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TIPO revises examination guidelines for post-grant patent amendments

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Introduction

Post-grant patent amendments are allowed in Taiwan. According to Article 67(1) of the Patent Act, a patentee may make the following amendments to the description, claims or drawings of its patent:

- delete a claim;
- narrow a claim's scope;
- correct typographical or translation errors; and
- clarify any ambiguous statements.

However, Article 67(4) of the act provides that no post-grant amendment can substantially enlarge or alter the scope of the claim as issued. On December 27 2016 the Taiwan Intellectual Property Office (TIPO) published an amended version of Chapter 9 of Part 2 of the Guidelines for Patent Examination, which concerns post-grant amendments. The amendments came into force on January 1 2017.

The main amendments include:

- changing the basis for determining whether a post-grant amendment has resulted in a substantial change in claim scope from the literal meaning of the amendment to the purposes of the claimed invention; and
- broadening the types of allowable post-grant amendment.

Narrowingscope

The wording "[a]fter the post-grant amendment, the technical field and the problem to be resolved by the patent shall remain unchanged" was deleted. TIPO considered the wording unnecessary because narrowing down the scope of a claim should still meet the requirement of no expansion in claim scope.

Correcting errors

The amendments concerning correcting errors state:

"A person having ordinary skill in the art... immediately identifies an obvious error... The intended meaning must have been suggested in the description, claim(s) or drawing(s) and the error does not affect the meaning of the original text."

This is because regarding the determination of whether a mistake in the patent results from an obvious oversight or error, the original guidelines did not state that the error could be corrected only if the meaning intended by the patentee is expressly disclosed in the description, claim or drawing. To avoid any misunderstanding, the words "have been expressly stated" have been changed to "have been suggested".

Clarifying an ambiguous statement

The amendments have also added the following provisions:

"If the issued claims are very likely to be misinterpreted, a claim(s) containing a reference to another claim may be rewritten as an independent claim. This type of amendment is also considered to be an amendment 'to clarify an ambiguous statement(s).'"

According to Article 26(2) of the Patent Act, each claim must be written in a clear and concise manner. Therefore, only when a claim containing a reference to another claim is very likely to be misinterpreted

can it be rewritten as an independent claim. For example, a dependent claim that is broader in scope or inconsistent with the independent claim from which it depends can be rewritten as an independent claim.

In principle, the amendments allow patentees to rewrite only claims (both independent and dependent claims) containing a reference to a single claim into independent claims. As for claims containing references to multiple dependent claims, the requirements in the 'examination matters requiring attention' section must still be met. The total number of claims can be increased only if the number of the claims referred to or serving as base claims is reduced.

Determining whether claim's scope is enlarged

Under the amendments, changing the use of the invention of a claim is no longer considered to be a type of amendment that substantially enlarges the claim's scope.

This amendment is made in line with the 2013 amendments to the guidelines. If the use of the product claimed in a claim merely describes the intended use or method of use, without implying any particular product structure or composition, the use recited in the claim does not serve to limit the product. Therefore, with regard to any post-grant amendment made to use-limited product claims allowed after 2013, if the uses do not serve to limit the product, the purpose of the invention – whether before or after the post-grant amendment (modifying or deleting the use) – still depends on the structure or composition of the product and does not depend on any change to the use. This type of post-grant amendment will therefore not substantially enlarge or alter the scope of a claim and should be permitted.

However, all post-grant amendments must be examined in accordance with the laws, regulations and guidelines in force at the time of filing. To avoid any confusion in claim construction, if the post-grant amendment is made to a use-limited product claim allowed before 2013, the claim's scope should be determined based on the guidelines in force at the time of the examination of the claim. In other words, the use does not serve to limit the product. Therefore, any post-grant amendment that changes or deletes any use of the invention of a claim will substantially enlarge or alter the claims and should not be permitted.

Determining whether claim's scope is altered

The amendments include:

- changing the basis for determining whether a post-grant amendment has substantially altered the scope of the claim as issued from the literal meaning of the amendment (eg, defining a specific claim feature not using a subordinate feature or adding new material); and
- changing the field of the claimed invention or the problem to be solved by the claimed invention (eg, amending a claim to include new features that cannot achieve the purpose of the invention is an amendment that results in a substantial change in claim scope).

Both are considered to result in a substantial change in claim scope to the purpose of the claimed invention.

Regarding the purposes of inventions, the amendments clearly state:

"In principle, in determining the purpose of the invention of a claim, a person having ordinary skill in the art will, based on the invention as a whole, consider the problem to be solved by the invention described in the description, the technical means used to solve the problem and the expected technical functions, compare the claim with the prior art, and then identify the specific purpose of the invention. However, the purpose that is not expressly disclosed but can be directly inferred from the description can also be recognised as the purpose of the claimed invention."

Comment

The latest amendments provide clearer rules for determining whether a post-grant amendment substantially enlarges or alters the scope of the claims as issued. This would be useful guidance to patentees that intend to file post-grant amendments.

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