

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

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

1. Overview

Article 17bis of the Patent Act provides the timing and the scope within which the description, claims or drawings (In this part, hereinafter, referred to as "description, etc.") may be amended.

In order to smoothly and promptly proceed with the procedures, it is desirable for the applicant to submit documents having perfect contents from the beginning. However, due to the need for haste in a patent application under the first-to-file principle or other reasons, such perfect documents may not be possible in actuality. In addition, for example, in the case where any reason for refusal is found as a result of the examination, the description, etc. may need to be modified. Under the circumstances, Article 17bis provides that the description, etc. may be amended. However, if the description, etc. may be freely amended at any time, the procedures will be confused, and a delay in processing of patent application would occur. Therefore, Article 17bis provides the timing at which the description, etc. may be amended (time requirements). In addition, in order to guarantee a prompt grant of right and ensure the fairness of patent application handling and the balance between the applicant and third parties, Article 17bis provides the scope within which the description, etc. may be amended (substantive requirements).

Requirements for amendment made to the description, etc. are summarized in this chapter, and specific determination standards for the substantive requirements are explained in " Chapters 2 Amendment Adding New Matter" to "Chapter 4 Amendment for other than the Prescribed Purposes".

2. Time Requirements of Amendment

The applicant may amend the description, etc. in any of the following timing (i) to (v) (Article 17bis(1)).

- (i) After the application before the transmittal of a certified copy of an examiner's decision that a patent is to be granted (except after the applicant receives the first notice of reasons for refusal) (Article 17bis(1)) (Note 1)
- (ii) Within the designated time limit of a non-final notice of reasons for refusal (Article

17bis(1)(i))

- (iii) Within the designated time limit of a notice under Article 48septies (Note 2) after receiving a notice of reasons for refusal (Article 17bis(1)(ii))
- (iv) Within the designated time limit of a final notice of reasons for refusal (Article 17bis(1)(iii))
- (v) At the same time when a request is made for an appeal against an examiner's decision of refusal (Article 17bis(1)(iv))

(Note 1) For an international patent application, see 4.2 in "Part VIII International Patent Application."

(Note 2) For a notice under Article 48septies, see "Part II Chapter 1 Section 3 Requirements for Disclosure of Information on Prior Art Documents."

3. Substantive Requirements of Amendment

The applicant may amend the description, etc. within the scope in which the substantive requirements are satisfied (Article 17bis(3) to (6)). The substantive requirements are defined in the following manner in accordance with the timing of amendment. The scope within which the description, etc. may be amended shall be gradually limited with progression of the examination.

3.1 Before the first notification is sent to the applicant

Amendment shall not add a new matter (Patent Act Article 17bis(3). See "Chapter 2 Amendment Adding New Matter.")

3.2 After the non-final notice of reasons for refusal is noted

(1) In the case where any amendment is made in any of the following timing (i) or (ii), the amendment shall satisfy both of the following substantive requirements (i) and (ii).

Timing of Amendment

- (i) Within the time limit designated in a non-final notice of reasons for refusal (2.
- (ii) (excluding the cases where the amendment is made within the time limit designated in a notice of reasons for refusal with the notice under Article 50bis

(Note))

- (ii) Within the time limit designated in the notice under Article 48septies after reception of the notice of reasons for refusal (2. (iii))

Substantive requirements

- (i) Amendment does not add new matter (Patent Act Article 17bis(3). See “Chapter 2 Amendment Adding New Matter.”)
- (ii) Amendment does not change the special technical feature of invention (Patent Act Article 17bis(4). See “Chapter 3 Amendment Changing Special Technical Feature of Invention”)

(Note) For the notice under Article 50bis, see "Part VI Chapter 1 Section 2 Notice under Article 50bis."

- (2) In the case where any amendment is made in any of the following timing (i) to (iii), the amendment shall satisfy all of the following substantive requirements (i) to (iii).

Timing of Amendment

- (i) Within the time limit designated in the final notice of reasons for refusal (2. (iv))
- (ii) Within the time limit designated in a notice of reasons for refusal accompanied by the notice under Article 50bis (Note) (2. (ii) or 2. (iv))
- (iii) At the same time when a request is made for an appeal against an examiner's decision of refusal (2. (v))

