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2016 – Study Question (Patents)

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Added matter: the standard for determining adequate support for amendments

Responsible Reporter: Ari LAAKKONEN

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I. Current law and practice

You are reminded that a reference to patent in the following questions refers to both a granted patent and an application for a patent.

If your answer differs depending on the distinction between a granted patent and an application for a patent, please answer the questions for each, as applicable.

1) Under your Group's current law, are amendments to the description and/or figures of a patent possible?

Amendments to the description and/or figures are possible during the prosecution.
Corrections to the description and/or figures are possible after the grant of a patent.

2) Under your Group's current law, are amendments to the claims of a patent possible?

Amendments to the claims of a patent are possible during the prosecution.
Corrections of the claims of a patent are possible after the grant of a patent.

3) Further to your answers to questions 1) and 2), please indicate:

a) the standard for determining whether such amendments are permissible and indicate whether this

standard exists in statutes, regulations, patent office guidelines, and/or in case law.

(1) During Prosecution

The prohibition of addition of a new matter is set forth as a requirement (determination standard) that is common to amendments to the description, claims or drawings. Specifically, amendments must be made within the scope of the matters described in the description, claims or drawings "as of the filing" (Article 17bis, paragraph (3) of the Patent Act [the same applies hereinafter]).

The requirements for an amendment are provided in law (Patent Act), and are also provided in "Part IV Amendments to Description, Claims or Drawings" in the "Examination Guidelines for Patent and Utility Model."

The requirements other than the prohibition of addition of a new matter are mentioned in our answer to question 4) below.

(2) After Grant

The prohibition of addition of a new matter is set forth as a requirement (determination standard) that is common to corrections of the description, claims or drawings. Specifically, corrections must be made within the scope of the matters described in the description, claims or drawings "as of the grant of a patent" (Article 126, paragraph (5)).

The substantive requirements for permission of a correction are provided in law (Patent Act), and are also provided in "38-03 Requirements for Correction" in the "Manual of Appeal and Trial Proceedings."

The requirements other than the prohibition of addition of a new matter are mentioned in our answer to question 4) below.

b) whether there are the differences between the substantive standards for amendments under 1) and 2) above. If so, what?

(1) Before receiving a notice of reasons for refusal

There is no difference between the substantive standards for an amendment to the description or drawings and those to the claims.

(2) After receiving a notice of reasons for refusal

There is a difference between the substantive standards for an amendment to the description or drawings and those to the claims.

The only requirement for an amendment to the description or drawings is the prohibition of addition of a new matter (Article 17bis, paragraph (3)).

In addition to the prohibition of addition of a new matter (Article 17bis, paragraph (3)), additional requirements (Article 17bis, paragraphs (4) and (5)) are imposed as the requirements for an amendment to the claims. The reason therefor is to keep amendments to the claims within the scope where the results of the examination that was already conducted can be effectively utilized.

The specific requirements for an amendment are mentioned in our answer (1) to question 4) below.

(3) After Grant

There is no difference between the requirements for a correction of the description or drawings and those for a correction of the claims.

The specific requirements for a correction are mentioned in our answer (2) to question 4) below.

4) To the extent your answer to question 3) depends on timing (e.g. after filing but before examination, after allowance but before grant, and after grant), please explain how the standard changes and during which time periods.

(1) Before receiving a notice of reasons for refusal

The only requirement (substantive standard) for an amendment to the description, drawings, or the claims is the prohibition of addition of a new matter (Article 17bis, paragraph (3)).

(2) After receiving the first notice of reasons for refusal

The only requirement (substantive standard) for an amendment to the description or drawings is the prohibition of addition of a new matter (Article 17bis, paragraph (3)).

In addition to the prohibition of addition of a new matter (Article 17bis, paragraph (3)), it is required, as another requirement (substantive standard) for an amendment to the claims, that an amendment is not to change the special technical feature of the invention (Article 17bis, paragraph (4)).

(3) After receiving the final notice of reasons for refusal

The only substantive requirement (determination standard) for an amendment to the description or drawings is the prohibition of addition of a new matter (Article 17bis, paragraph (3)).

