

## 4 Amendment that Changes a Special Technical Feature of an Invention and Requirements of Unity of Invention<sup>(\*)</sup>

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*The Act for Partial Revision of the Design Act, etc. was put into force on April 1, 2007. Thereby, Article 17-2(4) of the Patent Act has come to prohibit applicants from making an amendment that changes the invention mentioned in the claims which has been examined into an invention that technically differs from said invention after receiving a notice of reasons for refusal.*

*In addition, the Examination Guidelines for Patent and Utility Model were revised in March 2007 in order to respond to the revised Act of 2006.*

*However, users point out that the practice concerning "amendment that changes a special technical feature of an invention" and the "requirements of unity of invention" is excessively rigid. In addition, there are requests for consideration of revision of the Examination Guidelines from the perspective of international harmonization.*

*Given this factor, we conducted this study with the aim of preparing basic materials to be used in considering revision of the Examination Guidelines concerning amendment that changes a special technical feature of an invention and the requirements of unity of invention as well as the practice thereof by studying and analyzing the past practice of the Examination Guidelines concerning "amendment that changes a special technical feature of an invention" and the "requirements of unity of invention," and similar examination standards and the practice thereof in major countries.*

### I Purpose of This Study

With regard to an "amendment that changes a special technical feature of an invention," the Examination Guidelines state as follows: "If the invention first mentioned in the claims before an amendment does not have any special technical feature, no same or corresponding special technical feature can be found between said invention and an invention after the amendment. Therefore, it cannot be said that the requirements of unity of invention are met in the relationships between all of the inventions that were examined in terms of the requirements for patentability, such as novelty and inventive step, in the claims before the amendment and all of the inventions in the claims after the amendment." In this regard, users point out that such practice is far from the legislative purpose of Article 17-2(4) of the Patent Act and is excessively rigid. In addition, there are requests for revision of the Examination Guidelines from the perspective of international harmonization of amendment systems.

Moreover, with regard to the practice of the "requirements of unity of invention," it has been pointed out that if the invention first mentioned in the claims does not have any special technical feature, severer determination is made based on the practice in Japan compared to the practice in Europe, etc. and inventions subject to

examination are very limited.

