

JPO – KIPO – SIPO

COMPARATIVE STUDY REPORT

ON

AMENDMENT OF SPECIFICATION, CLAIMS OR DRAWINGS

November 2014

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COMPARATIVE STUDY OF PATENT PRACTICES FOR AMENDMENT			
ITEM and SUBITEM	JPO	KIPO	SIPO
1. Legal bases concerning the amendment of specification, claims or drawings			
(1) Relevant provisions in laws and implementing regulations	<p>Patent Act Article 5 (Extension of time limits, etc.) Article 17 (Amendment of proceedings) Article 17bis (Amendment of Description, Claim or Drawing attached to the application) Article 17ter (Amendment of abstract) Article 36 (Patent applications) Article 36bis (Patent applications) Article 48septies (Notice of statement of information concerning invention known to the public through publication) Article 50 (Notice of reasons for refusal) Article 50bis (Notice to the effect that the reasons for refusal stated therein are the same as those stated in the previous notice) Article 53 (Dismissal of amendments) Article 126 (Trial for correction) Article 184ter (Patent application based on international application) Article 184quater (Translations of an international patent application in foreign language) Article 184sexies (Effect, etc. of application, description, etc. of international application) Article 184septies (Amendment under Article 19 of the Treaty with regard to an international patent application in the Japanese language) Article 184octies (Amendment under Article 34 of the Treaty) Article 184duodevicies (Special provisions concerning amendment) Article 184duodevicies (Provisions for reasons for refusal, etc)</p>	<p>Patent Act Article 42 (Patent application) Article 42 ter (Patent application in foreign language) Article 43 (Abstract) Article 47 (Amendment of Patent Application) Article 51 (Rejection of Amendment) Article 200 bis (International patent application) Article 201 (Translation of International patent application) Article 208 (Special provisions on amendment etc.)</p> <p>Enforcement Decree of the Patent Act Article 2 (Deposit of Micro-organisms) Article 3 (Matters to be entered in patent specifications of inventions related to micro-organism) Article 4 (Apportionment of Samples of Micro-organism)</p> <p>Enforcement Rule of the Patent Act Article 13 (Amendment etc.) Article 21 (Patent application etc.) Article 22 bis (Patent application with nucleotide and/or amino acid sequence) Article 22 (Patent application with Microorganism) Article 37 bis (Request of reexamination) Article 42 (rejection of amendment)</p>	<p>Article 33 (Scope of Amendment)Article 37 (Notice of reasons for refusal) Article 38(Refusal)Article 41(Reexamination and Trial) Rule 6 (Extension of period) Rule 43 (Amendment when Filing a Division of a Patent Application) Rule 44 (Preliminary examination) Rule 51(Dismisssal of amendments) Rule 52((Replacement sheet of amendment) Rule 53 (Reasons for refusal) Rule 61(Amendment for reexamination) Rule 65(Reasons for invalidation) Rule 68(notice during invalidation procedure, and response thereof) Rule 69(Amendment for invalidation) Rule 71(Extension of period for invalidation) Rule 99(Fees for extension of period) Rule 104 (Formalities for entering the Chinese national phase) Rule 106 (Time limit for submitting translation of amendment) Rule 112 (Self amendment for International Application) Rule 113(Correct mistakes in translation)</p>

	<p>Regulations under the Patent Act Article 11 (Format, etc., of Written Amendment) Article 11bis (Format of statement of correction of incorrect translation) Article 25quater (Foreign language written application) Article 30 (Amendment when Filing a Division of a Patent Application) Article 33 (Matters to be described in the ruling dismissing an amendment)</p>		
(2) Examination guidelines, manuals, standards, etc.	<p>Examination Guidelines for Patent and Utility Model Part III Amendment of Description, Claims and Drawings Part VII Examination Guidelines for Inventions in Specific Fields Part VIII Foreign Language Application Part IX Procedure of Examination</p>	<p>Examination Guidelines -Part IV Amendment of description, claims or drawings -Part V -Part VIII -Part IX</p>	<p>Examination Guidelines Part I Chapter 1 : Preliminary examination of patent applications for invention Examination Guidelines Part II Chapter 2 : Description and claims Examination Guidelines Part II Chapter 8 : Procedure for substantive Examination Examination Guidelines Part III Chapter 1 : Preliminary examination of international applications entering the national phase and processing of procedural matters therefore Examination Guidelines Part III Chapter 2 : Substantive examination of international applications entering the national phase Examination Guidelines Part IV Chapter 2 : Examination of requests for reexamination Examination Guidelines Part IV Chapter 3 : Examination of requests for invalidation Examination Guidelines Part V Chapter 7 : Time limit, restoration of right and suspension of procedure Examination Guidelines Part V Chapter 11 : Provisions on electronic application</p>
(3) Background and purpose of the amendment	In order to substantially secure a first-to-file system, any amendment shall be made	The amendment system of the specification or drawing(s) is designed to address	Where two or more applicants file applications for patent for the identical

