



AMENDING PATENT CLAIMS  
(ASEAN & CHINA)

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## BRUNEI

Country	Pre-publication claim amendments	Post-publication claim amendments	Substantive examination claim amendments	Post substantive examination claim amendments	Post grant claim amendments	Post issuance invalidity proceedings claim amendments
Brunei	Can claims be amended before the publication of a patent?	Can claims be amended after the publication of a patent and if so, what are the conditions?	Can claims be amended during the patent substantive examination and if so, what are the conditions?	Can claims be amended after the completion of the substantive examination of a patent, and if so, what are the conditions (e.g. non-broadening substitute claims)	Can claims be amended after the grant of a patent, and if so, what are the conditions, especially whether the Patent Office will require a new publication and substantive examination of the amended claims/patent and if so, how long would it take approximately?	During invalidity action, would a dependent claim (e.g. Claim 2) be automatically rendered invalid merely on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid? If not, can claims be amended (e.g. Claim 1 + 2 are merged) to allow Claim 1 (in the above example) to remain valid?
	YES	<p>YES</p> <ul style="list-style-type: none"> <li>A copy set of amendments is required. No additional patents forms required if done before requesting for Grant.</li> </ul>	<p>YES</p> <ul style="list-style-type: none"> <li>A copy set of amendments is needed. No additional patents forms required if done before requesting for Grant.</li> </ul>	<p>YES</p> <ul style="list-style-type: none"> <li>A copy set of amendments is needed. No additional patents forms required if done before requesting for Grant.</li> </ul>	<p>YES</p> <ul style="list-style-type: none"> <li>Filing for amendments after Grant is required. There will be additional fees. A copy set of amendments is needed. Usually any amendments done would need to file for substantive Examination. How long it takes depends on the designated Examiner.</li> </ul>	N/A

## CAMBODIA

Country	Pre-publication claim amendments	Post-publication claim amendments	Substantive examination claim amendments	Post substantive examination claim amendments	Post grant claim amendments	Post issuance invalidity proceedings claim amendments
Cambodia	Can claims be amended before the publication of a patent?	Can claims be amended after the publication of a patent and if so, what are the conditions?	Can claims be amended during the patent substantive examination and if so, what are the conditions?	Can claims be amended after the completion of the substantive examination of a patent, and if so, what are the conditions (e.g. non-broadening substitute claims)	Can claims be amended after the grant of a patent, and if so, what are the conditions, especially whether the Patent Office will require a new publication and substantive examination of the amended claims/patent and if so, how long would it take approximately?	During invalidity action, would a dependent claim (e.g. Claim 2) be automatically rendered invalid merely on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid? If not, can claims be amended (e.g. Claim 1 + 2 are merged) to allow Claim 1 (in the above example) to remain valid?
	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>Time limit: Amendment is allowed up to the time when the application is in order for grant.</li> <li>Condition: Any amendment must not go beyond the disclosure in the initial application.</li> </ul>	<ul style="list-style-type: none"> <li>If the substantive examination results in a decision on refusal to grant patent, the applicant can file an appeal against the refusal decision before competent courts. Relevant regulations are silent on whether amendment is possible during appeal procedure and there is no</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>Requirement: possible only by narrowing the scope of protection.</li> <li>Condition: amendment must not go beyond the disclosure contained in the initial application on which the patent was granted</li> <li>Correction of obvious errors in patent claims is possible.</li> <li>A new substantive examination of the amended claims of the granted patent is</li> </ul>	<ul style="list-style-type: none"> <li>By laws, invalidation of patents is handled by courts. However, in practice, MIH is in charge, i.e. accepting the request and communicate with relevant foreign patent offices that grant the corresponding patent application and work closely with them to deal with such action. Those foreign offices will decide on the issue based on their examination practice and policy.</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>Time limit: Amendment is allowed up to the time when the application is in order for grant</li> <li>Condition: Any amendment must not go beyond the disclosure in the initial application.</li> </ul> <p><b>Note:</b></p> <ul style="list-style-type: none"> <li>Under current practice, publication of</li> </ul>	<ul style="list-style-type: none"> <li>If the substantive examination results in a decision on refusal to grant patent, the applicant can file an appeal against the refusal decision before competent courts. Relevant regulations are silent on whether amendment is possible during appeal procedure and there is no precedent in practice.</li> <li>If the substantive examination results in</li> </ul>

