

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

## **Part III: AMENDMENT OF DESCRIPTION, CLAIMS AND DRAWINGS**

<b>Section I New Matter</b> .....	1
1. Relevant Provisions.....	1
2. Purport of Conditions for Amendment.....	1
3. Basic Principles.....	1
4. Amendment of Claims.....	3
4.1 General Principle.....	3
4.2 Detailed Discussion.....	3
5. Amendment of Detailed Description of the Invention.....	7
5.1 General Principle.....	7
5.2 Detailed Discussion.....	8
6. Amendment of Drawings.....	9
7. Explanation by an Applicant.....	9
<b>Section II Amendment that Changes a Special Technical Feature of an Invention</b> .....	11
1. Relevant Provisions.....	11
2. Purport of Article 17bis(4).....	11
3. Basic Concept.....	12
4. Procedure of Examination.....	12
4.1 Basic Procedure of Examination.....	12
4.2 Example of Basic Procedure of Examination.....	13
4.3 Procedure of Examination in Case where the Invention First mentioned in the Claims before an Amendment Does Not Have Any Special Technical Feature.....	15
4.3.1 Where an Invention with a Special Technical Feature Was Found among Inventions in the Claims before the Amendment that Were the Subject of the Examination.....	15
4.3.2 Where All Claimed Inventions before an Amendment that Were the Subject of the Examination Do Not Have Special Technical Features.....	17
5. Remarks.....	19
<b>Section III Amendment of Claims after Final Notice of Reasons for Refusal</b> .....	21
1. Basic Concept.....	21
2. Practical Application.....	21
2.1 Prohibition of Addition of New Matter (Patent Act Article 17bis (3)).....	21
3. Cancellation of Claim(s) (Patent Act Article 17bis(4)(i)) .....	21
3.1 Purport.....	21
3.2 Practical Application.....	22
4. Restriction of Claim(s) (Patent Act Article 17bis (5)(ii) and (6)) .....	22
4.1 Purport.....	22
4.2 Requirements for Restriction of Claim(s).....	22
4.3 Practical Application.....	23

4.3.1 Restriction of Claim(s).....	23
4.3.2 Restriction of Matters Necessary to Specify the Invention.....	23
4.3.3 Same Industrial Applicability and Problems to be Solved.....	24
4.3.4 Independently Patentable.....	25
4.4 Notes in Cases where Plural Amendments are Made after Final Notice of Reasons for Refusal.....	25
5. Clarification of Ambiguous Description (Patent Act Article 17bis(5)(iv)).....	25
5.1 Purport.....	25
5.2 Meaning of "Clarification of Ambiguous Description".....	26
5.3 Relation to Matters Mentioned in Reasons for Refusal.....	26
6. Correction of Errors in Description (Patent Act Article 17bis(5)(iii)).....	26
6.1 Purport.....	26
6.2 Meaning of " Correction of Errors in Description" .....	27
7. Procedure of Judgment.....	27

## **Section I New Matter**

### **1. Relevant Provision**

Patent Act Article 17bis(3) reads:

“...any amendment of the description, scope of claims or drawings... shall be made within the scope of the matters described in the description, scope of claims or drawings originally attached to the application...”

If an amendment fails to meet the requirement, it falls under a reason for refusal (Article 49(1)), as well as a ground for invalidation (Article 123(1)(i)). And an amendment in response to the final notice of reasons for refusal or an amendment made at the time of demanding an appeal against examiner’s decision of refusal is subject to the dismissal of amendment, if such amendment does not satisfy the requirement (Article 53, Article 159(1) and Article 163(1) respectively).

(Explanation)

Article 17bis(3) was stipulated with respect to amendment of a description, claims or drawings (hereinafter referred to as "description, etc.") based on Article 11 of the Act Concerning the International Application of the Patent Cooperation Treaty and Related Matters (hereinafter referred to as “International Application Act”). Article 11 of the International Application Act is applied in line with the PCT Guidelines aiming to prohibit adding of new matter like practices in the United States or Europe.

### **2. Purport of Conditions for Amendment**

It is desirable for an applicant to submit a complete description, etc. as of filing, for a smooth and prompt examination procedure. In fact, however, an application without any flaws cannot be expected in a few cases. Hence, it is necessary to allow an amendment of a description, etc. under certain conditions. If an amendment, however, which extends beyond the content of the description, etc. originally attached to a request (hereinafter referred to as "original description, etc.") were permitted, third parties relying on the content of the original description, etc. might suffer from unforeseeable disadvantages because the amendment would be in force retroactively from the time of filing.

For the purpose of settling the conflict of interests between an applicant and third parties, the Patent Act defines that any amendment shall be made within the scope of matters described in the original description, etc..

### **3. Basic Principles**

(1) An amendment which introduce matters extends beyond the “matters described in the original description, etc.” (i.e., an amendment containing new matter) is not acceptable.

(2) The phrase, “matters described in the original description, etc.” means not only “matters expressly presented in the original description, etc.” but also “matters inherently presented in the original description, etc..”

(3) In order to conclude that an amendment is done within the scope of “matters inherently presented in the original description, etc.,” the meaning of the particulars of the amendment shall be evident to a person skilled in the art in light of common general technical knowledge as of the filing date, as if it were written in the original description, etc. , even though it is not expressly presented there. (see, Notes 1 to 3)

(4) Addition of well-known art or commonly used art is not acceptable if the reason of the addition is simply because the art is well-known art or commonly used art. This kind of addition is acceptable only if such art is inherently presented in the original description, etc., that is, the art is evident to a person skilled in the art as if it were written in the original description, etc..

(5) In some cases, a matter is inherently presented to a person skilled in the art in light of several parts in the original description, etc. (e.g., problems to be solved and embodiments of an invention, a description and drawings).

Example: A specific elastic support is not disclosed in the description, but a device equipped with an elastic support is described therein. If a person skilled in the art would regard the elastic support as a helical spring, in light of matters described in the drawings and common general technical knowledge, an amendment changing the term “elastic support” to a “helical spring” is acceptable.

(Remarks)

① A priority certificate (i.e., a priority certificate in the case of priority under the Paris Convention or the like stipulated in Article 43(2) and 43bis, and a set of filing documents of an earlier application in the case of internal priority stipulated in Article 41) cannot be used as a basis for determining whether or not new matter is added in a description etc. because the priority certificate is not included in the description, etc.

② This guideline is applicable on determining whether or not a description, etc. of a divisional or a converted application is within the scope of matters described in the description, etc. of the parent application as filed.

**(Note 1)** Tokyo High Court Decision dated on Jul. 1, 2003 (Heisei 14 (Gyo Ke), No.3), Apparatus of a Network Transfer System for a Game or Pachinko or the like”

[“ Matters described in the description and drawings originally attached to the request” should be limited to either matters actually described in the description or drawings originally attached to the request or matters which are not actually described but are inherently presented in light of the actual description. Here, in order to conclude that the matters are inherently present based on an actual description, any person skilled in the art must recognize that they are all but described therein. It should not be regarded as matters inherently presented, if the matter does not become readily understandable until it is explained to a person.”]

This court decision is helpful to interpret the meaning of “matters inherently presented in the original description, etc..”

**(Note 2)** PCT Guidelines

An amendment should be regarded as introducing subject matter which extends beyond the content of the application as filed, and therefore unacceptable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information,

which was not expressly or inherently presented in the application as filed even when taking into account matter which is implicit to a person skilled in the art in what has been expressly mentioned. The term “inherently” requires that the missing descriptive matter is necessarily present in the disclosure, and that it would be recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

**(Note 3)** The Relationship with Rule 33 of the PCT

The term “Jimei” is used in a Japanese translation of Rule 33 of the PCT. This term is coined with reference to the word “obviousness” in the U.S. Patent Act which corresponds to the words “easily arrived” in Japanese Patent Act. (This is evident since the Rule 33 (1) is reciting the phrase “it does or does not involve an inventive step (to be non-obvious)”)

On the other hand, the term “Jimei” used in this examination guideline is used as a regular meaning of Japanese and stands for that “it is evident as it is without any supporting evidence (see, Koujien [5th edition] etc.),” which is similar to the interpretation of the term by courts etc.

