



# **Comparative Case Study on Amendments**

JEGPE 2015

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# CONTENTS

|   |           |
|---|-----------|
| <b>PREFACE.....</b>   | <b>1</b>  |
| <b>CASE STUDIES.....</b>                                    | <b>2</b>  |
| NUMERICAL LIMITATION.....                                   | 2         |
| CHANGE BETWEEN CLOSE-ENDED CLAIM AND OPEN-ENDED CLAIM.....  | 18        |
| RECOMBINATION OF FEATURES .....                             | 22        |
| CHANGE OF SUBJECT MATTER .....                              | 26        |
| ADDING INFORMATION RELATED TO PRIOR ART .....               | 28        |
| ADDING EMBODIMENT OR TECHNICAL EFFECT .....                 | 33        |
| AMENDMENT AFTER FINAL OFFICE ACTION.....                    | 42        |
| CORRECTION OF OBVIOUS MISTAKE .....                         | 51        |
| AMENDMENT BASED ON DRAWINGS .....                           | 54        |
| DISCLAIMER .....  | 59        |
| GENERIC AND SUBORDINATE CONCEPT .....                       | 66        |
| DELETION OF CLAIMED MATTER .....                            | 74        |
| COMMON GENERAL KNOWLEDGE .....                              | 79        |
| <b>ANALYSIS.....</b>  | <b>82</b> |
| NUMERICAL LIMITATION.....                                   | 82        |
| CHANGE BETWEEN CLOSE-ENDED CLAIM AND OPEN-ENDED CLAIM ..... | 82        |
| RECOMBINATION OF FEATURES .....                             | 83        |
| CHANGE OF SUBJECT MATTER .....                              | 83        |
| ADDING INFORMATION RELATED TO PRIOR ART .....               | 83        |
| ADDING EMBODIMENT OR TECHNICAL EFFECT .....                 | 84        |
| AMENDMENT AFTER FINAL OFFICE ACTION.....                    | 84        |
| CORRECTION OF OBVIOUS MISTAKE .....                         | 85        |
| AMENDMENT BASED ON DRAWINGS .....                           | 85        |
| DISCLAIMER .....  | 86        |
| GENERIC AND SUBORDINATE CONCEPT .....                       | 86        |
| DELETION OF CLAIMED MATTER .....                            | 87        |
| COMMON KNOWLEDGE .....                                      | 87        |
| <b>SUMMARY .....</b>  | <b>88</b> |
| COMMONALITIES.....  | 88        |
| DIFFERENCES .....   | 88        |

## **PREFACE**

The Joint Expert Group for Patent Examination (JEGPE) project was established in 2009 in order to promote cooperation in patent examination among the Japan Patent Office (JPO), Korean Intellectual Patent Office (KIPO) and State Intellectual Property Office of the P.R.C. (SIPO). The three offices have conducted comparative studies on patent laws and examination guidelines and comparative studies on patent laws, examination guidelines, and other selected topics, so users can fully understand the examination standards in terms of operating procedures, and prepare high quality patent applications accordingly. So far, JEGPE has completed a comparative study on inventive step, novelty, disclosure and claims, and protection of utility models. Study reports were published, such as the Comparative Study on Patent Laws and Examination Guidelines for Inventive Step (2010), Novelty (2012), Disclosure and Claims (2013), and Amendments (2014); and Case Studies for Inventive Step (2011), Novelty (2012), and Disclosure and Claims (2014).

For the case study on Amendments, thirty-seven small hypothetical cases were proposed by the three offices (ten by JPO, ten by KIPO, and seventeen by SIPO) and were studied in 2015. The three offices evaluated whether the cases satisfied the requirement for amendment according to each office's examination guidelines and practices. The three offices also discussed the result of the case study and the differences in the examination of the requirement for amendments.

This report is based on the study of hypothetical cases, thus it must be used for research purposes only.

## CASE STUDIES

### NUMERICAL LIMITATION

#### Case 1

|                        |  |  |                        |   |
|------------------------|--|--|------------------------|---|
|                        | Original   | Amended  |                        |   |
| Title of the Invention | Adhesive agent for temporary adhesion  |  |                        |   |
| Description            | (Working Example)  |  |                        |   |
|                        | HLB  | Softening point (°C)   | Adhesive strength (Pa) | Washing time (sec.)<br>(Warm water at 60°C) |
|                        | 11   | 50   | 0.0118                 | 40  |
|                        | 10   | 60   | 0.0147                 | 50  |
|                        | 9.5  | 50   | 0.0118                 | 40  |
|                        | 9  | 60   | 0.0196                 | 70  |
|                        | 8.5  | 65   | 0.0294                 | 100   |
|                        | 8  | 72   | 0.0490                 | 135   |
|                        | 7.5  | 85   | 0.0784                 | 200   |
|                        | The above active ingredient of the adhesive agent has an HLB of 7.5-11, preferably 9-11 ...  |  |                        |   |
| Claims                 | An adhesive agent for temporary adhesion which is insoluble in water but easily soluble in warm water, wherein the active ingredient of the agent is either a fatty acid ester of polyglycerin, an ethylene oxide adduct of polyglycerin, or a propylene oxide adduct of polyglycerin, all of which have an HLB of <b>9-11</b> , or a mixture thereof. | <b>[Case 1-1]</b><br>An adhesive agent for temporary adhesion which is insoluble in water but easily soluble in warm water, wherein the active ingredient of the agent is either a fatty acid ester of polyglycerin, an ethylene oxide adduct of polyglycerin, or a propylene oxide adduct of polyglycerin, all of which have an HLB of <b><u>7.5-11</u></b> , or a mixture thereof. |                        |   |

|       |  |  |
|-------|--|--|
|       |  | <b>[Case 1-2]</b><br>..., all of which have an HLB of <b><u>9.5-11</u></b> , or a mixture thereof. |
| Notes | <i>HLB is a numerical value which represents a balance between hydrophilic groups and lipophilic groups in molecules of surfactants.</i> |  |

[JPO]

Acceptable

Case 1-1: The numerical range “HLB of 7.5-11” in the amended claim is the range described in the original description.

Case 1-2: The amended claim mentions HLB with the numerical range of “9.5-11,” the lowest value of which is changed from “7.5” and which is the range included in the range of “7.5-11” described in the original description. In addition, the original description provides the numerical values of 9.5 and 11 of HLB, which are included in the amended numerical range and also in the values in the working example. Consequently, the amended numerical range is considered to be within the scope of the matters stated in the original description. (See “Examination Handbook for Patent and Utility Model” (hereinafter, referred to as “HB”), Annex A, 7. Case 31.)

[KIPO]

Case 1-1, 1-2: Acceptable.

The numerical limitations in the amended claims (HLB of 7.5-11, 9.5-11) are within the scope of numerical range stated in the description (HLB of 7.5-11). Therefore, the amendments are not deemed as addition of new matter.

However, if the amendment is made after a final office action (final notice of grounds for rejection), case 1-1 is not allowed since it expands the scope of the claim.

An amendment in response to a final office action shall be one of the followings: reduction of scope of claims, correction of clerical errors, clarification of ambiguous descriptions, or deletion of new matter. (Patent Examination Guideline, Part IV Section 2 2.1.)

[SIPO]

Acceptable.

The embodiment gives a series of HLB from 7.5 to 11, and the numerical range 7.5-11 has been disclosed in the description. Therefore, the amendment is not going beyond the original application. The amendment is acceptable under Art. 33.

## Case 2

|                        | Original  | Amended              |   |   |
|------------------------|---|----------------------|---|---|
| Title of the Invention | Adhesive agent for temporary adhesion   |                      |   |   |
| Description            | (Working Example)   |                      |   |   |
|                        | HLB   | Softening point (°C) | Adhesive strength (Pa)  | Washing time (sec.)<br>(Warm water at 60°C) |
|                        | 11  | 50                   | 0.0118  | 40  |
|                        | 10  | 60                   | 0.0147  | 50  |
|                        | 9.5   | 50                   | 0.0118  | 40  |
|                        | 9   | 60                   | 0.0196  | 70  |
|                        | 8.5   | 65                   | 0.0294  | 100   |
|                        | 8   | 72                   | 0.0490  | 135   |
|                        | 7.5   | 85                   | 0.0784  | 200   |
| Claims                 | An adhesive agent for temporary adhesion which is insoluble in water but easily soluble in warm water, wherein the active ingredient of the agent is either a fatty acid ester of polyglycerin, an ethylene oxide adduct of polyglycerin, or a propylene oxide adduct of polyglycerin |                      | <b>[Case 2-1]</b><br>An adhesive agent for temporary adhesion which is insoluble in water but easily soluble in warm water, wherein the active ingredient of the agent is either a fatty acid ester of polyglycerin, an ethylene oxide adduct of polyglycerin, or a propylene oxide adduct of polyglycerin, <b><u>all of which have an HLB of 7.5-11, or a mixture thereof.</u></b> |   |
|                        |   |                      | <b>[Case 2-2]</b><br>..., <b><u>all of which have an HLB of 9.5-11, or a mixture thereof.</u></b>   |   |
| Notes                  | (No numerical range is disclosed in the description)  |                      |   |   |



|  |  |
|--|--|
|  | <i>HLB is a numerical value which represents a balance between hydrophilic groups and lipophilic groups in molecules of surfactants.</i> |
|--|--|

[JPO]

Acceptable.

The original description provides the numerical values of 7.5 (9.5) and 11 of HLB, which define the numerical range in the amended claim. As far as it is found that a specific scope of 7.5 (9.5) to 11 of HLB was referred to in light of the whole statement of the original description, it can be evaluated that the numerical limitation was stated originally, and new technical matter is not introduced. The amendment is, therefore, permitted.

[KIPO]

Case 2-1, 2-2: Acceptable

“New matter” refers to an element which is out of the scope of the specification or drawing(s) originally attached to the patent application. In this context, matter in the original specification or drawing(s) means the elements which are explicitly described in the specification or drawing(s), or matter which can be considered to be originally stated in the specification, etc. by a person skilled in the art based on the technical knowledge at the time of filing even though the matter is not explicitly stated

In other words, even if elements are not explicitly described, if it is obvious for a person skilled in the art and he can regard it as the matter is written, such elements shall not be new matter. (Patent Examination Guideline, Part IV Section 2 1.1.)

In case 2-1 and 2-2, the applicant discloses 7 working examples with different HLB ratio between 7.5 and 11. Although working example with HLB 10 breaks the tendency of softening point, adhesive strength and washing time a little bit, it doesn't seem that there is a major singularity within the HLB range of 7.5-11. It seems obvious for a person skilled in the art that all the adhesive agents with HLB of 7.5-11 as well as explicitly written 7 examples are also available.

Therefore, case 2-1 and 2-2 appear to be within the scope of description and not deemed as addition of new matter.

Please note that if there is other information or circumstance that makes a person skilled in the art regard the amended numerical range as not obvious, the amendments may not be allowed.

[SIPO]

Unacceptable

The newly added numerical range is considered as going beyond the original application, because the description does not disclose any numerical range, and only some specific values of HLB have been indicated in the working example. A range between these specific values cannot be determined directly and unambiguously by a person skilled in the art according to the initial description and claims.

[Meeting Discussion]

If a person skilled in the art would understand that the indication of two numerical values in the description relates to a technical effect which could also be produced in the whole range between the points, JPO and KIPO accept an amendment from the two points to a numerical range, while this is not the case at SIPO, i.e., based on the Guidelines part II, chapter VIII, section 5.2.2.1. Normally this amendment is not acceptable. If the claim or specification describes the range 9-11, SIPO would accept the amendment in Case 2-2.

### Case 3

|             | Before amendment  | After amendment   |
|-------------|---|---|
| Description | .... Comprising 50-70wt% of high density polyethylene, 20-40wt% of chlorinated polyethylene and, <b>selectively, plasticizer</b> ”  | ....Comprising 50-70wt% of high density polyethylene, 20-40wt% of chlorinated polyethylene and <b><u>0-5 wt% of plasticizer</u></b> ” |
| Notes       | 1. Wt% of plasticizer was not stated in the originally attached description or drawing.<br>2. It is common to add some amount of plasticizer in the technical field.<br>3. It is easy for a person skilled in the art to select appropriate amount of plasticizer.<br>4. It is well known that adding plasticizer doesn't cause any special effect. |   |

[JPO]

Unacceptable.

In the case of an amendment which adds numerical limitation, unless the added numerical limitation does not introduce any new technical matter, the amendment shall not be permitted. (See “Examination Guidelines for Patent and Utility Model” (hereinafter, referred to as “GL”) Part IV, Chap. 2, 3.3.1 (3) a.)

Unless the numerical range 0-5% as added amount of plasticizer is obvious, this amendment includes new technical matter which is not stated in the originally attached description, etc.

[KIPO]

Acceptable

“New matter” refers to an element which is out of the scope of the specification or drawing(s) originally attached to the patent application. In this context, matter in the original specification or drawing(s) means that the elements which are explicitly described in the specification or drawing(s), or matter which can be considered to be originally stated in the specification, etc. by a person skilled in the art based on the technical knowledge at the time of filing even though the matter is not explicitly stated.

In other words, even if elements are not explicitly described, but if it is so obvious for a person skilled in the art that he/she can regard it as the matter is written, such elements shall not be new matter. (Patent Examination Guideline, Part IV Section 2 1.1.)

In this case study, according to the given condition(See notes), adding plasticizer is well known process and selecting appropriate amount of the plasticizer is easy for skilled person in the art. Therefore, it can be considered as a matter originally stated in the specification, etc. by a person skilled in the art based on the technical knowledge at the time of filing even though the matter is not explicitly stated. Please note that adding numerical limitation is acceptable only in a special case when the limitation is obvious for a person skilled in the art. In real examination case, there can't be an objective information such as the 'notes' given in the case study. Therefore, similar amendments could be rejected by examiners.

[SIPO]

Unacceptable.

The newly amended technical solution is regarded as going beyond the scope of the original disclosure, as the specific wt% of plasticizer is not stated in the original claims, description or drawing. Although it is easy for a person skilled in the art to select appropriate amount of plasticizer, this technical feature is not stated in the original application, and can not be determined directly and unambiguously from the original application.

[Meeting Discussion]

JPO stated that the amendment of "suitable amount" might be acceptable under the condition that the plasticizer itself, adding it and selecting a suitable amount of it to be added were well-known and conventional.

#### Case 4

|             | Before amendment  | After amendment  |
|-------------|---|--|
| Description | In example 1 of the description, the ratio of lipid to glycerol is 100:10, and in example 2 the ratio of lipid to glycerol is 100:15. |  |
| Claims      | A method for preparing product X: A) lipid and glycerol are added into the flask...   | A method for preparing product X: A) lipid and glycerol are added into the flask, <b><u>the ratio of lipid to glycerol is 100:10~15...</u></b> |
| Notes       | The added ratio is not explicitly disclosed in the original application.  |  |

[JPO]

Acceptable.

