

Amendments

Japan Patent Office

- I. Purpose of amendments
- II. Effect of amendments
- III. Targets of amendments
- IV. Restriction of amendments
- V. New Matter

I. Purpose of amendments

II. Effect of amendments

III. Targets of amendments

IV. Restriction of amendments

V. New Matter

I. Purpose of Amendments

If an applicant could not make any amendment . . .

(1) First-to file system



Applicant

✓ had to submit an application as rapidly as possible.

✓ had to submit a perfect application.



Patent Office

(2) Notification of reasons for refusal



Applicant

✓ had to respond to the notice.

✓ **could not avoid the refusal.**



Patent Office

Applicants need amendments !!

I. Purpose of amendments

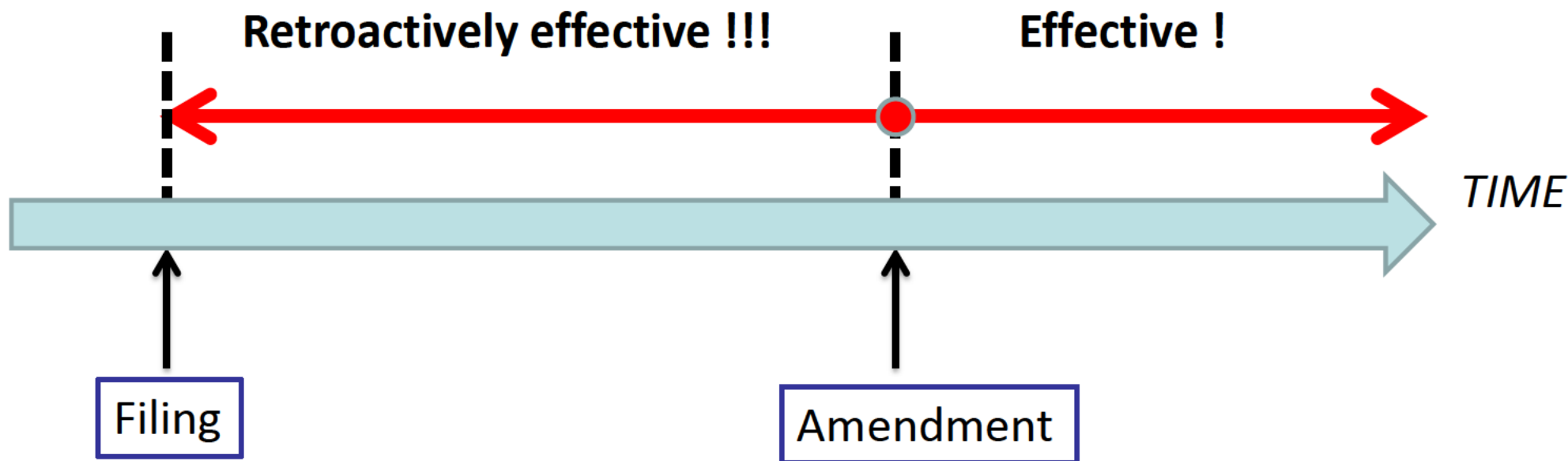
II. Effect of amendments

III. Targets of amendments

IV. Restriction of amendments

V. New matter

II. Effect of Amendments



Amendments should be retroactively effective to the filing date.

I. Purpose of amendments

II. Effect of amendments

III. Targets of amendments

IV. Restriction of amendments

V. New Matter

III. Targets of Amendments

Examples

Description

.....

[0001]

[0002]

Claims

1.

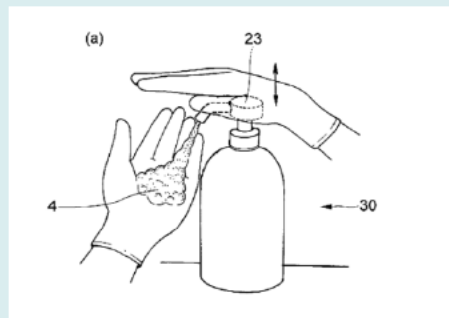
2.

Abstract

.....

Drawings

Fig.1



Targets of
amendments
are claims,
description,
drawings and
so on.



