



Featured Article

Navigating Claim Amendments in Patent Invalidation: Practical Strategies, Judicial Decisions, and Issues under China's Evolving Framework

As an administrative error correction procedure after grant of patents, patent invalidation is increasingly being utilized in addressing patent infringement risks and handling patent infringement disputes. To balance the legitimate rights of patentees for their inventive creations and the public's reliance interests defined by patent examination standards, China's Patent Law, on one hand, allows patentees to amend the claims during invalidation proceedings, and on the other hand, imposes explicit restrictions on such amendments. From the patentee's perspective, this involves a trade-off between striving to maintain the existing scope of patent protection and ensuring that the core right of the patent to exclude competition is not cancelled or weakened. This article attempts to comprehensively explore the strategies of amending claims during invalidation proceedings. It analyzes patentees' motivations for amendment and their practical effects through real cases. Additionally, it will discuss some controversial issues.

I. Timing the Amendment of Claims in Invalidation Proceedings

1. Provisions of the Patent Examination Guidelines on Timing and Methods of Amendment

The Patent Examination Guidelines stipulate different permissible timings for different types of amendment during invalidation proceedings. We can categorize amendment types into deletion-type amendments and non-deletion-type amendments:

For deletion-type amendments, the patentee may make them at any time before the invalidation decision is issued.

For non-deletion-type amendments, which include further limiting claims and correcting obvious errors, the patentee's opportunity to amend is limited to the following three scenarios:

- (1) In response to the invalidation request;
- (2) In response to additional invalidation grounds raised by the petitioner;
- (3) In response to new invalidation grounds or evidence introduced by the collegial panel on its own motion, which were not mentioned by the petitioner.

2. Considerations for Choosing the Timing of Amendment

During invalidation proceedings, a patentee can only use the method of further limiting claims in response to the invalidation grounds raised by the petitioner, additional grounds added by the petitioner, or grounds introduced by the collegial panel on its own motion.

The first two situations typically occur before the oral hearing. At this stage, if the patentee is relatively confident about the current claims, especially the independent claim(s), and the claim set already has multiple levels of fallback protection scopes, they may choose to postpone amendment. Even if it becomes apparent during or after the oral hearing that some claims are likely to be invalidated, they can still actively delete them or allow the collegial panel to rule on their validity in the invalidation decision.

If the patentee lacks confidence in all current claims and wishes to further limit them, they typically do so when responding to the petitioner's initially submitted invalidation grounds. Otherwise, if the petitioner does not supplement additional invalidation grounds within one month, the patentee may lose the opportunity for further limitation. An interesting question is: if an amendment is submitted in response to the petitioner's supplementary invalidation grounds but the amendment

is unrelated to these new grounds, would it violate the timing rules? The author believes that, based on the literal meaning of the Examination Guidelines, such an amendment might not be accepted.

The collegial panel's introduction of invalidation grounds on its own motion generally occurs during or after the oral hearing. Although not common, if based on the patentee's earlier analysis of the invalidation grounds and evidence (e.g., issues of claim clarity inevitably discovered during the examination of inventiveness), the patentee can still further limit the claims to overcome the clarity issue. Given this uncertainty, even if not amending when responding to the petitioner's initial grounds, a contingency plan should be prepared to make amendments and submit the text during the oral hearing or after the collegial panel issues an examination notice.

For deletion-type amendments, although they can be made at any time before the invalidation decision is issued, even passively waiting for the decision's ruling, active amendment in the early stages can help clarify the disputed points and highlight the innovative aspects of the core technical solution before the oral hearing.

3. Acceptance of Claims Regarding Multiple Amendment Submissions

Invalidation proceedings allow patentees to submit amended versions multiple times, and in principle, the last submitted version prevails. Attention must be paid to the issue of whether the amendment submission is complete and constitutes a full set. The author's awareness of this issue stems from an actual invalidation case.

In the invalidation proceeding for the invention patent No. 201180045589.1 titled "Liquid Crystal Display and Liquid Crystal Medium with Vertical Alignment," the patentee submitted a first set of claims within the period stipulated by the Examination Guidelines. During the oral hearing, three claims in this set were deemed by the collegial panel as not conforming to the permissible amendment methods under the Guidelines. The patentee stated at the hearing that they would delete those three claims and retain the other amended claims, constituting a second set of claims. Since the retained claims in this latter set contained amendments made by way of further limitation, the collegial panel considered that this set of claims submitted during the hearing was beyond the time limit for submitting evidence and therefore did not accept it.

