

The Unity of Invention Requirement and Shifting Amendments

February 2, 2009

If a patent application was filed on or after April 1, 2007, the unity of invention requirement must be fulfilled between the examined and amended claims. If the unity requirement is not met, the claims amended after a non-final office action are rejected, and amendments made after a final office action or decision of rejection are not entered.

1. Unity of Invention

The unity of invention requirement is fulfilled if the two or more inventions in question contain the same or a corresponding “special technical feature.” A special technical feature is not found if the inventions were described in prior art or made by addition of a well known technique to prior art. Which claims are to be examined is determined by seeking a special technical feature in Claim 1 and in any subsequent claim reciting all elements of the prior claims.

In Fig. 1A, the search for special technical features is only made for Claims 1 to 4. Which claims are examined depends on which claim contains a special technical feature, as shown in Fig. 1B. In Fig. 1A, when a special technical feature is not found in Claim 1, Claims 6 and 7 are not examined and lack of unity of invention is cited as a reason for rejection.

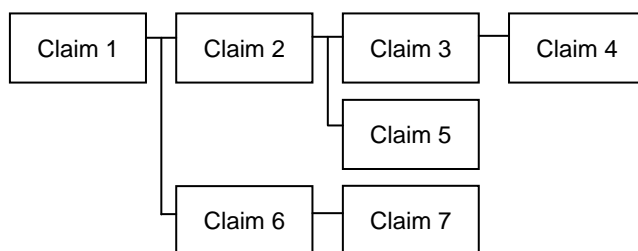


Fig. 1A Example of dependency

Claim in which a special technical feature was found	Subject claims for examination
1	1 to 7
2	1 to 5
3	1 to 4
4	1 to 4
None	1 to 4

Fig. 1B Claims to be examined

2. Shifting Amendments

In Fig. 2A, Claims 1 and 2 were examined and Claims I to V were subsequently presented by amendment. Fig. 2B shows which claims are to be further examined, which depends on where the special technical feature is found.

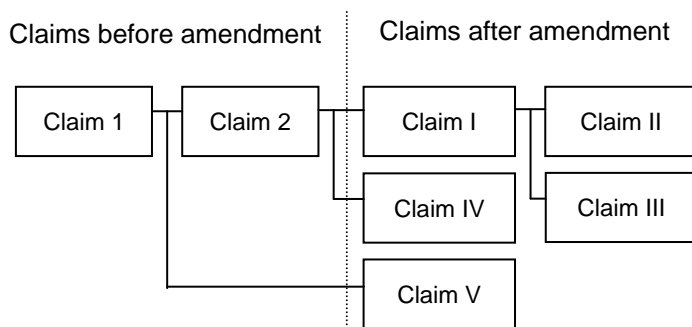


Fig. 2A Example of claim dependency

Claim in which a special technical feature was found	Subject claims for examination
1	I to V
2	I to IV
I	I to III
II	I, II
None	I, II

Fig. 2B Claims to be Examined

The amended claims must include all elements of the examined claim in which the special technical feature was found. If none of the examined claims includes a special technical feature, the amended claims must include all elements of the highest numbered examined claim, Claim 2 in Fig. 2A.

3. Our suggestions

A. When filing a patent application in Japan

- (1) List claims in order of importance.
- (2) Make dependent claims depend from as great a number of claims as possible.
- (3) Be even more careful to exclude unnecessary features in any dependent claim, for securing wider scope of non shifting amendment in a later prosecution

B. Before the first office action

Inquire the patent office of examination schedule of each patent application. Right before receiving the first office action, amend claims by considering amendments made for corresponding foreign patent applications. The above A(1) to A(3) could be done at this stage.

C. When responding to an office action

- (1) Carefully check that each of the amended claims includes all elements of an examined claim that was found to have a special technical feature, or if no special technical feature was found in any claim, all elements of all examined claims.
- (2) File a divisional application if any unexamined claim group needs to be examined or any elements mentioned in (1) must be removed.

Should you have any questions, please feel free to contact cases_to_jp@ryuka.com.

Thank you,
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