

AMENDMENT REQUIREMENTS in JAPAN

--- Generalized Concept Is
Not Accepted. ---

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Japanese Patent Examination Guideline Says:

“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.”

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Practically

- A new generic concept normally includes something not described in the original specification.

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- A generalized concept is rarely accepted.

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Example From the Guideline

- The claim recited “hydraulic cylinder,” and the specification did not disclose any other cylinder.
- The amendment from “hydraulic cylinder” to more generic, “fluid pressure cylinder”, is not permitted, since:
- The “fluid pressure cylinder” includes “air cylinder”, which was not disclosed.

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Medium Concept OK?

- Even when broader and narrower concepts are described, the medium concept is hardly accepted, since:
- the medium concept is the new matter from either a broader or a narrower concept.

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Practical Note

- Generally, choose words or phrases that originally exist in the specification for the amendment.

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Suggestions

- Before filing Japanese patent application or PCT application to be entered in Japan:
- Describe various general and medium concepts to support future amendments.
- Upon authorization, we would add those concepts considering Japanese Amendment Requirements, when filing a Paris-rout application.

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Thank you.

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

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