Cited from WO 2012/029692 A1

I. Purpose of amendments

II. Effect of amendments

III. Targets of amendments

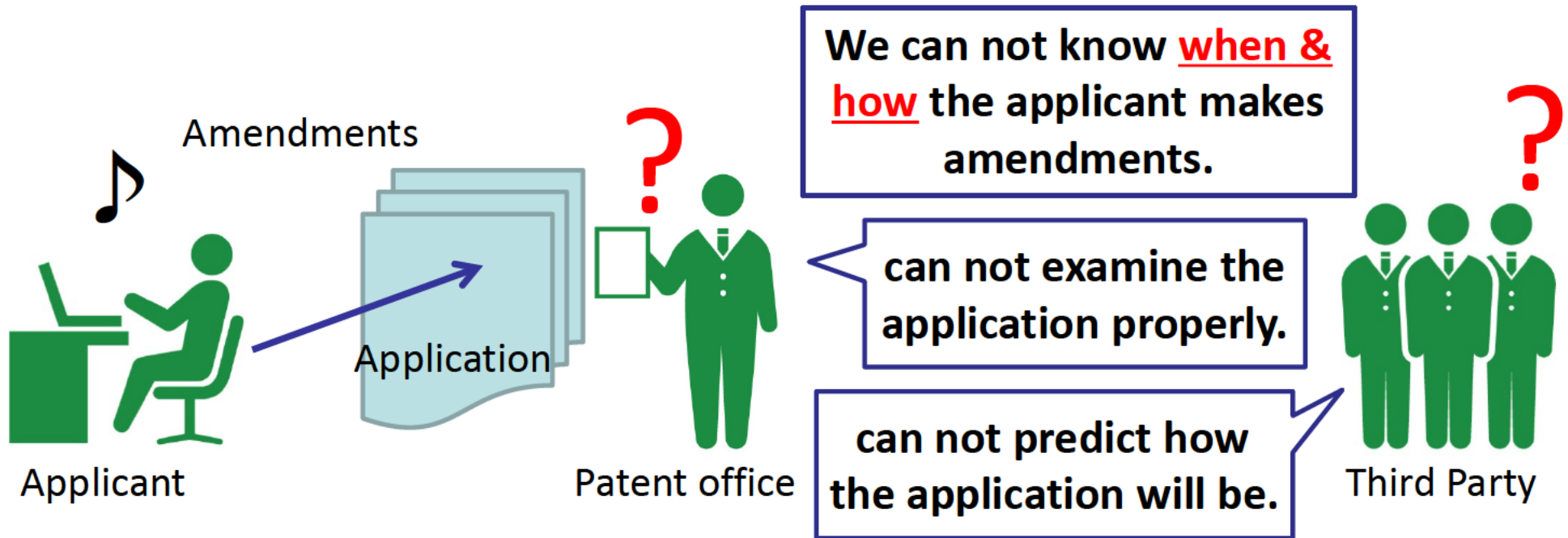
IV. Restriction of amendments

V. New Matter

IV. Restriction of Amendments

A. Purpose of the restriction

If an applicant could make amendments freely



Patent office and third parties need the restriction of amendments



WHEN : TIME restriction

HOW : CONTENT restriction

PCT

Patent Cooperation Treaty Article 34(2)(b)

“The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established.”