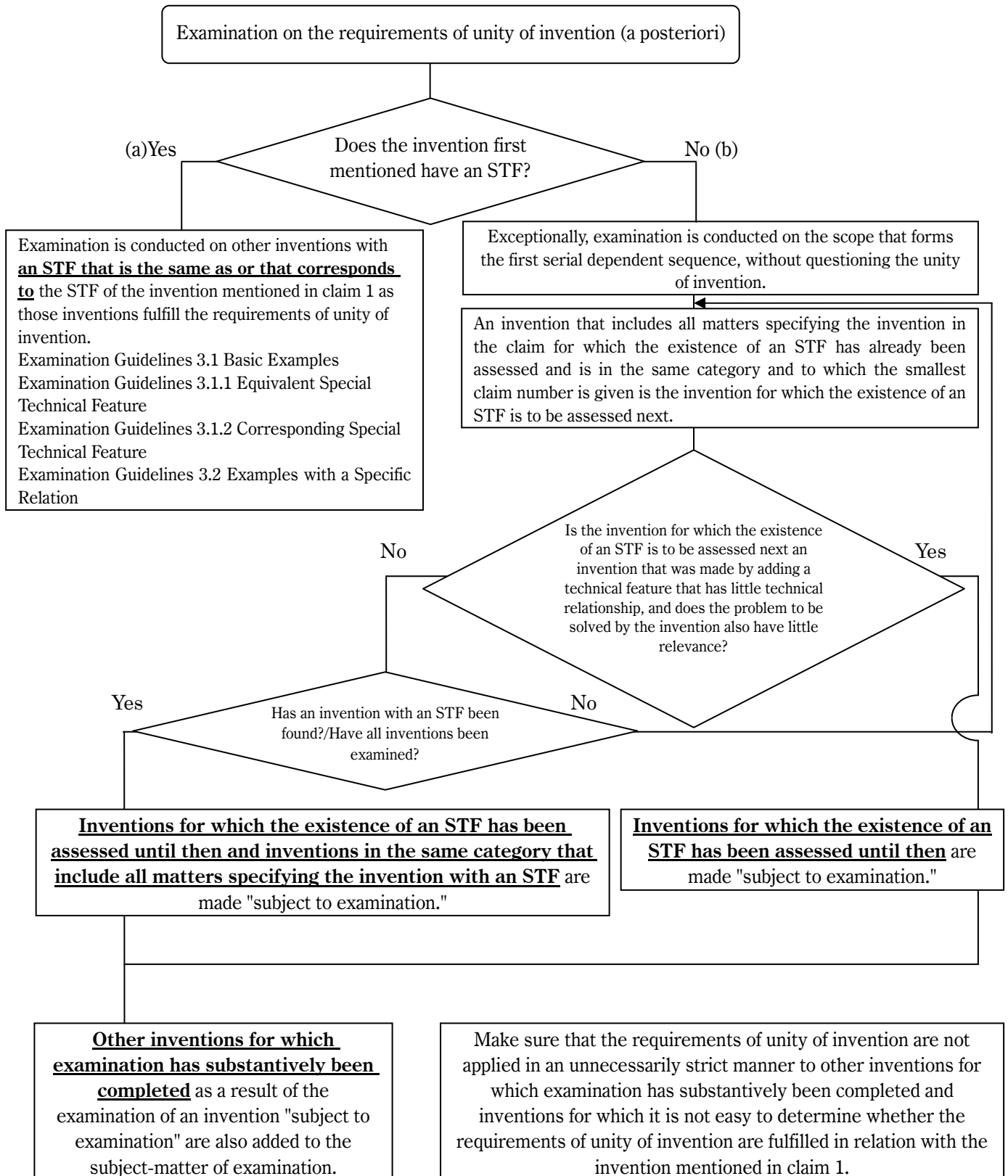
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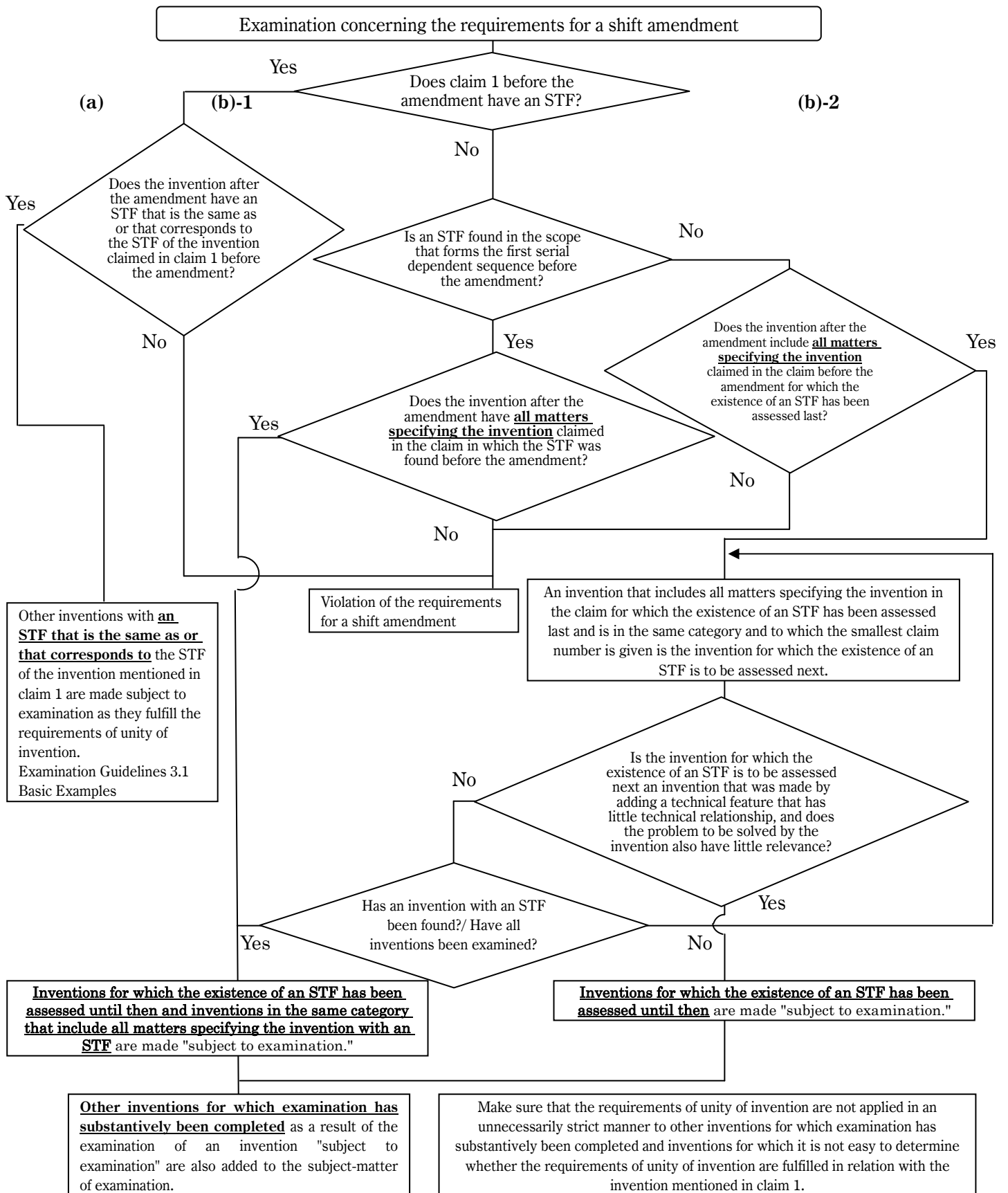
(\*) This is an English translation of the summary of the FY2011 JPO-commissioned research study report on the issues related to the industrial property rights system.