If a specific range of 100:10-15 was referred to in light of the whole statement of the original description (whenever, for example, 100:10 and 100:15 are found to be stated as border values of the upper limit and lower limit, etc. of a certain consecutive numerical range in light of the statement of the problem, effect, etc.), it can be evaluated that the numerical limitation was stated originally, and new technical matter is not introduced. The amendment is, therefore, permitted.  
(See GL Part IV, Chap. 2, 3.3.1 (3) a.)

[KIPO]

Acceptable.

Even if elements are not explicitly described, but if it is so obvious for a person skilled in the art that he can regard it as the matter is written, such elements shall not be new matter. (Patent Examination Guideline, Part IV Section 2 1.1.)

In this case, working examples disclose the ratio of lipid to glycerol for preparing product X could be 100: 10 or 100:15. It seems that it is obvious for a person skilled in the art that the ratio between 100:10 and 100:15 is also available for preparing product X unless there is a special circumstance.

However, if there is any reason that would break the obviousness, for example, a specific ratio in the range is not suitable for preparing product X, the amendment would not be allowed.

[SIPO]

Unacceptable.

The ratios between 100:10 and 100:15 are newly added subject matter and could not be derived directly and unambiguously from the original disclosure, so it is not acceptable.

[Meeting Discussion]

JPO asked whether the amendment could be accepted if the original description contained an expression such as “an appropriate range”. SIPO considered the amendment would not be permitted without any numerical range limited by the two specific extreme values according to the Guidelines.

## Case 5

|             | Before amendment  | After amendment   |
|-------------|---|---|
| Description | This application relates to bait used for controlling fertility of female rats. In example 1 of the description, edible oil occupies 0.5% of the total weight of the bait, and in example 2, edible oil takes 0.8% or 0.1% of total weight of the bait. |   |
| Claims      | A bait used for controlling fertility of female rats, comprising component A, B, C and edible oil, wherein edible oil accounts for <b>0.5%-1%</b> of the total weight of the bait.  | A bait used for controlling fertility of female rats, comprising component A, B, C and edible oil, wherein edible oil accounts for <u><b>0.1%-0.8%</b></u> of the total weight of the bait. |

[JPO]

Acceptable.

If a specific range of 0.1%-0.8% was referred to in light of the whole statement of the original description (in cases where, for example, 0.1% and 0.8% are found to be stated as border values of upper limit and lower limit, etc. of a certain consecutive numerical range in light of the statement of the problem, effect, etc.), it can be evaluated that the numerical limitation was stated originally, and new technical matter is not introduced. The amendment is, therefore, permitted. (See GL Part IV, Chap. 2, 3.3.1 (3) a.)

[KIPO]

Acceptable.

As mentioned in SIPO case 1, even if elements are not explicitly described, but if it is so obvious for a person skilled in the art that he can regard it as the matter is written, such elements shall not be new matter. (Patent Examination Guideline, Part IV Section 2 1.1.)

In this case, it seems to be obvious for a person skilled in the art that 0.1-0.8% of edible oil is available unless there is a special circumstance. Therefore, the amendment doesn't seem to be addition of new matter.

[SIPO]

Unacceptable.

The amended numerical range 0.1%-0.8% has extended beyond the original stated range 0.5%-1%. The end points 0.1% and 0.8% are stated in the original description. However, the range 0.1%-0.5% is not stated in the original document. If the range 0.1%-0.5% could not be derived directly and unambiguously from the original disclosure, the amendment is not acceptable.



## Case 6

|             | Before amendment  | After amendment  |
|-------------|---|--|
| Description | The present invention relates to a pharmaceutical composition containing A and B. In preferred example, the combination of 1 mg/kg A and 30 mg/kg B is disclosed. |  |
| Claims      | 1. A pharmaceutical composition containing A and B, wherein the ratio of A to B is <u>1:10-50</u> by weight.  | 1. A pharmaceutical composition containing A and B, wherein the ratio of A to B is <u>1:10-30</u> by weight. |
| Notes       | However, the ratio of 1:30 is not explicitly disclosed.   |  |

[JPO]

Acceptable.

The ratio 1:30 is implicitly stated by the expression “the combination of 1 mg/kg A and 30 mg/kg B”. Therefore, the amendment does not introduce any new technical matter.

[KIPO]

Acceptable

The ratio of A to B after amendment, 1:10-30, is within the scope of ratio before amendment, 1:10~50. Therefore, the amendment shall not be deemed as addition of new matter.

Whether the ratio of 1: 30 is disclosed in the description doesn't matter in this case since the claim before amendment already disclosed wider range of ratio than that of amended claim.

[SIPO]

Acceptable.

Whether the ratio 1:30 can be derived from “the combination of 1 mg/kg A and 30 mg/kg B” is the main issue. Technically speaking, in preferred examples of pharmaceutical composition, specific amount of A and B is always used instead of ratios. And normally “the combination of 1 mg/kg A and 30 mg/kg B” is interpreted as the ratio of A to B 1:30. Then the ratio 1:30 is implicitly disclosed in the description and the amended range 1:30 is within the original range 1:50. Thus the amendment is acceptable.

## Case 7

|        | Before amendment   | After amendment   |
|--------|--|---|
| Claims | 1. A compound of the general formula $X-(CH_2)_n-Y$ , wherein n is an integer from <b>0 to 6</b> , ...   | 1. A compound of general formula of $X-(CH_2)_n-Y$ , wherein n is <b><u>3, 4 or 5</u></b> , ... |
| Notes  | In the examples, there are compounds wherein n is 3, 4 or 5, but the corresponding X and Y are specific groups within the scope of generic group defined in claim 1. |   |

[JPO]

Acceptable.

When taking into consideration the original description, which provided an embodiment of compounds wherein  $n=3, 4$ , or  $5$ , and the original claim, the amendment does not introduce new technical matter. (See HB Annex A, 7. Case 37.)

[KIPO]

Acceptable.

The original description discloses the example of compounds wherein  $n$  is  $3, 4$ , or  $5$ . Therefore, it shall not be deemed as addition of new matter.

[SIPO]

Unacceptable.

In the general formula “ $n$  is  $3, 4$  or  $5$ ” is not explicitly disclosed in the original application files. In the exemplary compounds wherein  $n$  is  $3, 4$  or  $5$ , the corresponding  $X$  and  $Y$  are specific groups within the scope of generic group defined in claim 1. However, a person skilled in the art could not determine whether “ $n$  is  $3, 4$  or  $5$ ” could be extrapolated and apply to all the other compounds in the general formula. Therefore, this amendment is unacceptable according to Article 33 of CPL.

## Case 8

|                        | Before amendment   | After amendment   |
|------------------------|--|---|
| Title of the Invention | Method for controlling light emission characteristics in LCD for use in e.g. TV, involves selecting light emitters as function of characteristics corresponding to light transmitted from display panel  |   |
| Description            | Original description and claims also only contains “a plurality of adjacent regions”, also no embodiment refers to “two adjacent regions” or “more than two adjacent regions”.   |   |
| Claims                 | “.....selecting a portion of the plurality of light emitters using <u>a plurality of</u> adjacent regions of a multiple axis color space.....”   | “.....selecting a portion of the plurality of light emitters using <u>more than two</u> adjacent regions of a multiple axis color space.....” |
| Notes                  | The amendment was made after the examiner sent a notification of refusal for reason that D1 discloses a technical solution “.....two adjacent regions.....” The invention still doesn’t involve an inventive step when said feature adopts the numerical value after the “disclaimer”. |   |

[JPO]

Acceptable.

If the case of “more than two adjacent regions”, as well as the case of “two adjacent regions” is within the scope of the original description, the amendment does not introduce new technical matter.

[KIPO]

Acceptable

Limiting numerical value shall not be deemed as addition of new matter and allowed.

In this case, the amendment limits the numerical value from “a plurality of” to “more than two” and it is allowable.

Whether an amended claim involves an inventive step or not doesn’t matter when we consider the amendment requirement. If an amendment meets the requirement of prohibition of addition of new matter and requirement for

responding final office action, it is allowable. Whether the amended claim has patentability is determined after accepting or dismissing the amendment.

[SIPO]

Acceptable

Because “a plurality of adjacent regions” is equal to “two adjacent regions or more than two adjacent regions”, the solution “more than two adjacent regions” can be determined directly and unambiguously according to the contents described in the initial description and claims. Such amendment shall be allowed.

[Meeting Discussion]

Although SIPO originally classified this case into the “disclaimer” group, such classification is doubted and discussed at the meeting. After the discussion, three offices agreed that this case should not be classified into that group.

## CHANGE BETWEEN CLOSE-ENDED CLAIM AND OPEN-ENDED CLAIM

### Case 9

|        | Before amendment  | After amendment   |
|--------|---|---|
| Claims | 1. Enteric-soluble immediate-release tablets, wherein the formulating components and proportions by weight <b><u>are</u></b> : aconitine 0.14% ~ 20%, disintegrant 1.3% ~ 50%, adjuvant 1.0 ~ 35% ; enteric-soluble polymer 5% ~ 25%, plasticizer 0.2% ~ 5% ; and <b><u>solvent accounting for 70% ~ 93% of the above components by volume.</u></b> | 1. Enteric-soluble immediate-release tablets, which <b><u>comprises</u></b> the following formulating components and proportions by weight: aconitine 0.14% ~ 20%, disintegrant 1.3% ~ 50%, adjuvant 1.0 ~ 35% ; enteric-soluble polymer 5% ~ 25%, plasticizer 0.2% ~ 5%. |
| Notes  | Amendments relate to the deletion of “solvent accounting for 70% ~ 93% of the above components by volume” and the change from close-ended claim to open-ended claim.  |   |

[JPO]

Acceptable.

As far as the “enteric-soluble polymer” and “disintegrant” which are apparently important in view of common general knowledge are defined, the deletion of statement concerning “solvent” does not immediately introduce new technical matter.

[KIPO]

Acceptable.

Deletion of solvent and change from a close-ended claim to an open-ended claim by changing “are” to “comprises” shall not be deemed as addition of new matter since it seems to be obvious for a person skilled in the art that using appropriate amount of solvent can be chosen.

However, if the amendment is made after final office action, it shall not be allowed since it expands the scope of the claim by changing to an open-ended claim.

[SIPO]

Unacceptable.

Firstly, the amended claim is not explicitly disclosed in the original application. Secondly, from the original claim 1 we know that solvents are used. Although solvents are probably removed in the process, the use of specific amount of solvents could affect the final content of certain components. Therefore, the amended claim could not be derived directly and unambiguously from the original disclosure, and thus the amendment is not acceptable.

[Meeting Discussion]

KIPO noted that the amendment is not accepted if it is made after the final office action. JPO considered that the solvent was not as important as other claimed ingredients, i.e., enteric-soluble polymer and disintegrant in this case. Therefore, the deletion of the claimed element concerning “solvent” would not introduce any new technical matter. SIPO considered that the use of specific amount of solvents could affect the final content of certain components, and the different opinions stem from the different understanding of invention facts.

## Case 10

|                        | Before amendment  | After amendment   |
|------------------------|---|---|
| Title of the Invention | Enzymatic composition useful for treating the risk of a digestive tract infection caused by a protozoan, bacteria, comprises an enzyme cleaving a linkage effecting release of a cell-surface protein or carbohydrate |   |
| Description            | The description does not disclose specific composition only containing (I) and (II) and (III). The description discloses a composition comprising (I) and (II) and (III), as well as an antibiotics.                  |   |
| Claims                 | A feed composition <b>comprising</b> (I) bean flour (II) essential amino acids and (III) mannanase  | A feed composition <b>consisting of</b> (I) bean flour (II) essential amino acids and (III) mannanase |
| Notes                  | Normally, the feed composition will contain some antibiotics, but it is not compulsive.   |   |

[JPO]

Acceptable.

If containing antibiotics is irrelevant to the problem to be solved and an optional and additional matter, the amendment does not introduce new technical matter. (See GL Part IV, Chap. 2, 3.3.1 (1) b.)

[KIPO]

Acceptable

In this case, it is obvious for a person skilled in the art that antibiotics are not essential for the invention (See 'notes'). Therefore, it shall not be deemed as addition of new matter.

[SIPO]

Acceptable

The amended technical solution is mentioned in the original claim, that is, it is within the scope of the original disclosure. In this case, the open claim includes the technical solution of closed claim, and the amendment is regarded as the

deletion of inter-parallel technical solutions. Therefore, the amendment is acceptable.



## RECOMBINATION OF FEATURES

### Case 11

|             | Before amendment   | After amendment  |
|-------------|--|--|
| Description | The description only discloses a protein derived from protein X by substitution, and in other parts, the description discloses the protein derived from the protein X by <b>substitution</b> of one amino acid residue at the <b>amino terminal or carboxyl terminal</b> |  |
| Claims      | A protein derived from the protein X by substitution, deletion or addition of one amino acid residue   | A protein derived from the protein X by substitution, deletion or addition of one amino acid residue at the <b>amino terminal or carboxyl terminal</b> |
| Notes       | The description does not disclose the <b>amino terminal or carboxyl terminal for deletion or addition</b>  |  |

[JPO]

Acceptable.

The meaning of the expression “one amino acid residue” in the original claim, which relates to the protein X, is identical to the expression “an amino acid residue at the amino terminal, an amino acid residue at the 2nd site from the amino terminal, an amino acid residue at the 3rd site from the amino terminal, ..., or an amino acid residue at the carboxyl terminal”, by taking into consideration the common general knowledge. In this view, the protein claimed in the amended claim is composed of “an amino acid residue at amino terminal or an amino acid residue at carboxyl terminal”, a part of the original expression. Furthermore, taking into consideration the common general knowledge (terminals of a protein would be processed (e.g., cut, modified, etc.) after translation), selecting “an amino acid residue at amino terminal or an amino acid residue at carboxyl terminal” as a target of substitution, deletion or addition does not introduce new technical matter. (See GL Part IV, Chap. 2, 3.3.1 (5) and HB Annex A, 7. Case 36.)

[KIPO]

Acceptable.

Substitution, deletion or addition of one amino acid residue is disclosed in the claim before amendment. The description also discloses substitution of one amino acid residue at the amino terminal or carboxyl terminal. From these disclosures, it seems to be obvious for a person skilled in the art that deletion or addition as well as substitution are also available at the amino terminal or carboxyl terminal.

Furthermore, it is well known in the technical field that amino terminal (N-terminal) and carboxyl terminal (C-terminal) can be used for a manipulation to derive a protein.

Therefore, the amendments don't seem to be addition of new matter.