	<p><b>Note:</b></p> <ul style="list-style-type: none"> <li>Under current practice, publication of patent application is not yet available.</li> <li>There is no substantive examination team in Cambodia patent office (MIH). Therefore, the examination is conducted by external foreign patent offices upon request of the applicant.</li> </ul>	<p>precedent in practice.</p> <ul style="list-style-type: none"> <li>If the substantive examination results in a Notice of Allowance (NOA): amendment is possible based on the following:             <ol style="list-style-type: none"> <li><b>Condition:</b> any amendment must not go beyond the disclosure in the initial application and the applicant is required to submit a request to amend claims to MIH who then will forward the request to relevant foreign patent offices to conduct the substantive examination. The amendment is subject to payment of re-examination fee set by those foreign patent offices.</li> <li></li> </ol> </li> </ul>	<p>required. How long it would take depends on the foreign patent office who examines the initial application on the basis of which the patent was granted and handles the examination of the amended claims of the patent.</p> <ul style="list-style-type: none"> <li>Relevant regulations are silent on new publication of amended claims of granted patent.</li> </ul>		<p>patent application is not yet available.</p> <ul style="list-style-type: none"> <li>There is no substantive examination team in Cambodia patent office (MIH). Therefore, the examination is conducted by external foreign patent offices upon request of the applicant.</li> </ul>	<p>a Notice of Allowance (NOA): amendment is possible based on the following:</p> <ol style="list-style-type: none"> <li><b>Condition:</b> any amendment must not go beyond the disclosure in the initial application and the applicant is required to submit a request to amend claims to MIH who then will forward the request to relevant foreign patent offices to conduct the substantive examination. The amendment is subject to payment of re-examination fee set by those foreign patent offices.</li> <li></li> </ol>
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## INDONESIA

Country	Pre-publication claim amendments	Post-publication claim amendments	Substantive examination claim amendments	Post substantive examination claim amendments	Post grant claim amendments	Post issuance invalidity proceedings claim amendments
Indonesia	Can claims be amended before the publication of a patent?	Can claims be amended after the publication of a patent and if so, what are the conditions?	Can claims be amended during the patent substantive examination and if so, what are the conditions?	Can claims be amended after the completion of the substantive examination of a patent, and if so, what are the conditions (e.g. non-broadening substitute claims)	Can claims be amended after the grant of a patent, and if so, what are the conditions, especially whether the Patent Office will require a new publication and substantive examination of the amended claims/patent and if so, how long would it take approximately?	During invalidity action, would a dependent claim (e.g. Claim 2) be automatically rendered invalid merely on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid? If not, can claims be amended (e.g. Claim 1 + 2 are merged) to allow Claim 1 (in the above example) to remain valid?
	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>The amended claims should not extend the scope of invention as originally filed.</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>The amended claims should not extend the scope of invention as originally filed.</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>The amended claims should not extend the scope of invention as originally filed.</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>The amendment can be filed after the issuance of substantive examination result (1<sup>st</sup>, 2<sup>nd</sup>...) but should be before the final decision (notice of allowance/rejection). The amended claims should not extend the scope of invention as originally filed.</li> </ul>	<ul style="list-style-type: none"> <li>Post grant amendment can be requested to the Patent appeal commission for translation error within 3 months from the grant date. The implementation of this is still new, and it is too early to check the practice of this process as well as the turnaround time.</li> </ul>	<p><b>NO</b></p> <ul style="list-style-type: none"> <li>In theory the independent claim 1 is the broadest one. If claim 2 contains specific technical features which are able to distinguish it from those of the prior arts (which invalid claim 1), then the claim 2 will not be automatically rendered invalid merely on the basis that the claim that it is dependent upon claim 1. However, there is too little body of case law to give clear guidance in this regard.</li> </ul>

