scope. In practice, examiners shall make analysis on a case-by-case basis under the guidance of examination policies to achieve the balance between “promotion of scientific and technological progress and innovations” and administrative efficiency. To the contrary, as for a post-grant patent, a procedure specially designed to rectify improper granting so as to provide the patentee with an opportunity to initiate a simple and effective self-correction procedure will stimulate the patentee’s enthusiasm to enhance the stability of a patent, which not only resolves the imbalances of interests as a result of the amendments to “non-inventive points” going beyond the scope of the original disclosure, but also plays an active role in alleviating the pressure on the invalidation proceeding and satisfying needs of different types of the parties concerned. ■

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<sup>1</sup> Articles 254-256 of the existing U.S. Patent Act.

<sup>2</sup> Article 253 of the existing U.S. Patent Act.

<sup>3</sup> Articles 251-252 of the existing U.S. Patent Act.

<sup>4</sup> Articles 301-307 of the existing U.S. Patent Act.

<sup>5</sup> Articles 301-307 of the existing U.S. Patent Act.

<sup>6</sup> Articles 311-318 of the existing U.S. Patent Act.

<sup>7</sup> Article 126 of the Japanese Patent Law.

<sup>8</sup> Articles 113, 118 and 120-125 of the Japanese Patent Law.

<sup>9</sup> Article 150 of the Japanese Patent Law.