## **4. Amendment of Claims**

### **4.1 General Principle**

After an amendment is done, if the matters specifying the claimed invention extend beyond the matters described in the original description, etc., the amendment is not acceptable.

### **4.2 Detailed Discussion**

(1) Making a generic concept or a specific concept

① If a matter, which is not described in the original description, etc., is added, as a result of amending a matter specifying the claimed invention to be conceptually generic (for example, a matter specifying the invention is deleted) or if a matter, which is not described in the original description, etc., is singled out, as a result of amending it to be conceptually specific (for example, a matter specifying the invention is added), the amendment cannot be construed to be done within the scope of matters described in the original description, etc..

② In a case where it is amended to be conceptually generic by deleting a matter specifying the claimed invention, if the deleted matter does not essentially have technical significance, and if it is evident that new technical significance is not added by the amendment, the amendment is considered to be done within matters described in the original description, etc., because no new matter is added in this case (The same is true in a case where the deleted matter is an optionally additional matter based on a description, etc.).

Incidentally, if an amendment that changes a matter specifying the invention leads to addition of a matter which extends beyond the scope of matters described in the original

description, etc., the amendment is not considered to be within the scope of matters described in the original description, etc..

[Example of an Unacceptable Amendment]

Example 1: Amendment altering a matter specifying the invention

The amendment changes the language “when the control means is not put into normal operation” to “based on the negation signal in a case where the control means is not put into normal operation.”

(Explanation)

In this example, the original description, etc. merely states that when a control means fails to put into normal operation, absence of a positive signal lasts for a certain period of time and then a resetting signal starts. This amendment adds a situation where the resetting signal starts on the basis of a “negation signal” different from the absence of a positive signal, but this situation is not mentioned in the original description, etc..

(Reference: Tokyo High Court Decision dated on Nov. 16, 2001 (Heisei 12 (Gyo-Ke), No.221, “Apparatus for controlling a Pachinko Machine”)

[Example of an Acceptable Amendment]

Example 2: Amendment deleting a part of matters specifying the invention

The amendment changes the language “an impurity dispersion area constitutes a source and a drain” to “an impurity area constitutes a source and a drain” in the claim(s) on the invention concerning a semiconductor device consisting of a double-hetero compound.

(Explanation)

In this example, the heart of the invention is that a semiconductor layer of an active area consists of a specific structure and materials. Claims as filed happens to recite that the source and drain is limited to one having an “impurity dispersion area”, but it is not limited to the one using diffusion, because the language of the description inherently indicates that any impurity dispersion area is sufficient for the purpose of the invention. Therefore, the amendment does not affect technical significance of the invention.

Example 3: Amendment limiting a part of matters specifying the invention

The amendment changes the language “a recorder or player device” in the claim to “a disk recorder or player device”.

(Explanation)

In this example, a CD-ROM player is described in the original description, etc. as an embodiment. In light of the rest of the description (for example, this invention reduces battery power consumption by adjusting the power supply when the recorder and/or player device receives no operation command), it is evident that the invention is applicable not only to a CD-ROM player but also to any other disk recorder and/or player.

(Reference: Tokyo High Court Decision dated on Dec. 19, 2002 (Heisei 10 (Gyo-Ke), No.298, “A Power Supply Circuit using Battery”))

Example 4: Amendment limiting a part of matters specifying the invention

The amendment changes the word “work piece” in the claims to “rectangular work piece”

(Explanation)

In this example, the original description, etc. states that a glass base, wafer and other work pieces is coated with the coating device. Almost all of the examples present in

the description are virtually related to a square shape, but it is evident that the typical shape of a glass base is a rectangular shape. An amendment changing “work piece” to “rectangular work piece” is therefore considered to be within the scope of matters described in the original description, etc..

(Reference: Tokyo High Court Decision dated on May 23, 2001 (Heisei 11 Gyo-Ke), No.246, “A Device of Coating”)

## (2) Claims in Markush-Type

① When a claim is described in an alternative form such as the Markush-Type, an amendment deleting a part of the alternatives is acceptable if the rest of matters specifying the invention is within the scope of matters described in the original description, etc..

② For example, where chemical substances are described in the form of a combination of many alternatives in the original description, etc., if another specific combination of alternatives within the scope of the multiple alternatives in the original description, etc. is added to the claims, or if the specific combination of alternatives remains in the claims as a result of deletion of other alternatives, sometimes the specific combination may not be disclosed in the original description, etc..

Especially in cases where only one of the multiple alternatives for a substitution group as of the filing is left as a result of an amendment, namely the other alternatives no longer exist, unless the original description, etc. discloses the specific combination of alternative (refer to the example ③ below), such an amendment is not acceptable because the disclosure in the original description shows no intention of selecting that specific alternative.

③ On the other hand, as a result of an amendment which deletes alternatives so as to leave the alternatives that are supported by the embodiments, there may be cases where such alternatives are deemed to be described as of the filing, considering from the whole description, etc. including the embodiments.

For example, where a group of chemical substances is described in the original description, etc., in the form of a combination of substitutions with multiple alternatives, an amendment of a claim is acceptable only if the group, which is formed by a combination of specific alternatives corresponding to a “single chemical substance” described in the embodiments, etc. in the original description, etc., is left in the claim.

## (3) Limitation of Numerical Range

An amendment adding a limitation of numerical range is acceptable, provided that the numerical range is within the scope of matters described in the original description, etc..

For example, if there is a clear description such as “preferably between 24 – 25°C” in a detailed description of the invention, such numerical range may be introduced in claims. The embodiment at the points of “24°C” and “25°C” does not necessarily support the amendment adding numerical range “24 – 25°C”, but if the specified scope of “24 – 25°C” is deemed to be referred to by considering the whole description, etc. as filed (for instance, “24°C” and “25°C” are respectively deemed to be described as the boundary value of the upper and lower limits with a certain continuous numerical range, considering the entire description of the problems to be solved by the invention and the effect of the invention), the amendment adding such numerical range is acceptable because the numerical range is deemed to be described as of the filing. This case is distinguishable from one where no embodiment with numerical range is provided in a description.

(In the case where numerical values regarding an amendment are derived from plural parts of a description: Tokyo High Court Decision dated on Dec. 11, 2001 (Heisei 13 (Gyo Ke), No.89, "A Deep Ultraviolet Ray Lithography").

For instance, an amendment setting a new numerical range with a lower limit different from the range specified in former claims is acceptable, if the lower limit is specified in the original description, etc. and the new numerical range is within the numerical range specified in the original description, etc..

#### (4) Disclaimer

The word "disclaimer" stands for a claim expressly stating that a part of subject matter included in a claimed invention is excluded from the claim.

The disclaimer which excludes some matters described in the original description, etc. through an amendment while retaining original expressions in a claim before the amendment is acceptable, provided that the disclaimer after the exclusion remains within the scope of matters described in the original description, etc..

The amendments described in (i) and (ii) below, which are both based on a disclaimer, are exceptionally deemed to be within the scope of matters described in the original description, etc..

(i) An amendment excluding only overlaps between a claimed invention and the prior art, which may result in loss of novelty or the like (Article 29(1)(iii), Article 29bis or Article 39) while retaining an original expression described in a claim before the amendment.

(ii) An amendment excluding the term "human being," while retaining an original expression in a claim before the amendment, in case the application fails to meet the requirement in the main paragraph of Article 29 of the Patent Act or is refused under Article 32 of the Patent Act because the invention in the claim originally encompasses "human being."