## II System in Japan

### 1 Examination on the requirements of unity of invention



**2 Examination concerning the requirements for an amendment that changes a special technical feature**



### III Results of the Domestic User Survey

#### 1 Method of conducting the domestic user survey

##### (1) Selection of survey targets

Domestic questionnaire survey

We received answers from 138 respondents in total, comprising 77 applicants (chemical, material, and medicine manufacturing/machinery/electric equipment and telecommunications/other) and 61 patent firms. The response rate was 68%.

Domestic interview survey

We selected 14 applicants and 16 patent firms from among the respondents of the questionnaire survey and conducted interviews with them.

##### (2) Content of the survey

Domestic questionnaire survey

The outline of the questionnaire survey is as follows.

- Devices made at the time of filing corresponding to the requirements of unity of invention and the requirements for a shift amendment
- Changes in the tendency toward divisional applications, etc. corresponding to the requirements of unity of invention and the requirements for a shift amendment
- Examination concerning the requirements of unity of invention and the requirements for a shift amendment
- Examination Guidelines concerning the requirements of unity of invention and the requirements for a shift amendment
- International harmonization of examination practice concerning the requirements of unity of invention and the requirements for a shift amendment
- Fee opinions concerning the requirements of unity of invention and the requirements for a shift amendment, and so on

Domestic interview survey

The interview survey was conducted from the following perspectives.

- Examination practice concerning the requirements of unity of invention in cases where the invention claimed in claim 1 does not have any STF
- Examination practice concerning shift

amendment in cases where the invention claimed in claim 1 before the amendment does not have any STF

- Assessment concerning STF
- Examination practice concerning the requirements of unity of invention and shift amendment in consideration of applicants' benefits and examiners' burden
- Responses made by overseas applicants

##### (3) Results of the domestic questionnaire survey

###### (i) Regarding the requirements of unity of invention

73% and 74% of all respondents answered that they were "dissatisfied with" examination practice and the Examination Guidelines, respectively.

Comparing reasons for which the respondents are dissatisfied with examination practice and the Examination Guidelines, most respondents answered that they were "dissatisfied with" them for the reason that "the scope subject to examination is narrow in cases where claim 1 has been found to lack novelty" and that "the scope subject to examination is narrow in cases where the invention first mentioned in the claims does not have any special technical feature," accounting for 90% and 89% of all dissatisfied respondents, respectively.

###### (ii) Regarding the requirements for a shift amendment

63% and 75% of all respondents answered that they were "dissatisfied with" examination practice and the Examination Guidelines, respectively.

