

## A new type of prohibited amendment

Japanese Patent Law gives a definition of a new type of prohibited amendment abbreviated “shift-amendment” defined in Section 17bis(4). The prohibited rule will be applied to applications filed after April 01, 2007.

Shift amendment means an amendment changing the special technical features (STF) of invention(s) when the amendment held after receipt of a notification for refusal. The expression of STF shall mean those technical features that define a contribution which each of the claimed inventions makes over the prior art. Simply put, a claimed invention without any STF means the claimed invention lacks novelty.

In other words, all inventions described in amended claims should have a same STF which makes each of those inventions over the prior art, after receipt of a notification for refusal. Hereinafter, STF will be described with reference to the Examination Guidelines.

There is a sample to explain the prohibited rule of shift amendment. First of all, there are 4 claims listed following table, and the elements of those inventions are described as A, B, C, and D.

Claims before amendment	receipt of a notification for refusal*	Amended claimed	Results
Claim 1 (A)	Amended to	Delete	<b>OK</b>
Claim 2 (A + B)	Amended to	Claim 2 (A + B)	<b>OK</b>
Claim 3 (A + B + C)	Amended to	Claim 3 (A + B + C)	<b>OK</b>
Claim 4 (A + B + C + D)	Amended to	Claim 4 (A + B + C + D)	<b>OK</b>
Claim 5 (A + C)	Amended to	Claim 5 (A + C)	<b>NG</b>
Claim 6 (A + D)	Amended to	Claim 6 (A + D)	<b>NG</b>

\*The applicant will receive a receipt of a notification for refusal, when the element of Claim 1, A lacks novelty, which means Claim 1 does not have any STF. The applicant can make an amendment to delete Claim 1 and to keep Claims 2 to 4, but cannot keep Claim 5 and 6, if the element of Claim 2, A + B is a STF having novelty. The Reason is the prohibited rule, that the all Claims should have a same STF after the amendment. In this case, “A + B” is the STF of all of the Claims 2 to 4.

The applicant can file divisional applications to keep the invention of Claim 5 and/or the invention of Claim 6 alive. In addition, an amendment violating the prohibited rule will be a ground of rejection, not a ground for invalidation. An application will not be invalidated only since violating the prohibited rule.