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Taiwan

The Taiwan Intellectual Property Office Limits the Allowability of Undisclosed Disclaimers in Patents

A disclaimer recites "negative" features in a patent claim, i.e. features which describe elements and characteristics that the claimed subject matter does not have. Compared to the U.S., Japan, China and European countries, the patent examination practice in Taiwan has always been more lenient on the regulations with regard to excluding a technical feature not disclosed in the application as filed ("undisclosed disclaimers") in amendments or post-grant amendments.

However, the Taiwan Intellectual Property Office (IPO) has recently made an announcement¹ that limits the allowability of undisclosed disclaimers, which would be introduced below.

Enforcement Principles of the IPO before 19 November, 2020

According to the current Taiwan Patent Examination Guidelines, undisclosed disclaimers are allowed in amendments or post-grant amendments if "it is used to disclaim technical content that overlaps with prior art" and "deleting the overlapping content renders the resulting subject-matter unable to be defined more clearly and concisely by expressing with positive features."

Although the example given in the current Examination Guidelines happens to particularly concern novelty or a single cited reference, the IPO has always accepted that patentees amend their claims in amendments or post-grant amendments with undisclosed disclaimers in order to rebut the obviousness rejection. The current regulations in the Examination Guidelines are listed as below:

1. Amendments:

(1) Example 1:

d. Amending claims by negatively limiting actual values. Though values that are not disclosed in the specification, claims, or figures on the date of filing should be considered as new matter, it is exceptionally allowed to amend it by disclaimers (e.g. not including, excluding), if the values belong to prior art. For instance, the value provided in the

¹ <https://www.tipo.gov.tw/tw/cp-85-883542-7afc9-1.html>

original claims is $X1=600\sim 10000$, and the value provided in prior art is $X2=240\sim 1500$. It is exceptionally allowed to amend the values in the claims by disclaiming the overlapping content, which results in an amended description of “ $X1>1500\sim 10000$ ” or “ $X1=600\sim 10000$, excluding $600\sim 1500$.” (Pages 2-6-12, Chapter 6, Part 2 of the Patent Examination Guidelines)

(2) Example 2:

It is discovered from prior technical literature that the nitrogen-containing heterocyclic carboxylic acid described in the present invention is in fact nicotinic acid. However, since the claims do not describe the technical feature ‘nicotinic acid’, it cannot be directly deleted from the claims. Therefore, it is acceptable for the claims to be amended as “nitrogen-containing heterocyclic carboxylic acid (excluding nicotinic acid),” and it should exceptionally be considered as not introducing new matter. (Pages 2-6- 38 to 39, Chapter 6, Part 2 of the Examination Guidelines for Patents)

2. Post-grant Amendments:

Since deleting the overlapping content renders the resulting subject-matter unable to be defined more clearly and concisely by expressing with positive features, it is acceptable to disclaim the content that overlaps with prior art with disclaimers, and it should exceptionally be considered as not introducing new matter. (Page 2-9-9, Chapter 9, Part 2 of the Examination Guidelines for Patents)

Enforcement Principles of the IPO after 19 November, 2020:

Recently, the IPO found that there seem to be a superfluous use of undisclosed disclaimers in amendments or post-grant amendments of claims compared to the U.S., Japan and European countries. The IPO therefore made an announcement on 19 November, 2020, which limits the allowability of undisclosed disclaimers. An undisclosed disclaimer is only allowable in certain limited circumstances:

1. restoring novelty against a prior art under Article 22(1) of the Taiwan Patent Act ;
2. restoring novelty against an earlier filed but later published Taiwan application (secret prior art) under Article 23;
3. be in compliance with the first-to-file principle under Article 31(1), which is however not applicable when having the same filing date with the prior art;
4. disclaiming parts relating to “human beings” in product claims;
5. disclaiming “procedures performed on animate human and animal bodies” in method claims.

Wisdom's Strategy

From now on, in Taiwan it is no longer acceptable to amend claims in amendments or post-grant amendments with disclaimers in addressing the problem of obviousness.

On the other hand, the examination criteria on a negative limitation to a claim in major intellectual property office also differs. For example, the USPTO does not allow an undisclosed disclaimer in amendments, while the EPO allows an undisclosed disclaimer in the following cases:

1. restoring novelty over a disclosure under Art. 54(3);
2. restoring novelty over an accidental anticipation under Art. 54(2);
3. removing subject-matter which is excluded from patentability for non-technical reasons.

In order to develop a successful international patent portfolio, patentees should not only bear in mind the new judging criteria published by IPO, but also take notice of different regulations in different countries.