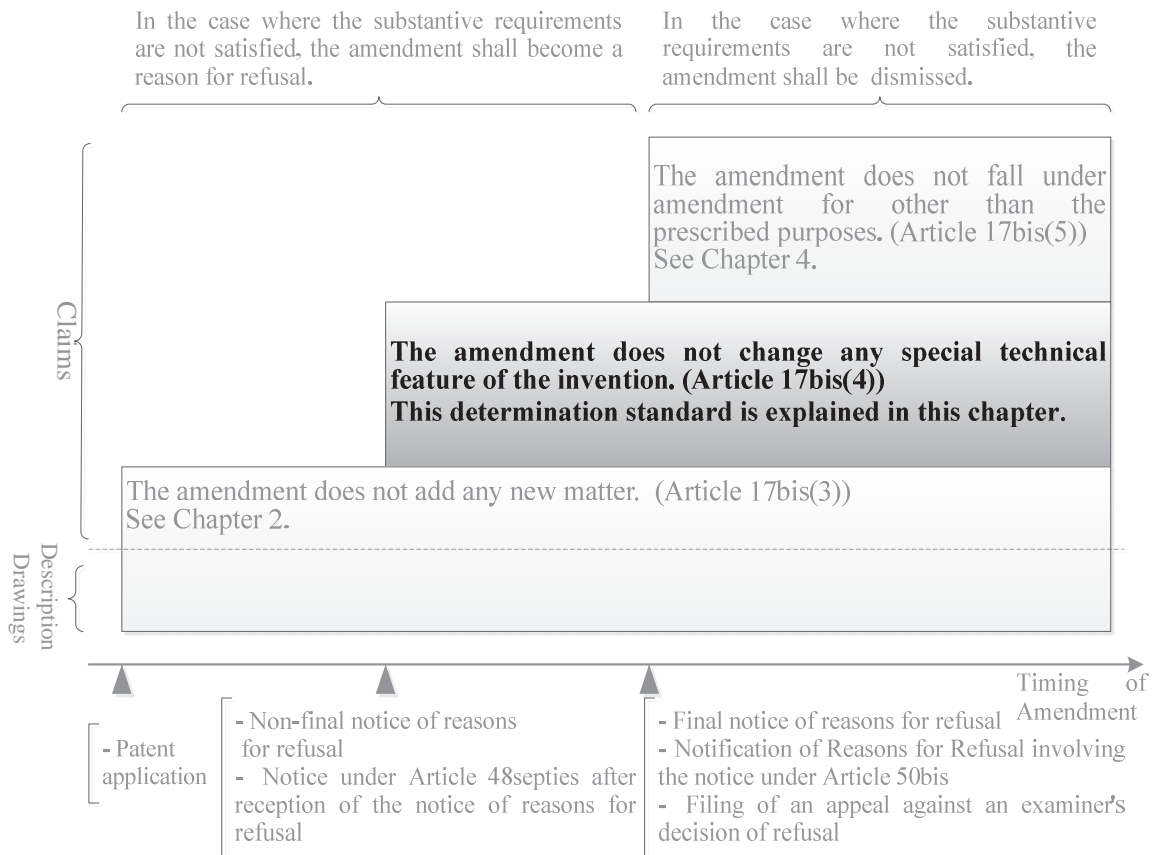


Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

### Chapter 3 Amendment Changing Special Technical Feature of Invention (Patent Act Article 17bis(4))



#### 1. Overview

Article 17bis(4) of the Patent Act is a provision for prohibiting an amendment which changes a special technical feature of an invention. The amendment which changes the special technical feature of the invention is an amendment after which the requirements of unity of invention are not fulfilled between the following inventions (i) and (ii), and Article 17bis(4) extends the requirements of unity of invention under Article 37 to between the inventions stated in the claims before and after the amendment.

- (i) All the inventions for which it is determined whether the invention is unpatentable in a notice of reasons for refusal, among the inventions stated in the claims before the amendment

- (ii) All the inventions identified by the matters stated in the claims after the amendment

If an amendment which changes a special technical feature of an invention is made, it may become impossible for the examiner to effectively utilize results of prior art searches and examinations which have been conducted until then. In this case, the examiner needs to conduct the prior art searches and examinations again, and hence a prompt and accurate grant of right is hindered. In addition, fairness of handling between patent applications cannot be sufficiently ensured. In light of these points, Article 17bis(4) is established in the Patent Act.