In addition to the prohibition of addition of a new matter (Article 17bis, paragraph (3)) and the requirement that an amendment is not to change the special technical feature of the invention (paragraph (4) of the same), as another requirement (determination standard) for an amendment to the claims, amendments to the claims are limited to those made for the following purposes (paragraph (5) of the same):

deletion of a claim or claims (item (i) of the same);

limitative restriction of the claims (for example, narrowing the already claimed feature) (item (ii) of the same) (provided that the invention after the amendment must be a patentable invention; Article 126, paragraph (7), as applied mutatis mutandis pursuant to Article 17bis, paragraph (6));

correction of errors (item (iii) of the same); or

clarification of an ambiguous term in relation to the matters stated in the reasons for refusal) (item (iv) of the same).

(4) After Grant

Corrections after the grant of a patent are limited to those made for the following purposes (Article 126, paragraph (1), Article 120-5, paragraph (2), and Article 134-2, paragraph (1)):

restriction of the claims (item (i) of the same) (provided that the invention after the correction must be a patentable invention (Article 126, paragraph (7)));

correction of errors or of incorrect translations (item (ii) of the same) (provided that the invention after the correction must be a patentable invention (Article 126, paragraph (7)));

clarification of an ambiguous term (item (iii) of the same); or

elimination of the citation relation between the claims (item (iv) of the same).

Further, corrections to the description, claims or drawings must not substantially enlarge or alter the scope of claims (Article 126, paragraph (6)).

5) Further to your answer to question 3), if impermissible added matter is a ground for refusing an amendment, please explain how impermissible added matter is defined.

An impermissible added matter is defined as one that introduces a new technical matter in connection with the technical matters that are derivable from all the disclosures in the description or drawings as a whole (Examination Guidelines, Part IV, Chapter 2, "Basic Way of Thinking about Determination on New

Matter"; a judicial precedent to the same effect is the IP High Court Grand Panel decision on "Solder Resist" case (dated 30 May 2008, 2006 (Gyo-Ke) No.10563).

6) In any assessment of impermissible added matter under your Group's current law, please explain:

a) how the patent application as filed is interpreted;

Technical matters that are derivable by a person skilled in the art (a notional skilled person) from all the disclosures in the description or drawings as a whole are understood as the matters described in the description or drawings of a patent application as of the filing.

More specifically, matters that are explicitly described in the description or drawings of a patent application as of the filing (hereinafter also referred to as the "originally attached description, etc.") and matters that are obvious from the statements in the originally attached description, etc. are understood as the matters described in the description or drawings of a patent application as of the filing. Here, a matter that is obvious from the statements in the originally attached description, etc. must be a matter which the notional skilled person who sees the originally attached description, etc. considers as if the matter added by amendment is described in the originally attached description, etc., in light of the common general technical knowledge as of the filing (Examination Guidelines, Part IV, Chapter 2, "3. Specific Determination on New Matter").

Incidentally, even if an amendment does not fall under any of the amendments stated in "3.1" and "3.2," as stated in "3.3 Various amendments," the amendment is permitted unless it introduces a new technical matter in connection with the "matters described in the originally attached description, etc."

b) if interpreted as the notional skilled person would understand the patent application as filed, what is the relevant date of knowledge of the notional skilled person?

The knowledge of the notional skilled person is considered to be that as of the filing (priority date) (Examination Guidelines, Part IV, Chapter 2, "3. Specific Determination on New Matter," Section 3.2: "In order to say that an amended matter is a 'matter that is obvious from the statements in the originally attached description, etc.,' it is required that the notional skilled person who sees the originally attached description, etc. considers as if the amended matter is described in the originally attached description, etc., in light of the common general technical knowledge as of the filing.

7) If an amendment that was made to a patent application prior to grant is later reviewed by your patent office or a court in a post-grant proceeding and determined to contain impermissible added matter, is there a mechanism for the patentee to remedy the defect, for example by removing portions of the amendment found to be impermissible?

yes

Please explain:

There is a mechanism called correction.

The patentee may remedy the defect as long as the relevant deletion fulfills the substantive requirements for a correction stated in 4) above.

II. Policy considerations and possible improvements to your current law

8) How does your Group's current law strike a balance between allowing a patent applicant to make appropriate amendments during the examination process and preventing the applicant from adding impermissible matter?