JP

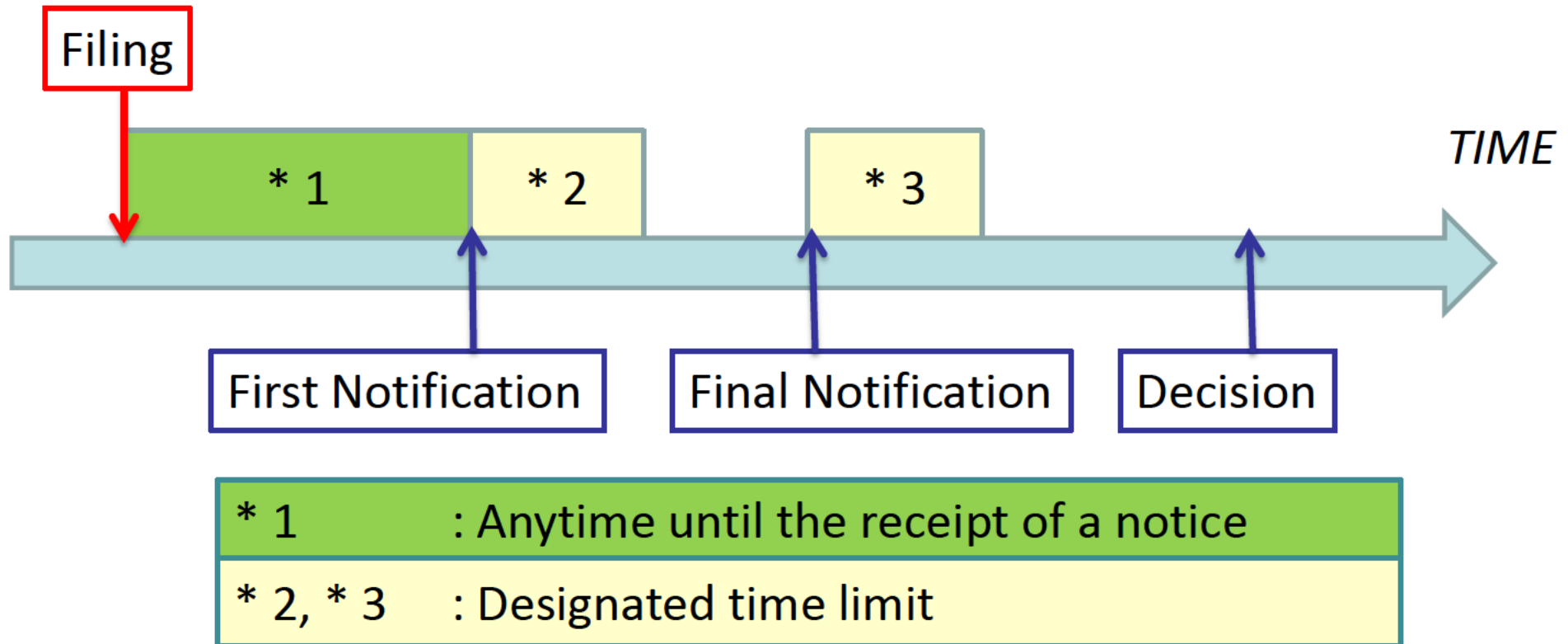
Japanese Patent Act Article 17bis(1)

“An applicant for a patent may amend the description, scope of claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted; provided, however, that following the receipt of a notice provided under Article 50, an amendment may only be made in the following cases:”

IV. Restriction of Amendments

B. TIME restriction (JP)

Time to make amendments is restricted.