	<p>“within the description, claims or drawings originally attached to the application”. This principle</p> <ol style="list-style-type: none"> (1) secures sufficient disclosure of the invention as of the filing, (2) guarantees an immediate grant of the right, (3) ensures fairness between an application that sufficiently discloses the invention as of the filing and an application that does not sufficiently disclose the invention as of the filing, and (4) prevents a third party who acted based on the scope of the invention disclosed as of the filing from being adversely affected unexpectedly. <p>(Patent Act Article 17bis (3)) (Examination Guidelines Part III. Chapter 1. Section 2)</p>	<p>incompleteness of a specification generated while a patent application is hurriedly filed under the first-to-file rule where the first person to file a patent application for the same invention is granted the patent right for the invention, and to draw measures to protect the rights of the applicant.</p> <p>Where a description is amended during the designated period or under the specified conditions after filing the application, the amendment shall take effect retroactively to the original filing date.</p> <p>Amendments shall be freely carried out before the start of the examination for the smooth progress of the examination. In the meantime, if an amendment was made after the start of an examination, invalidation of examination results and examination delay would be possible. Therefore, after an official notice of grounds for rejection, the amendment period is strictly limited to prevent a delay in the examination process. Moreover, if an invention not set forth in the original specification or drawing(s) was added through the amendment, the newly-added content would unfairly take effect retroactively to the original filing date. This is against the first-to-file rule and is likely to do an unexpected damage to a third party, and therefore, the scope of amendment is strictly limited. (Examination Guidelines Part IV, Chapter 1. Section 2.)</p>	<p>invention-creation, the patent right shall be granted to the applicant whose application was filed first.(Article 9)</p>
2. Overview of Amendment			
(1) Main provision in the patent law and implementing regulations	<p>Patent Act Article 17bis (Amendment of Description, Claim or Drawing attached to the application) Article 48septies (Notice of statement of information concerning invention known to the public through publication) Article 50 (Notice of reasons for refusal) Article 53 (Dismissal of amendments) Article 126 (Trial for correction)</p>	<p>Patent Act Article 42 (Patent application) Article 42 ter (Patent application in foreign language) Article 43 (Abstract) Article 47 (Amendment of Patent Application) Article 51 (Rejection of Amendment) Article 200 bis (International patent application) Article 201 (Translation of International patent</p>	<p>An applicant may amend his or its application for a patent, but the amendment to the application for a patent for invention may not go beyond the scope of disclosure contained in the initial description and claims. (Article 33) Where the patent administration department under the State Council, after examination, finds that the application is not in conformity with this Law, the</p>

		<p>application) Article 208 (Special provisions on amendment etc.)</p>	<p>applicant should be notified and requested to submit, within a specified time limit, the reply or to amend the application. If, without any justified reason, the time limit for making response is not met, the application shall be deemed to have been withdrawn.(Article 37)</p> <p>Where, after the applicant has made the observations or amendments, the patent administration department under the State Council finds that the application for a patent for invention is still not in conformity with this Law, the application shall be rejected. (Article 38)</p> <p>Where an applicant for patent is not satisfied with the decision of the said department rejecting the application, the applicant may, within three months after receiving the rejection, request the Patent Reexamination Board to make a reexamination. The Patent Reexamination Board shall, after reexamination, make a decision and notify the applicant for patent. Where the applicant for patent is not satisfied with the decision of the Patent Reexamination Board, he may, within three months from the date of receipt of the notification, institute legal proceedings in the people's court. (Article 41)</p> <p>Rule 6 :</p> <p>Where a time limit prescribed in the Patent Law or these Implementing Regulations or specified by the patent administration department under the State Council is not observed by a party concerned because of force majeure, resulting in loss of his or its rights, he or she may, within two months from the date on which the impediment is removed, at the latest within two years immediately following the expiration of that time limit request the patent administration department under the State Council to restore his or its rights.</p> <p>Except for circumstances prescribed in</p>
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		<p>preceding paragraph, where a time limit prescribed in the Patent Law or these Implementing Regulations or specified by the patent administration department under the State Council is not observed by a party concerned because of any other justified reason, resulting in loss of his or its rights, he or she may, within two months from the date of receipt of a notification from the patent administration department under the State Council, request the patent administration department under the State Council to restore his or its rights.</p> <p>Where any party concerned requests to restore his or its right according to paragraph one or paragraph two of this Rule, he or she shall submit a request for restoration of his or its right, stating the reasons, attaching, if necessary, the relevant certifying documents, and go through the relevant formalities which should have been complied with before the loss of his or its right. Where the party concerned requests for restoration of his or its right according to paragraph two of this Rule, he or she shall pay the fee for request for restoration of right.</p> <p>Where the party concerned makes a request for an extension of a time limit specified by the patent administration department under the State Council, he or she shall, before the time limit expires, state the reasons to the patent administration department under the State Council and go through the relevant formalities.</p> <p>The provisions of paragraphs one and two of this Rule shall not be applicable to the time limit referred to in Articles 24, 29, 42 and 68 of the Patent Law.</p> <p>A divisional application filed in accordance with Rule 42 shall be entitled to the filing date and, if priority is claimed, the priority date of the initial application, provided that the divisional application does not go</p>