Substantive requirements

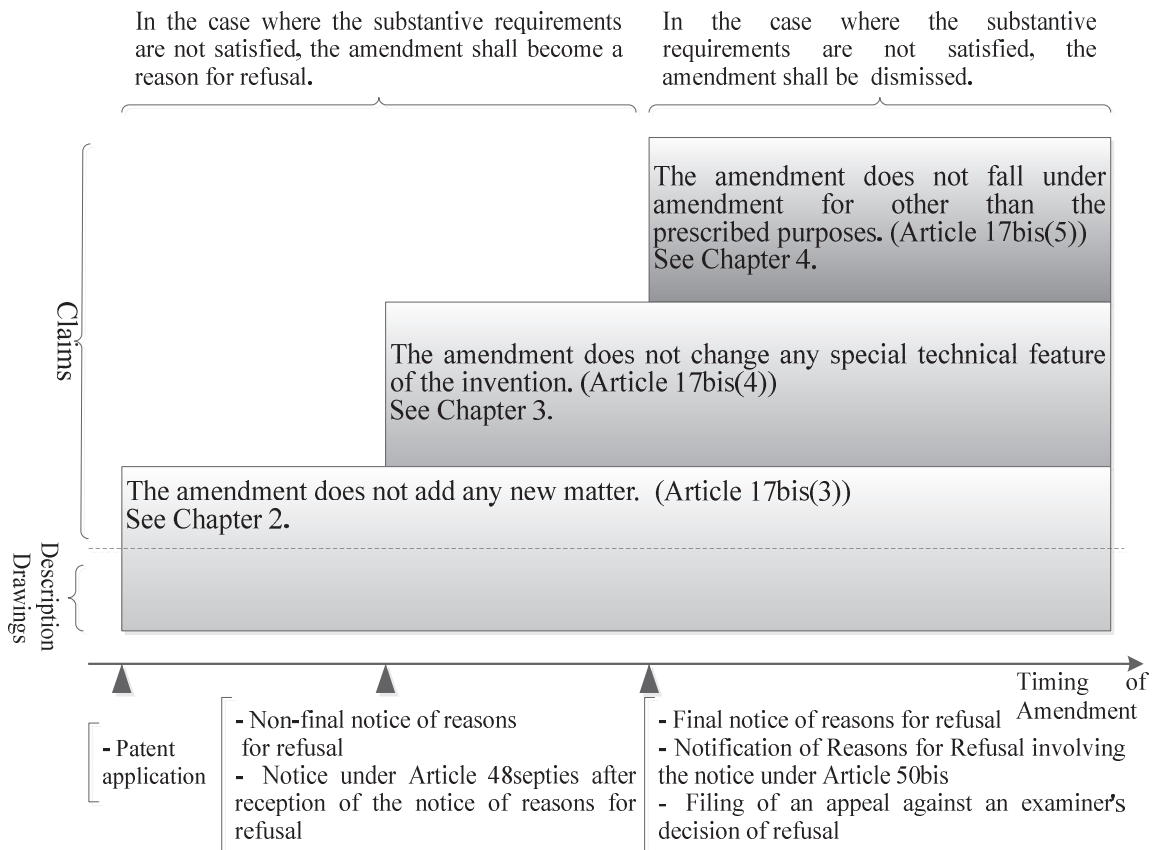
- (i) Amendment does not add new matter (Patent Act Article 17bis(3). See “Chapter 2 Amendment Adding New Matter.”)
- (ii) Amendment does not change the special technical feature of invention (Patent Act Article 17bis(4). See “Chapter 3 Amendment Changing Special Technical Feature of Invention”)
- (iii) An amendment made to the claims is intended for the following purposes (the amendment should not be made for other than the prescribed purposes) (Article 17bis(5). See “Chapter 4 Amendment for other than the Prescribed Purposes”)
 - (a) Deletion of claims (Article 17bis(5)(i))
 - (b) Restriction of claims in a limited way (Article 17bis(5)(ii))
 - (c) Correction of errors (Article 17bis(5)(iii))

(d) Clarification of an ambiguous statement (Article 17bis(5)(iv))

Further, with regard to an amendment made for the purpose (b) listed above, the invention identified by the matters stated in the claims after the amendment shall be independently patentable (requirements for independent patentability) (Article 17bis(6) and Article 126(7)).

In addition, the handling of an amendment which does not satisfy the substantive requirements shall also differ in accordance with the timing of amendment. In the case where an amendment does not satisfy the substantive requirements at the timing 3.1 or 3.2(1), the amendment shall become a reason for refusal. In the case where an amendment does not satisfy the substantive requirements at the timing 3.2(2), the amendment shall be dismissed.

The relation between the timing of amendment and the substantive requirements and the handling of an amendment which does not satisfy the substantive requirements are as shown in the following figure.



4. Procedures of Examination concerning Determination on Amendment
--

The procedures of examination concerning a determination on an amendment which are common to "Chapters 2 Amendment Adding New Matter" to "Chapter 4 Amendment for other than the Prescribed Purposes" shall be as follows. At the time of proceeding with the examination, also see "Chapters 2 Amendment Adding New Matter" to " Chapter 4 Amendment for other than the Prescribed Purposes" and "Part I Outline of Examination."

- (1) In the case where the examiner determines that an amendment satisfies the substantive requirements in light of the determination standards in "Chapters 2 Amendment Adding New Matter" to " Chapter 4 Amendment for other than the Prescribed Purposes", the examiner shall perform an examination based on the description, etc. after the amendment.
- (2) In the case of 3.1 or 3.2 (1), in the case where the examiner determines that an amendment does not satisfy the substantive requirements in light of the determination standards in "Chapter 2 Amendment Adding New Matter" and "Chapter 3 Amendment Changing Special Technical Feature of Invention", the examiner shall perform an examination based on the description, etc. after the amendment, and issue a notice of reasons for refusal to the effect that the amendment does not satisfy the substantive requirements.
- (3) In the case of 3.2 (2), in the case where the examiner determines that an amendment does not satisfy the substantive requirements in light of the determination standards in "Chapters 2 Amendment Adding New Matter" to " Chapter 4 Amendment for other than the Prescribed Purposes", the examiner shall dismiss the amendment, and then perform an examination based on the description, etc. before submission of the written amendment.
- (4) At the time of issuing the notice of reasons for refusal, decision to dismiss the amendment to the effect that the amendment does not satisfy the substantive requirements, the examiner shall point out an amended matter which is determined not to satisfy the substantive requirements, and specifically explain the reasons therefor.