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## Taiwan

### Key Points in the Amendment to “Taiwan Patent Examination Guidelines for Post-Grant Amendment” (2017) and Our Suggested Strategies

On 26<sup>th</sup> December, 2016, Taiwan Intellectual Property Office (IPO) published the newest edition of “Taiwan Patent Examination Guidelines for Post-Grant Amendment” and will be made effective as at 1<sup>st</sup> January, 2017.

The key revision of the “Patent Examination Guidelines for Post-Grant Amendments” 2017 edition is the relaxation of rules on items that can be amended if “including additional technical features in the claim(s) for post-grant amendments” could fulfil the purpose of invention before amending the claim. The important aspects of the new Guidelines and our suggested strategies are as follows:

#### 1. Relaxation of rules on items that can be amended if “including additional technical features in the claim(s) for post-grant amendments” could fulfil the purpose of invention before amending the claim:

##### I. Previous Edition of the “Patent Examination Guidelines for Post-Grant Amendments”:

In the event that “including additional technical features in the claim(s) for post-grant amendments”, the previous edition of the “Patent Examination Guidelines for Post-Grant Amendments” specifies amendments that substantially alters the scope of the claim(s) published in Publication are not allowed. (Note: The Previous Edition of “Patent Examination Guidelines for Post-Grant Amendments”, Section 4.2 “Judging amendments that substantially alter the scope of the claim(s) published in Publication” (4): After amending the claim(s), specific disclosure of technical features and further defined technical features that are not covered in the previous scope of the claim(s) are introduced.)

##### II. The 2017 Edition of “Patent Examination Guidelines for Post-Grant Amendments”:

In the 2017 edition of the “Patent Examination Guidelines for Post-Grant Amendments” (“the 2017 Guidelines”), the rules are relaxed: if the additional technical features in the claim(s) could not fulfil the purpose of invention before amending the claim, then it is considered as substantially altering the scope of the claim(s).

The “purpose of invention before amending the claim(s)” judging criteria in the 2017 edition stipulates that a person having ordinary skill in the art shall consider each claim as a complete invention, evaluate the problem(s) that the invention aims to solve, its technical solution adopted to solve the problem(s), state any advantageous effects of the invention with reference to the background art, thus determining the purpose of invention. By comparing the claim(s) of the invention before and after amendments, **if the amended claim(s) of an invention “cannot achieve” or “damage” the purpose of invention before amending the claim(s), it will be deemed as substantially altering the scope of the claim(s).** Therefore, on the assumption that “including additional technical features in the claim(s) for post-grant amendments” can achieve the purpose of invention before amending the claim(s), this shall not constitute as substantially altering the scope of the claim(s) and the amendments will be approved.

We would illustrate the judging criteria and examples in the next section:

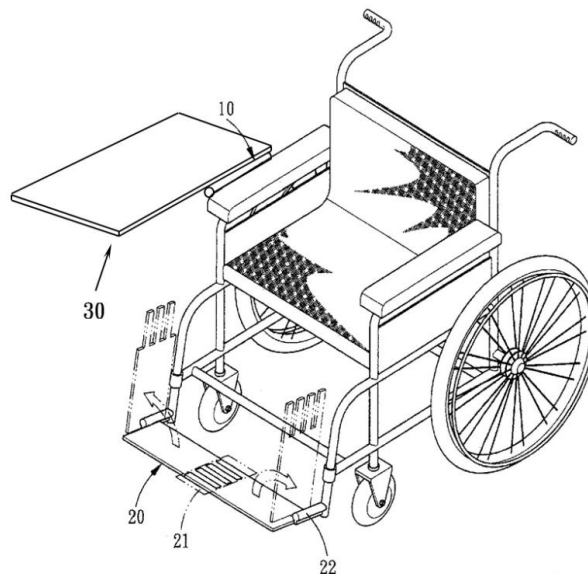
**a. “All” purposes of invention of a particular claim before amendments must be achieved after amendments:**

Although the 2017 edition of Guidelines states that the amendments only need to achieve the purpose of invention of a particular claim before amendments, the IPO has emphasized that the amendments shall be able to achieve “all” purposes of invention of a particular claim in order to be approved. Even if the amendments could accomplish a large portion of the purposes of invention while slightly “damaging” the purposes of invention, these amendments will not be allowed.

When the amendment can achieve “all” purposes of invention of a particular claim before amendments, even though other items are added to achieve other purposes of invention, the amendment will be accepted. (Please refer to the example below.)