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		<p>beyond the scope of disclosure contained in the initial application. (Rule 43.1)</p> <p>When requesting substantive examination, or within three months after receiving the notification of the patent administration department under the State Council on the entry into substantive examination, the applicant for a patent for invention may amend the application for a patent for invention on his or its own initiative. (Rule 51.1)</p> <p>Where the applicant amends the application after receiving the notification of opinions of the substantive examination of the patent administration department under the State Council, he or she shall make the amendment according to the defects indicated by the notification. (Rule 51.3)</p> <p>The patent administration department under the State Council may, on its own initiative, correct the obvious clerical mistakes and symbol mistakes in the documents of application for a patent. Where the patent administration department under the State Council corrects mistakes on its own initiative, it shall notify the applicant. (Rule 51.4)</p> <p>When an amendment to the description or the claims in an application for a patent for invention is made, a replacement sheet in prescribed form shall be submitted, unless the amendment concerns only the alteration, insertion or deletion of a few words. (Rule 52)</p> <p>Rule 53:</p> <p>In accordance with Article 38 of the Patent Law, the circumstances where an application for a patent for invention shall be rejected by the patent administration department under the State Council after substantive examination are as follows:</p> <p>(1) where the application falls under Article 5 or 25 of the Patent Law, or the applicant is not entitled to a patent right in accordance with Article 9 of the Patent</p>
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			<p>Law;</p> <p>(2) where the application does not comply with t Article 2, paragraph two, Article 20, paragraph one, Article 22, Article 26, paragraph three, four or five, or Article 31, paragraph one of the Patent Law, or of Rule 20, paragraph two of these Implementing Regulations;</p> <p>(3) where the amendment to the application does not comply with Article 33 of the Patent Law, or the divisional application does not comply with Rule 43.1.</p> <p>The person making the request may amend its or his patent application at the time when it or he requests reexamination or makes responses to the notification of reexamination of the Patent Reexamination Board. However, the amendments shall be limited only to remove the defects pointed out in the decision of rejection of the application or in the notification of reexamination. (Rule 61)</p> <p>Rule 65:</p> <p>Anyone requesting invalidation or part invalidation of a patent right in accordance with Article 45 shall submit a request and the necessary evidence in two copies. The request for invalidation shall state in detail the grounds for filing the request, making reference to all the evidence as submitted, and indicate the piece of evidence on which each ground is based.</p> <p>The grounds on which the request for invalidation is based, referred to in the preceding paragraph, mean that the invention-creation for which the patent right is granted does not comply with Article 2, Article 20, paragraph one, Article 22, Article 23, Article 26, paragraph three or four, Article 27, paragraph two, or Article 33 of the Patent Law, or of Rule 20, paragraph two or Rule 43, paragraph one of these Implementing Regulations; or the invention-creation falls under Article 5 or 25 of the Patent Law; or the applicant is not entitled to be granted the patent right</p>
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		<p>in accordance with Article 9 of the Patent Law.</p> <p>Rule 68:</p> <p>The Patent Reexamination Board shall send a copy of the request for invalidation of the patent right and copies of the relevant documents to the patentee and invite it or him to present its or his observations within a specified time limit.</p> <p>The patentee and the person making the request for invalidation shall, within the specified time limit, make responses to the notification concerning transmitted documents or the notification concerning the examination of the request for invalidation sent by the Patent Reexamination Board. Where no response is made within the specified time limit, the examination of the Patent Reexamination Board will not be affected.</p> <p>Rule 69:</p> <p>In the course of the examination of the request for invalidation, the patentee for the patent for invention concerned may amend its or his claims, but may not broaden the scope of patent protection.</p> <p>The patentee for the patent for invention concerned may not amend its or his description or drawings. The patentee for the patent for design concerned may not amend its or his drawings, photographs or the brief explanation of the design.</p> <p>Rule 99:</p> <p>The fee for requesting restoration of right shall be paid within the relevant time limit prescribed in these Implementing Regulations. If the fee is not paid or not paid in full within the time limit, the request shall be deemed not to have been made.</p> <p>The fee for request of extension of a time limit shall be paid before the expiration of the relevant time limit. If the fee is not paid or not paid in full within the time limit, the request shall be deemed not to have been made.</p>
