

To What Extent Is Amendment For Broader Concept of Claim Allowed Based on the Description in the Specification?*

by Atsushi MAEDA**

1. Introduction

Prior to the amendment of the Patent Law in 1993, amendments were judged based on whether or not they applied to a “change of gist,” and a relatively high degree of freedom of amendment was granted.

The 1993 amendment of the Patent Law introduced the “prohibition of addition of new matter” as a criterion for judging amendments to claims, specifications, etc. The examination guidelines stipulated that the scope of possible amendments should be “matters that can be directly and unambiguously derived by a person skilled in the art from the matters described in the original specification, etc. at the time of application”. In this connection, the requirements for amendments were criticized because they were too strict.

The 2003 revision of the examination guidelines changed the scope of amendments to “matters explicitly described in the original specification, etc.” and “matters obvious from the description in the original specification, etc.”, and amendments were allowed to the extent that they are obvious based on the description.

In addition, the examination guidelines were revised to the current ones following the 2008 IP High Court Grand Panel decision on a solder resist (Intellectual Property High Court decision, Heisei 18 (Gyo-Ke) No. 10563). Under the current examination guidelines, with regard to the limitation on the content of amendments, an amendment that does not introduce a new technical matter is not considered to be addition of a new matter.

With such a shift in the scope of permissible amendments, it is interesting in practice to see to what extent an amendment for a broader concept is allowed based on the description of the original specification at the time of application.

Therefore, the following will examine the limits on broadening the concept at the time of amendment, correction, or divisional application, based on case studies 1 to 4, in which amendments were allowed for a broader concept, and case studies 5 and 6, in which amendments were not allowed for a broader concept.

2. Summary of Cases Studies

(1) Case Study 1 (Case 7 of Casebook)

Annex A of the Examination Handbook for Patent and Utility Model in Japan provides, in “7. Corrections for adding new matters (Paragraph 3 of Article 17-2 of the Patent Law)” (merely referred to as “casebook” below), hypothetical cases in accordance with the examination criteria for addition of a new

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** Patent Attorney,
Fukami Patent Office, P.C.

matter.

For case 7 of the casebook, an amendment for a broader concept from a “recessed molded surface” to a mere “molded surface” is described as a case for which amendment for a broader concept is allowed. The reason why this amendment is allowed is as follows. (Underlined by the author.)

“A problem to be solved by the invention of the present application is to provide a molding die for optical elements with excellent mold release and durability at high temperatures by improving a coating film covering a surface of the molding die for optical elements, and the shape of the molded surface of the molding die for optical elements is not directly related to solving such a problem. Therefore, the shape of the molded surface of the molding die is not an essential element as a means for solving the above problem, and is an optional additional element to the invention of the present application and does not introduce any new technical matter.”

In case study 1, it is concluded that an amendment for a broader concept to delete an optional element, which is not directly related to solving the problem and is not an essential element as a means for solving the problem, does not introduce a new technical matter.

(2) Case Study 2 (Heisei 26 (Gyo-Ke) No. 10087)

Case study 2 is a litigation case, rescinding a trial decision against an invalidation trial decision that did not allow a request for correction because it introduced a new technical matter, and some claims were declared invalid.

A correction was made to add the description for a broader concept from “suspending the measuring unit” to “holding the measuring unit”.

The original specification at the time of filing describes that the “movable arm” “suspends and holds the measurement unit” and includes “mount”, “attach”, etc. in addition to “suspend”.

The court held as follows as to whether this correction was addition of a new matter. (Underlined by the author.)

“... A person skilled in the art who reads the description of the present specification would understand that how to attach the measurement unit to the movable arm is not an essential matter in the subject invention, and that it is sufficient if the measurement unit is held on the movable arm so as to exert its function. In addition, considering the above-mentioned technical common sense at the time of filing of the subject patent, it is considered that the measurement unit being attached to the movable arm in a manner of ‘being buried’ other than ‘being suspended’ is obvious from the specification.

... Further, even if there is a specific difference in the function and effect between ‘suspended’ and ‘buried’ for the measuring unit, this is not directly related to the technical significance of subject invention 7 described in the specification, and considering the technical common sense at the time of filing of the subject patent, it does not affect the above decision that the corrected invention 2 is obvious from the matters described in the specification of the present application.”