#### (Explanation)

The "disclaimer" in the case of (i) above means a claim excluding subject matter described in distributed publications or in the description, etc. of an earlier filed application (including subject matter virtually equivalent to the written matter) as the prior art under Article 29(1)(iii), Article 29bis or Article 39, while retaining original expressions of matter in claims before the amendment.

**(Note 1)** An invention in an application containing a disclaimer may be patented, in a case where it has an inventive step because it is remarkably different in technical ideas over the prior art but it accidentally lacks novelty by overlapping with the art. Otherwise a disclaimer hardly overcomes a rejection on the grounds of lack of an inventive step.

**(Note 2)** If a large part or many parts of an invention in claims are excluded in a disclaimer, attention should be paid, because sometimes a single invention cannot definitely be conceived from a single claim.

The disclaimer in the case of (ii) is a claim stating that the term “human being” is excluded from subject matter in claims, while an original expression of matters described in claims before the amendment remains.

The reasons for this exceptional treatment are given below:

① If an amendment of making a disclaimer were not allowed for an invention, which accidentally comes to lack novelty etc. by overlapping with the prior art, the invention could not be properly protected. Even if matters written as a prior art are excluded from the original claims, it does not inflict unforeseen disadvantages on third parties.

② Where the inclusion of “human being” in a claim leads to a failure to meet the requirement in the main paragraph of Article 29 of the Patent Act or constitutes a reason for refusal under Article 32 of the Patent Act, an amendment excluding “human being” indicates a definite range of exclusion and leads to the elimination of the reason for refusal. Furthermore, it does not make the invention, for which a patent is sought, indefinite.

(Concrete examples)

Example for (i): Suppose that a “washing agent for an iron plate whose main ingredient is inorganic salts containing sodium ion as a cation” is specified in claims before making an amendment and that an invention of “a washing agent for an iron plate whose main ingredient is inorganic salts containing carbon trioxide ion as an anion” is mentioned in a prior art and the sodium ion used as a cation is disclosed as a concrete example. It is acceptable in this case to make an amendment specifying “inorganic salt containing sodium ion (except when carbon trioxide is used as an anion)” to exclude the matter concerning a prior art from claims.

Example for (ii): Suppose that “a mammal characterized in that a certain polynucleotide with DNA Sequence No.1 is introduced into the chromosomes of the somatic cells of mammals and that the same polynucleotide was regenerated in those cells” is specified in the claims of an application before an amendment is made. “Mammals” essentially include “human beings” unless the detailed description of the invention clearly states that human beings are excluded. An invention directed to an object including human beings might be harmful to public order and immorality, and therefore violates Article 32 of the Patent Act. An amendment to change the language in claims to “mammals excluding human beings” in order to exclude human beings from the claims is acceptable even if human beings are not supposed to be excluded in the original description, etc..

## **5. Amendment of a Detailed Description of the Invention**

### **5.1 General Principle**

After making an amendment, if matters described in the detailed description of the invention extend beyond the matters disclosed in the original description, etc., such amendment is not acceptable.

## 5.2 Detailed Discussion

### (1) Addition of the content of prior art documents

<<The Guideline applied to the application whose filing date is on or after January 1, 2009 (In case of divisional applications and converted applications, the filing date is actual filing date.)>>

To provide description of the information on prior art documents (titles of publications concerning a related invention and any other information about location relating to an invention disclosed in prior publications) is required by the provision of Article 36(4)(ii) of the Patent Act. An amendment adding the information on prior art documents and the content of documents does not usually inflict unforeseeable disadvantages on third parties. Hence, an amendment adding the information on prior art documents to the detailed description of the invention is acceptable. And an amendment adding the content of documents to the column of [Background Art] in the detailed description of the invention is acceptable. However, it is not acceptable to make an amendment adding information on an evaluation of an invention such as a comparison with the invention of the application, adding information to carry out the invention or adding the content of prior art documents for the purpose of eliminating flaws to meet the requirement of Article 36(4)(i) of the Patent Act.

<<The Guideline applied to the application whose filing date is on or before December 31, 2008 (In case of divisional applications and converted applications, the filing date is actual filing date.)>>

To provide description of the information on prior art documents (titles of publications concerning a related invention and any other information about location relating to an invention disclosed in prior publications) is required by the provision of Article 36(4)(ii) of the Patent Act. An amendment adding the information on prior art documents as well as the content of documents to the column of [Background Art] in a detailed description of the invention does not usually inflict unforeseeable disadvantages on third parties. Hence, such an amendment is acceptable. But it is not acceptable to make an amendment adding information on an evaluation of an invention such as a comparison with the invention of the application, adding information to carry out the invention or adding the content of prior art documents for the purpose of eliminating flaws to meet the requirement of Article 36(4)(i) of the Patent Act.

### (2) Addition of concrete examples

Generally, an amendment adding concrete examples of an invention or materials extends beyond the matters described in the original description, etc.. For instance, it is not acceptable to amend a patent application concerning a rubber composition consisting of plural ingredients by adding information that "a particular ingredient may be added." Similarly, if a device equipped with an elastic support is described in the original description, etc. without disclosing a specific elastic support, it is not acceptable to add information that "a helical spring may be used as the elastic support."

### (3) Addition of effect of inventions

Generally, an amendment adding another effect of an invention extends beyond the matters described in the original description, etc.. However, if the additional effect is evident from the structure, operation and function of the invention explicitly described in the original description, etc., such an amendment is acceptable.

(4) Addition of unrelated or inconsistent matter

Needless to say, it is not acceptable to make an amendment adding matter unrelated or inconsistent with the content of the original description, etc..  
(Reference: Tokyo High Court Decision dated on Dec. 17, 2001 (Heisei 12 (Gyo Ke), No.396, " A Mid-passing Fishing Rod "))

(5) Resolution of inconsistent description/correction of ambiguous description

If two or more inconsistent parts are present in a description, etc. and the correct matter is evident to a person skilled in the art from the content of the original description, etc., an amendment leaving the correct one and eliminating the rest of them is acceptable. If matter is ambiguous in itself but its inherent meaning is evident to a person skilled in the art from the content of the original description, etc., an amendment clarifying the ambiguous matter is acceptable.

## **6. Amendment of Drawings**

An amendment of drawings is acceptable if it is done within the scope of matters described in the original description, etc.. But it should be noted that drawings after an amendment often contain matters extends beyond those described in the original description, etc.. It is to be noted especially when photographs attached to the request instead of drawings as filed are replaced after filing. Furthermore, it is deemed that drawings do not necessarily reflect actual measurements.

## **7. Explanation by an Applicant**

(1) An applicant who made an amendment is encouraged to underline the words, passages, etc. to expressly indicate amended parts, and to explain that the amendment is done within the scope of matters described in the original description, etc.. Such explanation is required in his or her written statement if the amendment is made before examination or in his or her written opinion if the amendment is made in response to a notice of reasons for refusal.

(Explanation)

Because an applicant knows the matters described in the original description, etc. and the content of the amendment thoroughly, they are required to fully explain that the amendment is done within the scope of the matters described in the original description, etc. in a written statement or a written opinion when they make an amendment. Unless doubt as to whether it is done within the scope of the matters described in the original description, etc. is cleared, the amendment is not considered within the scope.

In the case of the "elastic support" in 3. (5), for instance, the amendment is acceptable, provided the applicant successfully convinces that the "elastic support" is readily construed to mean a "helical spring" by a person skilled in the art when taking into consideration the drawings and other documents, and the doubt as to whether the

amendment is done within the scope of features disclosed in the original description, etc. is cleared. Otherwise, the amendment is not deemed to be within the scope.

(2) Even if a patent is granted for an application including matters extends beyond the matters described in the original description, etc., the applicant must bear in mind that the patent contains a potential ground for invalidation.

(3) If no explanation is given by an applicant and the relationship between the content of the amendment and the matters described in the original description, etc. is not understandable, an examiner may notice a reason for refusal or the like on the grounds that the amendment is deemed to extend beyond the matters described in the original description, etc..