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			<p>The fee for a change in the bibliographic data, fee for requesting for evaluation report of patent and fee for request of invalidation of patent right shall be paid within one month from the date on which such request is filed. If the fee is not paid or not paid in full within the time limit, the request shall be deemed not to have been made.</p> <p>Rule 104:</p> <p>When the applicant goes through the formalities for entering the Chinese national phase in accordance with t Rule 103 of these Implementing Regulations, it or he shall fulfill the following requirements:</p> <p>(1) submitting in Chinese a written statement for entering the Chinese national phase, indicating the international application number and the type of patent right sought;</p> <p>(2) paying the filing fee and the printing fee for the publication of the application as provided in Rule 93, paragraph one of these Implementing Regulations, and where necessary, the surcharge for the late entry as provided in Rule 103 of these Implementing Regulations;</p> <p>(3) submitting the Chinese translation of the description and the claims of the initial international application where an international application is filed in a foreign language;</p> <p>(4) indicating in the written statement for entering the Chinese national phase the title of the invention-creation, the name or title of the applicant, the address of the applicant and the name of the inventor, all of which should be in conformity with those recorded with the International Bureau under the World Intellectual Property Organization (hereafter referred to as the International Bureau). Where the inventor is not indicated in the international application, the name of the inventor shall</p>
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			<p>be indicated in the said statement;</p> <p>(5) where the international application is filed in a foreign language, submitting the Chinese translation of the abstract; submitting a copy of the drawings and a copy of the drawing of the abstract where there are drawings and the drawing of the abstract; the text matter in the drawings, if any, shall be replaced by the corresponding text matter in Chinese; where the international application is filed in Chinese, submitting a copy of the abstract and the drawing of the abstract as appeared in the documents of international publication;</p> <p>(6) where the applicant has gone through the formalities of changing the applicant before the International Bureau in the international phase, certifying documents shall be furnished to prove the right of the applicant after the change to the international application;</p> <p>(7) payment of the additional fee for application when necessary, as provided in Rule 93, subparagraph (1) of these Implementing regulations.</p> <p>Where the requirements set forth in subparagraphs (1) to (3), paragraph one of this Rule are met, the patent administration department under the State Council shall issue the filing number, indicate clearly the date of entry of the international application into the Chinese national phase (hereafter referred to as the date of entry), and notify the applicant that its or his international application has entered into the Chinese national phase.</p> <p>Where, after entering the Chinese national phase, it is found that an international application does not meet the requirements as set forth in subparagraphs (4) to (7), paragraph one of this Rule, the patent administration department under the State Council shall notify the applicant to make rectification within the specified time limit. If the applicant fails to do so,</p>
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			<p>the application shall be deemed to have been withdrawn.</p> <p>Rule 106: Where an international application was amended in the international phase and the applicant requests that the examination be based on the amended application, the Chinese translation of the amendments shall be submitted within two months from the date of entry. Where the Chinese translation is not submitted within the said time limit, the amendments made in the international phase shall not be taken into consideration by the patent administration department under the State Council.</p> <p>Rule 112.2: With regard to an international application for a patent for invention, Rule 51.1, shall apply.</p> <p>Rule 113: Where the applicant finds that there are mistakes in the Chinese translation of the description, the claims or the text matter in the drawings as filed, he or she may correct the translation in accordance with the international application as filed within the following time limits: (1) before the completion of technical preparations for publication of an application for a patent for invention by the patent administration department under the State Council; (2) within three months from the date of receipt of the notification sent by the patent administration department under the State Council, stating that the application for a patent for invention has entered into the substantive examination phase.</p> <p>Where the applicant intends to correct the mistakes in the translation, he or she shall file a written request and pay the prescribed fee for the correction of the translation.</p> <p>Where the applicant makes correction of</p>
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			the translation in accordance with the notification of the patent administration department under the State Council, he or she shall, within the specified time limit, go through the formalities prescribed in paragraph two of this Rule. If the prescribed formalities are not gone through at the expiration of the time limit, the international application shall be deemed to be withdrawn.