In case study 2, it is judged that when the corrected matter for a broader concept is not an essential matter in relation to the problem to be solved by the invention, it is an obvious matter from the description of the original specification, etc., even if it is not explicitly described.

(3) Case Study 3 (Heisei 26 (Gyo-Ke) No. 10242)

Case study 3 is a litigation case rescinding a trial decision against a board decision of rejection to maintain a decision of rejection that rejected an amendment on the ground that the amendment fell under the addition of a new matter.

The recitation of claim 1 before amendment “... (8) The width of the shredder auxiliary unit is about 35 cm because the width of the blade of the shredder

Current Issues in IP

machine body depends on the manufacturer or the model of the shredder machine. It is wide enough to fit A3 paper vertically.” was amended to “... (8) The width of the shredder auxiliary unit is equal to the corresponding width to fit the width of the blade of each shredder model of each manufacturer, because the width of the blade of the shredder machine body depends on the manufacturer or the model of the shredder machine.

The original specification at the time of filing describes “(1) The width of the blade of the shredder machine body depends on the manufacturer or the model of the shredder machine. (2) As the shredder auxiliary unit is attached, a child’s finger will not reach the blade of the shredder machine body, thus preventing injuries such as finger amputation.”

The court held as follows as to whether this amendment was addition of a new matter. (Underlined by the author.)

“In light of the technical problem and the function and effect of the invention disclosed in the original specification, etc., as well as the specific shape of the shredder auxiliary unit disclosed therein, it is difficult to understand that the width of the shredder auxiliary unit disclosed in the original specification, etc. was fixed to one width. Rather, it is clear that it was assumed that the width of the shredder auxiliary unit was fixed to the width of the paper inlet of the shredder machine body, i.e., the width of the blade corresponding to it. (8) The width of the shredder auxiliary unit is equal to the corresponding width to fit the width of the blade of each shredder model of each manufacturer, because the width of the blade of the shredder machine depends on the manufacturer or the model of the shredder.’ and each of the matters ... should be obvious from the description of the original specification, etc.”

In case study 3, it is concluded that when the specific numerical values are understood to be merely described as representative examples from the viewpoint of solving the technical problem of the invention, taking into account the technical problem and the function and effect of the invention disclosed in the original specification, etc., as well as the specific shape of the invention disclosed therein, amendment

for a broader concept by deleting specific numerical values is considered to be an obvious matter from the description of the original specification, etc.

(4) Case Study 4 (Heisei 31 (Gyo-Ke) No. 10046)

Case study 4 is a court case in which a divisional application for a broader concept of a claim was challenged as to whether it satisfied the requirements for division.

The original specification, etc. at the time of filing the present application discloses that the claw provided in the mounting plate fits with the recess provided in the circuit breaker, and that the fitting portion of the lock lever provided in the circuit breaker fits with the fitting portion (corresponding to the recess) provided in the mounting plate, as the manner of fitting for regulating the movement of the circuit breaker. In other words, the original specification, etc. describes a manner in which an engaging portion is provided in one member and a fitting portion is provided in the other member, but does not describe a manner in which the fitting portion is provided in one member and the engaging portion is provided in the other member.

Claim 1 of the divisional application recites “the vertical movement of the circuit breaker with respect to the mounting plate is regulated by the fitting portion and the fitting target portion, respectively provided corresponding to the mounting plate and the circuit breaker, being fitted to each other”. (Underlined by the author.)

The court held the conformity of the requirements for division as follows (Underlined by the author.)

“... It should be regarded that whether mounting plate 2 or circuit breaker 1 has a claw or a recess and the specific manner of fitting are not directly related to the solution to the above problem.

Considering the above, the configuration of requirement A in the subject invention, ‘the vertical movement of the circuit breaker with respect to the

Current Issues in IP

mounting plate is regulated by the fitting portion and the fitting target portion, respectively provided corresponding to the mounting plate and the circuit breaker, being fitted to each other', does not introduce any new technical matter in relation to the matter derived from the whole description of the original specification, etc. at the time of filing of the present application. This configuration is recognized as being within the scope of the matter described in the original specification, etc. at the time of filing of the present application."

In case study 4, it is judged that when the configuration of the claim amended for a broader concept is not directly related to the solution to the problem of the invention, it is within the scope of the matter described in the original specification, etc. even if there is no explicit description.

(5) Case Study 5 (Heisei 27 (Gyo-Ke) No. 10245)

Case Study 5 is a litigation case, rescinding a trial decision against a validation trial decision that maintained the patent while acknowledging that the amendment did not fall under the addition of a new matter.

As a result of the amendment, the recitation "the wiping arm drive unit moves the wiping arm through the clearance between the toilet bowl and the toilet seat" was added to claim 15.

The original specification at the time of filing describes only an embodiment of the wiping arm drive unit that drives the wiping arm through the clearance between the toilet bowl and the toilet seat created when the toilet seat is raised by the toilet seat elevating unit.

Therefore, a point of issue here is whether the amendment to specify "the clearance between the toilet bowl and the toilet seat," which is not limited to the clearance "created when the toilet seat is raised by the toilet seat elevating portion" is addition of a new matter.

According to the trial decision, it is obvious to a person skilled in the art that the toilet seat elevating

portion is not always necessary to achieve the object of the subject invention, but it is only necessary that a clearance be formed between the toilet bowl and the toilet seat to move the wiping arm. According to the publication of patent application, creating a clearance between the toilet bowl and the toilet seat without the toilet seat elevating portion has been publicly known prior to filing of the subject patent. Therefore, it is concluded that a clearance between the toilet bowl and the toilet seat for moving the wiping arm, which is not limited to the clearance created when the toilet seat is raised by the toilet seat elevating portion, can be substantially the same as that described in the original specification, etc.

The court held as follows as to whether this amendment was addition of a new matter. (Underlined by the author.)

"As described in 1(1) above, a toilet seat elevator is described as a means for creating a clearance between the toilet bowl and the toilet seat, but no other means is described or suggested in the description of the original specification, etc.

In other words, the invention before the amendment specifies only the toilet seat elevating device as its technical element, as a means for creating a clearance between the toilet bowl and the toilet seat.

Considering the above, the introduction of a means other than the toilet seat elevating device as a means for creating a clearance between the toilet seat and the toilet bowl is nothing but the addition of a new technical matter, and as stated above, this means is not described in the original specification, etc. Therefore, this amendment is deemed to add a new matter.

In case study 5, even if the matter amended for a broader concept is a configuration not directly related to the solution to the problem of the invention, when there is no clue at all in the description of the original specification that can be understood as applicable to the configuration amended for a broader conception, the new technical matter is judged to be added.

Current Issues in IP

(6) Case Study 6 (Heisei 31 (Gyo-Ke) No. 10026)

Case study 6 is a lawsuit rescinding a trial decision against a patent invalidation trial decision that concluded that the amendment fell under the addition of a new matter.

As a result of the amendment, the configuration of claim 1 “comprising a valve seat with which the valve body is contactable, a fluid pressure induction chamber that holds the valve body in a state in which it is advanced toward the output member by a fluid pressure in the fluid chamber, and a fluid pressure introduction channel that connects the fluid chamber to the fluid pressure induction chamber” was deleted, while the component “an elastic member that elastically urges the large-diameter shaft portion of the valve body toward the fluid chamber and holds the valve body in a state in which it is advanced toward the fluid chamber” was added.

The court held as follows as to whether the amendment was addition of a new matter. (Underlined by the author.)

“Thus, in Embodiment 2, hydraulic pressure introduction chamber 53 and hydraulic pressure introduction channel 54 can be regarded as components linked to the effects of the invention.

... As described above, in the description of the original description, etc., in the configuration of Example 2, urging by the hydraulic pressure is mainly performed by hydraulic pressure introduction chamber 53 and hydraulic pressure introduction channel 54, and urging by compression coil spring 53a is subsidiarily performed.... From such a configuration, it should be considered that it is impossible to eliminate the main configuration related to urging by the hydraulic pressure and introduce a configuration in which urging is performed only by a merely auxiliary compression coil spring. This is even more so that in Embodiment 2, hydraulic pressure introduction chamber 53 and hydraulic pressure introduction channel 54 are described in connection with the effects of the invention.... There is no disclosure of a configuration without a hydraulic pressure introduction chamber and a hydraulic pressure introduction channel in

other parts of the original specification, etc. at the time of filing of the present application.

Therefore, the configuration in which the valve body is held while being advanced toward the output member only by the elastic member without providing the fluid pressure inlet chamber and the fluid pressure introduction channel in the open/close valve mechanism is not a technical matter that can be derived by a person skilled in the art by taking into account the whole description of this original specification, etc.”