Comparing reasons for which the respondents are dissatisfied with examination practice and the Examination Guidelines, most respondents answered that they were "dissatisfied with" them for the reason that "the conditions for an amendment are excessively strict in cases where the invention in claim 1 before the amendment has been found to lack novelty" and that "the scope that becomes subject to examination without questioning the requirement set forth in Article 17-2(4) is narrow in cases where the invention first mentioned in the claims before the amendment does not have any special technical feature," accounting for 96% and 85% of all dissatisfied respondents, respectively.

###### (iii) Regarding international harmonization

Although 24% of all respondents answered that the requirements of unity of invention were

in harmony with the examination practice of other countries, 48% thereof answered that the requirements were severer compared to the examination practice of other countries. In addition, regarding the requirements for a shift amendment, 63% of all respondents answered that the requirements were severer compared to the examination practice of other countries.

#### **(4) Free answers in the domestic questionnaire survey and the results of the interview survey**

##### **(i) Regarding the entire system**

There are many opinions that point out problems with the entire system.

Problems have been pointed out from the perspective of protection of rights, burden of consideration, international harmonization, etc.

Although there are opinions that value the point that the current practice has brought about certain effect, such positive opinions are only a few.

With regard to the future direction, there are significant requests for relaxation from the perspective of the purpose of the system, the current status of filing in Japan, international harmonization, etc. Flexible practice is desired.

##### **(ii) Unity**

- Examination when the invention first mentioned in the claims does not have any STF

Under the current practice, when the invention first mentioned in the claims does not have any STF, it is construed that lack of unity occurs in relation with other inventions, and exceptionally, the inventions in the first serial dependent sequence are examined. Regarding this examination, there were opinions pointing out severity of the construction of lack of unity, which is a premise of the examination, and relevant practice.

##### **(iii) Shift amendment**

- Examination when the invention first mentioned in the claims does not have any STF

An applicant can make an amendment only based on an invention in the same category that includes all matters specifying the invention with

an STF before the amendment or an invention in the same category that includes all matters specifying the invention before the amendment for which the existence of an STF has been assessed last.

There are great many requests for relaxation of the requirements for an amendment based on an invention "in the same category that includes all matters specifying the invention." Such requests were especially numerous in free answers in the questionnaire survey and in the interview survey.

## IV Systems in Other Countries

### 1 Provisions of other countries

#### (1) Requirement of unity

	Requirements of unity	
	Provisions on "a single general inventive concept"	Provisions on the "same or corresponding special technical feature"
Japan	Article 25-8 of the Ordinance	Article 25-8 of the Ordinance
PCT	Rule 13.1	Rule 13.2
Europe	Article 82 of the Convention	Rule 44
China	Article 31 of the Patent Law	Rule 34 of the Implementing Regulations
South Korea	Article 45 of the Patent Act	Article 6 of the Enforcement Ordinance
United States	The standard for requirement for restriction is inclusion of independent and distinct inventions in one application, and there are no laws or regulations that provide for a single general inventive concept or the same or corresponding special technical feature. Laws and regulations concerning requirement for restriction: Section 121 of the patent law and Sections 1.141 and 1.142 of the Patent Rules	

#### (2) Amendment that changes a special technical feature

	Amendment that changes a special technical feature
Japan	Article 17-2(4) of the Patent Act
PCT	—
Europe	Rule 137(5)
China	No provisions; there are operational guidelines based on the examination standards.
South Korea	No provisions
United States	Section 1.145 of the Patent Rules

### 2 Comparison between practice in Japan and that in other countries

#### (1) Examination concerning unity in cases where the invention first mentioned in the claims does not have any STF

In Japan, where the invention first mentioned in the claims does not have any STF, it is understood that "it cannot be said that the requirement of unity of invention is met," and "the requirement of unity of invention will not be questioned exceptionally for inventions that become the subject of the examination through the following procedure" (hereinafter the procedure is referred to as the "exceptional examination"). In the exceptional examination, inventions in the first serial dependent sequence and other inventions for which examination has substantively been completed as a result of examination of said

inventions become subject to the examination.