Meanwhile, even if an amendment which changes a special technical feature of an invention is made, as long as there is no substantive deficiency in the invention, there is a mere formal deficiency that the applicant should have divided the application into two or more patent applications in order for it to be examined. Accordingly, it does not directly inflict serious damages on the interests of third parties, even if the patent application to which the amendment which changes the special technical feature of the invention is made is patented. Therefore, failure to fulfill the requirements of Article 17bis(4) constitutes a reason for refusal, but does not constitute a reason for invalidation.

Considering these circumstances, the examiner shall not make an unnecessarily strict determination on whether an amendment is an amendment which changes a special technical feature of an invention.

2. Determination on Amendment Which Changes Special Technical Feature of Invention
--

**For determining whether an amendment is an amendment which changes a special technical feature of an invention, the examiner shall determine whether a patent application fulfills the requirements of Article 37 assuming that the following inventions (i) and (ii) were filed with the same request.**

In the case where the patent application does not fulfill the requirements of Article 37, the examiner shall determine that the amendment is an amendment which changes a special technical feature of an invention.

- (i) All the inventions for which it is determined whether the invention is unpatentable in a notice of reasons for refusal (Note)

- (ii) All the inventions identified by the matters stated in the claims after the amendment

(Note) In this chapter, "the inventions for which a determination on patentability is shown in a notification of reasons for refusal" refer to inventions for which the requirements of novelty (Article 29(1)), inventive step (Article 29(2)), secret prior art (Article 29bis), and prior application (Article 39) have been examined. Since the purpose of Article 17bis(4) is to effectively utilize prior art searches and examinations which have been conducted before the amendment, the examiner shall make a determination based on inventions for which the requirements of the above-mentioned clauses which require prior art searches have been examined, among the inventions before the amendment.

Note that inventions for which reasons for refusal such as lack of novelty, inventive step, secret prior art, prior application, etc. have not been found as a result of the examination are also "the inventions for which a determination on patentability is shown in a notification of reasons for refusal."

(Explanation)

In view of the fact that Article 17bis(4) extends the requirements of unity of invention under Article 37 to between the inventions stated in the claims before and after the amendment, the examiner shall make a determination on whether an amendment is an amendment which changes a special technical feature of an invention pursuant to a determination on whether the requirements of Article 37 are fulfilled.

<p>3. Specific Procedures for Determining Whether Amendment is Amendment Which Changes Special Technical Feature of Invention</p>
---

3.1 Specific determination procedures

**According to the following procedures (1) to (3), the examiner shall determine whether an amendment is an amendment which changes a special technical feature of an invention.**

- (1) It is assumed that all the inventions identified by the matters stated in the claims after the amendment are stated subsequently to all the inventions for which it is determined whether the invention is unpatentable in a notice of reasons for refusal.

(2) On this assumption, it is determined whether the inventions after the amendment become the subject of the examination on requirements other than the requirements of Article 37, in light of 2. in "Part II Chapter 3 Unity of Invention."

(3) In the case where any of the inventions does not become the subject of the examination as a result of the determination in (2), it is determined that the amendment is an amendment which changes a special technical feature of an invention.

In addition, inventions which become the subject of the examination as a result of the determination in (2) shall be the subject of the examination (Note) on requirements other than the requirements of Article 17bis(4).

(Note) In this chapter, hereinafter the simple expression "subject of the examination" means the subject of the examination on requirements other than the requirements of Article 17bis(4).