## LAOS

Country	Pre-publication claim amendments	Post-publication claim amendments	Substantive examination claim amendments	Post substantive examination claim amendments	Post grant claim amendments	Post issuance invalidity proceedings claim amendments
Laos	Can claims be amended before the publication of a patent?	Can claims be amended after the publication of a patent and if so, what are the conditions?	Can claims be amended during the patent substantive examination and if so, what are the conditions?	Can claims be amended after the completion of the substantive examination of a patent, and if so, what are the conditions (e.g. non-broadening substitute claims)	Can claims be amended after the grant of a patent, and if so, what are the conditions, especially whether the Patent Office will require a new publication and substantive examination of the amended claims/patent and if so, how long would it take approximately?	During invalidity action, would a dependent claim (e.g. Claim 2) be automatically rendered invalid merely on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid? If not, can claims be amended (e.g. Claim 1 + 2 are merged) to allow Claim 1 (in the above example) to remain valid?
	<b>YES</b> <ul style="list-style-type: none"> <li>The amended claims should not extend the scope of invention as originally filed.</li> </ul>	<b>YES</b> <ul style="list-style-type: none"> <li>The amended claims should not extend the scope of invention as originally filed.</li> </ul>	<b>YES</b> <ul style="list-style-type: none"> <li>The amended claims should not extend the scope of invention as originally filed.</li> </ul>	<b>YES</b> <ul style="list-style-type: none"> <li>The amended claims should not extend the scope of invention as originally filed.</li> </ul>	<b>N/A</b>	<b>N/A</b>

## MALAYSIA

Country	Pre-publication claim amendments	Post-publication claim amendments	Substantive examination claim amendments	Post substantive examination claim amendments	Post grant claim amendments	Post issuance invalidity proceedings claim amendments
Malaysia	Can claims be amended before the publication of a patent?	Can claims be amended after the publication of a patent and if so, what are the conditions?	Can claims be amended during the patent substantive examination and if so, what are the conditions?	Can claims be amended after the completion of the substantive examination of a patent, and if so, what are the conditions (e.g. non-broadening substitute claims)	Can claims be amended after the grant of a patent, and if so, what are the conditions, especially whether the Patent Office will require a new publication and substantive examination of the amended claims/patent and if so, how long would it take approximately?	During invalidity action, would a dependent claim (e.g. Claim 2) be automatically rendered invalid merely on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid? If not, can claims be amended (e.g. Claim 1 + 2 are merged) to allow Claim 1 (in the above example) to remain valid?
	<ul style="list-style-type: none"> <li>There is no publication stage for a pending patent application, but the application is made available for public inspection after 18 months from the first priority date.</li> <li>Yes, the claims can be amended before the application is made available for public inspection provided that the amendments made do not go</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>The claims can be amended provided that the amendments made do not go beyond the disclosure of the application as originally filed.</li> </ul>	<p><b>YES</b></p> <p>The claims can be amended provided that the amendments made do not go beyond the disclosure of the application as originally filed.</p>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>The claims can be amended provided that the amendments made do not go beyond the disclosure of the application as originally filed.</li> <li>The claims may be broadened if the broadened claims do not go beyond the disclosure of the application as originally filed. However, if substantive examination has been completed, there is the additional proviso that a Notice of Allowance</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>The claims can be amended after the grant of a patent, provided that the amended claims do not confer a scope of protection which is broader than that conferred at the time of grant of the patent.</li> <li>The amendments must also not go beyond the disclosure of the patent application as originally filed.</li> <li>The post grant amendments will undergo substantive examination</li> </ul>	<p><b>NO</b></p> <ul style="list-style-type: none"> <li>A dependent claim would not be automatically rendered invalid merely on the basis that the independent claim that it is dependent upon is found to be invalid. This is in light of the recent Malaysia Federal Court decision of 21 August 2019 in <i>Merck v Hovid</i>, which overturned the ruling made by a previous Federal Court decision in the <i>SKB Shutters</i> case about 4 years ago.</li> <li>In the example given, if independent claim 1 is held invalid, dependent</li> </ul>



	beyond the disclosure of the application as originally filed.			(Clear Substantive Examination Report) must not have been issued yet.	which may take approximately 6 months.	claim 2 which is narrower in scope may still be valid. Thus claim 2 may be converted to an independent claim; however, under the current law, such amendments can only be made after the court case has come to an end.
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## MYANMAR