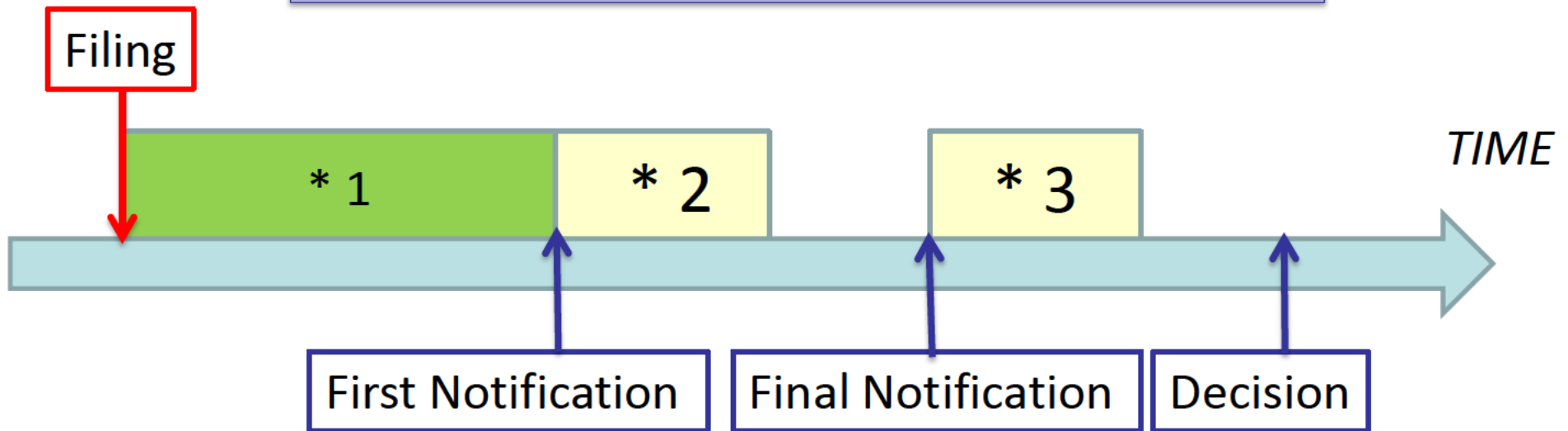


Final Notification : Final notification is the notification which notifies the applicant of reasons necessitated by an amendment after the first notification.

IV. Restriction of Amendments

C. CONTENT restriction (JP)

Contents of amendments are restricted.

