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Chinese Patent Law, Article 33: Perspectives and Related Issues

Andrew Schwaab

San Francisco Intellectual Property Law Association

Article 33

An applicant may amend his or its application for a patent, but the amendment to the application for a patent for an invention or utility model may not go beyond the scope of the disclosure contained in the initial description and the claims, and the amendment to the application for a patent for design may not go beyond the scope of the disclosure as shown in the initial drawings or photographs.

Yali Zheng et al. vs. Seiko – Epson Ltd. et al. (Zhixingzi 53/2010)

The question before the SPC (Supreme Court) in this case was whether the amended term “**storage device**” went beyond the original disclosure of “**semiconductor storage device**” under Article 33. The Board held that the amendment was beyond the original disclosure, but this decision was overturned by the Beijing High People’s Court.

In its decision, the SPC supported the Beijing High People’s Court’s decision and held that:

- One legislative purpose of Article 33 is to ensure that applicants have an opportunity to improve the quality of their patent applications by making amendments in light of newly identified prior art or evolving technology (though such amendments must not go beyond the original disclosure); and
- If the derived content is obvious to an ordinarily skilled person in the art, such content shall be regarded as within the scope of the original disclosure.

Article 19: Amendment of the Claims Before the International Bureau

(1) The applicant shall, after having received the international search report, be entitled to **one opportunity** to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit. He may, at the same time, file a brief statement, as provided in the Regulations, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.

(2) The amendments **shall not go beyond the disclosure in the international application as filed.**

(3) If the national law of any designated State permits amendments to go beyond the said disclosure, failure to comply with paragraph (2) shall have no consequence in that State

Article 123 Amendments

(1) The European patent application or European patent may be amended in proceedings before the European Patent Office, in accordance with the Implementing Regulations. In any event, the applicant shall be given at least one opportunity to amend the application of his own volition.

(2) The European patent application or European patent may not be amended in such a way that it contains subject matter which extends beyond the content of the application as filed.

(3) The European patent may not be amended in such a way as to extend the protection it confers.

Article 123(2) EPC

According to Art. 123(2) EPC the European patent application or the European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. The revision of the EPC has introduced a purely editorial change to the wording of Art. 123(2) EPC to bring it into line with Art. 123(1) EPC. However, Art. 123(2) EPC 1973 and Art. 123(2) EPC are substantively the same.

- 1. General issues
- 2. Intermediate generalisation - non-disclosed combinations
- 3. Technical contribution - addition or deletion of a feature
- 4. Disclaimers
- 5. Disclosure in drawings
- 6. The application as originally filed: formal aspects
- 7. "Tests" for assessing the allowability of an amendment

Japanese Patent Law § 17: Amendments and corrections

Under the current provisions, amendments of the description, claims or drawings may be made at any time until expiration of the term fixed for responding to the first official action in the substantive examination, and furthermore within the term fixed for responding to the second or a subsequent official action, and at the same time of filing an appeal notice.

Voluntary amendment and amendment in response to a non-final official action:

1. Any amendment can be made as long as the amendment does not introduce any new matters into the description, claims and drawings; that is, it is not permitted to add any¹⁸ new matters which have not been described in the description, claims or drawings as originally filed (which includes matters which are obvious for a person skilled in the art from the specification as originally filed).

2. Any amendment introducing a new matter into the description, claims and drawings shall constitute grounds for rejection and for invalidation (nullification).

3. In order to strictly comply with the provision of 'Unity of invention', for applications filed on or after 1 April 2007, an amendment of claims needs to follow the provision of 'Unity of invention', that is, amended claims need to have a certain technical relationship with the invention that has been examined on its patentability. The incompliance with the requirement shall constitute grounds for rejection, but not for invalidation (nullification). In order to avoid such a rejection, an applicant(s) can file a divisional application for an invention that has no certain technical relationship with the examined invention.