Country	Pre-publication claim amendments	Post-publication claim amendments	Substantive examination claim amendments	Post substantive examination claim amendments	Post grant claim amendments	Post issuance invalidity proceedings claim amendments	Remarks
Myanmar	Can claims be amended before the publication of a patent?	Can claims be amended after the publication of a patent and if so, what are the conditions?	Can claims be amended during the patent substantive examination and if so, what are the conditions?	Can claims be amended after the completion of the substantive examination of a patent, and if so, what are the conditions (e.g. non-broadening substitute claims)	Can claims be amended after the grant of a patent, and if so, what are the conditions, especially whether the Patent Office will require a new publication and substantive examination of the amended claims/patent and if so, how long would it take approximately?	During invalidity action, would a dependent claim (e.g. Claim 2) be automatically rendered invalid merely on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid? If not, can claims be amended (e.g. Claim 1 + 2 are merged) to allow Claim 1 (in the above example) to remain valid?	
	N/A  (Probably YES in Regulations)	N/A  (Probably YES in Regulations)	N/A  (Probably YES in Regulations)	N/A  (Probably YES in Regulations)	N/A  (Probably NO in Regulations)	N/A  (Probably YES in Regulations)	<ul style="list-style-type: none"> <li>The amendment for application, translation error and document can be requested to the registrar on payment of the prescribed fee before the registrar makes decision or before the Agency decides regarding the appeal on the decision of the registrar. However, the amendment of the application should not be exceeded the scope of invention as originally described.</li> </ul>

## PHILIPPINES

Country	Pre-publication claim amendments	Post-publication claim amendments	Substantive examination claim amendments	Post substantive examination claim amendments	Post grant claim amendments	Post issuance invalidity proceedings claim amendments
Philippines	Can claims be amended before the publication of a patent?	Can claims be amended after the publication of a patent and if so, what are the conditions?	Can claims be amended during the patent substantive examination and if so, what are the conditions?	Can claims be amended after the completion of the substantive examination of a patent, and if so, what are the conditions (e.g. non-broadening substitute claims)	Can claims be amended after the grant of a patent, and if so, what are the conditions, especially whether the Patent Office will require a new publication and substantive examination of the amended claims/patent and if so, how long would it take approximately?	During invalidity action, would a dependent claim (e.g. Claim 2) be automatically rendered invalid merely on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid? If not, can claims be amended (e.g. Claim 1 + 2 are merged) to allow Claim 1 (in the above example) to remain valid?
	<b>YES</b>	<b>YES</b> <ul style="list-style-type: none"> <li>Claims may be amended by cancelling particular claims, by presenting new claims, or by amending the language of particular new claims.</li> </ul>	<b>YES</b> <ul style="list-style-type: none"> <li>In presenting new or amended claims during examination, the applicant must point out how they avoid any reference or ground of refusal of record which may be permitted. Further, in order to facilitate the processing of the examination of the application, the applicant shall indicate in his response which form part in the original disclosure constitutes the basis of the amendments.</li> </ul>	<b>YES</b> <ul style="list-style-type: none"> <li>At any time before a patent is granted or refused, the applicant may still present amendments to the claims. The conditions for amending claims during substantive examination would apply.</li> </ul>	<b>YES</b> <ul style="list-style-type: none"> <li>The owner of a patent may request to make changes in the patent but only in order to:                             <ol style="list-style-type: none"> <li>limit the extent of the protection conferred by it;</li> <li>correct obvious mistakes or to correct clerical errors; and</li> <li>correct mistakes or errors, other than those referred to in section (b), made in good faith; Provided, that where the change would result in broadening of the extent of the protection conferred by the patent, no request may be made after the expiration of two (2) years from the grant of a patent and the change shall not affect the rights of any third party which has relied on the patent, as published.</li> </ol> </li> </ul>	<b>YES</b> <ul style="list-style-type: none"> <li>A dependent claim is not automatically rendered invalid on the basis that the claim it is dependent upon is found to be invalid. The qualifying element(s) in the dependent claim may render such dependent claim novel/inventive.</li> <li>Yes, the claims may be amended and merged with other claims during the cancellation proceedings to allow the main claim, e.g., claim 1, as amended, to be valid.</li> </ul>