The restriction on matters added through amendments is intended to permit amendments to an application on behalf of applicants. On the other hand, it is also intended to balance the interests of applicants and those of third parties while substantially securing the principle of the first to file system by refusing amendments that exceed the scope disclosed in the description as of the filing.

The Examination Guidelines first provide as follows: "The examiner shall determine whether an amendment is an amendment which adds a new matter by determining whether the amendment introduces a new technical matter in connection with the 'matters described in the originally attached description, etc.'" The Examination Guidelines then provide as follows while introducing specific judicial precedents: "In the case where an amended matter is a 'matter that is obvious from the statements in the originally attached description, etc.,' even if the amended matter is not explicitly described in the originally attached description, etc., the amendment shall be permitted because it does not introduce any new technical matter." In this manner, balance between allowing a patent applicant to make appropriate amendments and preventing the applicant from adding impermissible matters is secured through examiners' and trial examiners' determinations based on certain standards.

Furthermore, according to judicial precedents, there are some cases where even if an amended matter is not necessarily a "matter that is obvious from the statements in the originally attached description, etc.," the amendment is permitted because it is not one that "introduces a new technical matter" in connection with the technical matters that are derivable by a notional skilled person from all the disclosures in the description or drawings as a whole. However, as a constituent feature added by the amendment must not be distinctive, it is eventually refused or invalidated on the grounds of lack of an inventive step. Such trend of judicial precedents can also be evaluated as working to secure said balance.

9) Are there aspects of these laws that could be improved?

yes

Please explain:

The judicial precedents cited in the Examination Guidelines are considered to be biased toward those that are in line with the direction of the Examination Guidelines. There is room to cite a broader range of judicial precedents in the Examination Guidelines.

As mentioned above, according to judicial precedents, there are some cases where even if an amended matter is not necessarily a "matter that is obvious from the statements in the originally attached description, etc.," the amendment or correction is permitted because it is not one that "introduces a new technical matter" in connection with the technical matters that are derivable by a notional skilled person from all the disclosures in the description or drawings as a whole. However, there is no case where the involvement of an inventive step was recognized through such an amendment or correction. On the other hand, there are countless cases where an applicant got rid of a violation of the "enlarged novelty" clause (violation of Article 29-2 of the Patent Act) by disclaimer (one of the examples of such cases is the IP High Court Grand Panel decision on "Solder Resist" case dated 30 May 2008, 2006 (Gyo-Ke) No.10563). There is no problem in the case of a "disclaimer" because an invention that should be originally patented exists and the disclaimer excludes inventions other than said invention from the scope of rights. However, the practice where a patent can be granted even if an amendment is made by using a functional expression that can include a matter that cannot be considered to be a "matter that is obvious from the statements in the originally attached description, etc." should not be adopted. This is because even if there is a patentable invention, inventions that exceed said invention will be included in the scope of rights, which will disturb the balance between the patent applicant and third

parties.

The examples of the cases where such a problem became obvious are the IP High Court decision 2014 (Gyo-Ke) No.10198 and the IP High Court decision 2014 (Ne) No.10124.

- 10) Does your Group's current law allow amendments post grant? If so, how does your Group's current law strike a balance between allowing a patentee to make appropriate amendments to a granted patent (such as amendments necessary to sustain its validity) and preventing the patentee adding impermissible matter?

Amendments after grant ("corrections" in Japanese law) are allowed. Regarding the balance, the aforementioned provisions of the items of Article 126 of the Patent Act are to be strictly applied. In the case of excessive application, it is possible to seek redress from the court.

- 11) Are there aspects of these laws that could be improved?

yes

Please explain:

Our answer to this question is the same as our answer to question 9) above.

- 12) If your Group's current law uses, at least in part, the notional person skilled in the art to determine the permissibility of amendments, is this approach effective? Are there aspects of this that could be improved?

Whether an amendment is one that introduces a "new technical matter in connection with the technical matters that are derivable by a notional skilled person from all the disclosures in the description or drawings as a whole" is determined based on the technical level of the notional skilled person as of the filing date (priority date).

