

AMENDMENT REQUIREMENTS in JAPAN



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Before first Office Action (OA)

Even a new set of claims can be presented,
as far as **no new matter** is introduced.

After any OA

Claimed subject matter may **not shift**
beyond the unity of the invention

After the final OA

Only **existing elements** of claims can be
further limited

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

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.”

Intermediate Concept, OK?

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

Suggestions

- When filing a Japanese or PCT application, add general and intermediate words of key elements for supporting the future amendments.
- In a Paris-route, RYUKA can add those words upon your request.
- Choose the words from the specification for amendments.

After any OA (Office Action):

The claimed subject matter may not shift

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

Example

- Claims A and B lack unity of the invention.



- Only claim A is examined.



- Canceling claim A to leave claim B:
→ Not accepted.

Suggestions

- When claims A and B might not satisfy the unity of invention requirement,
 - Present more important claims in front.
- When cancelling the first claim group in a foreign country:
 - consider filing a preliminary amendment in JP.

After Final OA: Only existing claim elements can be further limited

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.