(2) Requirements for amendment			
(i) Procedural Requirements	<p>A person undertaking a procedure before the Japan Patent Office may make amendments only while the case is pending. (Patent Act Article 17 (1))</p> <p>An applicant for a patent may amend the description, claims, or drawings attached to the application. (Patent Act Article 17bis (1))</p> <p>For any amendment of procedures, written amendment shall be submitted in writing. (Patent Act Article 17 (4))</p> <p>Where two or more persons are jointly undertaking a procedure, each of them shall represent the other or others with respect to procedures of amendments. (Patent Act Article 14)</p>	<p>A person who can amend the specification or drawing(s) shall be the applicant of the patent application at the time of the amendment. Where two or more applicants for the same application are present, not all the applicants need to undertake the amendment proceedings but each applicant may amend the description individually.</p> <p>For the amendment of a specification claims or drawing(s), the patent application, which is the subject of the amendment, shall be pending before KIPO. Therefore, if the application has been invalidated, withdrawn, abandoned, or a decision to reject the application has become final and binding, the amendment shall not be made.</p> <p>The case where the application is pending before KIPO refers to the conditions in which KIPO can take necessary administrative actions to grant a patent to the application (which means the registration of establishment of a patent right in accordance with Article 87(2) of the Patent Act). Therefore, if the application has been invalidated, withdrawn, abandoned, registered for establishment of right, or a decision to reject the patent application has become final and binding, the application shall not be deemed to be pending.</p> <p>(Examination Guidelines Part IV, Chapter 1. Section 3.1)</p>	<p>Where the patent administration department under the State Council, after it has made the substantive examination of the application for a patent for invention, finds that the application is not in conformity with the provisions of this Law, it shall notify the applicant and request him or it to submit, within a specified time limit, his or its observations or to amend the application. If, without any justified reason, the time limit for making response is not met, the application shall be deemed to have been withdrawn. (Article 37)</p> <p>Where, after the applicant has made the observations or amendments, the patent administration department under the State Council finds that the application for a patent for invention is still not in conformity with the provisions of this Law, the application shall be rejected. (Article 38)</p> <p>The patent administration department under the State Council shall set up a Patent Reexamination Board. Where an applicant for patent is not satisfied with the decision of the said department rejecting the application, the applicant may, within three months from the date of receipt of the notification, request the Patent Reexamination Board to make a reexamination. The Patent Reexamination Board shall, after reexamination, make a</p>

			<p>decision and notify the applicant for patent. Where the applicant for patent is not satisfied with the decision of the Patent Reexamination Board, it or he may, within three months from the date of receipt of the notification, institute legal proceedings in the people's court. (Article 41)</p> <p>When requesting substantive examination, or within three months after receiving the notification of the patent administration department under the State Council on the entry into substantive examination, the applicant for a patent for invention may amend the application for a patent for invention on his or its own initiative. (Rule 51.1)</p> <p>Where the applicant amends the application after receiving the notification of opinions of the substantive examination of the patent administration department under the State Council, he or she shall make the amendment according to the defects indicated by the notification. (Rule 51.3)</p> <p>The patent administration department under the State Council may, on its own initiative, correct the obvious clerical mistakes and symbol mistakes in the documents of application for a patent. Where the patent administration department under the State Council corrects mistakes on its own initiative, it shall notify the applicant. (Rule 51.4)</p> <p>When an amendment to the description or the claims in an application for a patent for invention is made, a replacement sheet in prescribed form shall be submitted, unless the amendment concerns only the alteration, insertion or deletion of a few words. (Rule 52)</p> <p>The person making the request may amend its or his patent application at the time when it or he requests reexamination or</p>