## ***Section II Amendment that Changes a Special Technical Feature of an Invention***

### **1. Relevant Provisions**

Patent Act Article 17bis(4) reads:

In addition to the case provided in the preceding paragraph, where any amendment of the scope of claims is made in the cases listed in the items of paragraph (1), the invention for which determination on its patentability is stated in the notice of reasons for refusal received prior to making the amendment and the invention constituted by the matters described in the amended scope of claims shall be of a group of inventions recognized as fulfilling the requirements of unity of invention set forth in Article 37.

Patent Act Article 37 reads:

Two or more inventions may be the subject of a single patent application in the same application provided that, these inventions are of a group of inventions recognized as fulfilling the requirements of unity of invention based on their technical relationship designated in Ordinance of the Ministry of Economy, Trade and Industry.

Patent Act Enforcement Order Article 25octies

(1) The technical relationship defined by an ordinance of the Ministry of Economy, Trade and Industry under Patent Act Article 37 means a technical relationship in which two or more inventions must be linked so as to form a single general inventive concept by having the same or corresponding special technical features among them.

(2) The special technical feature provided in the former Paragraph stands for a technical feature defining a contribution made by an invention over the prior art.

(3) The technical relationship provided in the first Paragraph shall be examined, irrespective of whether two or more inventions are described in separate claims or in a single claim written in an alternative form.

If an amendment does not meet the requirements under Article 17bis(4), it shall constitute a reason for refusal (Article 49(1)). In addition, an amendment may be subject of a dismissal of amendment if the amendment is made in response to a notice of reasons for refusal given along with a notice under Article 50bis, made in response to the final notice of reasons for refusal, or made at the time that an appeal is demanded against the examiner's decision of refusal and does not meet the above-mentioned requirements (Article 53, Article 159(1), Article 163(1)).

### **2. Purport of Article 17bis(4)**

Inventions that may be the subject of a single patent application in the same application are limited to those that fulfill the requirements of unity of invention (Article 37). However, if claims can be amended freely beyond such limitation after reasons for refusal are notified, there may be amendments that require prior art search and examination to be conducted again since the result of prior art search and examination conducted until then cannot be effectively used in the examination after the notice of reasons for refusal is given. If such an amendment is made, it will not only obstruct the prompt and precise granting of

rights but also prevent ensuring of sufficient fairness in the handling of applications. Therefore, regarding amendments to claims after a notice of reasons for refusal has been given, the same limitation was set as the limitation on the scope of inventions that may be the subject of a patent application by single request.

### **3. Basic Concept**

Article 17bis(4) is a provision to prohibit making an amendment whereby inventions, of which patentability has been determined in a notice of reasons for refusal, in the claims before the amendment, and inventions amended after the notice of reasons for refusal is given do not meet the requirements of unity of invention because they do not have any same or corresponding special technical features (hereinafter referred to as the “amendment that changes special technical features of the inventions”). This provision makes the requirements of unity of invention extend to claimed inventions after amendment.

For this reason, whether or not an amendment that changes special technical features of the inventions is determined based on whether or not all of the inventions that were examined in terms of the requirements for patentability, such as novelty and inventive step, in the claims before the amendment and all of the inventions in the claims after the amendment meet the requirements of unity of invention as a whole.

In addition, where two or more notices of reasons for refusal have been given before an amendment, the above determination is made based on whether all of the inventions that were examined in terms of the requirements for patentability, such as novelty and inventive step, in the first notice of reasons for refusal and all other notices of reasons for refusal given before the amendment and all of the inventions in the claims after the amendment meet the requirements of unity of invention as a whole.

### **4. Procedure of Examination**

#### **4.1 Basic Procedure of Examination**

(1) Whether or not an amendment that changes special technical features of the inventions is determined based on whether or not all of the inventions that were examined in terms of the requirements for patentability, such as novelty and inventive step, in the claims before the amendment and all of the inventions in the claims after the amendment have the same or corresponding special technical feature. Whether or not such inventions have the same or corresponding special technical feature is determined by following Part I, Chapter 2 “Requirements of unity of Invention.” However, if the invention first mentioned in the claims before the amendment does not have any special technical feature, examination will proceed by following 4.3 below.

If all of the inventions that were examined in terms of the requirements for patentability, such as novelty and inventive step, in the claims before the amendment and all of the inventions in the claims after the amendment have the same or corresponding special technical feature, all inventions after the amendment will be the subject of the examination on requirements other than the requirements under Article 17bis(4). (Hereinafter “subject of the examination on the requirements other than the requirements under Article 17bis(4)” is merely referred to as “subject of the examination” in this Article.)

On the other hand, if the same or corresponding special technical feature cannot be found between all of the inventions that were examined in terms of the requirements for

patentability, such as novelty and inventive step, in the claims before the amendment and all of the inventions in the claims after the amendment, inventions that do not have any special technical feature that is the same as or corresponding to the technical feature of all of the inventions that were examined (only if the inventions have the same or corresponding technical feature between the invention first mentioned in the claims before the amendment) in terms of the requirements for patentability, such as novelty and inventive step, in the claims before the amendment (hereinafter referred to as the “inventions whose special technical features were changed”) are not the subject of the examination, and other inventions will be the subject of the examination. In this case, a reason for refusal on the grounds of violation of the requirements under Article 17bis(4) shall be notified along with the result of examination on inventions that become the subject of the examination.

(2) In making a determination as mentioned in (1) above, a special technical feature shall be understood based on description, claims and drawings (hereinafter referred to as “description, etc.”), common general technical knowledge as of the filing, and the prior art cited in the notice of reasons for refusal before the amendment.

(Explanation)

If whether or not all of the inventions that were examined in terms of the requirements for patentability, such as novelty and inventive step, in the claims before the amendment and all of the inventions in the claims after the amendment have the same or corresponding special technical feature could be determined based on the prior art which have not been presented to the applicant before the amendment, in addition to description, etc., common general technical knowledge as of the filing and the prior art cited in a notice of reasons for refusal before the amendment, the applicant who has received the notice of reasons for refusal would not be able to sufficiently predict the scope of acceptable amendment which does not change any special technical features of the inventions when he/she considers an amendment to make. If an amendment is made under such circumstances, the final notice of reasons for refusal to the effect that the amendment that changes special technical features of the inventions will be given by following “Part IX: Procedure of Examination.” This may result in closing the door to amendment to the invention which should have been patented otherwise. Therefore, the guidelines mentioned above shall be adopted.

#### **4.2 Example of Basic Procedure of Examination**

Example 1: [Claims before the amendment]

Claim 1: A cell-phone handset comprising; means for receiving TV broadcasts and a means for recording that can compress and record received TV broadcast data

[Claims after the amendment]

Claim ①: A cell-phone handset comprising; means for receiving TV broadcasts and a means for recording that can record received TV broadcast data at a different compression rate depending on the content of the broadcast

Claim ②: A cell-phone handset that can receive broadcasts of emergency warnings comprising; means for receiving TV broadcasts, and a

power supply control means that intermittently supplies power to said means for receiving TV broadcasts during standby

Cited document 1 describes a cell-phone handset comprising; means for receiving TV broadcasts, and cited document 2 describes a portable information device with a means for recording that can compress and record image data. Therefore, in the first notice of reasons for refusal, the examiner notified the applicant of a reason for refusal on the grounds of lack of inventive step based on cited documents 1 and 2. Through an amendment made after the above-mentioned notice of reasons for refusal was given, claimed inventions were changed to the invention claimed in claim ①, in which “a means for recording that can compress and record received TV broadcast data” in claim 1 before the amendment was restricted to “means for recording that can record received TV broadcast data at a different compression rate depending on the content of the broadcast,” and the invention claimed in claim ② that can receive broadcasts of emergency warnings.