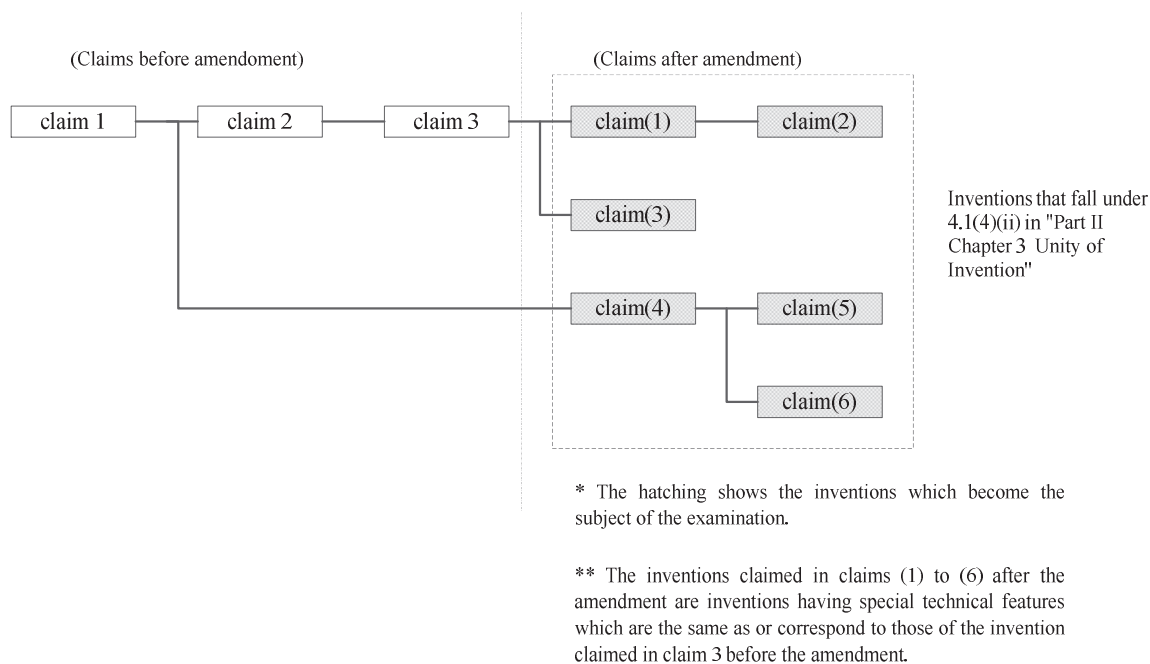
At the time of determining whether an amendment is an amendment which changes a special technical feature of an invention, the examiner shall understand the special technical feature of the invention based on the statement in the description, claims and drawings, the common general knowledge as of the filing and the prior art cited in the notice of reasons for refusal before the amendment.

For example, at the time of determining whether an amendment is an amendment which changes a special technical feature of an invention, the examiner shall not refer to the special technical feature of the invention based on the prior art newly found in the examination after the notice of reasons for refusal.

Example 1:

The inventions of Claims 2, 3 before the amendment are in the same category that includes all matters to specify the inventions of Claims 1, 2 before the amendment, respectively. The inventions of Claims 1, 2 did not have any special technical features, while a special technical feature was found in the invention of Claim 3. Regarding this application, the examiner issued the first notice of reasons for refusal due to lack of novelty to the inventions of Claims 1, 2 and lack of inventive step to the inventions of Claim 3. After said notice of reasons for refusal, the applicant amended the claims regarding Claims (1) to (3) in the same category including all matters to specify the invention of Claim 3 and Claims (4) to (6) including a

special technical feature same as or corresponding to the one found in the invention of Claim 3.



(Explanation)

The examiner assumes that the inventions claimed in claims (1) to (6) after the amendment are stated subsequently to the inventions claimed in claims 1 to 3 before the amendment, that is, assumes that the inventions claimed in claims (1) to (6) after the amendment are the inventions claimed in claims 4 to 9 before the amendment. Then, the examiner determines whether the inventions claimed in claims (1) to (6) become the subject of the examination on requirements other than the requirements of Article 37.

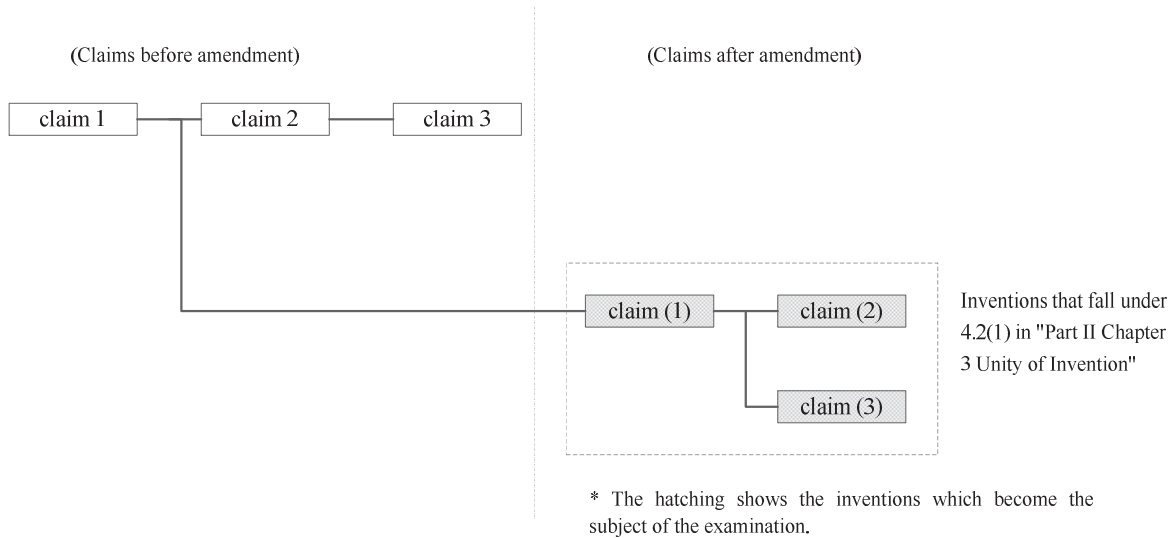
In the case of Example 1, the inventions of Claims (1) to (6) have special technical features same as or corresponding to the one found in the invention of Claim 3. Accordingly, the inventions claimed in claims (1) to (6) become the subject of the examination on requirements other than the requirements of Article 37.