[SIPO]

Acceptable

the description discloses the protein derived from the protein X by substitution, deletion or addition of one amino acid residue, and also the protein derived from the protein X by substitution of one amino acid residue at the amino terminal or carboxyl terminal is disclosed. The substitution can only be regarded as an example for the modification of the amino acids, and the applicants do not exclude the deletion or addition intentionally. Therefore, the amendment is regarded as acceptable according to Art. 33.

## Case 12

|                        | Before amendment   | After amendment  |
|------------------------|--|--|
| Title of the Invention | Method for calibrating temperature compensation coefficient to calculate accurate flow measurements  |  |
| Description            | According to the description, if the flow within the flow path is below the predetermined flow rate threshold, the second differential pressure reading is amplified by the "high gain channel"; if the flow is above the predetermined flow rate threshold, the "low gain channel" may be use. Or in other embodiment, the differential pressure readings will go into A-D converter 26 through both the low gain channel and the high gain channel. Processor 22 may select which signals to use for the air flow rate calculation- the signals received from the low gain channel or the signals received from the high gain channel, or a combination thereof. |  |
| Claims                 | <p>“.....using the differential pressure sensor to obtain a second differential pressure reading at the second time period; obtaining a compensated differential pressure value based on the temperature compensation coefficient, the measured first temperature, the first differential pressure reading, the measured second temperature, and the second differential pressure reading;.....”</p>   | <p>“.....using the differential pressure sensor to obtain a second differential pressure reading at the second time period; <b><u>comparing the flow within the flow path with the predetermined threshold; if the flow is below the threshold, the second differential pressure reading will be amplified</u></b>; obtaining a compensated differential pressure value based on the temperature compensation coefficient, the measured first temperature, the first differential pressure reading, the measured second temperature, and the <b><u>amplified</u></b> second differential</p> |

|       |                          |
|-------|--------------------------|
|       | pressure reading;..... ” |
| Notes |                          |

[JPO]

Acceptable.

If, taking into account common general knowledge, defining only the process where the flow is below the threshold does not introduce new technical matter, the amendment is permitted.

[KIPO]

Acceptable.

The description discloses that the second differential pressure reading is amplified if the flow within the flow path is below the predetermined flow rate threshold. It is obvious for a person skilled in the art that comparing the flow within the flow path and the predetermined flow rate is conducted to determine whether the flow path is below the predetermined threshold or not.

“[A]mplified second differential pressure reading” at the bottom of the amended claim is also obvious from the description which discloses that the second differential pressure reading is amplified.

Therefore, the amendment appears to be just rephrasing of the description and shall not be deemed as addition of new matter.

[SIPO]

Acceptable

According to the description, if the flow within the flow path is below the predetermined flow rate threshold, the signal from the differential pressure sensor 80(that is the second differential pressure reading) is amplified. So the amendment does not go beyond the scope of the original disclosure.

## CHANGE OF SUBJECT MATTER

### Case 13

|                        | Before amendment   | After amendment   |
|------------------------|--|---|
| Title of the Invention | Lipidomic Biomarkers For Identification of High-risk Coronary Artery Disease Patients  |   |
| Description            | <p>Description disclose:</p> <p>[0011], The method comprises administering a therapeutically effective dose of a drug capable of modulating one or more of the lipid concentration(s), lipid-lipid ratio(s) or lipid-clinical concentration ratio(s).</p> <p>[0012], Also encompassed by the present invention is a kit for predicting CVD complications or for performing any of the methods or uses of the present invention, wherein the kit comprises a lipid standard chosen from the lipids in Tables 4, 7, 10 or 13, one or more control lipidomic markers, an antibody against one of the said lipids, and reagents for performing the method.</p> <p>No other information about produce a medicament.</p> |   |
| Claims                 | <p>1. A method for determining whether a subject is at risk to develop one or more CVD complications such as acute myocardial infarction (AMI) and/or CVD death, comprising:</p> <p>a. determining in a sample from said subject the concentration(s) of one or more lipid(s).....</p> <p>b. determining in a sample from said subject one or more lipid-lipid ratio(s).....</p> <p>.....</p>  | <p>1. <b><u>The use of the following reagents in a medicament or a kit</u></b> for determining whether a subject is at risk to develop one or more CVD complications such as acute myocardial infarction (AMI) and/or CVD death, comprising:.....</p> <p>a. <b><u>reagent A used for</u></b> determining in a sample from said subject the concentration(s) of one or more lipid(s).....</p> <p>b. <b><u>reagent B used for</u></b> determining in a sample from said subject one or more lipid-lipid ratio(s).....</p> |

|       |   |  |
|-------|---|--|
|       |   |  |
| Notes | The amendment was made after the examiner sent a notification of reasons for refusal that claim 1 belongs to a method for treating or preventing a disease. |  |

[JPO]

Unacceptable.

Since “reagent A” and “reagent B” are not stated in the original description, the amendment introduces new technical matter.

Note that an amendment from a “method” claim to a “kit” claim would be acceptable if that a step using reagent A and a step using reagent B are carried out as an integrated manner and is referred to in light of the whole statement of the original description.

[KIPO]

Unacceptable.

Since the original description doesn’t disclose “reagent in a medicament used for determining in a sample from a subject”, it shall be deemed to introduce a new matter.

[SIPO]

Not acceptable.

Referring to the amendment to the topic, because the initial description describes a kit predicting CVD complications, the amendment is allowable in order to overcome the defects noticed in the office action. Reagent A and reagent B are not stated in the original description and the amended subject matter includes solution of using A and B together except using each of them separately. The solution of medicament or kit concerning using A and B together cannot be derived directly and unambiguously for a person skilled in the art based on the original disclosure. Therefore, the amendment is unacceptable.

## ADDING INFORMATION RELATED TO PRIOR ART

### Case 14

|                        | Original   | Amended   |
|------------------------|--|---|
| Title of the Invention | Golf ball  |   |
| Description            | <p>JPxx-xxxxxxA discloses compositions for golf balls.</p> <p>The present invention provides a golf ball whose diameter and weight are the same as those of conventional golf balls and which is divided into three sections: a surface layer, a middle layer, and a core, wherein the surface layer is composed of rubber and filler, ...</p> | <p>JPxx-xxxxxxA discloses compositions for golf balls.</p> <p>The present invention provides a golf ball whose diameter and weight are the same as those of conventional golf balls and which is divided into three sections: a surface layer, a middle layer, and a core, wherein the surface layer is composed of rubber and filler, <b><u>or A-B block copolymers disclosed in the said patent document,</u></b> ...</p> |
| Claims                 | A golf ball ...  | A golf ball ...   |
| Notes                  | <p><i>JPxx-xxxxxxA discloses a golf ball, wherein its surface layer is composed of one of specific A-B block copolymers, tri-block copolymers, etc.</i></p>  |   |

[JPO]

Unacceptable.

The original description cites a document to explain the compositions for golf balls. The amendment including the statement that A-B block copolymers, one of the materials disclosed in the document, is used for the surface layer of the claimed invention is, however, unacceptable, since it is considered to add the information relating to the working of the invention to the originally attached description. (See GL Part IV, Chap. 2, 3.3.2 (1) b and HB Annex A, 7. Case 39.)

[KIPO]

Unacceptable

An amendment based on the matter described only in the prior art documents other than the original specification shall be deemed as addition of new matter when such added matter is not obvious for a person skilled in the art based on the specification or drawing(s) originally attached to the patent application. (Patent Examination Guideline, Part IV Section 2 1.2.)

[SIPO]

Unacceptable.

This amendment relates to the solution of the present invention. Though the prior art document is cited in the present application, a surface layer composed of A-B block copolymers is obviously not included in the solution of the original description. If the amended description could not be derived directly and unambiguously from the original disclosure, the amendment is not acceptable according to Art. 33.



## Case 15

|                                 | Before amendment  | After amendment   |
|---------------------------------|---|---|
| Description<br>(Background art) | “US 5571540A discloses multi-layer film produced by ether.....” | “US 5571540A and <b><u>EP 437521A</u></b> disclose multi-layer film produced by ether.....” |

[JPO]

Acceptable.

An amendment which adds the prior art document information to the description does not introduce any new technical matter. Therefore, such an amendment shall be permitted.

(See GL Part IV, Chap. 2, 3.3.2 (1) a. (i).)

[KIPO]

Acceptable

Adding information of prior art document such as title, publication number, etc. is not deemed as the addition of new matter.

However, an amendment based on the matter described only in the prior art documents other than the original specification shall be deemed as addition of new matter when such added matter is not obvious for a person skilled in the art based on the specification or drawing(s) originally attached to the patent application. (Patent Examination Guideline, Part IV Section 2 1.2.)

[SIPO]

Acceptable.

If EP 437521A belongs to the prior art, the amendment is allowed. In fact, such amendment has introduced the contents which are not contained in the initial claims and description. However, since the background art is amended other than the invention per se, and the contents added are prior art already known to the public before the filing date, so it is allowable. (Patent Examination Guideline, Part II, Chapter 8, Section 5.2.2.2)

## Case 16

|                                 | Before amendment | After amendment   |
|---------------------------------|------------------|---|
| Description<br>(Background art) | -                | <b><u>Related prior art document is KR 2011-0060738A. The document discloses a semiconductor device with buried gate. The device is provided to prevent the deterioration of a gate insulation layer due to fluorine by using metal organic source without fluorine as source gas when a tungsten containing nitride layer is deposited. The device comprises: A trench is formed by etching a semiconductor substrate. A gate insulation layer is formed on the surface of a trench. A tungsten containing nitride layer with nitrogen concentration gradient is formed on the gate insulation layer. A first tungsten layer is formed on the surface of the tungsten containing nitride layer by removing nitrogen. A second tungsten layer is formed on the first tungsten layer to fill the trench.</u></b> |

[JPO]

Acceptable.

An amendment which adds contents stated in prior art documents to

“Background Art” of the description does not introduce any new technical matter. Therefore, such an amendment shall be permitted.  
(See GL Part IV, Chap. 2, 3.3.2 (1) a. (ii).)

[KIPO]

Unacceptable

As mentioned in case 1, an amendment based on the matter described only in the prior art documents shall be deemed as addition of new matter. (Patent Examination Guideline, Part IV Section 2 1.2.)

[SIPO]

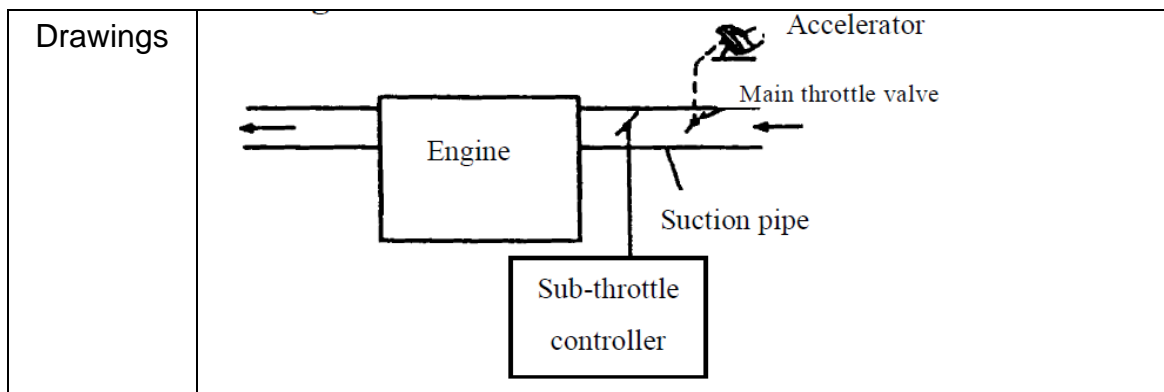
Acceptable.

Similar to case 1, if the examiner finds documents which are more related to the invention than the previous prior art cited by the applicant, the applicant shall be allowed to amend the description by adding the documents and citing them.

## ADDING EMBODIMENT OR TECHNICAL EFFECT

### Case 17

|                        | Original  | Amended   |
|------------------------|---|---|
| Title of the Invention | Output controller for an internal combustion engine   |   |
| Description            | <p>Regarding output controllers for engine by opening and closing of a sub-throttle valve arranged in series to the main throttle valve in the suction pipe, such sub-throttle valve is often firmly fixed and causes maloperation of the controller due to a long period of non-use.</p> <p>The present invention provides an output controller for internal combustion which periodically oscillates the sub-throttle valve at the timing when driving so that the opening and closing of the sub-throttle valve does not affect the operation of the engine and which prevents the sub-throttle valve from being firmly fixed.</p> | <p><u>...In addition, the present invention prevents the sub-throttle valve from maloperation due to icing in winter.</u></p> |



[JPO]

Unacceptable.

The condition of a sub-throttle valve which is firmly fixed due to a long period of non-use is different from that of a sub-throttle valve which is firmly fixed due to icing, and the timing for oscillating a sub-throttle valve to prevent it from being fixed is basically different between these two conditions, and a means for preventing a sub-throttle valve from being fixed due to a long period of non-use does not always prevent a sub-throttle valve from being fixed due to icing. Consequently, it is not clear that the original description mentions the effect that the controller prevents a sub-throttle valve from being fixed due to icing. (See GL Part IV, Chap. 2, 3.3.2 (2) a and HB Annex A, 7. Case 44.)

[KIPO]

Unacceptable

Adding technical meaning or effect which is not obvious from originally attached specification or drawing(s) is deemed as addition of new matter.

In this case, the technical effect of preventing the sub-throttle valve from mal-operation due to icing in winter seems not obvious from the original specification or drawing.

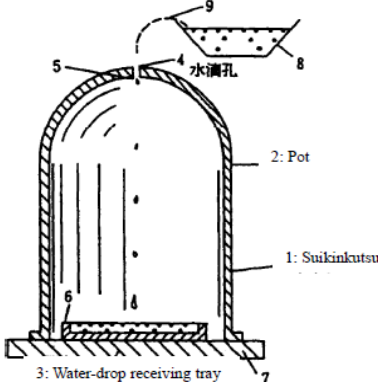
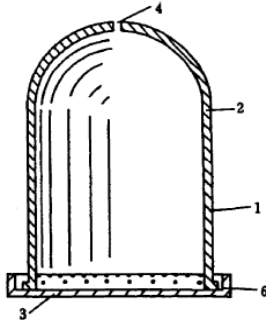
[SIPO]

Unacceptable

It is just indicated in the initial application that the technical problem to be solved by the invention is to solve “mal-operation of the controller due to a long period of non-use”. Although the amended technical problem “mal-operation due to icing in winter” falls into the scope of “mal-operation of the controller due to a long period of non-use”, a person skilled in the art is unable to draw a conclusion

that “mal-operation of the controller due to a long period of non-use” refers to “mal-operation due to icing in winter” from the initial application documents. Therefore, such amendment has introduced new contents and does not satisfy Art. 33.1.