## THAILAND

Country	Pre-publication claim amendments	Post-publication claim amendments	Substantive examination claim amendments	Post substantive examination claim amendments	Post grant claim amendments	Post issuance invalidity proceedings claim amendments
Thailand	Can claims be amended before the publication of a patent?	Can claims be amended after the publication of a patent and if so, what are the conditions?	Can claims be amended during the patent substantive examination and if so, what are the conditions?	Can claims be amended after the completion of the substantive examination of a patent, and if so, what are the conditions (e.g. non-broadening substitute claims)	Can claims be amended after the grant of a patent, and if so, what are the conditions, especially whether the Patent Office will require a new publication and substantive examination of the amended claims/patent and if so, how long would it take approximately?	During invalidity action, would a dependent claim (e.g. Claim 2) be automatically rendered invalid merely on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid? If not, can claims be amended (e.g. Claim 1 + 2 are merged) to allow Claim 1 (in the above example) to remain valid?
	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>A voluntary amendment to the claims can be initiated at any time before grant.</li> <li>The amended claims must, at least, comply with the followings:                             <ol style="list-style-type: none"> <li>The amended claims must not go beyond the scope of the application as originally filed;</li> </ol> </li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>A voluntary amendment to the claims can be initiated at any time before grant.</li> <li>The amended claims must, at least, comply with the followings:                             <ol style="list-style-type: none"> <li>The amended claims must not go beyond the scope of the application as originally filed;</li> </ol> </li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>A voluntary amendment to the claims can be initiated at any time before grant.</li> <li>The amended claims must, at least, comply with the followings:                             <ol style="list-style-type: none"> <li>The amended claims must not go beyond the scope of the application as originally filed;</li> <li>The amended claims must not involve non-patentable subject matters according to Section 9 of the Thai Patent Act;</li> <li>The amended claims comply with the requirement of unity of invention.</li> </ol> </li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>So long as the Notice of Grant has not been issued and the applicant has not paid the grant fee.</li> <li>Same conditions of amendment are applied.</li> </ul>	<p><b>NO</b></p> <ul style="list-style-type: none"> <li>The patentee cannot amend claims of the patent after the grant. However, the patentee is allowed to surrender claim or claims as Section 53 provides that the patentee may surrender any claim or claims, subject to a consent of concerned parties; e.g. co-patentee, licensee(s) etc.</li> </ul>	<p><b>NO</b></p> <ul style="list-style-type: none"> <li>If the patent is subject to an invalidation case, it is not possible to make a correction or amendment of the claims. This is indicated in Article 4(2) of the Ministerial Regulations No. 27 issued under Section 53, which provides that the surrender of patents or petty patents, or the cancellation of claims to a patent or petty patent, is prohibited in case wherein a complaint is made to the court, requesting the revocation of the patent or petty patent which is subject to surrender or cancellation of claims.</li> </ul>