Therefore, this amendment is not an amendment which changes a special technical feature of an invention.

Example 2:

The inventions of Claims 2, 3 before the amendment are in the same category that includes all matters to specify the inventions of Claims 1, 2 before the amendment, respectively. The inventions of Claims 1 to 3 before the amendment did not have any special technical feature and the examiner issued the first notice of reasons for refusal due to lack of novelty of the inventions of Claims 1 to 3 for this application. After said notice of reasons for refusal was issued, the

applicant amended the claims regarding Claims (1) to (3) in the same category including all matters to specify the invention of Claim 1.



(Explanation)

The examiner assumes that the inventions claimed in claims (1) to (3) after the amendment are stated subsequently to the inventions claimed in claims 1 to 3 before the amendment, that is, assumes that the inventions claimed in claims (1) to (3) after the amendment are the inventions claimed in claims 4 to 6 before the amendment. Then, the examiner determines whether the inventions claimed in claims (1) to (3) become the subject of the examination on requirements other than the requirements of Article 37.

In Example 2, the inventions claimed in claims (1) to (3) are inventions in the same category that include all matters specifying the invention of the invention claimed in claim 1. In this case, the inventions claimed in claims (1) to (3) shall be, in principle, the subject of the examination on requirements other than the requirements of Article 37, as inventions on which it is efficient to make an examination together.

Therefore, this amendment is not an amendment which changes a special technical feature of an invention.

However, in the case where the inventions claimed in claims (1) to (3) are inventions which fall under the following case (i) or (ii) and where there is no other reason for considering that it is efficient to make an examination together with the invention claimed in claim 1, the examiner may exclude the inventions claimed in claims (1) to (3) from the subject of the examination on requirements other than the

requirements of Article 37.

In this case, this amendment is an amendment which changes a special technical feature of an invention.

- (i) The case where a problem to be solved by the invention claimed in claim 1 and a specific problem to be solved understood by technical features added to said invention have low relevance
- (ii) The case where technical features of the invention claimed in claim 1 and technical features added to said invention have low technical relevance

### 3.2 Determination procedures in the case where a notice of reasons for refusal has been issued several times before the amendment

In the case where a notice of reasons for refusal has been issued several times before the amendment, the examiner shall assume that the amendment is made in response to each notice of reasons for refusal, and shall determine, on each of the assumptions, whether the amendment is an amendment which changes a special technical feature of an invention with reference to 3.1.

In the case where it is determined for any of the assumptions that the amendment is an amendment which changes a special technical feature of an invention, the examiner shall determine that the amendment is an amendment which changes a special technical feature of an invention.

In addition, the examiner shall decide inventions which become the subject of the examination on all of the assumptions as a result of the above determination, as the subject of the examination on requirements other than the requirements of Article 17bis(4).

<h2>4. Procedures of Examination Concerning Determination on Amendment Which Changes Special Technical Feature</h2>
---

In the case where the examiner determines that an amendment is an amendment which changes a special technical feature of an invention with reference to 3, the examiner shall issue a notice of reasons for refusal or a decision to dismiss the amendment to that effect.

At the time of issuing a notice of reasons for refusal or a decision to dismiss the amendment, the examiner shall specifically explain the reasons why it is determined

that the amendment is an amendment which changes a special technical feature of an invention, and shall clarify inventions which do not become the subject of the examination.

At the time of proceeding with the examination, also see 4. in "Chapter 1 Requirements for Amendments," "Part I Chapter 2 Section 4 Handling of Written Opinion, Written Amendment, etc." and "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment."