Amendments under the Japanese Patent Law

May 2014
Amendments

• Means to change (limit or broaden) the scope of claims and repair deficiency of claims to overcome the rejections

• Amendment beyond the scope of the original disclosure is a reason for rejection as well as a reason for invalidation.

• Care should be taken upon making amendments.
Amendments

• Patent Act Article 17bis(3)
  “... any amendment of the description, claims or drawings ... shall be made within the scope of the matters stated in the description, claims or drawings originally attached to the application”
Way of judging admissible amendments

Making an amendment to not only “matters explicitly stated in the originally attached description” but also “matters obvious from the disclosure in the originally filed description” does not introduce new technical matter and is permitted.

(a) In order to find that amended matters are “matters obvious from the disclosure in the originally filed description,” it is required that a person skilled in the art who reads the disclosure evidently understands the meaning thereof and understands them as if they were stated therein”.

(b) As for well-known art or commonly used art, the technology cannot sufficiently be considered as “matters obvious from the disclosure in the originally filed description” just because the technology itself is well-known art or commonly used art.

(c) In some cases, a matter is considered obvious from several statements in the originally filed description (for example, statement of the problem to be solved by the invention, statement of examples of the invention, statement of the drawings) from a standpoint of a person skilled in the art.
[Claim 1]
A rolling controller for a combine with crawler traveling units at both sides of the combine body, wherein a pair of oil [hydraulic] hydrostatic cylinders, which respectively work for both traveling units, are arranged in a manner so that one side of each oil hydraulic cylinder is attached to one respective travelling unit and the other side of each [hydraulic] hydrostatic cylinder is attached to the body.

• This amendment is only admissible if the original description expressly recite hydrostatic cylinders as a general concept of hydraulic cylinders.
Amendment to limit to “X=alkyl and Y=alkoxy” is admissible, but amendment to limit to “X=alkyl and Y=phenyl” is not admissible because the original description does not disclose a specific compound wherein “X=alkyl and Y=phenyl”.

X = alkyl, alkenyl, amino, aralkyl, halogen, cycloalkyl
Y = alkyl, phenyl, alkoxy
Amendments - Case 3 picked up from JPO Examination Guideline

[Claim 1] A method of drying unhulled rice by irradiating the rice with an infrared ray, the wavelength of which is 3μm or 9μm.

Amendment to limit “wavelength is 3μm or 9μm” to “wavelength is 2-3.5μm or 8-9.5μm” is inadmissible, because the original description does not include any reasoning to select these numerical ranges from the drawing.
Amendments - Case 4 picked up from JPO Examination Guideline

[Claim 1] Hollow glass microsphere which have substantially equal diameters of 200-10,000μm...

The original description include the following sentence.

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

Amendment to limit “diameters of 200-10,000μm” to “diameters of 200-6,000μm” is admissible, because amended numerical range of “200-6,000μm” is within the range of “200-10,000μm”, and the originally description describes the value 6,000μm.
Amendments - Case 5 picked up from JPO Examination Guideline

[Claim 1] 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 olyglycerin, an ethylene oxide adduct of polyglycerin, or a propylene oxide adduct of polyglycerin, all of which have an HLB of 9-11, or a mixture thereof.

Amendments to limit “HLB of 9-11” to “HLB of 7.5-11” or “HLB of 9.5-11” are both admissible, because amended numerical ranges are clearly extracted from the working example.

<table>
<thead>
<tr>
<th>HLB</th>
<th>Softening point (°C)</th>
<th>Adhesive strength (Pa)</th>
<th>Washing time (Warm water at 60 °C)</th>
</tr>
</thead>
<tbody>
<tr>
<td>11</td>
<td>50</td>
<td>0.0118</td>
<td>40′*</td>
</tr>
<tr>
<td>10</td>
<td>60</td>
<td>0.0147</td>
<td>50′*</td>
</tr>
<tr>
<td>9.5</td>
<td>50</td>
<td>0.0118</td>
<td>40′*</td>
</tr>
<tr>
<td>9</td>
<td>60</td>
<td>0.0196</td>
<td>1′10″</td>
</tr>
<tr>
<td>8.5</td>
<td>65</td>
<td>0.0294</td>
<td>1′40″</td>
</tr>
<tr>
<td>8</td>
<td>72</td>
<td>0.0490</td>
<td>2′15″</td>
</tr>
<tr>
<td>7.5</td>
<td>85</td>
<td>0.0784</td>
<td>3′20″</td>
</tr>
</tbody>
</table>
Amendments - Case 6 picked up from JPO Examination Guideline

[Claim 1] A photosensitive plate for planography which has a photosensitive layer, disposed on a hydrophilically treated aluminum plate, composed of partially saponificated polyvinyl acetate and a photopolymerized monomer having at least one ethylenic unsaturated bond, wherein the photosensitive layer further comprises 1-100% by mass of a nitrogen-containing heterocyclic carboxylic acid (excluding nicotinic acid) with respect to the partially saponificated polyvinyl acetate.

This amendment to disclaim nicotinic acid which was disclosed in a prior art is admissible. A “disclaimer” approach should be adopted in the potential invention only when the filed invention is an art totally different from prior art in view of the technical idea and basically has an inventive step, but has an overlapped section with the prior art by chance.
Amendments against Final OA and Decision of rejection

The scope of amendments against Final OA and Decision of Rejection is restricted to:

• claim cancellations,
• claim limitations,
• clerical error corrections or clarification of unclear recitations in claims
Admissible amendments at Final or Appeal

- a sensor → a sensor consisting of a thermocouple
- roughing the surface of said layer-thickness-regulating member. → roughing the surface of said layer thickness regulating member, and the roughness is set to be in the range from 0.5D to 1.5D (D: average particle diameter).
- an ejection nozzle protruding in the tangent direction → an ejection nozzle in which its opening is reduced in diameter and protruding in the tangent direction
- interconnecting the transmitter and the receiver as an integrated member → interconnecting LED as the transmitter and photodiode as the receiver as an integrated member
Inadmissible amendments at Final or Appeal

Addition of new issue (underlined feature) is not allowed at this stage.

× A production method of compound C comprising reacting compound A with compound B at the temperature above 80°C.

× An input device with a touch panel on the display to input required data through the touching of a part of the display that corresponds to the display position, wherein the input device is equipped with a guidance system that indicates the next item to be input by flashing the space into which the data is to be inserted, and has a speaker to provide voice instructions on the next item to be input.
Amendment after 1st OA is also restricted.

- **Patent Act Article 17bis(4):**
  - Amendments to claims should be made such that the amended claims meet unity with the claims examined in the Office Action.
Amendment after 1st OA is also restricted.

- Example
  Claim 1  A
  Claim 2  A+B
  Claim 3  A+C

1st OA
- When the Examiner judged that claim 1 does not have a novel technical feature, but claim 2 has a novel technical feature, it is judged that claim 2 and claim 3 do not have unity, and only claims 1 and 2 are examined.
- In response to the 1st OA, an amendment to cancel claims 1 and 2, and maintain claim 3 is not allowed.
- If the applicant desires to prosecute claim 3 (A+C), the applicant should file a divisional application.