## Case 18

|                        | Original   | Amended  |
|------------------------|--|--|
| Title of the Invention | Suikinkutsu (water harp cave)  |  |
| Description            | <p>... The external size of the receiving tray is smaller than the internal diameter of the bottom of the pot, and the receiving tray is arranged inside the pot.</p>  | <p>... <u>In addition, the size of the receiving tray may be larger than the bottom of the pot, and the suikinkutsu may also be created to position the pot in the receiving tray.</u></p> |
| Drawings               | <p>[Fig. 1] 4: Hole for dropping water</p>    | <p>[Fig. 1] (not amended)</p> <p><b>[Fig. 2]</b> (added)</p>   |
| Claims                 | <p>A suikinkutsu, or water harp cave, which includes an upside down hollow pot made of a hard material with a hole for dripping water at the top, and a water-drop receiving tray which is positioned at the bottom of the pot, whose upper side is opened and positioned below the hole, which is shaped so as to store the predetermined amount of water in the receiving tray, and which has a path for discharging overflowed water through which water dripped into the opening of the receiving tray overflows, wherein the dripping water falls from the hole to the surface of the receiving tray in the pot and the impact of the dripping water on the surface makes a</p> |  |

|  |  |
|--|--|
|  | resonance sound loud enough to reach the outside of the pot. |
|--|--|

[JPO]

Unacceptable.

The original description mentions the suikinkutsu in which the receiving tray is positioned inside the pot, and it is not considered that a person skilled in the art who reads the original description would clearly understand that the pot is positioned in the receiving tray. (See GL Part IV, Chap. 2, 3.3.2 (5) and HB Annex A, 7. Case 54.)

[KIPO]

Unacceptable

Adding an embodiment which is not obvious from originally attached specification or drawing(s) is deemed as addition of new matter.

In this case, added embodiment seems not obvious from the original specification or drawing.

[SIPO]

Unacceptable

The supplement of the drawing and the description of the drawing that are not mentioned in the initial application cannot be directly or unambiguously derived from the contents described in the initial application. Thus the amendment is not allowable.



## Case 19

|             | Before amendment  | After amendment  |
|-------------|---|--|
| Description | Ink for printing extracted from benzopyrene wherein the ink reacts to ultraviolet rays. | Ink for printing extracted from benzopyrene wherein the ink reacts to ultraviolet rays. <b><u>For printing with the ink having benzopyrene, during the process of dry with the heat after printing, the benzopyrene is the first content hardened and gathered a lot in the outer edge of printout. After finishing hardening of the ink, the outer edge becomes darker than middle part of the printout. So, through ultraviolet ray light, the printout shows fluorescence white along the outline of the printing pattern. To make it, add solution of 0.3wt% rhodamine B melted in 6wt% ethanol and 0.2wt% benzopyrene to 100wt% hollow particulate dispersion(20wt% solid content, 0.3 <math>\mu</math>m diameter of particle, glass transition temperature 30 °C) of styrene acrylic acid ester resin, and mix them.</u></b> |
| Notes       | 1. Benzopyrene had not been widely used for the ink in the technical field of printing. |  |

[JPO]

Unacceptable.

In general, an amendment which adds new effects of the invention introduces new technical matter. Therefore, such an amendment shall not be permitted. (See GL Part IV, Chap. 2, 3.3.2 (2) a.) Amendments that include technical effects and/or embodiments which are not obvious from the original description introduce new technical matter.

[KIPO]

Unacceptable

Adding technical meaning, effect or composition example of the ink with benzopyrene which has not been widely used for printing shall be deemed as addition of new matter. (Patent Court ruling 2006Heo3984)

[SIPO]

Unacceptable.

Since the amended description could not be derived directly and unambiguously from the original disclosure, the amendment is not acceptable according to Art. 33.

## Case 20

|             | Before amendment   | After amendment  |
|-------------|--|--|
| Description | A sensor for detecting snow is located between a tongue rail and a fixed rail. | A sensor for detecting snow is located between a tongue rail and a fixed rail. <u>The snow detecting sensor is a reactance-operating type. If snow exists between a pair of metal plates, capacitance of the capacitor changes due to the change of permittivity. The change of capacitance cause change of alternating current and the sensor detects it.</u> |

[JPO]

Unacceptable.

In general, an amendment which adds a specific example of the type of invention introduces new technical matter. Therefore, such an amendment shall not be permitted. (See GL Part IV, Chap. 2, 3.3.2 (5).)

The original description did not state any specific type of “sensor for detecting snow”. Therefore, any amendment that includes a specific type of sensor, as in this case, introduces new technical matter.

[KIPO]

Unacceptable.

Adding operational principles which are not obvious from originally attached specification, drawing(s) shall be deemed to be an addition of new matter.

[SIPO]

Unacceptable.

It is neither stated nor derived directly or unambiguously from the original disclosure that the sensor for detecting snow is a capacitance-type one. Because there are various types of sensors, such as photosensitive sensors, sound sensitive sensors, etc., snow could be detected by echo or reflected light

in the prior art, not necessarily capacitance-type sensor. Besides this, even though a capacitance-type sensor is used, it is neither stated nor derived directly or unambiguously from the original disclosure that the change of capacitance is detected by measuring the change of alternating current.

## AMENDMENT AFTER FINAL OFFICE ACTION

### Case 21

|        | Before amendment  | After amendment  |
|--------|---|--|
| Claims | "A mainframe supported by a spring ..."   | "A mainframe supported by an <b><u>elastic body</u></b> ..." |
| Notes  | <ol style="list-style-type: none"><li>1. The amendment was made after final office action.</li><li>2. "Elastic body" was stated only in the prior application which is basis of the priority of this application (subsequent application).</li><li>3. "Elastic body" was not stated or obvious in this application (subsequent application) when filed.</li></ol> |  |

[JPO]

Unacceptable.

When determining that an amendment made in response to "the final notice of reasons for refusal" does not satisfy any of the requirements of Article 17bis (3) to (6), an examiner shall dismiss the amendment. (See GL Part I, Chap.2, Sec. 6, 3.2.)

It needs to be determined whether a new matter has been added to the description, claims, or drawings by an amendment in response to "the final notice of reasons for refusal" (Article 17bis (3)). The claims, to which the amendment has been made for adding a new matter, shall be determined on a claim-by-claim basis. With regard to the claim to which the amendment has been made for adding a new matter, the examiner shall not determine whether the amendment falls under the cases prescribed in Article 17bis(4) to (6). (See GL Part I, Chap. 2, Sec. 6, 3.2 (1).)

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. (See GL Part IV, Chap. 2, 3.3.1(1).)

A priority certificate is not included in the description, etc. Therefore, the examiner cannot determine whether the amendment adds any new matter based on the priority certificate. (See GL Part IV, Chap. 2, 5. (2).) This amendment which changes "a spring" into "an elastic body" introduces a new technical matter, i.e., elastic bodies other than springs.

[KIPO]

Unacceptable.

A prior application which is the basis of the priority is not considered when assessing addition of new matter. The specification or drawing(s) originally attached to the patent application shall be the subject for comparison of whether new matter is added to the amended specification or drawing(s). In this context, the phrase “originally attached to the patent application” refers to the submission of the specification or drawing(s) along with the patent application by the filing date, not priority date, of the application. It is also applied in case of divisional or converted applications. (Patent Examination Guideline, Part IV Section 2 1.1.) Therefore, whether the elastic body is stated in the prior application doesn’t matter when considering the requirement for prohibition of addition of new matter.

An amendment in response to a final office action (final notice of grounds for rejection) shall be one of the followings: reduction of scope of claims, correction of clerical errors, clarification of ambiguous descriptions, or deletion of new matter. (Patent Examination Guideline, Part IV Section 2 2.1.)

The amendment doesn’t satisfy the requirement since it expands the scope of the claim.

If amended matter is not obvious based on the matter described in the originally attached specification or drawing(s), the amendment shall be deemed as addition of new matter. (Patent Examination Guideline, Part IV Section 2 1.2.)

The amendment in this case would be deemed as addition of new matter unless it is obvious for a person skilled in the art to adopt elastic bodies other than spring. With the given information, it seems that there is no reason to regard that the adoption of elastic bodies other than spring is obvious. Therefore, the amendment shall not be allowed.

[SIPO]

Unacceptable.

Due to the doctrine of hearing, which requires at least one chance must be provided to applicants when new facts and reasoning are submitted. So SIPO examiners cannot judge whether the office action is final or not because it depends on applicant’s reply and the amendment.

If the applicant wants to amend the application after final rejection he shall initiate the reexamination procedure. The amendment submitted with the request for reexamination should meet the requirements of Article 33 and Rule 61.1.

The priority document shall not be taken into account to judge whether the amendment is acceptable. The basis for comparison is original application.

According to Art.33, “elastic bodies” is not stated in the original specification and can not be derived directly and unambiguously, so the amendment is not acceptable.

[Meeting Discussion]

KIPO notifies final office actions when all the reasons for refusal have been brought by amendments made in response to office actions. In notifying its final office actions, KIPO informs applicants that the office action is final. But even after sending the final office action, it is possible that KIPO may send a non-final office action again, if examiners find any reason for refusal that has not been brought by an amendment made in response to an office action. JPO also explicitly indicates that the office action is final.

## Case 22

|        | Before amendment   | After amendment   |
|--------|--|---|
| Claims | <p>Claim 1 : Device comprising A, B</p> <p>Claim 2 : The device of claim 1 further comprising C</p> <p>Claim 3 : The device of claim 1 or claim 2, further comprising D, E</p>   | <p>22-1.<br/>Claim 1 : <b><u>(Deleted)</u></b></p> <p>22-2.<br/>Claim 2 : Device comprising <b><u>A</u></b>, <b><u>B</u></b>, C</p> <p>22-3.<br/>Claim 3 : Device comprising <b><u>A</u></b>, <b><u>B</u></b>, D, E</p> <p>22-4.<br/>Claim 4 : <b><u>Device comprising A, B, C, D, E</u></b></p> <p>22-5.<br/>Claim 5 : <b><u>Device comprising A</u></b></p> |
| Notes  | <p>1. The amendment was made after final office action (final notification of reason for refusal).</p> <p>2. The reason for refusal in the final action was lack of clarity of claim 3. The examiner didn't raise any reason for novelty or inventive steps.</p> <p>3. Components A, B, C, D, E and the all the combinations of them were described in the originally attached description.</p> <p><b>4. The applicant submitted a written argument stating that the purpose of the amendment is deleting claim 1 and rearranging claims due to deletion of claim 1.</b></p> |   |

[JPO]

Cases 22-1 – 22-4: acceptable / Case 22-5: unacceptable.

When determining that an amendment made in response to "the final notice of reasons for refusal" does not satisfy any of the requirements of Article 17bis(3) to (6), an examiner shall dismiss the amendment. (See GL Part I, Chap.2, Sec. 6, 3.2.)

Based on the inventions described in other claims which no new matter has been added and which are not a basis for determining "amendments that change a special technical feature of the invention", whether the amendment has been



made for any of the purposes prescribed in Article 17bis(5)(i) to (iv), shall be determined. (See GL Part I, Chap. 2, Sec. 6, 3.2 (3).)

When amendments of the claims are made within the period specified in the final notice of reasons for refusal, the purposes are limited to (a) Deletion of a claim (item (i)), (b) Restriction in a limited way of the claims (item (ii)), (c) Correction of errors (item (iii)), or (d) Clarification of an ambiguous statement (item (iv)). (See GL Part IV, Chap. 4, 1.1.)

The examiner shall determine whether the amendment at issue is intended to delete a claim, as prescribed in Article 17bis(5)(i) if it falls under either (i) or (ii) below.

(i) Amendment that deletes claims

(ii) Formal amendment to any other claim as an inevitable result of making an amendment to delete a claim

The following (ii-1) or (ii-2) is a specific example of amendment type (ii) above.

(ii-1) Amendment that changes a citation number in other claims which cites the deleted claim

(ii-2) Amendment that changes a dependent claim into an independent one

(See GL Part IV, Chap. 4, 3.)

The amendment of Claim 1 deletes the claim.

The amendments of Claims 2-4 are formal amendments of the claims as inevitable results of the amendment for Claim 1.

The amendment of Claim 5 is not made for any of the purposes (a)-(d).

[KIPO]

Case 22-1, 22-2, 22-3, 22-4: acceptable

Case 22-5: Unacceptable

An amendment in response to a final office action (final notice of grounds for rejection) shall be one of the followings: reduction of the scope of claims, correction of clerical errors, clarification of ambiguous descriptions, or deletion of new matter. (Patent Examination Guideline, Part IV Section 2 2.1.)

Case 22-1, deletion of claim, falls within the scope of reduction of the scope of claim.

Cases 22-2, 22-3 and 22-4 cover rearranging claims due to deletion of an independent claim.

Generally, addition of new claim is not allowed after final office action. However,

even in the case of the new establishment of a claim, if it is inevitable for rearranging claims and such a reason is clearly expressed in a written argument, it shall be allowed. (Patent Examination Guideline, Part IV Section 2 2.2.)

Case 22-5 established a new claim, but it doesn't belong to the exceptional case mentioned above. Furthermore, it expanded the scope of claim compared to the claims before amendment. Therefore, the amendment in case 22-5 shall not be allowed.

[SIPO]

Claims 22-1 – 22-4: acceptable

Claim 22-5: unacceptable

As mentioned in case 8, The amendment replying the office action in the substantial procedure should satisfy the Rule 51.3, which requests the amendment shall be made in answer to the defects as indicated in the office action. (Guideline, Part II Chapter 8, Section 5.2.1.3).

Claim 22-1: Deletion of claim meets the requirement of Article 33 and it does not introduce new matter. Thus it shall be allowed.

Claims 22-2 – 22-4: They are all stated and can be found in the original claims. Thus they shall be allowed.

Claim 22-5: It deletes B and then expands the protection scope of claim 1. The amendment doesn't satisfy the requirement of Article 33. Thus it is unacceptable.

### Case 23

|                        | Before amendment  | After amendment   |
|------------------------|---|---|
| Title of the Invention | <i>Not necessary for the case study</i>   |   |
| Description            | <i>Not necessary for the case study</i>   |   |
| Drawings               | <i>Not necessary for the case study</i>   |   |
| Claims                 | <p>Claim 1 : Device comprising A+B</p> <p>Claim 2 : Device comprising A+B+C</p> <p>Claim 3 : Device comprising A+B+C+D</p> <p>[First amendment]</p> <p>Claim 1 : Device comprising A+B+E</p> <p>Claim 2 : Device comprising A+B+C+E</p> <p>Claim 3 : Device comprising A+B+C+D</p>  | <p>[Second amendment]</p> <p>23-1.</p> <p>Claim 1 : Device comprising A+<u>b</u></p> <p>23-2.</p> <p>Claim 2 : Device comprising A+B+C+<u>F</u></p> <p>23-3.</p> <p>Claim 3 : Device comprising A</p> |
| Notes                  | <ol style="list-style-type: none"> <li>1. All the claims before the first amendment involve inventive steps.</li> <li>2. First amendment was made after a non-final office action.</li> <li>3. Component E is a new matter</li> <li>4. Second amendment was made after a final office action.</li> <li>5. The reason for refusal in the final action was that the first amendment introduced new matters to claim 1 and 2.</li> <li>6. b is a subordinate concept of B.</li> <li>7. F is not a new matter.</li> </ol> |   |

[JPO]

Unacceptable.