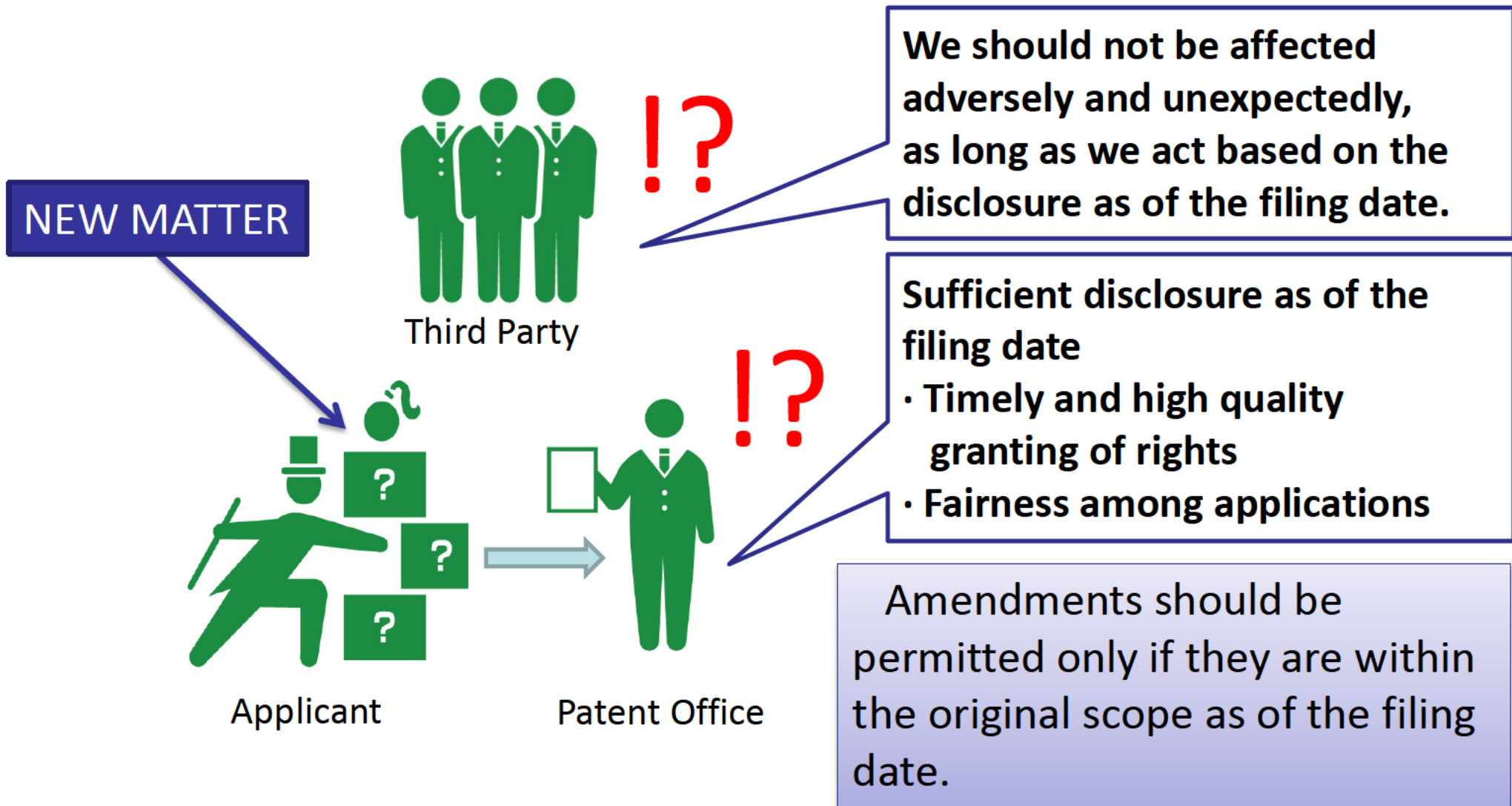


** 1* - ** 3* : **Addition of new matter** is prohibited.

IV. Restriction of Amendments

D. Addition of NEW MATTER

Why is the addition of new matter prohibited ?



- I. Purpose of amendments
- II. Effect of amendments
- III. Targets of amendments
- IV. Restriction of amendments
- V. New Matter**

V. New Matter

A. Overview of New Matter

B. Exercise

C. Example of Notification of Reasons
for Refusal

A. Overview of New Matter

PCT

Patent Cooperation Treaty Article 34(2)(b)

“The amendment shall not go beyond the disclosure in the international application as filed.”

JP

Japanese Patent Act Article 17bis(3)

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

A. Overview of New Matter

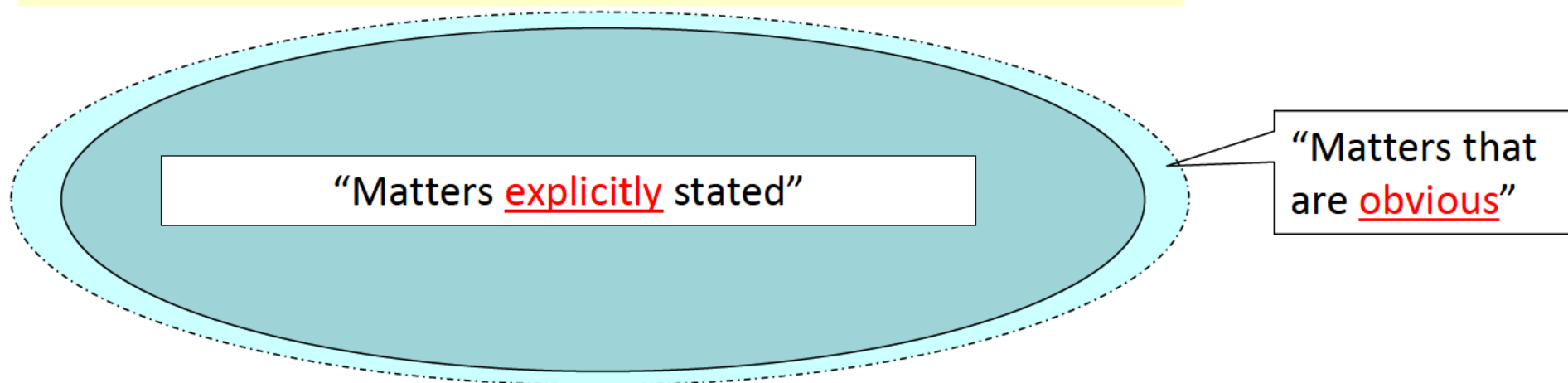
Amendments shall be made within the scope stated in the original application.

(“within the scope stated in the original application”

= Does not include contents beyond the scope of matters stated in the originally attached description, etc. (“description, etc.” = “description, claims or drawings”))

- (1) “matters stated in the originally attached description, etc.,” means not only “matter explicitly stated in the originally attached description, etc.,” but also “matter that are obvious from the statement in the originally attached description, etc.”
- (2) Amendments are not permitted if they introduce new technical matters.