Adding new matters to the originally filed description, claims and drawings is of course prohibited. An amendment of the scope of claims is only permitted, as long as it aims at any one of the following objects:

1. cancellation of a claim or claims;
2. specific restriction of a claim or claims (only to further limit at least a part of the matter set forth in a claim in such a manner that the amended invention becomes an invention having the same 'Field of Industrial Utility' and the same 'Problem to be Solved by the Invention' as the invention claimed before the amendment) (it should be noted that, in such cases, the claimed invention after the amendment must be independently patentable);
3. correction of errors;
4. clarification of unclear description (it is permitted to clarify the unclear description only relating to the matters as indicated as a ground for the rejection in the notice of the ground for rejection in a final official action or final rejection).

Claims potentially amendable to “**storage device**” from “**semiconductor storage device**” if “semiconductor” is not the key subject (or distinguishable feature) of the invention and does not introduce a new technical matter. Likelihood of success higher at appeal stage than examination stage.

Article 47 (2) and Article 62 (v) of the Korean Patent Act deal with amendments outside the scope of the original disclosure, as follows:

Article 47 (Amendment to Patent Application)

- ...
- (2) An amendment to the specification or drawings under paragraph (1) shall be made within the scope of the features disclosed in the specification or drawings initially attached to the patent application.

Article 62 (Decision to Reject Patent Application)

- Any Examiner shall make a decision to reject a patent application where the invention falls under any of the following subparagraphs:
 - ...
 - (v) Where the application is amended beyond the scope under Article 47 (2).

Effective from 1 July 2001, a new amendment procedure of patent application has been introduced.

An amendment to a description including claim(s) or drawing(s) must be within the scope of the features disclosed in the original description or drawing(s) of the application. Specifically, in the case of an amendment made in response to the further office action (under the above provision 2) and an amendment made within thirty days from the date of filing a trial against a decision of final rejection, an amendment to the claim(s) must be limited to the scope prescribed in any of the following:

1. to narrow the scope of a claim by limiting or cancelling the claim, or by adding element (s) into the claim;
2. to correct a clerical error;
3. to clarify an ambiguous description; or
4. to revert a claim before the amendment being beyond the scope of the disclosures of the original specification, or while reverting, also to narrow a claim, to correct a clerical error or to clarify an ambiguous description (effective from 1 July 2009).

Claims potentially amendable to “**storage device**” from “**semiconductor storage device**” if “semiconductor” is not the key subject (or distinguishable feature) of the invention and does not introduce a new technical matter.

35 U.S.C. 112: Amendments and corrections

The application, including the description, figures, and claims, may be amended during prosecution, except that no amendment shall introduce new matter.

35 U.S.C. 112 Specification.[Applicable to any patent application filed on or after September 16, 2012.]

(a) IN GENERAL.—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.

(b) CONCLUSION.—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.

(c) FORM.—A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

(d) REFERENCE IN DEPENDENT FORMS.—Subject to subsection (e), a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

(e) REFERENCE IN MULTIPLE DEPENDENT FORM.—A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

(f) ELEMENT IN CLAIM FOR A COMBINATION.—An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claims likely amendable to “**storage device**” from “**semiconductor storage device**” so long as claim is not being broadened to encompass something that was not disclosed/enabled in the original disclosure.

Article 33 Rejections

Percentage of Applications Receiving Article 33 Rejections

2012 data:

	# of Apps	# of OAs	Rejection Type					Totals # of Unique Rejections
			Art. 33	Prior Art	Other	Both 33 & Other	All three	
Original Applns	30	37	19	4	27	3	1	50
<u>Divisonals</u>	114	147	99	20	90	21	10	209
TOTALs	144	184	118	24	117	24	11	

Article 33 Rejections

2012 con't:

		Rejection Type by Percentage				
		% of Apps	% of OAs	% Art. 33	% Prior Art	% Other
Originals		21%	20%	38%	8%	54%
Divisonals		79%	80%	47%	10%	43%

Article 33 Rejections

2011 data:

RAW NUMBERS	Article 33 Rejections	Prior Art Rejections	Other Rejections	Both 33 and Other	All three
Divisional Apps. = 112	58	5	49	22	2
Original Apps. = 89	32	10	47	17	1

In terms of percentages	Article 33 Rejections	Prior Art Rejections	Other Rejections	Both 33 and Other	All three
Divisional Apps. = 112	52%	4%	44%	20%	2%
Original Apps. = 89	36%	11%	53%	19%	1%

2011: 36% & 52% (DIV)

2012: 38% & 47% (DIV)

Comparative Rejections/Allowances

Company	Year	Percentage Granted
Chinese Telephone	2010	59%
Non-Chinese Telephone	2010	20%
Chinese Semiconductor/ Materials	2010	67%
Non-Chinese Semiconductor/ Materials	2010	0%
Chinese Hardware	2010	32%
Non-Chinese Hardware	2010	28%

semiconductor crystals and crystal product and device support method

CPC:	IPC:	Publication info:	Priority date:
C3021100	C3021100	CN101407936 (A)	2001-07-05
C30211002	C3021104	2009-04-15	
C3021104	C3021114		
(44)	(43)		

state

CPC:	IPC:	Publication info:	Priority date:
C3021100	C3021100	CN102220525 (A)	2001-07-05
C30211002	C3021104	2011-10-19	
C3021104	C3022102		
(44)	(43)		

semiconductor crystals with rigid support, carbon doping and resistivity control and

CPC:	IPC:	Publication info:	Priority date:
C3021100	C3021100	CN102791032 (A)	2001-07-05
C30211002	C3021104	2012-11-25	
C3021104	C3022102		
(44)	(43)		

SEMICONDUCTOR CRYSTALS WITH A RIGID SUPPORT WITH CARBON DOPING AND GRADIENT CONTROL

CPC:	IPC:	Publication info:	Priority date:
C3021100	C3021100	EP1456556 (A2)	2001-07-05
C30211002	C3021104	2004-09-15	
C3021104	C3021112	EP1456556 (A4)	
(44)	(44)	2005-05-20	
		EP1456556 (B1)	2012-05-12

semiconductor crystals with a rigid support and with carbon doping

CPC:	IPC:	Publication info:	Priority date:
C3021100	C3021100	EP2444531 (A2)	2001-07-05
C30211002	C3021104	2012-04-25	
C3021104	C3021106	EP2444531 (A3)	
(44)	(45)	2012-10-31	

SEMICONDUCTOR CRYSTALS WITH A RIGID SUPPORT WITH CARBON DOPING AND GRADIENT CONTROL

CPC:	IPC:	Publication info:	Priority date:
C3021100	C3021100	JP2004534710 (A)	2001-07-05
C30211002	C3021104	2004-11-15	
C3021104	C3022102	JP4324487 (B2)	
(44)	(45)	2005-09-02	

SEMICONDUCTOR CRYSTAL PROVIDED WITH RIGID SUPPORT INVOLVING AND TEMPERATURE GRADIENT CONTROL

CPC:	IPC:	Publication info:	Priority date:
C3021100	C3021100	JP2009051725 (A)	2001-07-05
C30211002	C3021104	2009-02-12	
C3021104	C3022102	JP5005651 (B2)	
(44)	(42)	2012-05-22	

SEMICONDUCTOR CRYSTAL WITH A RIGID SUPPORT WITH CARBON DOPING AND GRADIENT CONTROL

CPC:	IPC:	Publication info:	Priority date:
C3021100	C3021100	JP2012126644 (A)	2001-07-05
C30211002	C3021104	2012-07-05	
C3021104	C3022102		
(44)	(43)		

semiconductor crystals with a rigid support with carbon doping and resistivity control

CPC:	IPC:	Publication info:	Priority date:
C3021100	C3021100	US2003037721 (A1)	2001-07-05
C30211002	C3021104	2003-05-21	
C3021104	C3022102	US6696729 (B2)	
(44)	(47)	2005-05-24	