	<p>b. The amended claims must not involve non-patentable subject matters according to Section 9 of the Thai Patent Act;</p> <p>c. The amend claims comply with the requirement of unity of invention.</p>	<p>b. The amended claims must not involve non-patentable subject matters according to Section 9 of the Thai Patent Act;</p> <p>c. The amended claims comply with the requirement of unity of invention.</p>	<ul style="list-style-type: none"> <li>In practice, claims amendment during the substantive examination is made to conform to a corresponding granted patent, which presents both pros and cons. As for the pros, it expedites examination. But for the cons, it could be unfavorable if such corresponding granted patent receives an opposition after its grant. The opposition procedure of the corresponding patent could delay the examination of the Thai patent application, and if the result of the opposition is negative (i.e. the corresponding patent is revoked.), the Thai patent application could subject to an objection based on the same ground as the opposition.</li> </ul>			<ul style="list-style-type: none"> <li>Further, during invalidity action, a dependent claim (e.g. Claim 2) will be invalidated on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid by the Court. Thai Judges refer to Section 54 of the Patent Act to base their decision. Under that Section “<i>Any patent granted not in compliance with the provisions of section 5, section 9, section 10, section 11 or section 14 shall be deemed invalid [...]</i>”. However, Section 5 of the same Act reads “<i>an invention eligible for a patent application shall consist of the following characteristics: (1) the invention is new; (2) the invention involves an inventive step and; (3) the invention is industrially applicable</i>”. Section 5 does not limit the grounds of invalidation to apply to only independent claim(s) but to all claims since it mentions “the invention” and as such dependent claims should be treated as having their fate untied to the validity of their parent independent claim.</li> </ul>
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## SINGAPORE

Country	Pre-publication claim amendments	Post-publication claim amendments	Substantive examination claim amendments	Post substantive examination claim amendments	Post grant claim amendments	Post issuance invalidity proceedings claim amendments
Singapore	Can claims be amended before the publication of a patent?	Can claims be amended after the publication of a patent and if so, what are the conditions?	Can claims be amended during the patent substantive examination and if so, what are the conditions?	Can claims be amended after the completion of the substantive examination of a patent, and if so, what are the conditions (e.g. non-broadening substitute claims)	Can claims be amended after the grant of a patent, and if so, what are the conditions, especially whether the Patent Office will require a new publication and substantive examination of the amended claims/patent and if so, how long would it take approximately?	During invalidity action, would a dependent claim (e.g. Claim 2) be automatically rendered invalid merely on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid? If not, can claims be amended (e.g. Claim 1 + 2 are merged) to allow Claim 1 (in the above example) to remain valid?
	<ul style="list-style-type: none"> <li>Pre-grant amendments of a patent (or patent application) is allowable at any time except after a request for a search report, a search and examination report, an examination report or a supplementary examination report, or an examination</li> </ul>	<ul style="list-style-type: none"> <li>Pre-grant amendments of a patent (or patent application) is allowable at any time except after a request for a search report, a search and examination report, an examination report or a supplementary examination report, or an examination</li> </ul>	<ul style="list-style-type: none"> <li>After examination has been requested, the claims can only be amended in response to a Written Opinion (Office Action) issued by the examiner. Similarly, any claim amendments must have support in the description.</li> </ul>	<ul style="list-style-type: none"> <li>If the examination report is positive and a notice of eligibility is issued (i.e. the patent application is allowable), no amendments to the claims are allowed. The only amendments allowable at this point are those made to meet the formal requirements, e.g. title, abstract, drawings, page numbering.</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>Post grant claim amendments must have support in the patent specification (i.e. no new subject matter) and must not extend the scope of protection.</li> <li>The patent proprietor needs to provide evidence setting out fully the reason(s) for the amendments.</li> <li>Post-grant amendments will be assessed on the following criteria:                             <ol style="list-style-type: none"> <li>Whether relevant matters are sufficiently disclosed;</li> </ol> </li> </ul>	<ul style="list-style-type: none"> <li>It is possible for claims to be amended to remain valid in invalidity proceedings, but it is at the discretion of the court or Registrar. The same points as above for the post-grant amendments by the patentee would be considered by the court or Registrar in whether to allow the amendments.</li> <li>In a recent Court of Appeal (CA) judgement, the CA indicated <i>in obiter</i> that “if the independent claims are invalid, it</li> </ul>