**Example 1:**

A claim of an application: (as in Publication)	A claim of an application: (as in the post-grant amendment)
A wheelchair, which provides the pedal (20) pivoted on the wheelchair (10), where the pedal (20) is a set of two, and the two sides of the pedal (20) are a engagement portion (21) and a pivot portion (22) respectively, where the pivot portion (22) is pivoted on the wheelchair and the engagement portion of two pedals (20) are engaged.	A wheelchair, which provides the pedal (20) pivoted on the wheelchair (10), where the pedal (20) is a set of two, and the two sides of the pedal (20) are a engagement portion (21) and a pivot portion (22) respectively, where the pivot portion (22) is pivoted on the wheelchair and the engagement portion of two pedals (20) are engaged; <u>the wheelchair armrests are installed with a pivotable and telescopic dining table (30).</u>



Previous Guidelines: This amendment is not allowed.

The 2017 Guidelines: This claim can be amended.

**Reason:** The claim after amendment adds the pivotable and telescopic dining table (30) which is already disclosed in the specification. This is deemed as to narrow down the scope of claim(s) and does not extend beyond the scope of content disclosed in the specification, claim(s) or drawings filed originally. The amended claim also adds technical features related to “dining table (30)” which can achieve the original invention purpose of the claim: prevent the wheelchair user’s feet from sliding and have extensive space for the footrest. Although the claim extends the purpose of providing the dining table, it does not constitute as substantially altering the scope of the published claim(s).

- b. To determine the purpose of invention, a person having ordinary skill in the art shall consider each claim as a complete invention, and the evaluation criteria should include but not limited to “the problem(s) that the invention aims to solve”, “its technical solution adopted to solve the problem(s)”, “state any advantageous effects of the invention with reference to the background art” as stated in the specification by the patentee:**

The 2017 Guidelines specified that a person having ordinary skill in the art should consider each claim as a complete invention and determine the purpose of invention.

In the Public Hearing, the IPO strongly stated that even though the patentee has indicated “the problem(s) that the invention aims to solve”, “its technical solution adopted to solve the problem(s)”, “state any advantageous effects of the invention with reference to the background art” in the specification, a person skilled in the art should integrate actual technical features of each claim when judging the invention and should not treat the aforementioned parts in the specification as the absolute standard. When the patentee includes purposes of invention that are not related to the claim in the specifications, the IPO shall not restrict the judging standards to these parts.

## 2. Our Suggested Strategies

Post-grant amendment is a crucial defensive means for the patentee when facing invalidation actions or ineffective defences in civil infringement lawsuits. The relaxed rules on items that can be amended in the 2017 Guidelines are certainly more beneficial to the patentee.

The post-grant amendment judging standards of IPO are subjected to the Examination Guideline at the time of filing the post-grant amendment request. **For invalidation actions being filed before 1<sup>st</sup> January, 2017, if the patentee submits the amendment request after 1<sup>st</sup> January, 2017, IPO shall examine the amendments according to the new version of “Patent Examination Guidelines for Post-Grant Amendments” (except for amendments of “purpose-defining claims”, which they are subjected to the Guidelines as at the publication date).**

Since the previous edition of the Guidelines forbids “including additional technical features in the claim(s) for post-grant amendments”, assuming the patentee has already filed the amendment request, the patentee can file another amendment including additional technical features in the claim(s) **after the new Guidelines has been put into effect on 1<sup>st</sup> January, 2017. This could disqualify the previous amendment request and keep the claim(s) valid.**

In addition, the offensive and defensive strategies for the patentee and the invalidation petitioner/accused infringer will be aiming at: “what is the purpose of invention of that claim?” and “are all purposes of invention of a particular claim before amendments can be achieved after amendments?” Although the 2017 Guidelines specifies that a person skilled in the art shall consider each claim as a complete invention, evaluate the problem(s) that the invention aims to solve and its technical solution adopted, thus determining the purpose of invention, the IPO emphasises in the Public Hearing that the specification is not an absolute standard when examining the case.

In the future, we believe that the specification still plays a significant role in the actual practice of post-grant amendments. When the patentee tries to distinguish the invention purposes of the patent with prior art by responding to Office Actions or invalidations, apparently these will be treat as internal evidences and substantially affect the IPO’s judgement of “purposes of invention”. Therefore, the patentee should consider pros and cons carefully when drafting the specification or responding to any Office Actions.