However, in the second instance of the administrative litigation for this case, the Supreme People's Court held that during an invalidation oral hearing, when the CNIPA finds that some amended claims are unacceptable, the patentee should be

allowed to choose to delete the unacceptable claims from the current claim set and have the remaining claims serve as the basis for examination. This position reflects the court's view that the patentee's right to amend claims in invalidation proceedings is the primary value of the amendment system. The court believed that the amendment in this case would not harm the public's reliance interests, considering the boundary of the public's reliance interests to be the maximum scope of protection of the original claims.

The author believes that while the second-instance judgment's elaboration on balancing interests has its rationality, its compatibility with the current Patent Examination Guidelines must also be fully considered. The second-instance judgment focused more on the issue of "whether the relevant claims could be deleted" and less on the issue of "whether the text on which the deletion is based is an already accepted text." In fact, the text on which the deletion was based was the one previously unaccepted. The remaining claims, which contained "further limitations," should be understood as submitted during the oral hearing. They cannot be understood as being part of the text that had been previously accepted by the collegial panel. Submitting a text containing "further limitations" during the hearing does not comply with the timing requirements for amendments.

In the newly revised Patent Examination Guidelines (effective January 1, 2026), it is emphasized that amendments submitted by patentees during the invalidation stage should be in written form. This undoubtedly reiterates the CNIPA's stance that it can only accept a complete set of claims submitted as a whole and cannot accept partial modifications where some claims meeting requirements are accepted while allowing the deletion of non-conforming claims at any time. The author believes this stance stems from the seriousness of patent documents as legal instruments defining the scope of rights and the value orientation of ensuring the efficient operation of invalidation proceedings.

Given the conflicting judgments in practice, to avoid potential uncertainties, it is necessary to adhere to the CNIPA's rule of accepting only complete, written submissions of amendment sets and to exercise greater caution in making permissible "further limitations" to claims.

II. Selection of Methods for Amending Claims in Invalidation Proceedings

Amending claims inevitably requires comprehensive consideration of factors such as the threat posed by the invalidation grounds, the defects in the current claims, and the patentee's needs and bottom line

for patent protection, which are highly case-specific. Therefore, fundamentally, the approach to selecting amendment methods is similar to responding to office actions during substantive examination. However, considering the restrictions on claim amendment methods during the invalidation stage and the slightly different value goals pursued by applicants/patentees in grant and validity confirmation procedures, the author attempts to explore some perspectives typically considered by patentees in invalidation proceedings.

1. Choice Between Deletion-Type Amendments and Further Limitation

Although both deletion-type amendments and further limitation amendments have the effect of narrowing or abandoning specific protection scopes based on the original claims, both require consideration of multiple factors.

When the petitioner only raises threatening invalidation grounds against some claims, and the patentee also believes these claims are highly likely to be invalidated or that they no longer have practical significance for enforcement, active deletion can be adopted to avoid consuming resources of all parties in the proceeding. For example, deleting entire claims or deleting alternative technical solutions within them. Another advantage of this method is that it can shift the focus of dispute from the deleted claims to the retained claims, allowing for more

concentrated and effective arguments regarding the novelty, inventiveness, or support issues of the remaining claims.

Of course, more often, patentees do not wish to actively abandon any complete claim or alternative technical solution. In such cases, considering further limiting the protection scope is necessary, and this is the preferred amendment method in most situations. Whether to overcome defects in inventiveness or lack of support from the description, further limitation allows for precise narrowing of claims based on the inventive points asserted by the patentee, preserving as much as possible the patent's ability to restrict and combat potentially infringing acts.

It should be noted that the overall protection scope obtained through deletion-type amendments is not necessarily smaller than that obtained through further limitation. The reason is that after further limiting an independent claim, the scope of all its dependent claims will shrink accordingly; whereas after deleting some claims, the protection scope of the remaining claims that have not been further limited may not necessarily be smaller than the scope after further limitation.

2. Considerations for Selecting Features for Further Limitation

In essence, further limiting a claim involves redefining, within the maximum scope defined by the independent claim, a

protection scope that did not independently appear before, so that it can be re-examined for compliance with novelty, inventiveness, and support requirements. Typically, features for limitation can be selected based on the following approaches:

(1) Extracting Some of The Additional Technical Features from Dependent Claims

Within the same group of independent claims, partial additional technical features from one or more dependent claims can be incorporated into the independent claim or into other dependent claims. The former is an overall narrowing of the protection scope for that group of claims, while the latter aims to alter the protection hierarchy of the claims or to overcome defects existing only in specific dependent claims.