(Explanation)

Out of the technical features common to the invention claimed in claim 1 before the amendment and the invention claimed in claim ① after the amendment, “cell-phone handset comprising means for receiving TV broadcasts” does not make any contribution to the prior art in light of cited document 1. However, “cell-phone handset comprising means for receiving TV broadcasts and a means for recording that can compress and record received TV broadcast data” makes a contribution to the prior art in light of common general technical knowledge as of the filing and cited documents 1 and 2. Therefore, it is a special technical feature. Consequently, the invention claimed in claim 1 before the amendment and the invention claimed in claim ① after the amendment meet the requirements of unity of invention.

On the other hand, the invention claimed in claim ② after the amendment does not meet the requirements of unity of invention in relation to the invention claimed in claim 1 before the amendment since claim ② does not have said special technical feature which the invention claimed in claim 1 before the amendment and the invention claimed in claim ① after the amendment have in common.

Therefore, only the invention claimed in claim ① after the amendment is the subject of the examination, and in the second (final) notice of reasons for refusal, a reason for refusal on the grounds of violation of the requirements under Article 17bis(4) is notified along with the result of examination on the invention claimed in claim ①.

Example 2: [Claims before the amendment]

Claim 1: Quick-drying ink for an ink-jet printer containing specific component X

Claim 2: An ink-jet printer characterized by having a nozzle of a special shape that enables the user to adjust the amount of ink being dropped

[Claims after the amendment]

Claim ①: An ink-jet printer characterized by having a nozzle of a special shape that enables the user to adjust the amount of ink being dropped

Although the invention claimed in claim 1 before the amendment has a special technical feature, that is, “specific component X,” the inventions claimed in claims 1 and 2 before the amendment do not meet the requirements of unity of invention since the

invention claimed in claim 2 before the amendment does not have said special technical feature. Therefore, in this case, the invention claimed in claim 1 before the amendment was the subject of the examination, and a reason for refusal on the grounds of violation of the requirements of unity of invention was notified in the first notice of reasons for refusal along with a reason for refusal on the grounds of lack of inventive step. Through an amendment after the above-mentioned notice of reasons for refusal, claim 1 before the amendment was deleted, and claim 2 before the amendment was moved to claim     after the amendment.

(Explanation)

The invention claimed in claim     after the amendment does not meet the requirements of unity of invention in relation to the invention claimed in claim 1, which was examined in terms of the requirements for patentability, such as novelty and inventive step, before the amendment, as already indicated in the first notice of reasons for refusal. Therefore, the invention claimed in claim     after the amendment is not the subject of the examination, and in the second (final) reasons for refusal, only a reason for refusal on the grounds of violation of the requirements under Article 17bis(4) is notified.

#### **4.3 Procedure of Examination in Case where the Invention First mentioned in the Claims before an Amendment Does Not Have Any Special Technical Feature**

If the invention first mentioned in the claims before an amendment does not have any special technical feature, no same or corresponding special technical feature can be found between said invention and an invention after the amendment. Therefore, it cannot be said that the requirements of unity of invention are met in the relationships between all of the inventions that were examined in terms of the requirements for patentability, such as novelty and inventive step, in the claims before the amendment and all of the inventions in the claims after the amendment.

However, since Article 17bis(4) stipulates that the scope of possible amendment of claims shall be the same as the scope prescribed in Article 37, even in such a case, claimed inventions after the amendment will exceptionally be the subject of the examination without questioning the requirements under Article 17bis(4) if they are inventions within the certain scope mentioned in 4.3.1 or 4.3.2 below. This idea is same as that of “Part I: Chapter 2. Requirements of Unity of Invention,” in which the scope of inventions that exceptionally become the subject of the examination is determined without questioning the requirements under Article 37 in consideration of the convenience of applicants, etc..

##### **4.3.1 Where an Invention with a Special Technical Feature Was Found among Inventions in the Claims before the Amendment that Were the Subject of the Examination**

Where an invention with a special technical feature was found among inventions in the claims before the amendment that were examined in terms of the requirements for patentability, such as novelty and inventive step, by following     to     of the [Procedure for deciding the subject of the examination] in 4.2 in Part I, Chapter 2 “Requirements of unity of Invention,” inventions in the claims after the amendment, in the same category, which include all matters specifying the invention with a special technical feature before the amendment (see, Note), will be the subject of the examination without questioning the requirements under Article 17bis(4). On the other hand, inventions in the claims after the

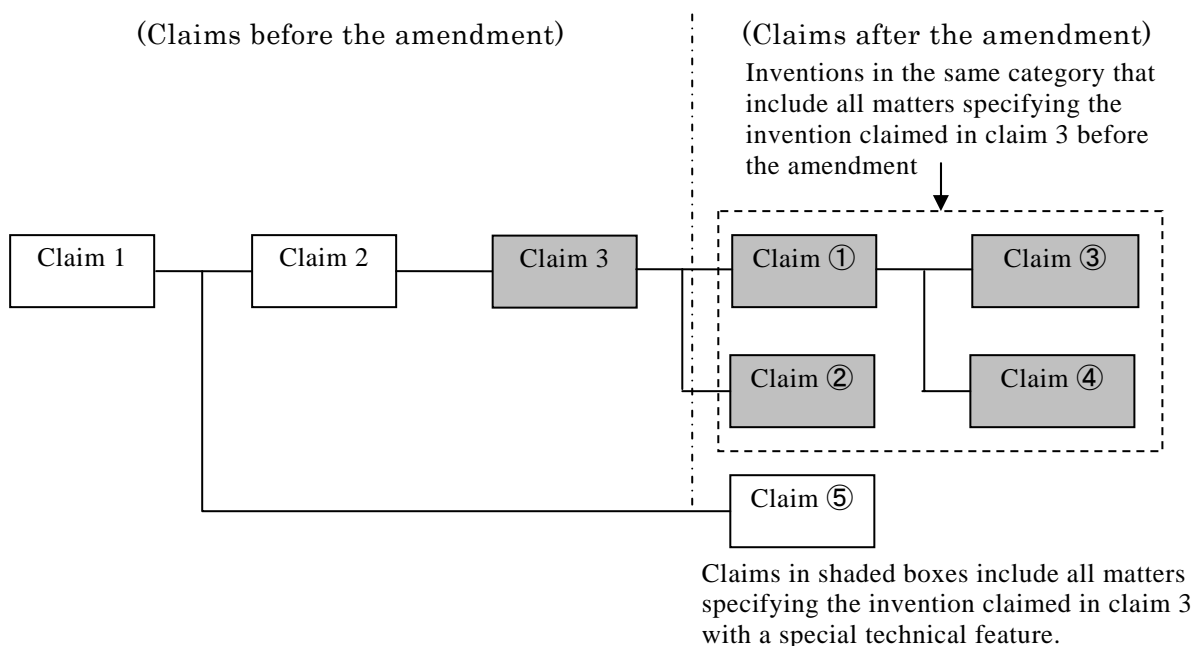
amendment which do not include all of the matters specifying the invention with a special technical feature before the amendment will not be the subject of the examination, and a notice of reasons for refusal on the grounds of violation of the requirements under Article 17bis(4) shall be given.

In addition, other inventions of which examination has been substantially completed as a result of examination on the above-mentioned subject of the examination and inventions of which examination has been substantially completed through examination conducted before the amendment are also added to the subject of the examination without questioning the requirements under Article 17bis(4).

**(Note)** The cases where an invention “includes all matters specifying the invention” includes cases of making some or all matters specifying the invention into a subordinate concept and cases of further limiting numerical ranges when some of the matters specifying the invention are numerical ranges, in addition to the cases of adding another matter specifying an invention to the invention.

Example:

The inventions claimed in claims 2 and 3 before the amendment are those in the same category that include all matters specifying the invention claimed in 1 or 2 respectively. The inventions claimed in claims 1 and 2 before the amendment do not have any special technical feature, and a special technical feature was found in the invention claimed in claim 3 before the amendment. Regarding this application, the first notice of reasons for refusal was given for the inventions claimed in claims 1 and 2 based on lack of novelty and for the invention claimed in claim 3 based on lack of inventive step. Through amendment after said notice of reasons for refusal was given, claimed inventions were changed to inventions claimed in claims 1 to 5, which include all matters specifying the invention claimed in claim 3 before the amendment, and invention claimed in claim 5, which does not include some of the matters specifying the invention claimed in claim 3.



(Explanation)

In this example, the inventions claimed in claims to after the amendment, which include all matters specifying the invention claimed in claim 3 before the amendment, will be the subject of the examination without questioning the requirements under Article 17bis(4) since the invention claimed in said claim 3 has a special technical feature. In addition, the invention claimed in claim after the amendment will not be the subject of the examination since it does not include some of the matters specifying the invention claimed in claim 3 before the amendment.

Regarding this application, the examiner shall notify the applicant of reasons for refusal on the grounds of violation of Article 17bis(4) for the invention claimed in claim after the amendment and the result of examination on inventions claimed in claims to after the amendment in the second notice of reasons for refusal.

#### **4.3.2 Where All Claimed Inventions before an Amendment that Were the Subject of the Examination Do Not Have Special Technical Features**

Where all of the inventions in the claims before the amendment that were the subject of the examination by following [Procedure for deciding the subject of the examination] in 4.2 in Part I, Chapter 2 “Requirements of unity of Invention” do not have any special technical feature, the existence of a special technical feature will be determined with respect to inventions in the claims after the amendment through [Procedure for deciding the subject of the examination after the amendment] below. Thereby the subject of the examination shall be decided.

[Procedure for deciding the subject of the examination after the amendment]

① Following the procedure for deciding the subject of the examination in 4.2 in Part I, Chapter 2 “Requirements of unity of Invention,” the existence of a special technical feature is assessed with respect to the invention to which the smallest claim number is attached out of the inventions claimed after the amendment in the same category, which include all matters specifying the invention before the amendment for which the existence of a special technical feature has been assessed in the last place.

② Where there is no special technical feature in the inventions in the claims for which the existence of a special technical character have already been assessed, the existence of a special technical feature will be assessed by selecting an invention to which the smallest claim number is attached out of inventions in the claims in the same category, which include all matters specifying the invention in the claim for which the existence of a specific technical feature was just assessed.

③ The procedure mentioned in is repeated until an invention with a special technical feature is found. If an invention with a special technical feature is found, inventions in the claims after the amendment for which the existence of a special technical feature has been assessed until then and inventions in the same category that include all matters specifying said invention with a special technical feature will be the subject of the examination.

④ In the procedure mentioned in and , if the claimed invention for which the existence of a special technical feature is to be assessed next is an invention that has made by adding a technical feature that has little technical relevance to the invention for which the existence of a special technical feature has been just assessed (including the invention for which the existence of a special technical feature has been assessed in the last place in the

inventions in the claims before the amendment), and the specific problem to be solved by the invention, which is understood from said technical feature, also has little relevance, the inventions for which the existence of a special technical feature has been assessed until then will be the subject of the examination without further assessing the existence of a special technical future.

⑤ Other inventions of which examination has been substantially completed as a result of examination on inventions that were the subject of the examination in ③ or ④ (for example, inventions that differ only in terms of category expression) will also be added to the subject of the examination.

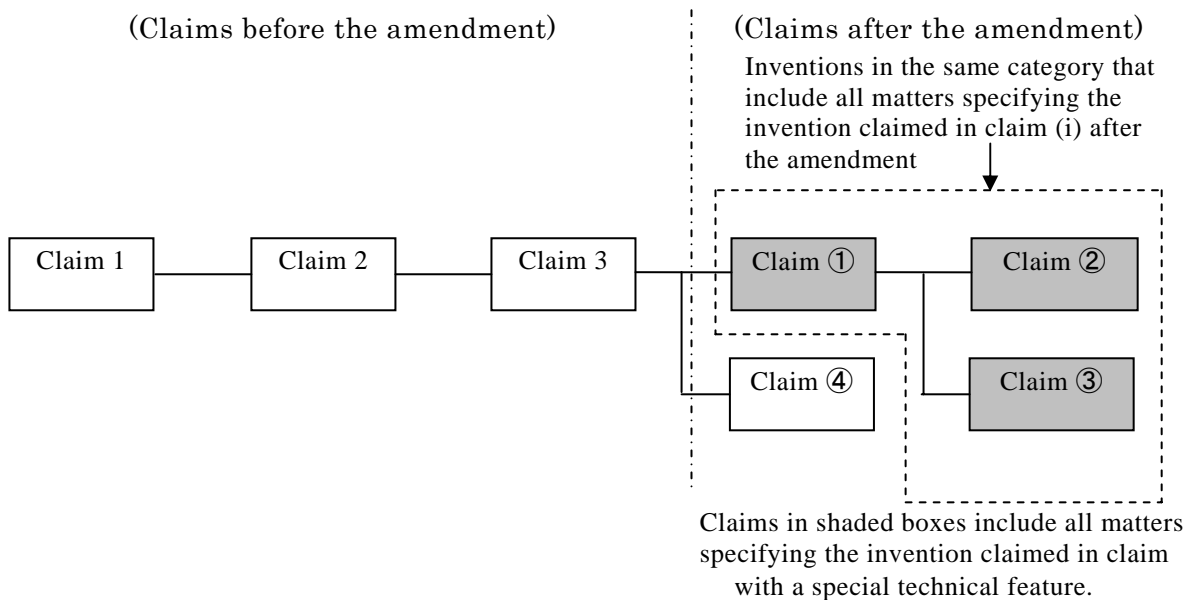
⑥ Furthermore, inventions of which examination has been substantially completed through examination before the amendment will also be added to the subject of the examination.

In the above procedure, where a matter specifying the invention is expressed by alternatives in a claim (including multiple dependent claims), such a claim is treated as if each invention understood by choosing each alternative is described as a separate claim in the order of said alternatives. In determining if the claim includes all matters specifying an invention, it doesn't matter whether a claim is formally an independent claim or a dependent claim.

Inventions in the claims after the amendment that become the subject of the examination through the above procedure will be the subject of the examination without questioning the requirements under Article 17bis(4). If any invention that does not become the subject of the examination is included in the claims, a reason for refusal shall be notified on the grounds of violation of Article 17bis(4).

#### Example:

Inventions claimed in claims 2 and 3 before the amendment are inventions in the same category, which include all matters specifying the invention claimed in claims 1 and 2 respectively. The inventions claimed in claims 1 to 3 before the amendment do not have any special technical feature. For this application, the first notice of reasons for refusal was given for the inventions claimed in claims 1 to 3 based on the lack of novelty. Through amendment after said notice of reasons for refusal was given, the claims were amended to claims 1 to 3, which include all matters specifying the invention of claim 3 before the amendment. Claims 1 and 2 after the amendment include all matters specifying the invention claimed in claim 3 after the amendment. A technical feature added to the invention claimed in claim 1 after the amendment has close technical relevance to the invention claimed in claim 3 before the amendment.



(Explanation)

In this example, firstly, the existence of a special technical feature is assessed for claim 1 after the amendment. The claim includes all matters specifying the invention claimed in claim 3 before the amendment and the smallest claim number is attached thereto. Since a special technical feature is found in said claim 1, the inventions claimed in claims 2 and 3, which include all matters specifying the invention claimed in said claim 1, are the subject of the examination without questioning the requirements under Article 17bis(4). Claim 3 after the amendment is not the subject of the examination since it is not a claim to which the smallest claim number is attached in the claims that include all matters specifying the invention claimed in claim 3 before the amendment without any special technical feature and it also does not include some of the matters specifying the invention claimed in claim 1 after the amendment with a special technical feature.