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		<p>makes responses to the notification of reexamination of the Patent Reexamination Board. However, the amendments shall be limited only to remove the defects pointed out in the decision of rejection of the application or in the notification of reexamination.</p> <p>The amendments to the application for patent shall be in two copies. (Rule 61)</p> <p>The Patent Reexamination Board shall send a copy of the request for invalidation of the patent right and copies of the relevant documents to the patentee and invite it or him to present its or his observations within a specified time limit. The patentee and the person making the request for invalidation shall, within the specified time limit, make responses to the notification concerning transmitted documents or the notification concerning the examination of the request for invalidation sent by the Patent Reexamination Board. Where no response is made within the specified time limit, the examination of the Patent Reexamination Board will not be affected. (Rule 68)</p> <p>In the course of the examination of the request for invalidation, the patentee for the patent for invention concerned may amend its or his claims, but may not broaden the scope of patent protection. The patentee for the patent for invention concerned may not amend its or his description or drawings. (Rule 69)</p> <p>Where an international application was amended in the international phase and the applicant requests that the examination be based on the amended application, the Chinese translation of the amendments shall be submitted within two months from the date of entry. Where the Chinese translation is not submitted within</p>
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			<p>the said time limit, the amendments made in the international phase shall not be taken into consideration by the patent administration department under the State Council. (Rule 106) With regard to an international application for a patent for invention, Rule 51.1 shall apply. (Rule 112) Where the applicant finds that there are mistakes in the Chinese translation of the description, the claims or the text matter in the drawings as filed, he or she may correct the translation in accordance with the international application. (Rule 113) The response of the applicant may include the arguments only, the revised application documents (replacement sheet and/or rectification) may be also included. (Guidelines Part II chapter 8, Section 5.1)</p> <p>The Patent Reexamination Board shall, if need be, transfer the relevant documents to the parties concerned. Where it is necessary to prescribe a time limit for submitting the response, the time limit shall be one month. If the party fails to make a response within the time limit, said party shall be deemed to have been aware of the facts, causes, and evidence contained in the transferred documents and does not raise any objection. Any observations and the attachments submitted by the parties concerned shall be made in duplicate. (Guidelines Part IV chapter3 section 4.4.1)</p> <p>In the invalidation procedure, the Patent Reexamination Board may issue Notification of Examination on Request for Invalidation to both parties concerned in any of the following circumstances. For the party to which the notification of</p>
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			<p>examination is directed, it shall respond within one month from the date of receiving the notification. If no response is made within the time limit, the party shall be deemed to have been aware of the facts, causes and evidence contained in the notification and does not raise any objection.</p> <p>(Guidelines Part IV chapter3 section 4.4.3)</p> <p>The amendments made under Article 19 of the Treaty in the international phase, referred to in the statement concerning the basis for examination, shall have corresponding contents in the international publication document. The corresponding contents of the amendments made under Article 34 of the Treaty shall be attached to the international preliminary report on patentability. Where it is found that the amendments made in the international phase which are referred to in the statement concerning the basis for examination do not exist, the examiner shall issue the Notification to Make Rectification to notify the applicant to correct the relevant contents in respect of basis for examination in the entering statement.</p> <p>(Guidelines Part III Chapter 1 Section 3.1.6)</p> <p>Where, according to the statement of the applicant, the claims amended under Article 19 of the Treaty are served as the basis for examination, and the international publication of the amendments is in a language other than Chinese, the applicant shall submit its translation at the time of entering the national phase, or at the latest within two months from the date of entry. In accordance with Rule 106, the amendments of which the translation is submitted after the said period shall not be taken into consideration. The examiner shall issue the</p>
