

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

Part IV Amendments of Description, Claims or Drawings

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Chapter 1 Requirements for Amendments (Patent Act Article 17bis)

4101 List of Relevant Articles

	July 1, 1995 to March 31, 2007	After April 1, 2007
Reasons for Refusal	Article 49(i)	
Amendment Adding New Matter	Article 17bis (3)	
Amendment Changing Special Technical Feature of Invention		Article 17bis (4)
Dismissal of Amendment	Article 53(1)	
Amendment Adding New Matter	Article 17bis (3)	
Amendment Changing Special Technical Feature of Invention		Article 17bis (4)
Amendment for other than the Prescribed Purposes	Article 17bis (4)	Article 17bis (5)
Requirement of Independent Patentability	Article 126(5) as applied mutatis mutandis under Article 17bis (5)	Article 126(7) as applied mutatis mutandis under Article 17bis (6)

Chapter 2 Amendment Adding New Matter (Patent Act Article 17bis(3))

4201 Reference Court Decision Regarding the Term "Matters Obvious from the Statement in the Originally Attached Description, etc."

Tokyo High Court decision July 1, 2003 (case of request for rescission of trial decision 2002 (Gyo Ke) No. 3) "Network Transmission System such as Game and Japanese Pinball"

"Also, in order for matters to be found obvious from those actually stated therein, the matters must be such that any person skilled in the art who should contact what is actually stated would understand them as if they were stated therein. Matters that could only be understood easily if any explanation is provided therefor cannot be obvious matters."

The above court decision will serve as a reference for understanding the meaning of the term as such of "matters obvious from the statement in the originally attached description, etc."

4202 Example of Amendment Changing Matters Specifying the Invention

Examination guidelines "Part IV Chapter 2 Amendment Adding New Matter," 3.3.1
(Excerpt)

(1) In the case of an amendment which converts the matters specifying the invention into generic concepts or deletes or changes them

- a In the case where an amendment which converts the matters specifying the invention in a claim into generic concepts or deletes or changes them introduces any new technical matter, such an amendment shall not be permitted.
- b On the other hand, even in the case of an amendment which converts the matters specifying the invention in a claim into generic concepts or deletes or changes them, particularly, in the case of an amendment which deletes part of the matters specifying the invention in a claim, if it is obvious that the amendment does not add any new technical significance, the amendment does not introduce any new technical matter. Therefore, such an amendment shall be permitted (Example 1).

For example, in the case where a matter to be deleted is not related to a problem to be solved by the invention and is obviously an optional additional matter from the statement in the originally attached description, etc., the amendment does not add any new technical significance in many cases.

(Amendment changing the matters specifying the invention (example of above "a"))

Example:

[Claim]

Amendment for changing the phrase "when control means are not executed normally" to the phrase "based on a negation signal in case control means are not executed normally."

[Originally attached description, etc.]

It is merely stated that, when the control means are not executed normally, the absence of a positive signal lasts for a predetermined period of time and a resetting signal is generated.

(Explanation)

This amendment adds a configuration in which the resetting signal is generated based on "a negation signal," which is different from the no signal state. This is not, however, stated in the originally attached description, etc.

4203 Points to Note for Amendment by Applicant

- (1) When the applicant intends to make an amendment, the applicant is requested to explicitly specify the amended portions by indicating underlines thereto. The applicant is also requested to indicate portions of the originally attached description, etc. as the basis for amendment in a written statement in the case of a voluntary amendment and in a written opinion in the case of an amendment to respond to a notice of reasons for refusal, and to explain that an amendment is made within the scope of matters stated in the originally attached description, etc.

(Explanation)

As an applicant knows the content of the matters stated in the originally attached description, etc. and the content of the amendment, the applicant requested, when making an amendment, to fully explain that the amendment is made within the scope of the matters stated in the originally attached description, etc. in a written statement or a written opinion. When failing to eliminate doubt as to whether or not an amendment is made within the scope of the matters stated in the originally attached description, etc., the amendment cannot be found to be made within the scope of the matters stated in the originally attached description, etc.

For example, in the example of "an elastic support" of 3.2(ii) of "Part IV Chapter 2 Amendment Adding New Matter" of the Examination Guidelines for Patent and Utility Model, if an applicant establishes that a person skilled in the art would naturally understand that "an elastic support" means "a helical spring," referring to the drawings, etc., which eliminates any doubt as to whether or not the amendment is within the scope of matters stated in the originally attached description, etc., then the amendment is permitted. When such a doubt is not eliminated, the amendment is not found to be made within the scope of the matters stated in the originally attached description, etc.

- (2) The applicant should be reminded that the patent involves a ground for invalidation if the patent was granted with content beyond the scope of the matters stated in the originally attached description, etc.

4299 Others

Concerning matters in the left columns of the following table below, refer to Reference in the columns on the right.

	Refer to:
Request for submission of a document explaining the basis for the amendment	1.(6) in "1218 Cases Where the Examiner Requests to Submit the Documents or Other Materials under the Provision of 194(1)" in "Part I Chapter 2 Procedures of Examination"

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

Chapter 4 Amendment for other than the Prescribed Purposes
(Patent Act Article 17bis(5))

4499 Others

Concerning matters in the left columns of the following table below, refer to Reference in the columns on the right.

	Refer to:
Points to Note in a case where more than one round of amendment has been made within the designated time period of the final notice of reasons for refusal	2. in "1208 Handling in Cases Where a Plurality of Written Amendment etc. were submitted" in "Part I Chapter 2 Procedures of Examination"
Handling of cases where the amendment made to the claims after the final notice of reasons for refusal is determined as being made for more than one purpose from the items of Article 17bis (5) of the Patent Act	"1215 Handling in Cases where the Amendment of Claims after the Final Notice of Reasons for Refusal is Considered to Aiming at Two or More Matters Listed in Items of Article 17bis (5) of the Patent Act" in "Part I Chapter 2 Procedures of Examination"
Request for submission of a document explaining the purpose(s) of the amendment	1.(6) of "1218 Cases Where the Examiner Requests to Submit the Documents or Other Materials under the Provision of 194(1)" in "Part I Chapter 2 Procedures of Examination"