

日本专利的修改要求

AMENDMENT REQUIREMENTS in JAPAN

• RYUKA •
with Free Vision

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机密

日本代理人·美国律师 龙华 明裕

1. **上位概念被视为“新主题”。**
Generalized concept is considered as
“New Matter.”
2. **在审查意见(OA)之后不允许修改主题。**
Subject matter may not shift after the OA.
3. **在最终OA之后仅可对权利要求中存在的要素进行进一步限定**
Only existing elements of claims can be
further limited after the final OA.

1.上位概念被视为“新主题”。

Generalized concept is considered as “New Matter.”

当修改引入一个新的上位概念，该上位概念包括未在原说明书中介绍的主题，则该修改被视为引入了一个新主题。

“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.”

--摘自日本专利审查指南
from Japanese Patent Examination Guideline

摘自指南的举例

Example from the Guidelines

- The claim recited “hydraulic cylinder,” and the specification did not disclose any other cylinder.
权利要求记载了“液压缸”，且说明书中未公开是何种缸，
- The amendment from “hydraulic cylinder” to the more generic “fluid pressure cylinder” is not permitted, since:
不允许将“液压缸”修改成上位的“流体压力缸”，
- A “fluid pressure cylinder” includes an “air cylinder,”
这是因为“流体压力缸”包括“气缸”。

是否允许中间概念

Intermediate Concept OK?

- Even when broader and narrower concepts are described, a medium concept is rarely accepted, since:

即使描述了较宽概念或较窄概念，中间概念也难以通过审查，

- It is new matter with respect to a broader or narrower concept.

这是因为中间概念相对于较宽概念或较窄概念是新主题。

建 议

Suggestions

- When filing a Japanese or PCT application, add general and intermediate words of key elements for supporting the future amendments.

在提交日本或PCT申请之前，增加关键要素的上位概念词和中间概念词语，以便支持后续的修改。

- In a Paris-route, RYUKA can add those words upon your request.

在巴黎路径申请中，我们能够根据你的要求来增加这些词语。

- Choose the words from the specification for amendments.
从说明书中选择词进行修改。

2. 在审查意见(OA)之后不允许修改主题

Subject matter may not shift after OA

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

修改的权利要求和被审查的权利要求必须满足发明的单一性要求。

举 例

Example

- Claims A and B, which lack unity of invention, were originally presented and only claim A was examined.
原申请的权利要求A和权利要求B缺乏发明的单一性，且仅权利要求A被审查。
- ↓
- Canceling claim A to leave claim B is not accepted.
删除权利要求A而保留权利要求B将不被接受。
 - See “The unity of Invention Requirement and Shifting Amendments”
--参见“发明单一性和移位修改要求”

建议

Suggestion

- When claims A and B might not satisfy the unity of invention requirement,
 - Present more important claims in front.
- 当权利要求A和B可能不满足发明的单一性要求时,
 - 将更重要的权利要求放在前面。
- When the first claim group is cancelled in US/EP,
 - file a preliminary amendment in JP.
- 当在美国/欧洲放弃第一权利要求组时,
 - 在日本提交初步修改。

3. 在最终OA后，只能限定现存的权利要求

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

New elements cannot be added. 不能增加新要素

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

例如：均引用权1的权2和权3具有不同的要素



Claim 3 cannot be amended to depend from claim 2.

权3不能被修改为引用权2

建议

Suggestion

In response to the first OA, amend dependent claims to depend from all possible claims.

在答复一通时，将权利要求修改为引用全部可能的权利要求

→ Reserves more freedom to choose any combination of claims for the future.

→ 保留更大的自由性，以便将来选择任意的权利要求组合