(2) Extracting Technical Features from Another Set of Independent Claims

It is worth noting that further limitation of claims is not limited to using technical features from within the same group of independent claims. It is permissible to cross between independent claims or even between claims of different protection subjects. In mechanical field cases, patentees can integrate features from method-type claims with features from apparatus-type claims across subjects. For example, using specific implementation features from an apparatus independent claim to further narrow and limit the

protection scope of a method independent claim, thereby highlighting the innovative aspects of that method over prior art.

In the invalidation proceeding for the invention patent No. 201080028266.7 titled "Antenna Configuration for Coordinated Beamforming," the patentee incorporated the additional technical feature of original dependent claim 3 (with modified wording) into original independent claims 12 and 13, forming two new independent claims. In this amendment, the protection subject of original claim 3 was "A method for communicating in a network," while the protection subjects of original claims 12 and 13 were "A first primary station having a first antenna array dedicated to a first cell of a network" and "A secondary station comprising means for communicating in a network," respectively. The second-instance court accepted this method of "further limitation" across claims of different protection subjects.

(3) Merging of Claims or Technical Solutions

Merging claims or technical solutions essentially involves incorporating all technical features of one or more claims or technical solutions into another claim or technical solution to achieve further limitation. For example, merging can occur between independent claims, between dependent claims, or merging multiple dependent claims into an independent claim together. This amendment method is more common in the mechanical field.

In the invalidation proceeding for the utility model patent No. 201521112402.7 titled "Explosion-Proof Device," the patentee merged dependent claims 2 and 4 into independent claim 1. The amended claim 1 integrated multiple core structures such as a top cover reinforcement mechanism, explosion-proof sheet, protective layer, and connection mechanism, clarifying the fixing method of the reinforcement ring, the composition of the sealed chamber, and the setting location and function of the connection mechanism, forming a complete structural and functionally synergistic technical solution. The invalidation decision held that the interdependence and synergistic effects of these components in structure and function collectively solved a series of problems related to strength improvement and convenient detection, therefore the invention possessed inventiveness.

(4) The Reference Claim for Judging Compliance with "Further Limitation"

Regarding the judgment of what constitutes "further limitation," there was once controversy: does "narrowing the protection scope" refer to the claim being amended or to the protection scope of all the claims? The Supreme People's Court has provided a clear answer through precedent, determining that the amended claim should be judged based on whether it constitutes a further limitation relative to the scope of the original independent claim(s).

In the invalidation proceeding for the invention patent No. 200680018368.4 titled "Method for Brazing Stainless Steel Products and Stainless Steel Brazed Product Obtained by the Method," independent claim 1 protected a method for brazing stainless steel products, only broadly limiting core steps like heating. Dependent claim 2 limited "sealing or filling joints larger than 76 μm , etc.," and dependent claim 20 specifically limited the elemental composition and content of an iron-based brazing filler material. Facing the invalidation ground of "support," the patentee incorporated the aforementioned technical features from dependent claim 2 and dependent claim 20 together into original independent claim 1. The invalidation decision held that since dependent claim 20 referenced dependent claim 19, incorporating the additional features of claim 20 into claim 1 without incorporating those of claim 19 expanded the patent protection scope relative to claim 19. The second-instance court overturned this view, stating that the amended independent claim should be compared with the independent claim having the broadest protection scope in the original patent, not with a dependent claim having a narrower scope. Therefore, the amendment complied with the requirement of further limitation.

This case triggers reflection on the reference claim for "further limitation" of claims: whether all claim amendments can reference the broadest claim in the granted claim set to judge if they constitute further

limitation. This remains an issue of balancing interests. One interpretation is that if further limitation for each claim in a group is referenced against the independent claim(s) of that group, then any amendment to a dependent claim that does not exceed the scope of the independent claim is deemed to meet the further limitation requirement. Under this view, amendments to dependent claims could involve adding limiting features, simultaneously adding features and deleting individual features, adjusting claim dependencies, or even deleting a claim while adding a new dependent claim with a broader scope. Another interpretation is that if further limitation for each claim in a group needs to consider the correspondence between the amended claim and its predecessor, meaning the amended claim should be referenced against the claim serving as its amendment basis, then the aforementioned methods of both adding and deleting features would not be allowed, let alone increasing the number of claims.