The examiner shall determine whether the amendment at issue is intended for restriction in a limited way as prescribed in Article 17bis(5)(ii) if it meets all of the requirements (i) to (iii) below.

- (i) The amendment is intended to restrict the claims.
- (ii) The amendment is intended to limit matters specifying the invention described in the claims, as they stand before the amendment (“pre-amendment” invention).
- (iii) The pre-amendment invention and the invention as amended are identical to each other in terms of the field of industrial application and the problems to be solved.

(See GL Part IV, Chap. 4, 2.1.)

An amendment that deletes part of the matters specifying the invention laid out in series is one of the examples of amendments that are made without any intentions to the claims. (See GL Part IV, Chap. 4, 2.1.1 (1) (i).)

“Second amendment” deletes “E”, the matter specifying the pre-amendment invention. Therefore, such an amendment is not an amendment intended to restrict the claim.

Note: unlike amendments that add a new matter, amendments in breach of the provision of Article 17bis(5) do not entail substantive deficiencies pertaining to the contents of the invention, and thus do not constitute any grounds for invalidation. Therefore, in applying the provision thereof, the examiner shall ensure that the provision will not be applied more strictly than necessary if the inventions at issue are found to be subject to protection and the examiner believes that the examination already performed can be used effectively to complete the examination process promptly. (See GL Part IV, Chap. 4, 1.1.)

[KIPO]

Case 23-1, 23-2: acceptable

Case 23-3: unacceptable

In case new matter was added on a particular stage of an amendment, an amendment of reverting to the claim before addition of new matter shall be accepted. If such case were not accepted, an amendment of deleting new matter in order to address a ground for rejection would be declined. Then, the applicant has no way to overcome the ground for rejection and it would lead to a decision of rejection, which is too harsh for the applicant.

Amendment according to Patent Act Article 47(3)( i ) to ( iii ), i.e. deletion of claims, reduction of scope, correcting, clarifying, while reverting to the content of a claim before addition of new matter shall be also accepted. An examiner shall

assess the legitimacy of an amendment by comparing the amended claims with the claims before addition of new matter. (Patent Examination Guideline, Part IV Section 2 2.5.)

The amendments in case 23-1 reduces the scope of claims (changing a generic concept B to a subordinate concept b) while reverting to the claim before the addition of new matter (reverting to A+B by deletion of new matter E).

The amendments in case 23-2 reduces the scope of claims (adding F) while reverting to the claim before the addition of new matter (reverting to A+B+C by deletion of new matter E).

Therefore, they are legitimate amendments.

The amendment in case 23-3 shall not be allowed since it expands the scope of claim (A+B+C+D →A).

[SIPO]

Amendment to claim 1 and 2 are acceptable

Amendment to claim 3 is not acceptable

Amendments to claim 1 and 2 are made in answer to the defects indicated in the first OA, which introduce new matter E, both b and F are not new matter, they can be found in the original disclosure, then the amendments are complied with Rule 51.3, are acceptable.

Amendment to claim 3 extremely expands the scope of the previous claim 3, it is not complied with Rule 51.3, are unacceptable.

## CORRECTION OF OBVIOUS MISTAKE

### Case 24

|                        | Original   | Amended                                  |
|------------------------|--|--|
| Title of the Invention | Device for reading figures in using an abacus  |  |
| Description            | <p>The lower-angles <math>\alpha</math>, <math>\beta</math> are respectively about 45 degrees and <u>about 130 degrees</u>, which makes an angle of an ejected beam about 40 degrees (<math>\gamma</math>), thereby providing the optimal condition for users to see the abacus.</p>   | <p>... <u>about 110 degrees</u>, ...</p> |
| Drawings               |  |  |
| Claims                 | <p>A device for reading figures in using an abacus, which includes: a cross-sectional prism (1) whose lower-angles <math>\alpha</math>, <math>\beta</math> are respectively about 45 degrees and <u>about 130 degrees</u>, and which is stored in a casing frame (5) with thin view holes (2)-(4) respectively positioned at all of the front, upper rear surface and bottom; the casing front (5) whose lower front is formed in a vertical</p> | <p>... <u>about 110 degrees</u>, ...</p> |

|  |   |  |
|--|---|--|
|  | shape (6); and a pair of L-shaped rods (7) protruding from the front. |  |
|--|---|--|

[JPO]

Acceptable.

The original description mentions that angle  $\beta$  is about 130 degrees, but angle  $\beta$  should be about 110 degrees to make the angle of the ejected beam about 40 degrees ( $\gamma$ ) in respect to a paper surface based on the calculation and considering the ejected beam in the drawing. In addition, when angle  $\beta$  is about 130 degrees, the angle of the ejected beam would be about 80 degrees, which would make it difficult for users using an abacus to read the figures. Consequently, the original description clearly states that the expression “the angle  $\beta$  (is) about 130 degrees” is a misdescription and that the angle  $\beta$  should be “about 110 degrees.” (See GL Part IV, Chap. 2, 3.3.2 (3) and HB Annex A, 7. Case 47.)

[KIPO]

Seems to be acceptable

It is obvious that one or some of the angles  $\alpha$ ,  $\beta$ ,  $\gamma$  is (are) misdescription(s) considering basic physical law of reflection. It seems that prohibiting amendment to the error is too harsh for applicants. It seems that it is appropriate to allow the amendment,

[SIPO]

Unacceptable.

If the ejected beam from the hole 4 is vertical to the bottom, it can be judged that one or more of the numerical value of angles  $\alpha$ ,  $\beta$  or  $\gamma$  is not correct based on law of reflection. But it seems difficult to identify which angle is not correct since the present information is not enough to determine the wrong angle. The amendment which  $\beta$  is 110 degrees cannot be directly or unambiguously derived from the original disclosure. Thus the amendment is not allowable.

[Meeting Discussion]

It is clear that one of the values of  $\alpha$ ,  $\beta$ , and  $\gamma$  is wrong. JPO considered that amending the value of  $\beta$  to 110 degrees is most appropriate when taking into consideration the common general knowledge as well as the problem to be

solved by the claimed invention. Therefore, such an amendment would be allowed. However, SIPO still believe it is hard to decide which angle is wrong based on the same invention facts.

KIPO would like to indicate that there might be different views among examiners.



## AMENDMENT BASED ON DRAWINGS

### Case 25

|                        | Original  | Amended   |
|------------------------|---|---|
| Title of the Invention | Beverage container serving plate  |   |
| Description            | <p>The side portion (3) is perimetrically arranged around the outer side of the storage (S) via the hollow portion (4). For example, when the serving plate (1) is placed on the surface of bedclothes, the serving plate (1) prevents beverage containers from tumbling since the anti-slip device (5) prevents the serving plate (1) from moving and the edge (6) on the back of the side portion (3) is caught on the surface of the bedclothes.</p> |   |
| Drawings               |   |   |
| Claims                 | <p>A beverage container serving plate comprising:</p> <ul style="list-style-type: none"> <li>a storage that contains a beverage container;</li> <li>an anti-slip device attached to the bottom of the storage;</li> <li>a side portion perimetrically arranged around the outer side of the storage via the hollow portion; and</li> <li>an edge located on the back of the side portion.</li> </ul>  | <p>A beverage container serving plate comprising:</p> <ul style="list-style-type: none"> <li>a storage that contains a beverage container;</li> <li>an anti-slip device attached to the bottom of the storage;</li> <li>a side portion perimetrically arranged around the outer side of the storage via the hollow portion; and</li> <li>an edge located on the back of the side portion,</li> </ul> <p><b><u>wherein the positional level of the lower end of the side portion is nearly the same as that of the bottom of the</u></b></p> |

|  |  |                 |
|--|--|-----------------|
|  |  | <u>storage.</u> |
|--|--|-----------------|

[JPO]

Acceptable.

The drawing shows the positional relationship between the lower end of the side portion (3) and the bottom of the storage (S) portion, while the original description describes that the edge (6) on the back of the side portion (3) is caught on the surface of the bedclothes when the serving plate (1) is placed on the surface of the bedclothes, which clearly tell that the positional level of the lower end of the side portion (3) is nearly the same as that of the bottom of the storage (S) portion and, as a result, that the serving plate (1) prevents beverage containers from tumbling. Thus, it is obvious to a person skilled in the art who reads the originally attached description, etc. that the serving plate (1) stabilizes beverage containers in the storage (S) portion. Consequently, the amendment is within the scope of the matters stated in the original description, etc. (See HB Annex A, 7. Case 56.)

[KIPO]

Acceptable

As mentioned in case 2, even if added matter is not explicitly described, but if it is obvious for a person skilled in the art and he can regard it as the matter is stated in the originally attached specification or drawing(s), such elements shall not be new matter. (Patent Examination Guideline, Part IV Section 2 1.1.)

In this case, the drawing clearly shows that the positional level of the lower end of the side portion is almost the same as that of the bottom of the storage.

Therefore, it is not deemed as addition of new matter.

Apart from amendment requirement, if the applicant amended only claim but not description, it may not meet the support requirement. The applicant should amend the description accordingly.

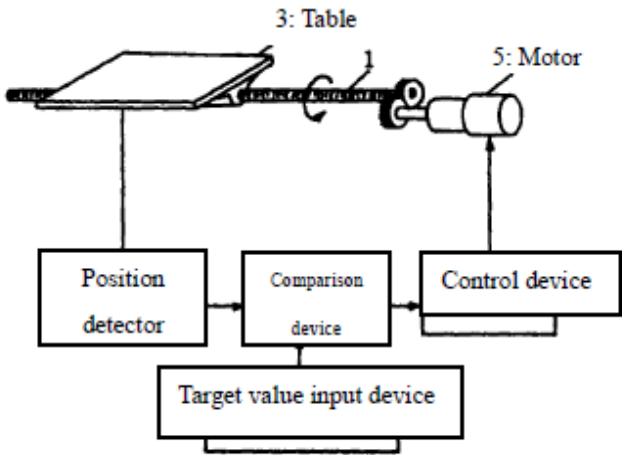
[SIPO]

Acceptable.

Description discloses that the edge (6) on the back of the side portion (3) is caught on the surface of the bedclothes when the serving plate (1) is placed on the surface of the bedclothes, from this and the drawings, It can be directly and

unambiguously derived that the positional level of the lower end of the side portion is nearly the same as that of the bottom of the storage. Thus the amendment is allowable.

## Case 26

|                        | Original   | Amended  |
|------------------------|--|--|
| Title of the Invention | Table position control device  |  |
| Description            | ... 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               |   |  |
| Claims                 | <p>A table position control device comprising:</p> <ul style="list-style-type: none"> <li>a table;</li> <li>a motor connected to the table through <u>a feed mechanism</u>; and</li> <li>a control device which controls the rotation of the motor and the position of the table.</li> </ul> | <p>A table position control device comprising:</p> <ul style="list-style-type: none"> <li>a table;</li> <li>a motor connected to the table through <u>a screw feed mechanism which moves the table linearly by the rotation of a screw</u>; and</li> <li>a control device which controls the rotation of the motor and the position of the table.</li> </ul> |

[JPO]

Acceptable.

According to the phrase "a feed mechanism" in the original description and the 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.  
(See HB Annex A, 7. 59.)

[KIPO]

Acceptable

As mentioned in case 4, if added matter is obvious for a person skilled in the art from the originally attached drawing, it is not deemed as addition of new matter. In this case, added matter (a screw feed mechanism which moves the table linearly by the rotation of a screw) seems to be obvious from the original drawing.

[SIPO]

Not Acceptable.

It can only be directly and unambiguously derived from the drawings that the feed mechanism is a screw feed mechanism, but it cannot be derived that the feed mechanism moves the table linearly. Besides moving linearly, the table may also rotate. Thus the amendment goes beyond the scope of original disclosure and it is not allowable.

But if it can be derived that there is no table rotation from the original disclosure, the amendment can be determined directly and unambiguously and thus is allowable.

[Meeting Discussion]

SIPO holds whether the amendment is acceptable depends on the interpretation of linear movement, if it includes rotation then the amendment is acceptable. SIPO and KIPO both believe that the use of the table have impact on the judgment, since it may provide more information for examiners to judge how the table moves forward.

JPO believed that the phrase “a screw feed mechanism” defined a technical feature in which an object attached with the screw would move in the direction of the rod of the screw, either forward or backward by rotating the screw. Therefore, the meaning of “moves ... linearly” in the amended claim is clear.

## DISCLAIMER

### Case 27

|                        | Original  | Amended  |
|------------------------|---|--|
| Title of the Invention | Photosensitive plate for planography  |  |
| Description            | The present invention provides nitrogen-containing heterocyclic carboxylic acid which includes certain substances, such as picolinic acid and isonicotinic acid.  |  |
| Claims                 | A photosensitive plate for planography which has a photosensitive layer, on a hydrophilically treated aluminum plate, composed of partially saponificated polyvinyl acetate having saponification degrees of 60-80 mol % and a photopolymerized monomer having at least one ethylenic unsaturated bond, wherein the photosensitive layer contains 1-100% by mass of a nitrogen-containing heterocyclic carboxylic acid for the partially saponificated polyvinyl acetate. | A photosensitive plate for planography which has a photosensitive layer, on a hydrophilically treated aluminum plate, composed of partially saponificated polyvinyl acetate having saponification degrees of 60-80 mol % and a photopolymerized monomer having at least one ethylenic unsaturated bond, wherein the photosensitive layer contains 1-100% by mass of a nitrogen-containing heterocyclic carboxylic acid <b><u>(excluding nicotinic acid)</u></b> for the partially saponificated polyvinyl acetate. |
| Notes                  | <i>*A prior art describing the “nicotinic acid” as “nitrogen-containing heterocyclic carboxylic acid” was found.</i>  |  |

[JPO]

Acceptable.

The amended claim mentions “nitrogen-containing heterocyclic carboxylic acid (excluding nicotinic acid),” a partial change from the original claim, which explicitly excludes only the art disclosed as a prior art. Consequently, this example is included whenever claims should be amended within the scope of

the matters stated in the original attached description. (See GL Part IV, Chap. 2, 3.3.1 (4) (i) and HB Annex A, 7. Case 32.)