The scope stated in the original application



V. New Matter

A. Overview of New Matter

B. Exercise

C. Example of Notification of Reasons
for Refusal

B. Exercise [1] Question

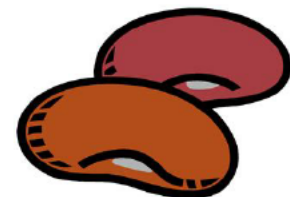
Originally attached description, etc.

[Claim 1]

A sweet bean paste that includes boiled red soy beans, sweeteners and glycerin.

[Overview of the description]

... Adding glycerin to conventional sweet bean paste creates new effects which are excellent in preservation and preventing the paste from freezing under refrigeration.



Amended Description, etc.



[Claim 1]

A sweet bean paste for ice cream that includes boiled red soy beans, sweeteners and glycerin.

[Overview of the description]

... preventing the paste from freezing even under refrigeration, and is especially optimal for ice cream.



B. Exercise [1] Answer

[Conclusion]

The addition of new matter.

[Explanation]

Although it mentions the expression “preventing the paste from freezing under refrigeration,” the originally attached description, etc., does not mention anything about the use of the paste specified for “ice cream.” Also, the sweet bean paste, which does not freeze under refrigeration, could be used for various purposes. Consequently, it is not considered that a person skilled in the art who contacts the originally attached description, etc., would understand the paste as being specially adapted “for ice cream,” as if they were stated therein.

B. Exercise [2] Question

Originally attached description, etc.

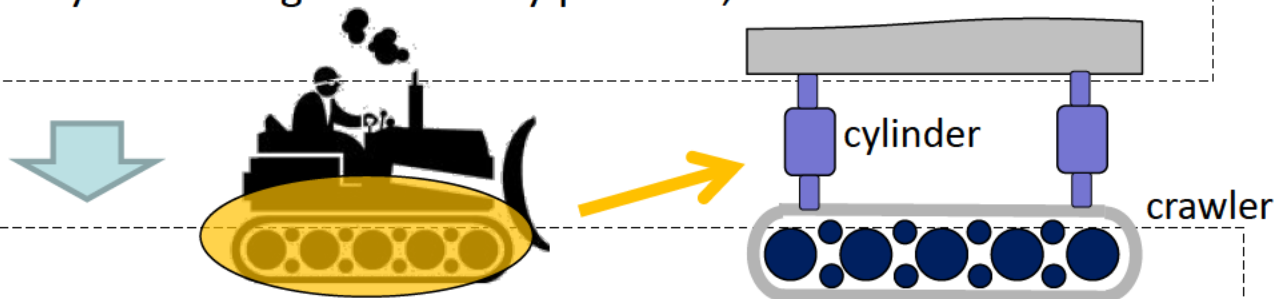
[Claim 1]

A rolling control device for a combine having crawler travel devices on the right and left sides of the body, comprising a pair of oil pressure cylinders operating individually for the right and left travel devices where each end of the oil pressure cylinders is connected to the travel devices, and each of the other ends of the oil pressure cylinders is connected to the body.

[Overview of the description]

If oil leakage from the oil pressure cylinders might cause any problem, water or air may be used instead.

Amended Description, etc.



[Claim 1]

A rolling control device for a combine having crawler travel devices on the right and left sides of the body, comprising a pair of fluid pressure operated cylinders operating individually for the right and left travel devices where each end of the fluid pressure operated cylinders is connected to the travel devices, and each of the other ends of the fluid pressure operated cylinders is connected to the body.

B. Exercise [2] Answer

[Conclusion]

Not the addition of a new matter.

[Explanatory Note]

This amendment is to replace “oil pressure cylinders” with “fluid pressure operated cylinder,” which is a generic concept.

With respect to “oil pressure cylinders,” the originally attached description, etc. states use of water or air other than oil, and it can be understood that it is stated to use “water pressure cylinders” and “air cylinders” which are well-known to a person skilled in the art.

And, “oil pressure cylinders” and “water pressure cylinders” can also be expressed as “liquid pressure cylinders,” and “air cylinders” can be expressed as “gas pressure cylinders.”