In this manner, incorporating the technical level of the "notional skilled person" in the determination standard is effective for keeping balance between interests. This is because if the technical level of the "notional skilled person" does not exist as a standard, it eventually becomes possible to add only the matters that are clearly specified in the originally attached description by amendment or correction, which is significantly disadvantageous to patent applicants and lacks balance.

Regarding aspects that could be improved, examiners and trial examiners make determinations as the notional skilled persons, but their technical level varies and they are not the notional skilled persons as of the filing date (priority date). As a matter of course, the parties should allege and prove the technical level of the notional skilled person as of the filing date (priority date), but there is sometimes the situation where an unexpected trial decision is rendered as a result of insufficient examination of the "technical level of the notional skilled person as of the filing date (priority date)." When the question of whether or not a new matter is added is disputed also as a problem with the level of the trial practice at the JPO, it is desired that each of the parties alleges and proves the technical level of the notional skilled person as of the filing date (priority date) and that the panel has the parties do their best to allege and prove said technical level and examines said technical level to a sufficient extent.

In addition, the information provision system at the examination stage, the post-grant opposition system, and the technical advisor system in lawsuits are available as the systems to utilize the ability of the actual "notional skilled persons." These systems have the effect of alleviating variation in

determinations.

III. Proposals for harmonisation

13) Is harmonisation of the definition of impermissible added matter desirable?

If yes, please respond to the following questions without regard to your Group's current law. Even if no, please address the following questions to the extent your Group considers your Group's laws could be improved.

yes

Please explain:

Yes, it is desirable. The definition of impermissible added matter should be harmonised.

Technical ideas have in principle no borders in the same manner as the saying "Music has no borders." Therefore, it is ideal that the scope of a patent right granted to one technical idea under the principle of absolute novelty is always the same. This is considered to eventually contribute to the establishment of an effective international patent portfolio.

However, actually, the scope of a patent right granted for one technical idea differs from one country to another depending not only differences in language and differences in the requirements for patentability, such as novelty, an inventive step, and description requirements, but also differences in the requirements for an amendment or correction.

In order to eliminate one of the causes of difference in the scope of a patent right, the harmonisation of the definition of impermissible added matter is desirable.

14) If yes, please propose a definition of impermissible added matter that you believe is appropriate.

In Japan, permissible added matter is deemed as "one that does not introduce any new technical matter in connection with the technical matters that are derivable by a notional skilled person from all the disclosures in the description or drawings as a whole" (IP High Court Grand Panel decision on "Solder Resist" case dated 30 May 2008, 2006 (Gyo-Ke) No.10563).

In the case of narrowing (restricting) a claim by adding a limitation, (1) not only the matters that are explicitly described in the description or drawings (2) but also the matters that are obvious from the disclosures in the description or drawings are deemed to be permissible added matters that can be added by correction (amendment) unless there are special circumstances. That is, an amendment to a claim is permissible that adds "an obvious matter that is derivable by a notional skilled person from all the disclosures in the description or drawings as a whole," even if such matter is not explicitly described in the description or drawings (the same decision).

The purpose to restrict the matters to be added by amendment is to balance the interests of applicants and those of third parties by prohibiting amendments that exceed the scope disclosed as of the filing as well as allowing amendments to an application on behalf of applicants.

Therefore, even a matter that is not explicitly described in the description or drawings should be deemed to be a permissible added matter, provided that it is within the scope of "the matters that are derivable by a notional skilled person from all the disclosures in the description or drawings as a whole" (for example, obvious matters). This is because no third party who acts on the premise of the scope of an invention disclosed as of the filing would suffer an unpredictable disadvantage and because it is difficult to unambiguously describe an invention, which is an intangible technical idea, in the description or drawings as of the filing without a knowledge of all possible prior art which might be

cited after the filing.

Accordingly, the Japanese Group proposes that an impermissible added matter is defined as an added matter that exceeds “the matters that are derivable by a notional skilled person from all the disclosures in the description or drawings as a whole” (for example, obvious matters).

15) Should this definition depend on when an amendment is made (for example, after filing but before examination, after allowance but before grant, and after grant)?

no

Please explain:

No, the definition of "impermissible added matter" should not vary depending on when an amendment is made.