[KIPO]

Acceptable

An amendment to a so-called 'disclaimer claim' is mostly not deemed as addition of new matter. For example, where it is not specified whether the claimed invention involves medical methods for humans or for animals, the amendment of deleting the parts related to humans shall not be deemed as addition of new matter. (Patent Examination Guideline, Part IV Section 2 1.2.)

[SIPO]

Unacceptable

The amendment is regarded as an "undisclosed" disclaimer, which is one that is not supported by the description as filed. This kind of amendment can only be accepted when the specific technical solution is deleted to overcome novelty from the conflicting application or the occasional previous disclosure (that is to say, the technical field and technical problem to be solved of the previous disclosure is totally different from the present invention), or it should be proved that the excluded technical solution can not be put into practice. In this case, it seems that nicotinic acid is excluded from the claim to overcome the deficiency of novelty, however, if the technical solution relating to nicotinic acid can be used to assess the inventive step of the amended claim, it can not be accepted in the sense of Art. 33.

## Case 28

|        | Before amendment   | After amendment  |
|--------|--|--|
| Claims | “Surgical method for mammal wherein ...”   | “Surgical method for mammal <b><u>except human</u></b> wherein...” |
| Notes  | 1. There was no statement in the originally attached description and claims that human was excluded from the subject matter. |  |

[JPO]

Acceptable.

Whenever the claimed invention includes the term “human being” and does not fulfill the requirement of industrial applicability (main paragraph of Article 29(1)), an amendment to provide a “disclaimer” to exclude “human beings” from the subject of the invention, in order to eliminate the reason for refusal, does not change the technical matter introduced from the original description at all. It is evident that such an amendment does not introduce any new technical matter. (See GL Part IV, Chap. 2, 3.3.1 (4) (ii).)

[KIPO]

Acceptable.

An amendment to a so-called ‘disclaimer claim’ is mostly not deemed as addition of new matter. For example, where it is not specified whether the claimed invention involves medical methods for humans or for animals, the amendment of deleting the parts related to humans shall not be deemed as addition of new matter. (Patent Examination Guideline, Part IV Section 2 1.2.)

[SIPO]

Acceptable.

The amendment is made to overcome the deficiency of treatment method, it excludes the unpatentable subject matter “human being”, and this kind of amendment which excludes the unpatentable subject matter should be acceptable, otherwise it is unfair for the applicant.



## Case 29

|        | Before amendment   | After amendment   |
|--------|--|---|
| Claims | 1. A compound of general formula (I), ...  | 1. A compound of general formula (I),... <b><u>the compound of general formula (I) is not compound A.</u></b> |
| Notes  | <p>Both application 1 and application 2 relate to the same general formula (I). A concrete compound A is disclosed in application 1 but not in application 2. A conflicting application which disclosed concrete compound A was found during examination. Both application 1 and application 2 amend by adding the above disclaimer.</p> <p><i>A conflicting application refers to an application whose filing date is earlier than and publication date later than the filing date of the present applications.</i></p> |   |

[JPO]

Acceptable.

Whenever the claimed invention overlaps with the prior art and is thus likely to lack novelty, etc. (Article 29(1)(iii), 29bis and/or 39), making an amendment to exclude only the overlapping scope, while leaving the expression of the statement of matters stated in claims before the amendment was made, does not introduce new technical matter.

(See GL Part IV, Chap. 2, 3.3.1 (4) (i).)

[KIPO]

Acceptable

An amendment to a so-called ‘disclaimer claim’ is mostly not deemed as addition of new matter. (Patent Examination Guideline, Part IV Section 2 1.2.)

It is same in the case that the excluded matter is disclosed in a conflicting application.

[SIPO]

Acceptable.

For application 1, the excluded compound is explicitly disclosed in the application files and this “disclaimer” is only a deletion of one option from the original general formula. No new information is introduced and thus is acceptable according to Art. 33.

For application 2, it is an exception which is allowed according to GL Part II, Chapter 8, 5.2.3.3(3), pages 296-297.

### Case 30

|        | Before amendment  | After amendment   |
|--------|---|---|
| Claims | 1. A composition comprising A, B and C.   | Amendment 1: A composition comprising A, B and C, <b><u>and the composition is not the one comprising A, B, C and D.</u></b><br>Amendment 2: A composition comprising A, B and C, <b><u>and the composition does not contain D</u></b> ". |
| Notes  | A conflicting application has disclosed a composition comprising A, B, C and D, and has also disclosed in its example 1 a composition comprising 25%(wt.) A, 25%(wt.) B, 25%(wt.) C and 25%(wt.) D, and its example 2 a composition comprising 30%(wt.) A, 30%(wt.) B, 10%(wt.) C and 30%(wt.) D.<br><i>A conflicting application refers to an application whose filing date is earlier than and publication date later than the filing date of the present applications.</i> |   |

[JPO]

Acceptable.

Whenever the claimed invention overlaps with the prior art and is thus likely to lack novelty, etc. (Article 29(1)(iii), 29bis and/or 39), making an amendment to exclude only the overlapping scope, while leaving the expression of the statement of matters stated in claims before the amendment was made, does not introduce new technical matter.

(See GL Part IV, Chap. 2, 3.3.1 (4) (i).)

[KIPO]

Acceptable.

As mentioned in SIPO case 12, an amendment to a so-called 'disclaimer claim' is mostly not deemed as addition of new matter. (Patent Examination Guideline, Part IV Section 2 1.2.)

It is same in the case that the excluded matter is disclosed in a conflicting application.

[SIPO]

Acceptable

The basic rule for amendment is Art.33, “not go beyond the scope of original disclosure”, however, there are several exceptions which are allowed. According to Guideline Part 2, chapter 8, section 5.2.3.3(3), exceptions are: the applicant can prove, in accordance with the contents described in the application as filed, that the invention cannot be carried out when said feature adopts the “disclaimed” numerical value, or the invention is novel and involves an inventive step when “disclaimed” numerical value are excluded. Amendment 1 and 2 both belong to the above exceptions, so they are accepted.

[Meeting Discussion]

JPO, KIPO and SIPO define “disclaimer” as the “excluding of some elements that have been claimed.

In SIPO, according to requirements for making amendments, disclaimers are not allowed in principle. However, to be fair to applicants, there are three exceptions as follows, which you can find in detail in Guideline, Part II, Chapter 8, section 5.2.3(3). Disclaimers are acceptable when:

1. some of the values claimed are disclosed in a conflicting application and those values are excluded through filing an amendment to make the claimed invention novel over the conflicting application, and as a result, the amended invention must be novel;
2. some of the claimed elements are excluded by making an amendment, rendering the amended invention inventive; or
3. some of the parts in the claimed invention cannot be put into practice, and those parts are excluded by making an amendment, and as a result, the amended invention is rendered practical.

Note that, since neither conflicting applications nor occasional previous disclosures can be used to assess the inventive step of the present invention, in case 1 above, the invention after the amendment by the allowable disclaimer is novel and inventive.

## GENERIC AND SUBORDINATE CONCEPT

### Case 31

|             | Before amendment   | After amendment  |
|-------------|--|--|
| Description | One of the prior art documents uses alkali metal monoalkyl carbonate in the preparation of compound A, the cost of which is high. The present invention aims to provide a cost-efficient method for preparing compound A with high yield and purity.   |  |
| Claims      | <p>1. A method for preparing compound A, which comprises the following steps:<br/>           (1).....alkali metal carbonate or alkali earth metal <b><u>carbonate</u></b> and inert organic solvent are added to the reactor..... ;<br/>           (2).....。</p> <p>2. The method according to claim 1, the alkali metal carbonate or alkali earth metal <b><u>carbonate</u></b> in step (1) is sodium carbonate or potassium carbonate.</p> | <p>1. A method for preparing compound A, which comprises the following steps:<br/>           (1).....alkali metal carbonate or alkali earth metal <b><u>carbonate salt</u></b> and inert organic solvent are added to the reactor..... ;<br/>           (2).....。</p> <p>2. The method according to claim 1, the alkali metal carbonate or alkali earth metal <b><u>carbonate salt</u></b> in step (1) is sodium carbonate or potassium carbonate.</p> |
| Notes       | Carbonate can be a salt or an ester of carbonic acid.  |  |

[JPO]

Acceptable.

The expressions “alkali earth metal carbonate” and “alkali earth metal carbonate salt” have the same meaning. Therefore, the amendment which changes “alkali earth metal carbonate” into “alkali earth metal carbonate salt” does not introduce any new technical matter.

[KIPO]

Acceptable.

It seems to be obvious for a person skilled in the art that carbonate can be in a form of salt as described in the notes.

Therefore, the amendment doesn't seem to be addition of new matter.

[SIPO]

Acceptable.

Although carbonate includes carbonate ester or carbonate salt, "alkali earth metal carbonate" means the salt of alkali earth metal and carbonic acid to the person skilled in the art. Moreover, it is stated in the description that the present invention aims to solve the technical problem of the prior art which alkali metal monoalkyl carbonate is used. And in view of the fact that the present invention specifically uses sodium carbonate or potassium carbonate instead of alkali metal monoalkyl carbonate in prior art, therefore it is derived from these information that the present invention avoids using carbonate ester and replace it with carbonate salt. Therefore, this amendment is acceptable.

### Case 32

|             | Before amendment   | After amendment  |
|-------------|--|--|
| Description | In the description, the definition for lower alkyl is “examples of lower alkyl are methyl, ethyl, n-propyl and n-butyl”.                               |  |
| Claims      | A compound of general formula (1), wherein R1 is <b>lower alkyl</b> ,...   | A compound of general formula (1), wherein R1 is <b><u>C1-4 alkyl</u></b> ,... |
| Notes       | After the Office Action raised the objection that lower alkyl is unclear, the applicants amended the definition for R1 from lower alkyl to C1-4 alkyl. |  |

[JPO]

Acceptable.

In response to an office action (i.e., to a notice of reasons for refusal) that raised an objection that the word “lower” was unclear (i.e., the number of Cs is unclear), an amendment was made that clarifies the number of Cs in the range of 1-4, which is originally stated in the description, and which does not introduce new technical matter.

[KIPO]

Acceptable

“Lower alkyl” doesn’t have a strict definition, but generally refers to C1-4 or C1-6 alkyl. Therefore, it is understood that the amendment corrects an ambiguous expression to a clear expression. It may be also understood that the amendment limits the scope of the claim by change a generic concept (lower alkyl including C1-6) to a subordinate concept (C1-4 alkyl). In both the point of view, it shall not be deemed as addition of new matter since C1-4 alkyl is within the generally known scope of lower alkyl.

It is also allowable when the amendment is made after a non-final office action or final office action since it is a clarification of ambiguous description and/or reduction of scope of claim.

Please note that an amendment in response to a final office action(notice of grounds for rejection) shall be one of the followings: reduction of scope of claims, correction of clerical errors, clarification of ambiguous descriptions, or deletion of new matter. (Patent Examination Guideline, Part IV Section 2 2.1.)

The only restriction for an amendment in response to a non-final action is prohibition of addition of new matter, which is same as that for a voluntary amendment. (Patent Examination Guideline, Part IV Section 2 1.)

[SIPO]

Acceptable.

Theoretically, C4 alkyl includes primary, secondary and tertiary butyl, and from n-butyl we could not derive C4 alkyl directly and unambiguously. However, the original expression “lower alkyl” concerns primarily the carbon number of alkyl but not the structure of a certain alkyl. Therefore, from the specific examples and what the original expression mainly concerns ,we could derive the C1-4 alkyl. This amendment is acceptable.



### Case 33

|             | Before amendment   | After amendment   |
|-------------|--|---|
| Description | In the description, heterocycle is defined as being saturated, unsaturated or aromatic, containing 5-7 member atoms, at most 4 of which is hetero atoms such as nitrogen, oxygen and sulphur. Examples of heterocycles comprise imidazolyl, pyridyl, pyrimidyl...; R1 is preferably hydrogen, acyl, and optionally substituted alkyl or cyano. |   |
| Claims      | 1. A compound of generic formula I, in which: A2 is <b>heterocycle or carbocycle</b> , each of which is optionally substituted; R2 is Rb, cyano, nitro, halogen...; Rb is hydrogen, alkyl, chain alkylene, alkyne, carbocycle or heterocycle, each of which is optionally substituted...   | 1. A compound of generic formula I, in which: A2 is <b><u>imidazolyl, pyridyl, pyrimidyl or benzo[b]thienyl</u></b> , each of which is optionally substituted; R2 is Rb, cyano, nitro, halogen...; Rb is hydrogen, alkyl, chain alkylene, alkyne, carbocycle or heterocycle, each of which is optionally substituted... |
| Notes       | Compounds in which A2 is benzo[b]thienyl are disclosed in the exemplary compounds, but such an option is not disclosed in the definition for A2 in the generic formula.  |   |

[JPO]

Acceptable.

If, taking into consideration the embodiment of A2 being benzo[b]thienyl and the general formula stated in the description, it is obvious that whenever A2 is benzo[b]thienyl, it could be included in the general formula. As a result, the amendment does not introduce new technical matter.

[KIPO]

Acceptable.

The original description discloses that imidazolyl, pyridyl, pyrimidyl are examples of heterocycles and the exemplary compounds where A2 is benzo[b]thienyl. Although benzo[b]thienyl is not disclosed in the definition for A2 in the generic

formula, it is obvious for a person skilled in the art that benzo[b]thienyl could be included in the generic formula. Therefore, it shall not be deemed as addition of new matter.

[SIPO]

Unacceptable.

In the definition of heterocycle “benzo[b]thienyl” is not explicitly disclosed. In the exemplary compounds wherein A2 is benzo[b]thienyl, the corresponding R2 and Rb are necessarily specific groups within the options defined in claim 1. However, a person skilled in the art could not determine whether “benzo[b]thienyl” could be extrapolated and apply to all the other compounds in the general formula.

Therefore, this amendment is unacceptable according to Article 33 of CPL.

[Meeting Discussion]

In JPO, when an amended claim describes an intermediately generalized invention, i.e., an invention the scope of which is more limited than the originally claimed invention but more generalized than the embodiment originally stated in the description, if the amended claim falls within the original disclosure and no new technical matter is added, such an amendment is acceptable (see GL Part IV, Chap. 2, 3.3.1 (2)). SIPO holds that technical fields are closely connected with determining whether amendments are acceptable. In organic chemistry and medicinal chemistry, the requirements for amendments are generally higher, because the structures of compounds normally have to be closely connected with their effects, so intermediate generalizations may more likely induce new inventions. (Intermediate generalization refers to a new scope being introduced between the original claim and the original embodiments, after amendments are made.)