Regarding this application, the examiner shall notify the applicant of the reasons for refusal on the grounds of violation of Article 17bis(4) for the invention claimed in claim 1 after the amendment and the result of examination on the inventions claimed in claims 2 to 3 after the amendment in the second notice of reasons for refusal.

**5. Remarks**

(1) The requirements under Article 17bis(4) make the requirements of unity of invention extend to the inventions claimed after amendment. The determination on whether or not the requirements under Article 17bis(4) are met includes the determination on whether or not the requirements of unity of invention are met among the claims after amendment. Therefore, the determination on the requirements under Article 37 can be omitted after the first notice of reasons for refusal.

(2) In light of what is indicated in 4.1 or 4.3 above, if there is a claimed invention that does not become the subject of the examination, the invention shall be clearly indicated in a notice of reasons for refusal along with reasons thereof.

(3) If it is clear that a reason for refusal notified before the amendment has not been dissolved yet in the inventions described in the claims after the amendment, the examiner may render a decision of refusal notwithstanding “4. Procedure of Examination.”

(4) An amendment that changes technical features of the inventions (Article 17bis(4)) constitutes a reason for refusal (Article 49) but does not constitute a ground for invalidation (Article 123). This is because there is no substantial defect in the invention but only a formal defect (two or more patent applications should have been filed to receive examination on the inventions after the amendment) and the third parties' benefits will thus not be directly harmed to a significant extent even if the invention is patented as it is. Considering such circumstances, the requirements under Article 17bis(4) shall not be applied in an unnecessarily strict manner to other inventions of which examination has been substantially completed as a result of examination on inventions that become the subject of the examination in light of what is indicated in 4.1, inventions of which examination has been substantially completed through examination before the amendment, and inventions for which it is not easy to determine whether a special technical feature thereof has been changed.

## **Section III Amendment of Claims after Final Notice of Reasons for Refusal**

### **1. Basic Concept**

Patent Act Article 17bis (5) was introduced with the purport that the amendment to the claims to the final notice of reasons for refusal shall be made within the degree that the examination results already obtained are effectively usable for the purpose of establishing such examination procedures that enable the prompt and precise grant of patent rights, taking into consideration the fundamental objective of the patent system to fully protect inventions. Amendments against this provision, different from those adding new matter, do not cause substantial defects to the content of the invention, thus the amendment shall not retroactively be dismissed after the decision of refusal or the decision to grant a patent even if amendments against this provision were overlooked. Consequently, the nature of Article 17bis (5) differs from that of Article 17bis (3). Taking full consideration of the purport of this provision, Article 17bis (5) should not be strictly applied to such inventions as are deemed to be protected in cases where the examination results already obtained are effectively usable for the examination to be made after notifying the final notice of the reasons for refusal.

### **2. Practical Application**

#### **2.1 Prohibition of Addition of New Matter (Patent Act Article 17bis (3))**

"...any amendment of the description, scope of claims or drawings... shall be made within the scope of the matters described in the description, scope of claims or drawings originally attached to the application..."

The judgment on whether or not the amendment meets the requirements of Article 17bis (3) shall be made by following "Secion 1. New Matter."

#### **2.2 Amendment that Changes a Special Technical Feature of an Invention (Patent Act Article 17bis (4))**

"...where any amendment of the scope of claims is made in the cases listed in the items of paragraph (1), the invention for which determination on its patentability is stated in the notice of reasons for refusal received prior to making the amendment and the invention constituted by the matters described in the amended scope of claims shall be of a group of inventions recognized as fulfilling the requirements of unity of invention set forth in Article 37."

The judgment on whether or not the amendment meets the requirements of Article 17bis (4) shall be made by following "Secion 2. Amendment that Changes a Special Technical Feature of an Invention."

### **3. Cancellation of Claim(s) (Patent Act Article 17bis (5)(i))**

#### **3.1 Purport**

The cancellation of a part of the plural number of claims is allowable, since it does not cause the necessity of making a second examination or trial examination.

### **3.2 Practical Application**

Not only the cancellation of a part of claims but also an formal amendment of other claims accompanying the former shall be deemed as an amendment for the cancellation of claims.

For example:

Changes that inevitably occur together with the cancellation of claims such as:  
changes in the cited number of other claims that have cited the cancelled claim; or  
changes from a dependent form to an independent form.

## **4. Restriction of Claim(s) (Patent Act Article 17bis (5)(ii) and (6))**

### **4.1 Purport**

Among the amendments corresponding to restriction of the claim(s), since the amendment for restricting a matter specifying the invention without changing the field of industrial applicability and the problem to be solved by the invention does not drastically alter the subject of the examination as well as the trial examination, and the examination results already obtained are generally utilized, such amendment is treated as allowable.

However, even when this type of amendments are made, there may be cases where a second reasons for refusal shall be notified if the invention in the amended claim is not to be granted a patent. In such cases there may arise a need for another examination or trial examination if an amendment is made in response to the second notice of reasons for refusal. Consequently, from the viewpoint of securing the promptness of the examination and the fairness among patent applications, the amendment is limited in such cases where patents are to be granted.

### **4.2 Requirements for Restriction of Claim(s)**

For the amendment of the claim(s) to fall under Article 17bis(5)(ii), the following requirements shall be satisfied:

- (1) restriction of the claim(s);
- (2) restriction of matters specifying the invention claimed in the claim(s) before the amendment (hereinafter referred to as "invention before the amendment"); and
- (3) the industrial applicability and problems to be solved by the inventions after amendment are the same as those before the amendment).

(Explanation)

The requirements mentioned in the parenthesized part of 17bis(4)(ii) provides that the amendment for the restriction of all or some of the matters specifying the invention before the amendment shall be made so that the field of the industrial applicability and the problem to be solved by the invention is the same as those before the amendment. In another word, the inventions before and after the amendment must have the same industrial applicability and problems to be solved.

## 4.3 Practical Application

### 4.3.1 Restriction of Claim(s)

Regardless of whether or not the requirements mentioned in the parenthesized part are satisfied, the amendment which enlarges the claim(s) does not fall under Article 17bis(5)(ii), because the amendment does not correspond to the restriction of the claims.

Since "the claims" are a collection of claims specifying the invention, the judgment on "whether the amendment restricts the claim(s)" shall be made for each claim in general.

- (1) Concrete examples deemed as not correspond to restriction of the claim(s):
  - deletion of a part of matters specifying an invention described in series;
  - addition of an element described in alternative form;
  - amendment to increase the number of claims (excluding the cases mentioned in (2) below).
  
- (2) Concrete examples deemed as corresponding to restriction of claim(s):
  - deletion of an element described in alternative form;
  - serial addition of matters specifying the invention;
  - change from a generic concept to a more specific concept;
  - reduction of the number of claims cited in the multiple dependent form claims;
  - Example: Amendment of the claim from "air conditioners comprising a mechanism A claimed in one of the claims from 1 to 3" to "air conditioners comprising a mechanism A claimed in claim 1 or claim 2."
  - change of the multiple dependent form claims citing n claims into claims the number of which is (n-1) or below (n-1).
  - Example: Amendment of the claim from "air conditioners comprising a mechanism A claimed in one of the claims from 1 to 3" to two separate claims, "air conditioners comprising a mechanism A claimed in claim 1," and "air conditioners comprising a mechanism A claimed in claim 2."

### 4.3.2 Restriction of Matters Necessary to Specify the Invention

#### (1) Interpretation of "matters necessary to specify the invention"

Since "matters necessary to specify the invention" as laid down in 17bis(5)(ii) are matters described in the claim(s) before the amendment, the finding thereof shall be based on the description of the claim(s) before the amendment.

In the practical application of Article 36(4)(i), if deemed necessary to carry out the claimed invention, the operation (function/role) of matters necessary to specify the invention shall be described in the detailed description of the invention.

Therefore, "matters necessary to specify the invention" as stated in Article 17bis(5)(ii) must be found based on the claims before the amendment in correspondence with the function described in the description and drawings.