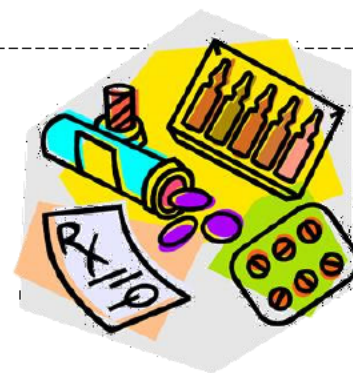
Then, it can be said that a person skilled in the art who had access to the originally attached description, etc. would understand that it is stated that “fluid pressure operated cylinders,” which means “liquid pressure cylinders” or “gas pressure cylinders” is used as a concept generalizing “oil pressure cylinders,” “water pressure cylinders” and “air pressure cylinders” for a rolling control device.

B. Exercise [3] Question

Originally attached description, etc.

[Claim 1]

A therapeutic agent for digestive system diseases containing chemical compound A as an active ingredient.



Amended Description, etc.

[Claim 1]

A therapeutic agent for pancreatitis containing chemical compound A as an active ingredient.

(JPO Examination Handbook Annex A 7 Example 21)

B. Exercise [3] Answer

[Conclusion]

The addition of new matter.

[Explanation]

The originally attached description, etc., does not mention anything about therapeutic agents for pancreatitis and it is not considered that it is obvious to a person skilled in the art that the therapeutic agent for digestive system diseases which protects alimentary canal mucosa represents therapeutic agents for pancreatitis, even taking the whole of the originally attached description, etc., and the common general knowledge as of the filing into consideration.

B. Exercise [4] Question

Originally attached description, etc.

[Claim 1]

A stabilized resorcin-containing agent comprising a resorcin-containing agent having a clay mineral as a base and 0.001 to 2% by mass of lactic acid.

[Overview of the description]

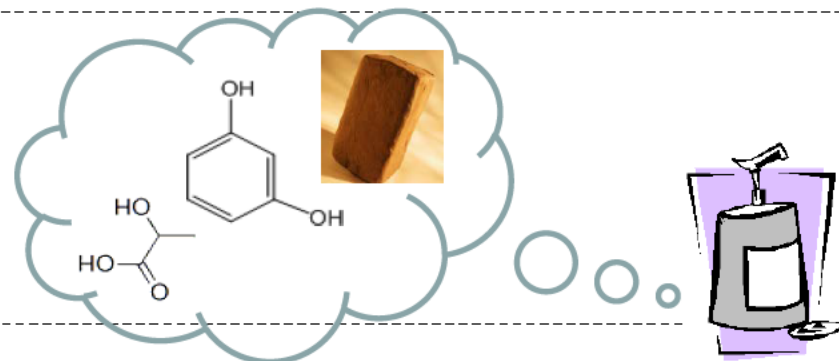
The amount of lactic acid added to the resorcin-containing agent is preferably 0.05 to 2% by mass. (no statements of values of 0.1% by mass and 1% by mass.)



Amended Description, etc.

[Claim 1]

A stabilized resorcin-containing agent comprising a resorcin-containing agent having a clay mineral as a base and 0.1 to 1% by mass of lactic acid.



B. Exercise [4] Answer

[Conclusion]

The addition of new matter.

[Explanation]

There are no statements of the values 0.1% by mass and 1% by mass in the originally attached description, etc.. Also, the numerical range cannot be assumed to be stated as "0.1 to 1% by mass" from the originally attached description etc.. Furthermore, there are no special circumstances to consider that this amendment does not introduce any new technical matter.

B. Exercise [5] Question

Originally attached description, etc.

[Claim 1]

Hollow glass microsphere which have substantially equal diameters of 200-10,000 μ m ...

[Excerpts from the Detailed Explanation of the Invention]

The glass microsphere have varied diameters according to the desired final applications between 200-10,000 μ m, preferably 500-6,000 μ m.

Amended Description, etc.



[Claim 1]

Hollow glass microsphere which have substantially equal diameters of 200-6,000 μ m ...

B. Exercise [5] Answer

[Conclusion]

Not the addition of a new matter.