	<p>review (i.e. after a Notice of Refusal is issued).</p> <ul style="list-style-type: none"> <li>Whether the patent application has been published does not affect whether amendments to the claims can be made.</li> <li>Any claim amendments must have support in the description, i.e. no new subject matter.</li> </ul>	<p>review (i.e. after a Notice of Refusal is issued).</p> <ul style="list-style-type: none"> <li>Whether the patent application has been published does not affect whether amendments to the claims can be made.</li> <li>Any claim amendments must have support in the description, i.e. no new subject matter.</li> </ul>		<ul style="list-style-type: none"> <li>If the examination report is negative and a notice of refusal is issued (i.e. the patent application is not allowable), amendments to the claims may be made before the request for examination review.</li> </ul>	<ul style="list-style-type: none"> <li>b. Whether there was any unreasonable delay in seeking amendments; and</li> <li>c. Whether the patentee has gained an unfair advantage obtained by delaying amendments which are known to be needed.</li> <li>d. The proposed amendments would be sent to a patent examiner for review. Typically, we would expect any objection from the examiner to be received within 6 months. If the amendments are allowed, the amended specification would be published for opposition by any person for a 2 month period.</li> <li>e. If there is no opposition within the 2 month period, the amended specification would be accepted.</li> </ul> <ul style="list-style-type: none"> <li>For post-grant amendments, an important point for the patentee to take note of is that when there are corresponding patents in other countries, the patentee should review the claims in the SG patent to determine if the claims are valid over additional prior art that may have been cited in other countries.</li> </ul>	<p><i>follows the dependent claims must also fall</i>". However, the case before the CA itself was with regards to whether the court had jurisdiction to revoke a patent and not on the validity of the patent claims. As a result, this point was not raised by either party in their pleadings and it is not clear how the CA arrived at this.</p> <ul style="list-style-type: none"> <li>The Singapore patent office recently issued a circular stating that the examination of independent and dependent claims continue to apply. As a result, there is some uncertainty as to the issue, although we are of the view that dependent claims are valid on its own. Nonetheless in invalidity proceedings, it would be prudent to plead that the dependent claims are separately valid.</li> </ul>
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## VIETNAM

Country	Pre-publication claim amendments	Post-publication claim amendments	Substantive examination claim amendments	Post substantive examination claim amendments	Post grant claim amendments	Post issuance invalidity proceedings claim amendments
Vietnam	Can claims be amended before the publication of a patent?	Can claims be amended after the publication of a patent and if so, what are the conditions?	Can claims be amended during the patent substantive examination and if so, what are the conditions?	Can claims be amended after the completion of the substantive examination of a patent, and if so, what are the conditions (e.g. non-broadening substitute claims)	Can claims be amended after the grant of a patent, and if so, what are the conditions, especially whether the Patent Office will require a new publication and substantive examination of the amended claims/patent and if so, how long would it take approximately?	During invalidity action, would a dependent claim (e.g. Claim 2) be automatically rendered invalid merely on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid? If not, can claims be amended (e.g. Claim 1 + 2 are merged) to allow Claim 1 (in the above example) to remain valid?
	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>Time limit: amendment must be filed before issuance of a Decision on refusal of formality acceptance.</li> <li>Requirements: Amendment must not go beyond the content disclosed in the original specification and must not change the nature of the subject matter stated in the</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>Time limit: amendment must be filed before issuance of a Decision on grant (grant date) or Decision on refusal to grant patent.</li> <li>Requirements: Amendment must not go beyond the content disclosed in the original specification and must not change the nature of the</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>Time limit: amendment must be filed before issuance of a Decision on grant (grant date) or Decision on refusal to grant patent.</li> <li>Requirements: Amendment must not go beyond the content disclosed in the original specification and must not change the nature of the</li> </ul>	<ul style="list-style-type: none"> <li>If the substantive examination results in a Decision on refusal to grant patent: amendment is impossible after the refusal Decision. This means that it is impossible for amendment submitted when filing the appeal or during the appeal procedure.</li> <li>If the substantive examination</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>Requirements: possible only if narrowing the scope of protection. IP Vietnam has recently confirmed that only amendment by deletion of one or more claims of the patent is allowed.</li> <li>Re-examination of amendment of patent claims is required. Time frame for re-examination: not exceeding 12 months from the date requesting the amendment. In practice, the re-examination period may be longer due to IP Vietnam' backlog.</li> <li>Publication: yes (publication of decision on amendment of patent</li> </ul>	<p><b>NO</b></p> <ul style="list-style-type: none"> <li>A dependent claim (e.g. Claim 2) is not automatically rendered invalid merely on the basis that it is dependent upon (e.g. independent Claim 1) is found to be invalid.</li> <li>There is no detailed guidance on post issuance invalidity proceedings claim amendment. However, no prohibition of amendment during invalidation procedure. Therefore, it is interpreted that amendment of claim during invalidation is possible.</li> <li>Requirements: only possible by narrowing the scope of protection. IP Vietnam has recently confirmed that only amendment by deletion of one or more claims of the patent is allowed.</li> <li>Therefore, it is possible for amending claims by deleting invalid independent claims and incorporating all technical features from the deleted independent claims into the dependent claims (e.g.</li> </ul>