In Europe, China, and South Korea, fulfillment of the requirements of unity is examined in terms of two or more inventions that are in a parallel relationship (hereinafter referred to as "parallel examination"), irrespective of whether the invention claimed in claim 1 has an STF. For example, where there are two or more independent claims, examination concerning unity based on the same or corresponding STF is conducted between those independent claims while where two or more dependent claims directly depend on an independent claim that lacks novelty, such examination is conducted between those dependent claims.

Where an independent claim does not have any STF and it is necessary to examine its dependent claims in terms of the requirements for patentability, including novelty, in both the exceptional and parallel examinations, the scope

of examination could be changed according to the extent of the inventive link among parallel and serial claims.

Given this factor, we consider the link among two or more inventions in the exceptional examination in Japan and the parallel examination overseas.

In the exceptional examination in Japan, the serial examination of claim 1 and subsequent claims is discontinued "where (the invention in a claim for which the existence of a special technical feature is to be assessed next) is an invention that was made by adding a technical feature that has little technical relationship (to the invention for which the existence of a special technical feature has been just assessed), and the specific problem to be solved by the invention, which is understood from said technical feature, also has little relevance."

That is, where a claim that serially depends on a claim falls under the aforementioned conditions, this dependant claim may not become subject to examination in some cases.

It cannot also be said that lack of unity is not at all pointed out among serial claims that are in a dependent-depended relationship in Europe, China, and South Korea. However, these countries adopt a practice in which a dependent claim with novelty substitutes for an independent claim, and even where a depended claim lacks novelty, the procedure whereby a claim depending on said depended claim substitutes for the depended independent claim is repeated in series, and the serial examination is continued in principle.

In the exceptional examination in Japan, the parallel examination covers "inventions in the same category that include all matters specifying the invention ..." and "other inventions for which examination has substantially been completed...." The scope of examination is narrower than the scope based on the same or corresponding STF.

In the case of Europe, China, and South Korea, the subject of said examination is based on the same or corresponding STF in the same manner as where an invention has an STF. Therefore, the scope of the subject-matter of said examination in Japan is highly likely to be narrower than that in those countries.

## **(2) Amendment that changes a special technical feature**

Amendments which becomes subject to the exceptional examination in Japan without

questioning the requirement set forth in Article 17-2(4) are amendments based on an invention in the same category that includes all matters specifying the invention with an STF before the amendment or an invention in the same category that includes all matters specifying the invention before the amendment for which the existence of an STF has been assessed last.

In Europe and China, amendments are not required to be "amendments based on an invention in the same category that includes all matters specifying the invention with an STF before the amendment or an invention in the same category that includes all matters specifying the invention before the amendment for which the existence of an STF has been assessed last."

## **V Conclusion**

### **1 Regarding the entire system**

#### **(1) Examination burden**

Examination burden related to finding of an STF is increasing under the present circumstances.

#### **(2) International harmonization**

In particular, the practice in Japan is not in harmony with the practice in other countries in terms of cases where the invention first mentioned in the claims does not have any STF.

At the same time, according to the user questionnaire survey in Chapter II, only 15% of all respondents answered that the examination practice for shift amendment in Japan was in harmony with that in other countries (24% answered in this manner for the practice for unity).

In light of the aforementioned actual conditions concerning the purpose of legal revision and user opinions, we consider it necessary to review the practice in consideration of the original purpose.

### **2 Examination concerning unity**

The current examination practice in Japan is a cause of narrow scope of the subject-matter of examination. In addition, it can hardly be said to be in harmony with the practice in other countries. We consider it necessary to hold discussions to have examination conducted based on the same or corresponding STF even in cases where the

invention first mentioned in the claims does not have any STF, in conformity with the practice in other countries.

### **3 Examination concerning an amendment that changes a special technical feature**

Under the current examination practice in Japan for the case where the invention first mentioned in the claims before the amendment does not have any special technical feature, amendments are required to be based on an invention in the same category that includes all matters specifying the invention with an STF before the amendment or an invention in the same category that includes all matters specifying the invention before the amendment for which the existence of an STF has been assessed last. This is a cause of the evaluation that restrictions on amendments in Japan are severe. In addition, this practice can hardly be said to be in harmony with the practice in other countries. We consider it necessary to review the practice concerning "inventions in the same category that include all matters specifying the invention...."

It is important to improve the practice in the future in consideration of applicants' benefits and examiners' burden.

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