The purpose not to permit the introduction of a new technical matter is to ensure the sufficient disclosure of an invention as of an original filing so as to substantially secure the principle of the first to file system. Therefore, the criterial "description or drawings" for determining if the to-be-added matter is permissible should be those as of the filing, and there is no reason that said standard depends on when an amendment is made.

16) Should rules against impermissible added matter prohibit the addition of claims per se, as opposed to adding limitations to claims?

No, the addition of claims per se should not be prohibited.

This is because no third party who acts on the premise of the scope of an invention disclosed as of the filing would suffer an unexpected disadvantage as long as a to-be-added claim is within the scope of “the obvious matters that are derivable by a notional skilled person from all the disclosures in the description or drawings as a whole.”

17) Should rules against impermissible added matter prohibit the removal of claims per se, as opposed to removing limitations from claims?

no

Please explain:

No, the removal of claims per se should not be prohibited because it does not cause any unpredictable disadvantage to third parties.

18) Should the definition of impermissible added matter be the same when applied by a patent office as when applied by a court?

yes

Please explain:

Yes, the definition of an impermissible added matter should be the same when applied by a patent office as when applied by a court.

The purpose not to permit the introduction of a new technical matter is to ensure the sufficient disclosure of an invention as of an original filing so as to substantially secure the principle of the first to file system. Therefore, the criterial "description or drawings" for determining if the to-be-added matter

is permissible should be those as of the filing (priority date), and there is no reason for said standard to depend on when a determination is made or which organization makes a determination.

19) If your proposed definition refers to the notional skilled person, what should be the relevant date of knowledge for the notional skilled person in evaluating the permissibility of an amendment?

The relevant date of knowledge for the notional skilled person in evaluating the permissibility of an amendment should be the time of the filing of a patent application (priority date, if appropriate).

This is because the permissibility of an amendment should be evaluated in a manner that no third party who acts on the premise of the scope of an invention disclosed as of the filing (priority date, if appropriate) would suffer an unpredictable disadvantage.

20) If the deletion of impermissible added matter by amendment would result in an impermissible extension of scope, how should the impermissible added matter defect be remedied in these circumstances?

Before the grant of a patent, the procedure for remedying an impermissible added matter defect should be permitted. The amendment dismissal procedure that blocks the retroactive effect of amendments, the divisional application system, and the system that permits the submission of multiple draft amendments can be enumerated.

On the other hand, after the grant of a patent, the following procedures are conceivable in order to keep balance between the interests of applicants (patentees) and those of third parties.

(1) To give the opportunity to remedy the impermissible added matter defect by exceptionally permitting the broadening of scope, which is in principle impermissible, only for a prescribed short period of time, such as two years after the grant of the patent, comparable to the reissue system in the United States, even if the deletion of an impermissible added matter by amendment would result in an impermissible broadening of the scope.

(2) To apply different interpretation rules in different phases. That is, during the course of an infringement lawsuit in determining whether an accused product falls under the technical scope of a patented invention, the impermissible added matter defect is remedied by finding the technical scope of the patented invention in the form of including the impermissible added matter in the constituent features of the patented invention. On the other hand, in determining the validity of a patent in a trial for patent invalidation, etc., the impermissible added matter defect is remedied by finding the gist of the invention in the form of not including the impermissible added matter in the constituent features of the invention.

21) Please comment on any additional issues concerning any aspect of impermissible added matter you consider relevant to this Study Question.

None

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Summary

It is desirable that the definition of impermissible added matter should be harmonized. The Japanese Group proposes that an impermissible added matter is defined as an added matter that exceeds the matters that are derivable by a notional skilled person from all the disclosures in the description or drawings as a whole. It is also proposed that the above definition should not vary depending on when an amendment is made, and that the definition should be the same when applied by a patent office as when applied by a court. Further, the relevant date of knowledge for the notional skilled person in evaluating the permissibility of an amendment should be the time of the filing of a patent application. If the deletion of impermissible added matter by amendment results in an impermissible extension of scope, such an impermissible added matter defect should be remedied in consideration of relative interests of applicants or patentees and third parties. In this respect, the Japanese Group also proposes two types of remedial measures as described in the main report.