	<p>application. Explanation/su pport for the amendment is required.</p>	<p>subject matter stated in the application. Explanation/su pport for the amendment is required.</p>	<p>subject matter stated in the application. Explanation/su pport for the amendment is required.</p>	<p>results in a Notice of Allowance (NOA): amendment after receiving the NOA is possible:</p> <ol style="list-style-type: none"> <li>a. Time limit: Amendment must be filed before issuance of a Decision on grant (grant date).</li> <li>b. Requirements: A mendment must not go beyond the content disclosed in the original specification and must not change the nature of the subject matter stated in the application. Explanation/sup port for the amendment is required.</li> <li>c. The application is subject to re-examination (examination fee must be paid).</li> </ol>	<p>claims in the IP Gazette). Publication is 2 months as of the date of decision on amendment. Correction of obvious errors in patent claims is possible. The patent owner must pay a required fee for the rectification if the error is due to its fault. If the error is caused by IP Vietnam, the patent owner is not required to pay the fee. However, in practice, because no detailed guidance on obvious errors, rectification of errors will be examined and accepted by IP Vietnam on case by case basis.</p>	<p>incorporating all technical features of claim 1 into claim 2).</p>
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## CHINA

Country	Pre-publication claim amendments	Post-publication claim amendments	Substantive examination claim amendments	Post substantive examination claim amendments	Post grant claim amendments	Post issuance invalidity proceedings claim amendments
China	Can claims be amended before the publication of a patent?	Can claims be amended after the publication of a patent and if so, what are the conditions?	Can claims be amended during the patent substantive examination and if so, what are the conditions?	Can claims be amended after the completion of the substantive examination of a patent, and if so, what are the conditions (e.g. non-broadening substitute claims)	Can claims be amended after the grant of a patent, and if so, what are the conditions, especially whether the Patent Office will require a new publication and substantive examination of the amended claims/patent and if so, how long would it take approximately?	During invalidity action, would a dependent claim (e.g. Claim 2) be automatically rendered invalid merely on the basis that the claim that it is dependent upon (e.g. independent Claim 1) is found to be invalid? If not, can claims be amended (e.g. Claim 1 + 2 are merged) to allow Claim 1 (in the above example) to remain valid?
	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>If the applicant makes amendments when filing the substantial amendment request before publication. But the amendments will not be published in the publication of application.</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>The amendments should not go beyond the scope of the original claims and specification.</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>The amendments should not go beyond the scope of the original claims and specification. When filing a request of examination or within three months after entering into the substantive examination procedure, the applicant can make voluntary amendments; after, the applicant can only make amendments based on the office actions.</li> </ul>	<p><b>YES</b></p> <ul style="list-style-type: none"> <li>If patent right to be issued; after the completion of the examination procedure the applicant can only make amendments through filing divisional application.</li> <li>Yes, if patent application to be rejected; after issuing of Rejection Decision the applicant can file reexamination request and make amendments against the rejection.</li> </ul>	<p><b>NO</b></p>	<p><b>NO</b></p> <ul style="list-style-type: none"> <li>The dependent claim can remain valid if it possesses patentability. Such amendments are called “deletion” (same as “merge”).</li> </ul>