

AMENDMENT REQUIREMENTS in JAPAN



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Confidential

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1. A generalized concept is considered as a “New Matter.”
2. The claimed subject matter may not shift after an OA.
3. Only existing elements of claims can be further limited after a final OA.



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1. A generalized concept is considered as a “New Matter.”

“when an amendment introduces a new generic concept that includes a subject matter not described in the original specification, the amendment is deemed to have introduced a new matter.”

from JPEG: Japanese Patent Examination Guideline



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Example from the JPEG

The claim recited “hydraulic cylinder.”
No other cylinder was disclosed.

“hydraulic cylinder” cannot be amended to
“fluid pressure cylinder.”

∴ “fluid pressure cylinder” includes “air cylinder.”



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Intermediate Concept, OK?

- Even when broader and narrower concepts are described, an intermediate concept is rarely accepted, since:
- it is a new matter with respect to either broader or narrower concept.



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Practical Note

- Choose concepts that were explicitly described in the original specification, for an amendment.



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Suggestions

- Before filing a Japanese patent application or PCT application to be entered in Japan:
 - Describe various general and intermediate concepts to support future amendments.
- When filing a Paris-route application, RYUKA adds those concepts considering Japanese amendment requirements.

2. The claimed subject matter may not shift after an OA, if the application was filed on or after April 1, 2007.

The amended claims and examined claims must satisfy the unity of invention requirement.

Example

- Claims A and B lacking unity of invention were originally presented.
- Only claim A was examined.
 - ↓
- Canceling claim A to leave claim B:
 - Not accepted.

See “[The unity of Invention Requirement and Shifting Amendments.](#)”

Suggestions

- When claims A and B might not satisfy the unity of invention requirement,
 - Present more important claims in front.
- When the first claim group is cancelled in US/EP,
 - file a preliminary amendment in JP.

3. Only existing claim elements can be further limited after a final OA.

New elements cannot be added.

ex. Claims 2 and 3 having different elements depend from claim 1.



Claim 3 cannot be amended to depend from claim 2.

Suggestions

- In response to the first OA, amend dependent claims to depend from all possible claims.
 - Reserves more freedom to choose any combination of claims for the future.

Thank You.

Should you have any questions, please
feel free to contact us!