[Explanation]

The amended claim provides the numerical range of diameters of “200-6,000μm,” the highest value of which is changed from “10,000μm” in the original claim. The amended numerical range of “200-6,000μm” of the diameter is within the range of “200-10,000μm” in the originally attached description, and the originally attached description describes the value “6,000μm,” which specifies the amended numerical range, as a value to indicate a preferable range. Consequently, the amended numerical range is within the scope of the matters stated in the originally attached description, etc.

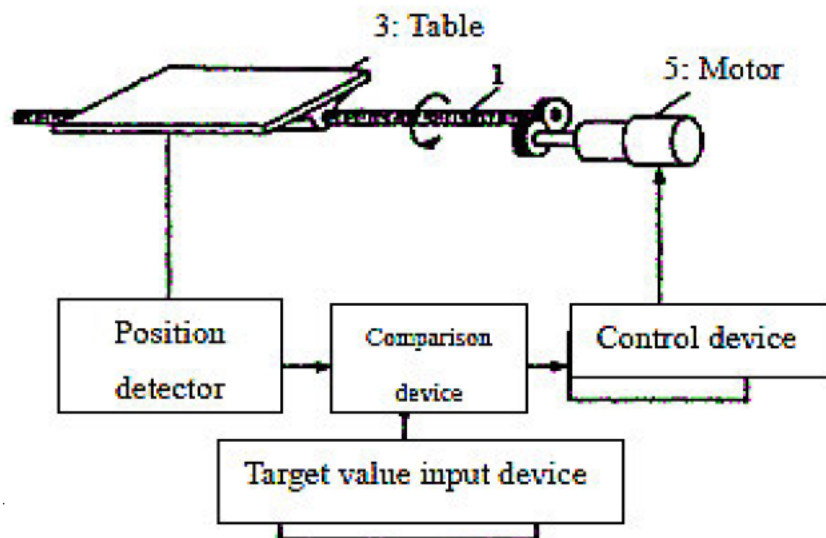
B. Exercise [6] Question

Originally attached description, etc.

[Excerpts from the Detailed Explanation of the Invention]

... a table (3) is connected to a motor (5) through a feed mechanism, and the position of the table (3) is controlled through the control of the rotation of the motor (5).

[Drawings]



Amended Description, etc.

[Excerpts from the Detailed Explanation of the Invention]

... a table (3) is connected to a motor (5) through a screw feed mechanism which moves the table (3) linearly by the rotation of the screw (1), and the position of the table (3) is controlled through the control of the rotation of the motor (5).

B. Exercise [6] Answer

[Conclusion]

Not the addition of a new matter.

[Explanation]

According to the statement, "feed mechanism," in the description before the amendment and the originally attached drawings, the device indicated by the drawing is obviously recognized as a screw feed mechanism which moves the table linearly by the rotation of a screw.

V. New Matter

A. Overview of New Matter

B. Exercise

**C. Example of Notification of Reasons
for Refusal**

C. Example of Notification of Reasons for Refusal -1/2

Notification of Reasons for Refusal

Application number: Application for patent 2013 - 700000

Date of Drafting: Heisei 25 (2013) June 17

Patent examiner: TOKKYO, Taro

Representative/Applicant: KEIZAI, Hana (other four persons)

Applied Provisions: Article 17bis(3)

This application should be refused for the reason stated in the following Reason. If there is an opinion about this, please submit a Written Argument within 60 days after the dispatch date of this notice.

Reason

(New matter) Since the Amendment as of Heisei 25 (2013) March 17 was not carried out within the limits of the matter described in the Description, Claims, or Drawings attached to the request first with respect to the following, it does not satisfy the requirements specified in Patent Act Article 17bis(3).

C. Example of Notification of Reasons for Refusal -2/2

Note

Although it mentions the expression “preventing the paste from freezing under refrigeration,” the originally attached description, etc., does not mention anything about the use of the paste specified for “ice cream.” Also, the sweet bean paste, which does not freeze under refrigeration, could be used for various purposes. Consequently, it is not considered that a person skilled in the art who reads the originally attached description, etc., would understand the paste as being specially adapted “for ice cream” as if that were stated therein.