### Case 34

|                        | Before amendment   | After amendment   |
|------------------------|--|---|
| Title of the Invention | Producing functional readthrough protein encoded by nucleic acid sequence comprising nonsense mutation useful for treating disease associated with nonsense mutation in gene involves orally administering nonsense codon suppressor agent   |   |
| Description            | The description does not disclose the specific amino acids at such position.   |   |
| Claims                 | <p>Claim 1: A functional protein having any amino acid residue at position <b>414</b> <b>except glutamine</b></p> <p>Claim 2: A functional protein having any amino acid residue at position <b>414</b> except glutamine, any amino acid residue at position <b>493</b> except glutamine</p> | <p>Claim 1: A functional readthrough protein having amino acid residue selected from <b>Arginine, glutamate, histidine, isoleucine, methionine, phenylalanine, proline, serine, tryptophane or valine</b> at position 414</p> <p>Claim 2: A functional protein having amino acid residue selected from Arginine, glutamate, histidine, isoleucine, methionine, phenylalanine, proline, serine, tryptophane or valine at position 414, amino acid residue selected from Arginine, glutamate, histidine, isoleucine, methionine, phenylalanine, proline, serine, tryptophane or valine at position 493.</p> |
| Notes                  | The description does not disclose the specific amino acid at said position.  |   |

[JPO]

Acceptable.

The expression “any amino acid residue ... except glutamine” is usually, by taking into consideration common general knowledge, identical to the

Markush-type expression “Alanine, Arginine, Asparagine, Aspartic acid, Cysteine, Glutamine, Glutamate, Glycine, Histidine, Isoleucine, Leucine, Lysine, Methionine, Phenylalanine, Proline, Serine, Threonine, Tryptophan, Tyrosine, or Valine”. Consequently, a chemical agent claimed in the amended claim is composed exclusively of a part of alternatives stated in the claim before the amendment was made. Furthermore, the amendment to “amino acid residue selected from Arginine, glutamate, histidine, isoleucine, methionine, phenylalanine, proline, serine, tryptophane or valine” does not constitute any change to a specific group of amino acids (e.g., hydrophobic, polar) nor does introduce any explicit or implicit effect.

Therefore, the amendment does not introduce any new technical matter.

(See GL Part IV, Chap. 2, 3.3.1 (5).)

[KIPO]

Acceptable

Changing a generic concept to a subordinate concept, if it is still obvious for a person skilled in the art after the change, is not deemed as addition of new matter. In this case, specific amino acids are not disclosed in the description, but it seems that it is obvious for a person skilled in the art that arginine, glutamate, histidine, isoleucine, methionine, phenylalanine, proline, serine, tryptophane and valine are amino acids. Therefore, the amendment shall not be deemed as addition of new matter.

[SIPO]

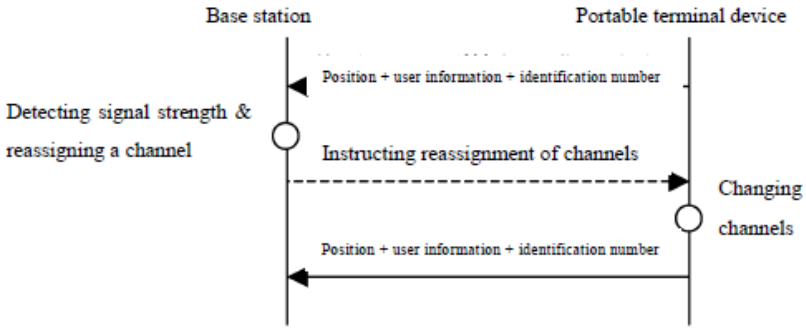
Unacceptable

Although the kinds of amino acids are known in the prior art, the description does not disclose the newly amended specific kinds of amino acids. The original application files limit the amino acids as any amino acid residue except for one specific amino acid, that is to say, there are at least 19 possibilities at each position. While the amended claims limit 6-12 kinds of specific amino acids for each position, which is considered as selecting specific amino acids from the 19 possibilities, and can not be determined directly and unambiguously from the original claims and description. Thus the amendment can not be accepted.

## DELETION OF CLAIMED MATTER

### Case 35

|                        | Original   | Amended |
|------------------------|--|---------|
| Title of the Invention | Mobile communication system  |         |
| Description            | <p>[Background of the invention]</p> <p>... Currently, the International Standardization Committee XXX has proposed the following process for providing information according to the positional information of portable terminal devices located within the certain cell site of the base station:</p> <p>First, the positional information is measured by the portable terminal device. Next, the positional information and the user information as well as the identification number to identify the device are transmitted from the device to the base station through the predetermined dedicated physical channel</p> <p>...</p> <p>[Problem to be Solved by the Invention]</p> <p>However, there is a problem that once the portable terminal device is set to select a specific physical channel and the channel is in a failure state, the mobile communication system cannot communicate with the portable terminal device until it recovers...</p> <p>The present invention provides a mobile communication system which gains the positional information of the device regardless of the communication state of dedicated physical channels, which solves the above mentioned problem by sending "signals instructing reassignment of physical channels" and changing physical channels using predetermined protocols.</p> |         |

|          |   |   |
|----------|---|---|
| Drawings |  <pre> sequenceDiagram     participant BS as Base station     participant PTD as Portable terminal device     Note over BS: Detecting signal strength &amp; reassigning a channel     BS-&gt;&gt;PTD: Position + user information + identification number     PTD-&gt;&gt;BS: Changing channels     BS-&gt;&gt;PTD: Instructing reassignment of channels     PTD-&gt;&gt;BS: Position + user information + identification number </pre> |   |
| Claims   | <p>A mobile communication system which includes a portable terminal device and a base station that communicates with the portable terminal device and which sends a position coordinate <u>and the user information</u> of the portable terminal device, as well as an identification number for identifying the portable terminal device through a vacant dedicated physical channel selected from several of these channels ...</p>   | <p>... a position coordinate <b>[deleted]</b>of the portable terminal device as well as an identification number for identifying the portable terminal device through a vacant dedicated physical channel selected from several of these channels ...</p> |

[JPO]

Acceptable.

The original description does not mention anything about sending only “a position coordinate and the identification number” to a base station, but the problem to be solved is to allow the system to provide information to the device according to the gained positional information regardless of the communication state of dedicated physical channels, and the means for solving the problem is to send “signals instructing reassignment of physical channels” using the predetermined protocol and changing physical channels. The invention also provides a first step of sending information from the portable terminal to the base station, which is definitely required to establish a channel, but the “user

information” is irrelevant to the problem to be solved by the invention, which explicitly states that the expression “user information” is an optional and additional new matter to the originally attached description. Consequently, the amendment is within the scope of the matters stated in the original description. (See HB Annex A, 7. Case 8.)

[KIPO]

Acceptable

Deleting a component or technical feature in a claim if it can be regarded obvious for a person skilled in the art is not deemed as addition of new matter. In this case, the invention is about sending signals instructing reassignment of physical channels and it is obvious for a person skilled in the art that the user information could be added or deleted for the invention. Therefore, the amendment in this case shall be allowed.

However, if the amendment is made after a final office action, it is not allowed since it expands the scope of the claim.

[SIPO]

Acceptable.

According to SIPO Guideline part 2, chapter 8, and section 5.2.3.3, it is needed to consider whether the deleted technical feature is an essential technical feature, and the relationships among the deleted technical feature and other technical features. According to the description, the technical problem of this case is that once the portable terminal device is set to select a specific physical channel and the channel is in a failure state, the position information cannot be communicated. The technical means for solving this problem is to send signals instructing reassignment of physical channels to the portable terminal device and change channels. As the portable terminal device is identified by the identification number, the absence of only user information would not result in not sending the above mentioned instruction signals to the portable terminal device and changing the channels. And, it seems that the user information and other technical features are independent to each other, and only have simple aggregation relationship. Therefore, the deletion of the above mentioned feature would not go beyond the scope of disclosure contained in the initial description and claims.

## Case 36

|                        | Before amendment   | After amendment   |
|------------------------|--|---|
| Title of the Invention | Composition useful for the treatment of a T-cell mediated disease e.g. graft rejection, graft versus host disease, autoimmune disease comprises a protein or peptide and a decreased or increased content of diketopiperazines   |   |
| Description            | “.... Suitable dipeptidyl peptidases and carboxypeptidases are available commercially from, e. g., Sigma. <b>The reaction should be conducted at pH 6-8, preferably in a buffer, such as phosphate buffer, at a temperature high enough to speed the reaction but not so high that the protein is denatured (e. g., 37 C) ”</b>  |   |
| Claims                 | <p>Claim 63,<br/>A method of synthesizing a diketopiperazine comprising contacting a solution of a protein or peptide with an enzyme that cleaves the two N-terminal or the two C-terminal amino acids of the protein or peptide under conditions effective to produce the diketopiperazine.</p> <p>Claim 67.<br/>The method of claim 63, wherein the enzyme is a dipeptidyl peptidase</p> | <p>Claim 63:<br/>A method of synthesizing a diketopiperazine comprising contacting a solution of a protein or peptide with an enzyme that cleaves the two N-terminal or the two C-terminal amino acids of the protein or peptide, <b><u>wherein the enzyme is a dipeptidyl peptidase.</u></b></p> |
| Notes                  | The applicant delete the technical feature “under conditions effective to produce the diketopiperazine”, while the description refers to the reaction under specific conditions  |   |

[JPO]

Acceptable.

It is common for enzyme reactions to occur under the specific condition, therefore, as long as the deleted matter is irrelevant to the problem to be solved, and is optional, additional matter, the amendment (deletion) does not introduce new technical matter.(See GL Part IV, Chap. 2, 3.3.1 (1) b.)



[KIPO]

Acceptable.

If an invention is obvious for a person skilled in the art even after deleting a technical feature, it shall not be deemed as addition of new matter.

It seems to be obvious for a person skilled in the art that a suitable condition (such as “under conditions effective to produce the diketopiperazine”) can be adopted.

[SIPO]

Acceptable

The applicant delete the technical feature “under conditions effective to produce the diketopiperazine”, while the description refers to the reaction under specific conditions. However, the reaction should have been carried out under suitable conditions to be completed, therefore, the feature “under conditions effective to produce.....” is considered as an implicit disclosed feature. Thus the amendment is accepted under Article 33 CPL.

## COMMON GENERAL KNOWLEDGE

### Case 37

|        | Before amendment  | After amendment  |
|--------|---|--|
| Claims | <p>“A method of manufacturing an Al-Si-Zn alloy comprising the steps of; heating an Al-Si alloy; stopping heating the Al-Si molten alloy; melting process <u>which is started by putting Zn into the molten alloy at a temperature below 750°C and keeping putting Zn into the molten alloy while decreasing temperature to 620±20°C</u>”</p> | <p>“A method of manufacturing an Al-Si-Zn alloy comprising the steps of; heating an Al-Si alloy; stopping heating the Al-Si molten alloy; melting process <b><u>by putting Zn into the molten alloy at 750~620±20°C</u></b>”</p> |
| Notes  | <p>1. It is well known for persons skilled in the art that if Zn is put into an alloy, the temperature of the alloy drops rapidly.</p> <p>2. It is also well known that the melting process can't be started at 620±20°C because of solidification problem by cooling.</p>  |  |

[JPO]

Acceptable.

Taking into consideration the common general knowledge stated in Notes 1, the temperature of an alloy drops rapidly when Zn is put into the alloy. Then, taking into account the common general knowledge stated in Notes 2 that the melting process cannot be started at 620±20°C, it is the same as the original claim stating that melting of Zn is processed between 750°C and 620±20°C, even though the temperature where to stop putting Zn is not explicitly stated in the amended claim.

Note that the amended claim may be construed to mean that Zn is put only once. If the claimed invention in the amended claim is interpreted to be such an invention, while the originally claimed invention is construed to be an invention having a technical feature in which Zn is constantly being added little by little in

order to avoid rapid cooling, (taking into consideration the entire statement in the description), the amendment would appear to add a new technical significance, and therefore, could add a new technical matter.

[KIPO]

Acceptable

Korean Patent Court ruled that a person skilled in the art is able to understand that he/she can't mold at  $620 \pm 20^{\circ}\text{C}$  since the temperature of the molten alloy would decrease rapidly, resulting cooling and solidification.

Therefore, the amended claim can be understood or interpreted same as the claim before amendment by a person skilled in the art. The amendment shall not be deemed to have deleted the target temperature while only remaining starting temperature. (Patent Court ruling 2008Heo14377)

Whether new matter is added to an amended specification or drawing(s) shall be determined by whether elements described in the amended specification or drawing(s) (the subject of assessment) are in the scope of the elements described in the originally attached specification or drawing(s) (the subject of comparison).

In this context, "being in the scope of the elements described in the specification or drawing(s)" does not mean being completely and externally the same within the scope of matter described in the specification or drawing(s) originally attached to the patent application. The matter that is obvious for a person skilled in the art based on matter described in the specification or drawing(s) originally attached to the patent application shall be also deemed as being in the scope of matter described in the specification or drawing(s). (Patent Examination Guideline, Part IV Section 2 1.1.)

[SIPO]

Unacceptable

According to the common knowledge in prior art, if Zn is putted into the alloy, the temperature of the alloy drops rapidly, that is to say, the melting process should be started from the higher temperature to the lower temperature. From "keeping putting Zn into", it can be interpreted that Zn can not be putted into only once, and should be added little by little. However, according to the amended claim, it can not be derived directly and unambiguously that Zn is putted into little by little. Zn can also be added only once. Therefore, the amendment can not be

determined directly and unambiguously from the original application. So it is not acceptable.

[Meeting Discussion]

JPO noticed that the original claim stated, “keeping putting Zn” while the amended claim did not. In some cases, the addition of new technical matter may be incurred by such a difference. In this case, however, JPO paid attention to the common general knowledge indicated in the “Notes”, and determined that, even after the amendment, Zn would also be added little by little in order to avoid rapid cooling. Therefore, the amendment did not introduce any new technical matter. If a special technical feature of the originally claimed invention would be to keep putting, even when taking into consideration the common general knowledge provided in the case, and such a technical feature generates a technical effect of the invention which is not generated by putting Zn only once, the amendment might not be permitted.

SIPO holds that “keeping putting Zn into” is construed as adding Zn little by little, while from the amended claim it can not be derived directly and unambiguously that Zn is added little by little; Zn can also be added only once. So this amendment is unacceptable.