#### (2) Interpretation of "restriction"

The amendment to "restrict" "matters necessary to specify the invention" is interpreted as follows.

To amend one or more "matters necessary to specify the invention" in the claim before the amendment to "matters necessary to specify the invention" of a more specific concept.

"Matters specifying the invention" having the operation different from the operation below is usually not to be deemed as a more specific conception of "matters specifying the invention" which specify a product in operative terms ("function-realization means" etc.).

To delete a part of alternatives in cases where "matters necessary to specify the invention" is expressed alternatively in such as Markush-Type.

### (3) Method of judgment

The judgment of whether or not the amendment is restricting "matters necessary to specify the invention" shall be made by comparing "the matters specifying the invention" before the amendment with those after the amendment.

## **4.3.3 Same Industrial Applicability and Problems to be Solved**

### (1) Finding of "problems to be solved" and "industrial applicability"

In finding "problems to be solved" and "industrial applicability," the problems to be solved and the field of industrial applicability shall be concretely specified based on "the matters necessary to specify the invention" as are understood from the description in the claim(s) taking into account the description on the problems to be solved and the technical field to which the invention pertains in the detailed description of the invention. In this case, the problems to be solved are not necessarily those having not been unsolved.

### (2) Same problems to be solved

Besides cases where the problems to be solved by the inventions before and after amendment are the same, the cases where the problems to be solved by the invention after amendment are closely related to those before the amendment (in judging the sameness of the problems to be solved, "...be closely related to..." means the cases where the problems to be solved after the amendment are more specific concepts than those before the amendment, or the cases where the problems to be solved by the inventions before and after the amendment are of the same kind, etc.) are also to be regarded as the cases where the problems to be solved is the same. (For example, "increase in strength" and "increase in strength for pulling," or "making compact" and "making light.")

If the amendment makes the problems to be solved by the invention after the amendment not to be the same as those of the invention before the amendment, such amendment shall be deemed as not complying with these requirements.

When applying the Ministerial Ordinance in accordance with Article 36(4)(i), in cases where the problems to be solved had not originally been conceived, such as inventions developed under novel ideas utterly different from the prior art and inventions based on discoveries as the result of trial and error, the description of the problems to be solved is not mandatory. In such cases, since it is considered that the examination had been carried out regardless of the problems to be solved, it is deemed that these requirements are satisfied.

### (3) Same industrial applicability

“The industrial applicability of the invention after the amendment is the same as that of the invention before the amendment” means the cases where the fields of industrial application of the inventions before or after the amendment are the same, or the cases where the field of the technology the invention after the amendment is technologically closely related to that of the invention before the amendment.

(Explanation)

The reason why the problems to be solved and the industrial applicability before the amendment shall be the same as those after the amendment as required in (2) and (3) above is because the examination procedures for the invention after the amendment having such relationships as mentioned above are considered to be proceeded without further substantial burden to the examination by effectively utilizing the examination results already obtained before the final notice of reasons for refusal.

#### **4.3.4 Independently Patentable**

Notwithstanding the amendment being deemed as falling under Article 17bis(5)(ii), the invention specify by the matters stated in the amended claim shall be patentable.

This requirement is applied only to claim(s) which was amended to be restricted. The claim(s) which was amended solely in terms of "the correction of errors in the description" or "the clarification of an ambiguous description" as well as claim(s) that has not been amended must not be refused by the reason that they cannot independently be granted patents.

Patent Act Articles 29, 29bis, 32, 36(4)(i) or (6) (except (iv)), and 39 (1) to (4) are applied with respect to the requirements of independently patentable. The other handling shall follow "Part IX: Procedure of Examination Section 2" 6.2.3.

#### **4.4 Notes in Cases where Plural Amendments are Made after Final Notice of Reasons for Refusal**

In cases where the plural number of amendments of the description, claims or drawings are made within the time limit designated in the last notice of reasons for refusal, the description, claims or drawings to be the basis for judging whether the second or following amendment complies with the requirements under Article 17bis(5) and (6) shall be those that were legally amended immediately before the second or following amendment concerned. However, the description, claims or drawings to be based under Article 17bis(3) are those originally attached to the request.

### **5. Clarification of Ambiguous Description (Patent Act Article 17bis(5)(iv))**

#### **5.1 Purport**

Where deficiency in the description is indicated in the final notice of reasons for refusal, since an minor amendment for correcting the said deficiency does not alter the subject for the examination or the trial examination, and the applicant for a patent, if such

amendment is not allowable, will have difficulty in responding to the reasons for refusal, therefore it cannot be said to be appropriate not to admit such kind of the amendment from the viewpoint of protecting inventions. Thus the amendment "to clarify an ambiguous description" "with respect to the matters mentioned in the reasons for refusal concerned" in the notice of the reasons for refusal shall be allowable.

## **5.2 Meaning of "Clarification of Ambiguous Description"**

"An ambiguous description" means a description causing deficiency in the description such as a description whose meaning is not clear.

"An ambiguous description" with respect to the claim(s) corresponds to such cases where the description of the claim itself is ambiguous in meaning, or where the description of the claim itself is not consistent with the other descriptions of the claim, or where the claimed invention, although the description of the claim itself is clear, cannot be said to be technologically accurately specified. "Clarification" is meant to clear "the intended meaning of the description" by correcting the ambiguity.

Consequently, where the description of the claim itself is clear, and the invention is technologically accurately specified, the amendment to clear that the claimed invention is involving the novelty, inventive step, etc. in response to the notice of the reasons for refusal with respect to novelty, inventive step, etc. does not fall under "the clarification of ambiguous description."

For example, where the amendment is deemed to resolve the reasons for refusal with respect to novelty, inventive step, etc., and is deemed as restricting the matters specifying the invention without altering the problems to be solved, or the amendment is deemed as adding new technological matters to solve new problems, the amendment concerned does not fall under "the clarification of ambiguous description."

Such amendment is to be subjected by the further examination as to whether it falls under the requirement such as "the restriction of the claim(s)" in each Paragraph under Article 17bis(5).

## **5.3 Relation to Matters Mentioned in Reasons for Refusal**

In order to prevent the arising of new reasons for refusal as the result of the amendment of matters for which the examination or trial examination has already been carried out, the amendment for clarification of an ambiguous description is limited only to the cases where the amendment is made for the matters mentioned in the reasons for refusal in the notice of the reasons for refusal.

The amendment to resolve the reason for refusal with respect to the deficiency of the description mentioned in the last notice of the reasons for refusal under Article 36 falls under the parenthesized part in Article 17bis(4)(iv) stating "with respect to the matters mentioned in the reasons for refusal."

In contrast, the amendment restricting the matters specifying the invention, or the amendment adding new technological matters for solving new problems to the claim, made irrelevant to the deficiency in the description mentioned in the last notice of the reasons for refusal, do not fall under "the matters mentioned in the reasons for refusal."

## **6. Correction of Errors in Description (Patent Act Article 17bis(5)(iii))**

### **6.1 Purport**

Since a minor amendment for correction of errors in the description in response to the final notice of reasons for refusal does not alter the subject for the examination or trial examination, and the applicant for a patent, if such amendment is not allowable, will have difficulty in responding to the reasons for refusal, therefore it cannot be said to be appropriate not to admit such kind of the amendment from the viewpoint of protecting inventions. Consequently, the amendment for "correction of errors in the description" is treated to be allowable.

### **6.2 Meaning of "Correction of Errors in Description"**

"The correction of errors in the description" means to "correct the errors of the wording or phrasing to the original meaning thereof" in cases where "the original meaning of the said wording and phrasing is apparent from the description, claims or drawings."

## **7. Procedure of Judgment**

The procedures for the examination with respect to the requirements prescribed in each of the Paragraphs under Article 17bis shall be made by following 6.2 in Section 2 of "Part IX: Procedure of Examination."