The author believes that from the perspective of maintaining the public notice function of claims and protecting public reliance interests, it is necessary to both maintain the maximum boundary of the claim protection scope and preserve the basic dependency relationships and protection hierarchies of the claims, enabling the public to have reasonable expectations regarding the protection hierarchy and stability of different claims. From the perspective of the patentee's right

to amend claims, the primary purpose of amendment is to obtain an opportunity to redefine the protection scope during the invalidation stage in response to substantive defects not identified during substantive examination due to undiscovered prior art or unraised issues, rather than further enriching protection hierarchies, increasing the number of claims, or expanding the protection scope of some dependent claims. Therefore, the second interpretation of the reference point mentioned above is closer to the value orientation of balancing interests.

In the newly revised Patent Examination Guidelines (effective January 1, 2026), the one-to-one correspondence between claims before and after amendment during the invalidation stage is emphasized (judging by the Comparison Table of Claim Amendment from the Official Announcement of Patent Examination Guidelines). The author believes this reflects the CNIPA's restrictions on claim amendments during invalidation: on one hand, the number of claims cannot be increased; on the other hand, only a single further limitation can be made to each claim serving as the basis.

3. Necessity of Correcting Obvious Errors

Correcting obvious errors addresses obvious clerical errors or ambiguities in the patent documents. Its recognition requires meeting two core conditions: first, a person skilled in the art can recognize the ambiguity or error; second, a single correct

understanding can be derived by reading the patent documents. Necessary correction of obvious errors ensures the clarity and accuracy of the technical solution defined by the claims, avoiding invalidation due to expression issues.

A common situation is inherent defects in the granted text caused by translation errors during PCT national phase entry or typographical errors. Whether such defects would be recognized as obvious errors allowing correction during invalidation proceedings once became a focus of attention.

In the invalidation proceeding for the invention patent No. 200580036180.8 titled "Fatty Amine Polymer Salts for Use as Tablets," the patentee corrected the mistranslated "sodium chloride" in claim 1 back to "monovalent anion" (i.e., chloride ion) from the PCT internationally published text, thereby overcoming the defect of the granted text's amendment beyond the scope relative to the PCT international publication regarding the numerical range for sodium chloride content. The invalidation decision did not recognize this error as an obvious error and thus did not accept the patentee's amendment. However, based on reasonable protection of the patentee's technical contribution, the invalidation decision also did not find that granted claim 1 constituted an amendment beyond scope. The first and second-instance courts in the administrative litigation for this case made different determinations, holding

that the limitation regarding chloride compound content was not recorded in the original description or claims (PCT application), and that the applicant should bear the consequences for not discovering and correcting the translation error during substantive examination.

This case shows that the CNIPA does not consider translation errors as obvious errors. Although the amendment in this case was necessary for the patentee, in many other situations, if patent stability is not affected, it is unnecessary to touch upon the potentially contentious issue of correcting obvious errors. Even if there is some dispute over the claim's protection scope, it can be left for determination and resolution during infringement litigation proceedings.

III. Conclusion

Amending claims in patent invalidation proceedings is not merely a simple text adjustment but a systematic strategy based on "legality as the foundation, targeting as the core, stability and practicality as the goals." Mastering scientific amendment strategies can not only effectively respond to invalidation challenges but also maximize the protective value of patents. With the continuous refinement of patent examination standards, claim amendment strategies also need constant updating. As patentees, it is essential to pay closer attention to the alignment between

amendments and specific case circumstances, particularly evidence analysis and argument presentation, to

construct a more robust defense system for invalidation proceedings.

The "Featured article" is not equal to legal opinions.

If you need special legal opinions, please consult our professional consultants and lawyers.

Email address : ltbj@lungtin.com Website www.lungtin.com

For more information, please contact the author of this article.



YAN, Zhujun

Partner, Attorney at
Law, Patent Attorney

Mr Yan's main practice areas include: intellectual property litigation and arbitration; patent and trademark invalidation declarations; intellectual property administrative law enforcement cases; and intellectual property legal counsel services. He has represented a large number of cases involving patent invalidation declarations and administrative litigation thereof, patent infringement, ownership disputes and other civil cases, and has provided enterprises with numerous consulting reports on patent portfolio, early warning and infringement analysis. The cases he represented have been repeatedly selected into the Top Ten Cases of the Patent Reexamination Board of CNIPA.

Mr. Yan used to work in Patent Reexamination Board and Department of Treaty and Law of the CNIPA for more than 10 years. He examined hundreds of patent invalidation cases in the fields of medical biotechnology, utility models and industrial designs, and participated in the fourth revision of the Patent Law and a number of research projects of CNIPA, and published several articles in China Invention & Patent, Intellectual Property News and CNIPA Examination Business Newsletter. He has rich experience in patent law interpretation, patent infringement determination and government affairs coordination.