## ANALYSIS

### NUMERICAL LIMITATION

|               |     | JPO          | KIPO       | SIPO         |
|---------------|-----|--------------|------------|--------------|
| <b>Case 1</b> | 1-1 | Acceptable   | Acceptable | Acceptable   |
|               | 1-2 | Acceptable   | Acceptable | Acceptable   |
| <b>Case 2</b> | 2-1 | Acceptable   | Acceptable | Unacceptable |
|               | 2-2 | Acceptable   | Acceptable | Unacceptable |
| <b>Case 3</b> |     | Unacceptable | Acceptable | Unacceptable |
| <b>Case 4</b> |     | Acceptable   | Acceptable | Unacceptable |
| <b>Case 5</b> |     | Acceptable   | Acceptable | Unacceptable |
| <b>Case 6</b> |     | Acceptable   | Acceptable | Acceptable   |
| <b>Case 7</b> |     | Acceptable   | Acceptable | Unacceptable |
| <b>Case 8</b> |     | Acceptable   | Acceptable | Acceptable   |

Regarding numerical limitations, if a numerical range stated in the amended claim falls within a numerical range originally stated, three offices accept such an amendment (Case 1, Case 6). In SIPO, however, when the original description only disclosed numerical values as “points,” not as “ranges” defined by the points, adding a range defined by two points which were disclosed in the description is not permitted. In SIPO’s view, such an amendment introduces new technical matter, a “range,” which was neither explicitly stated in the description nor determined directly and unambiguously from the original disclosure (Case 2, 4 and 5).

In KIPO’s view, even if any numerical values were not stated in the description, addition of numerical values may be allowed when it would be obvious for a person skilled in the art to select the added values (Case 3).

### CHANGE BETWEEN CLOSE-ENDED CLAIM AND OPEN-ENDED CLAIM

|                | JPO        | KIPO       | SIPO         |
|----------------|------------|------------|--------------|
| <b>Case 9</b>  | Acceptable | Acceptable | Unacceptable |
| <b>Case 10</b> | Acceptable | Acceptable | Acceptable   |

Although the category is defined as changing between close-ended claim and open-ended claim, in these two cases, it is more close to the deletion of technical features. JPO considers that the deletion of elements which are irrelevant to the problem to be solved and optional may be acceptable. SIPO considers if the deleted feature could affect the final technical solution, the amendment can not be accepted

#### RECOMBINATION OF FEATURES

|                | JPO        | KIPO       | SIPO       |
|----------------|------------|------------|------------|
| <b>Case 11</b> | Acceptable | Acceptable | Acceptable |
| <b>Case 12</b> | Acceptable | Acceptable | Acceptable |

Three offices all consider the amendment is acceptable.

#### CHANGE OF SUBJECT MATTER

|                | JPO          | KIPO         | SIPO         |
|----------------|--------------|--------------|--------------|
| <b>Case 13</b> | Unacceptable | Unacceptable | Unacceptable |

Three offices all consider the amendment cannot be accepted, not because the subject matter is changed, but the amended reagents are not disclosed in the original description and claims. An amendment from a “method” claim to a “kit” claim would generally be acceptable.

#### ADDING INFORMATION RELATED TO PRIOR ART

|                | JPO          | KIPO         | SIPO         |
|----------------|--------------|--------------|--------------|
| <b>Case 14</b> | Unacceptable | Unacceptable | Unacceptable |
| <b>Case 15</b> | Acceptable   | Acceptable   | Acceptable   |
| <b>Case 16</b> | Acceptable   | Unacceptable | Acceptable   |

Concerning adding information related to prior art to the “background art” of the description, both JPO and SIPO can accept the addition of both of bibliographic data and contents of prior arts. On the other hand, KIPO can only accept the additional bibliographic data, e.g. title and publication number, and does not accept the addition of the contents described in the prior art.

## ADDING EMBODIMENT OR TECHNICAL EFFECT

|                | JPO          | KIPO         | SIPO         |
|----------------|--------------|--------------|--------------|
| <b>Case 17</b> | Unacceptable | Unacceptable | Unacceptable |
| <b>Case 18</b> | Unacceptable | Unacceptable | Unacceptable |
| <b>Case 19</b> | Unacceptable | Unacceptable | Unacceptable |
| <b>Case 20</b> | Unacceptable | Unacceptable | Unacceptable |

JPO and KIPO consider adding technical meaning or effect which is not obvious from originally attached description or drawing(s) is deemed as addition of new matter. SIPO considers if the added technical meaning or effect can not be derived from the original application as filed unambiguously and directly, such an amendment can not be accepted. Though the wordings are different, the conclusions for cases above were the same among three offices.

## AMENDMENT AFTER FINAL OFFICE ACTION

|                |           | JPO          | KIPO         | SIPO         |
|----------------|-----------|--------------|--------------|--------------|
| <b>Case 21</b> |           | Unacceptable | Unacceptable | Unacceptable |
| <b>Case 22</b> | 22-1-22-4 | Acceptable   | Acceptable   | Acceptable   |
|                | 22-5      | Unacceptable | Unacceptable | Unacceptable |
| <b>Case 23</b> | 23-1,23-2 | Unacceptable | Acceptable   | Acceptable   |
|                | 23-3      | Unacceptable | Unacceptable | Unacceptable |

Concerning “the final notice of reasons for refusal” and “amendments after the final office action”, JPO and KIPO have specific requirements for the amendment respectively. In JPO and KIPO, after the final notice, amendments are allowable only when they delete claim(s), restrict the scope of claimed invention(s) in a limited way, correct error(s), or clarify ambiguous statement(s). Furthermore, KIPO accepts an amendment which removes a claimed matter which was regarded as a new matter in the previous office action, while JPO does not. , However, SIPO does not have similar requirements because it does not have the system of the final office action.

Instead, besides “not going beyond the scope of the original disclosure”, SIPO has another important requirement for amendments stipulated under Rule 51.3, which requires the applicant to amend for the purpose of overcoming the problems raised in an office action (OA). This requirement applies for all

amendments, not only for the amendments made after the final OA. Actually, SIPO examiners do not know when to issue the final OA due to the “hearing doctrine”. The hearing doctrine requires examiners to give applicants at least one chance to make amendments when new facts and reasoning are submitted. So SIPO examiners have to wait for the reply from the applicant and then decide whether there are new facts and reasoning.

With regard to Rule 51.3, there is an exception. Even when the amendment does not comply with Rule 51.3, as far as it complies with Art.33 (prohibition of new matter) and all the problems of the original application raised in an OA have been resolved, and thus there is a possibility for application to be granted, in order to speed up the examination procedure, such an amendment can be accepted.

#### **CORRECTION OF OBVIOUS MISTAKE**

|                | <b>JPO</b> | <b>KIPO</b> | <b>SIPO</b>  |
|----------------|------------|-------------|--------------|
| <b>Case 24</b> | Acceptable | Acceptable  | Unacceptable |

From this case, it seems the understanding of “obvious mistake” is a little bit different among the three offices. JPO and KIPO consider if there are several means to overcome the mistake, and the correction is the most appropriate when taking into consideration the common general knowledge as well as the problem to be solved by the claimed invention, and thus such an amendment would be allowed. SIPO can only accept apparent written mistake, which can be corrected unambiguously on the basis of the description and common knowledge.

#### **AMENDMENT BASED ON DRAWINGS**

|                | <b>JPO</b> | <b>KIPO</b> | <b>SIPO</b>  |
|----------------|------------|-------------|--------------|
| <b>Case 25</b> | Acceptable | Acceptable  | Acceptable   |
| <b>Case 26</b> | Acceptable | Acceptable  | Unacceptable |

All of three offices allow amendments based on drawings if they do satisfy the fundamental requirements for amendments (Case 25). On a certain case, SIPO expressed its view that a claimed element in an amended claim is unclear and thus the scope of the claimed invention goes beyond the extent of disclosure in the original description (Case 26).



## DISCLAIMER

|                | JPO        | KIPO       | SIPO         |
|----------------|------------|------------|--------------|
| <b>Case 27</b> | Acceptable | Acceptable | Unacceptable |
| <b>Case 28</b> | Acceptable | Acceptable | Acceptable   |
| <b>Case 29</b> | Acceptable | Acceptable | Acceptable   |
| <b>Case 30</b> | Acceptable | Acceptable | Acceptable   |

Concerning disclaimer, KIPO generally accepts disclaimer and JPO accepts disclaimer when it excludes only the elements disclosed in a prior art from the originally claimed invention. On the other hand, SIPO normally does not accept disclaimer. There are, however, several exceptions in SIPO to accept disclaimer, which can be found in Guideline, Part II, Chapter 8, section 5.2.3(3). According to the Guideline, disclaimers may acceptable when:

- (1) an amendment disclaims elements which were disclosed in a conflicting application to make the claimed invention novel over the conflicting application and the amended claim is actually novel;
- (2) an amendment disclaims a part of a claimed matters to have the rest of the claimed invention involve an inventive step; or
- (3) an amendment disclaims a part of elements originally claimed in order to resolve the issue of impracticality raised by the examiner due to the excluded values and the amended claim is practical.

## GENERIC AND SUBORDINATE CONCEPT

|                | JPO        | KIPO       | SIPO         |
|----------------|------------|------------|--------------|
| <b>Case 31</b> | Acceptable | Acceptable | Acceptable   |
| <b>Case 32</b> | Acceptable | Acceptable | Acceptable   |
| <b>Case 33</b> | Acceptable | Acceptable | Unacceptable |
| <b>Case 34</b> | Acceptable | Acceptable | Unacceptable |

SIPO does not accept an amendment of a claim to an invention the scope of which is more limited than the originally claimed invention but more generalized than embodiments originally stated in the description unless the claimed invention after the amendment would be determined directly and unambiguously from the original disclosure by a person skilled in the art (Cases 33, 34). On the other hand, JPO and KIPO accept such an amendment as far as it does not

introduce any new technical matter.

#### **DELETION OF CLAIMED MATTER**

|                | <b>JPO</b> | <b>KIPO</b> | <b>SIPO</b> |
|----------------|------------|-------------|-------------|
| <b>Case 35</b> | Acceptable | Acceptable  | Acceptable  |
| <b>Case 36</b> | Acceptable | Acceptable  | Acceptable  |

JPO considers if the deleted matter is irrelevant to the problem to be solved by the invention, and is an optional and additional new matter to the originally attached description, the amendment may be acceptable. KIPO considers deleting a component or technical feature in a claim if it can be regarded obvious for a person skilled in the art is not deemed as the addition of new matter. In SIPO, it should be considered whether the deleted technical feature is an essential technical feature, and the relationships between the deleted technical feature and other technical features.

#### **COMMON KNOWLEDGE**

|                | <b>JPO</b> | <b>KIPO</b> | <b>SIPO</b>  |
|----------------|------------|-------------|--------------|
| <b>Case 37</b> | Acceptable | Acceptable  | Unacceptable |

JPO and KIPO consider if the amended claim can be understood or interpreted to be the same as the claim before amendment by a person skilled in the art according to common knowledge, the amendment does not introduce any technical matter and thus is acceptable. SIPO only accept the amendment which can be derived directly and unambiguously from the original disclosure.

## **SUMMARY**

After comparing the conclusions and reasoning of the three offices, we find out some commonalities and differences as follows.

### **COMMONALITIES**

1. In JPO and KIPO, the basic requirement for amendments is that an amendment shall not introduce any new technical matter in relation to the original disclosure. In SIPO, the basic rule is that amendments shall “not go beyond the scope of the original disclosure”. Though the wordings are different, the underlying rationale seems to be similar in three offices, i.e., if an application would share the same filing date even after an amendment which introduces any new technical matter, it would be considered as unfair for the public.

2. To judge whether an amendment adds any new technical matter or goes beyond the scope of the original disclosure, the amended application needs to be compared with the original application itself, not the priority application.(for example, Case 21)

3. The content disclosed in the original application includes what is written in the description, claims, and drawings (for example, Case 25). Besides those matters, matters which are not explicitly stated in the original application, but are obvious for a skilled person in the art, and do not introduce new technical matters (in JPO and KIPO), or matters which can be determined directly and unambiguously from the original disclosure (in SIPO) are included.

### **DIFFERENCES**

1. Concerning “amendments after the final office action”, JPO and KIPO have specific requirements respectively (for example, Case 21). In JPO and KIPO, after the final notice, amendments are allowable only when they delete claim(s), restrict the scope of claimed invention(s) in a limited way, correct error(s), or clarify ambiguous statement(s). Furthermore, KIPO accepts an amendment removing new matter, while the JPO does not. KIPO also accepts one of four amendments mentioned above (i.e. deleting claim, restricting the scope of claim,

correcting error, clarifying ambiguous statement) while reverting to the claim before addition of new matter.

SIPO does not have such requirements because it does not have the system of final office action.

Instead, besides “not going beyond the scope of the original disclosure”, SIPO has another important requirement for amendments as stipulated under Rule 51.3, which requires the applicant to amend for the purpose of overcoming the problems raised in an office action (OA). This requirement applies for all the amendments, not only for amendments made after the final OA. Actually, SIPO examiners do not know when to issue the final OA due to the hearing doctrine. This hearing doctrine requires examiners to give applicants at least one chance to make amendments when new facts and reasoning are submitted. So SIPO examiners have to wait for the reply from the applicant and then decide whether there are new facts and reasoning.

With regard to Rule 51.3, there is an exception. Even when the amendment does not comply with Rule 51.3, as long as it complies with Art.33 (prohibition of new matter) and all the problems of the original application raised in an OA have been resolved, and thus there is a possibility for a right to be granted, such an amendment can be accepted in order to speed up the examination procedure.

The purpose of SIPO Rule 51.3 is to restrict applicants, to avoid the amendments which may cause examiners to search again and again when they get the amended application, and to guarantee examination efficiency.

2. In addition to explicitly stated matters in the original application, all three offices have rules to accept adding matters which are not explicitly stated in the original application. For JPO and KIPO, the added matters must be “obvious for the skilled person in the art” and the amendment must not introduce new technical matters, while for SIPO, the added matters must be “determined directly and unambiguously from the original disclosure”. Though practices in all three offices sound similar, in practice, obviously SIPO is stricter than JPO and KIPO concerning the degree of flexibility. For example, Cases 2 and 26 clearly demonstrated the differences.

3. Concerning adding information related to prior art to the “background art” section in the description, both JPO and SIPO accept the addition of both of bibliographic data and details of prior arts. On the other hand, KIPO only accepts the former and does not accept the latter.

4. Concerning disclaimers, KIPO generally accepts disclaimers and JPO accepts disclaimers when it excludes only the elements disclosed in a prior art from the originally claimed invention. On the other hand, SIPO normally does not accept disclaimers. There are, however, several exceptions for SIPO to accept disclaimers, which can be found in Guideline, Part II, Chapter 8, section 5.2.3(3). According to the Guideline, disclaimers may be acceptable when:

- (1) an amendment disclaims elements which were disclosed in a conflicting application to make the claimed invention novel over the conflicting application and the amended claim is actually novel;
- (2) an amendment disclaims some of the claimed matters to have the rest of the claimed invention involve an inventive step; or
- (3) an amendment disclaims some of the elements originally claimed in order to resolve the issue of impracticality raised by the examiner due to the excluded values and the amended claim is practical.