In case study 6, it is concluded that the amendment to delete a configuration linked to the effects of the invention (the reverse of the problem) by amendment introduces a new technical matter if there is no disclosure of the configuration after the amendment in the original specification, etc.

3. Requirements to Ensure that Amendment for Broader Concept Does Not Result in Addition of New Matter

(1) Non-Essential Matter not Directly Related to the Problem to be Solved by the Invention

As can be seen from the above case studies, in order to prevent a matter amended for a broader concept from being regarded to be addition of a new matter, the requirement is that the matter amended for a broader concept is not an essential matter directly related to a problem to be solved by the invention.

Therefore, whether a matter amended for a broader concept falls under the addition of a new matter may depend on how a problem to be solved by the invention is recognized.

The Examination Guidelines state an object of the invention as follows.

In principle, the examiner identifies a problem to be solved by the invention from the statement in the description. The examiner, however, identifies the problem while taking into account the common general knowledge

Current Issues in IP

at the time of filing in addition to all of the statements in the description and drawings in either (i) or (ii) of the following cases:

- (i) when any problem is not clearly indicated in the description; or
- (ii) when, ... it is unreasonable as a problem to be solved by the claimed invention in light of the other parts of the statement in the description and/or the common general knowledge at the time of filing.

In the above cases 1 through 6, the object of the invention is also certified based on the description of the detailed description of the invention. In other words, a problem to be solved by the invention is, in principle, recognized as being described in the specification.

The problem to be solved by the invention is not limited to the problem described in the [Problem to be Solved by the Invention] field of the specification, but in case study 2, the problem corresponding to the invention including a matter amended for a broader concept is identified based on the description in the [Means for Solving the Problem] field.

(2) Interchangeability and Ease of Interchange Based on the Standard at the Time of Filing

In case studies 5 and 6 above, it is judged that, in order to prevent a matter amended for a broader concept by deletion of a configuration from falling under the addition of a new matter, it should be understood from the description of the specification, etc., that this configuration is interchangeable with a configuration other than the configuration in question.

In the above case study 2, it is judged necessary that, with respect to the configuration to be amended for a broader concept, multiple forms be explicitly described in the specification, or even if there is no explicit description, a person skilled in the art derive multiple forms from the description of the specification, etc., taking into account the technical common sense at the time of filing of the patent application (in the case of divisional application, at the time of the filing of the original application).

Taking all of the above into consideration, it is possible that it will be judged that, in order to prevent a matter amended for a broader concept from falling under the addition of a new matter, the interchangeable forms included in the broader concept must be recognized from the description of the specification, etc. (interchangeability) as described in case studies 5 and 6, and the interchangeable forms must be derived from the description of the specification, etc. in consideration of the technical common sense at the time of filing (ease of interchange based on the standard at the time of filing) as described in case study 2.

When the interchangeability and the ease of interchange based on the standard at the time of filing are not recognized, amendment may be judged as addition of a new matter even if the matter amended for a broader concept is not an essential matter directly related to the problem to be solved by the invention.

4. Conclusion

(1) Limitations on Amendment for Broader Concept

As stated above, it is considered necessary to satisfy requirements for non-essential matter, interchangeability, and ease of interchange based on the standard at the time of filing, which are similar to the first requirement (non-essential part), the second requirement (interchangeability), and the third requirement (ease of interchange at the time of infringement) of the Doctrine of Equivalents, as requirements to prevent amendment for a broader concept from falling under the addition of a new matter.

Therefore, as a limitation on describing a specific description of the specification in a claim by broadening its concept at the time of amendment, correction, or divisional application, it is possible that the amendment for a broader concept may be permitted up to the scope of a broader concept which is a non-essential matter not directly related to the subject to be solved by the invention, and for which interchangeability and ease of interchange based on

Current Issues in IP

the standard at the time of filing are allowed based on the description of the specification, etc.

(2) Practical Advice

Broadening a concept in filing an amendment, correction or divisional application to broaden the technical scope of an invention is a useful way in practice.

In order to ensure the possibility for a broader concept, it is important to describe in the specification any optional configuration that is not

always necessary to solve the problem in the claimed configuration so as to satisfy the requirement for non-essential matter, so that such a configuration can be understood as an optional configuration.

It is also important to specify multiple embodiments in the specification, etc., even if the configuration is not directly related to a problem to be solved by the invention, so that the requirements for interchangeability and ease of interchange based on the standard at the time of filing can be met.