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			<p>Notification of Non-consideration of the Amendment. Where an international publication document contains the statement concerning amendments under Article 19(1) of the Treaty and the applicant requests the examiner to take the said statement into consideration, the applicant shall submit the translation of the statement at the same time when the translation of the amended claims is furnished.</p> <p>For amendments which were submitted in the international phase but were refused by the International Bureau for not being in conformity with Rule 46 of the PCT Regulations, they shall not be submitted as amendments under Article 19 of the Treaty at the time of entering the national phase. For the translation of the amended documents which are submitted after entering the national phase, the Form to Supplement the Translation of Amended Document or the Amended Document shall be attached. The applicant shall indicate in the Form that he intends to use the amended contents as the basis for examination.</p> <p>Where the translation of the amended documents fails to meet the requirements, the examiner shall issue the Notification of Defects of the Amended Document to notify the applicant to make rectifications. If the applicant fails to submit the rectifications within the specified time limit, the examiner shall issue the Notification of Non-consideration of the Amendment.</p> <p>Where the claims amended under Article 19 of the Treaty is also used as the basis for international preliminary examination, and the applicant has submitted it as the translation of the annexes of the international preliminary report on patentability at the time of entering the national phase, the said translation shall not be published in the national publication.</p>
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		<p>(Guidelines Part III Chapter 1 Section 4.1) Where, according to the statement of the applicant, the amendments made under Article 34 of the Treaty are served as the basis for examination, and the amendments are made in a language other than Chinese, the translation shall be submitted at the time of entering the national phase, and at the latest within two months from the date of entry. The translation of the amended part submitted after the said period shall not be taken into consideration. The examiner shall issue the Notification of Nonconsideration of the Amendment. For the translation of the annexes of the international preliminary report on patentability submitted after entering the national phase, the Form to Supplement the Translation of Amended Document or the Amended Document shall be attached. The willing to use the amendments as the basis for examination shall be indicated in the said Form.</p> <p>Where the translation of the amended documents fails to meet the requirements, the examiner shall issue the Notification of Defects of the Amended Document to notify the applicant to make rectifications. If the rectifications are not submitted within the specified time limit, the examiner shall issue the Notification of Non-consideration of the Amendment.</p> <p>(Guidelines Part III Chapter 1 Section 4.2) According to Rule 112, the applicant may file requests to amend the patent application documents within the prescribed time limit after going through the formalities for entering the national phase, and such amendments are called the amendments in the national phase.</p> <p>For an international application pursuing a patent right for invention, the applicant may amend the application documents on his own initiative according to Rule 51.1. When an international application enters the national phase, if the applicant</p>
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			requests definitely that the amendments made under Article 28 or 41 of the Treaty serve as the basis of examination, the amendments may be submitted together with the translation of the original application, and such amendments are considered as the amendments submitted on the applicant's own initiative according to Rule 112. (Guidelines Part III Chapter 1 Section 5.7)
(ii) Substantive Requirements	<p>(1) Voluntary amendment (i) The amendment which adds new matters shall be prohibited. (Patent Act Article 17bis (3))</p> <p>(2) Amendment in response to non-final notice of rejection (i) The amendment which adds new matters shall be prohibited. (Patent Act Article 17bis (3))</p> <p>(ii) The amendment of claims which changes a special technical feature of an invention shall be prohibited. (Patent Act Article 17bis (4))</p> <p>(3) Amendment in response to final notice of rejection or amendment on request for an appeal (i) The amendment which adds new matters shall be prohibited. (Patent Act Article 17bis (3))</p> <p>(ii) The amendment of claims which changes a special technical feature of an invention shall be prohibited. (Patent Act Article 17bis (4))</p> <p>(iii) The amendment of claims which does not intend the followings shall be prohibited. (a) Deletion of the claim (b) Restriction of the claims (c) Correction of errors in the description (d) Clarification of an ambiguous description</p>	<p>The scope of an amendment to the specification or drawing(s) differs depending on the amendment periods. The addition of new matter shall be prohibited when an amendment is carried out within the self-amendment period before the start of an examination or within the period designated for submitting arguments on a non-final notice of grounds for rejection (Patent Act 47①(i)).</p> <p>However, where an amendment is made within the period designated for submitting arguments on a final notice of grounds for rejection (Patent Act 47①(ii)) and where an amendment is made upon a request for reexamination, the scope of the amendment shall be further restricted by only allowing the reduction of scope of claims, etc. as well as the prohibition of the addition of new matter to the application.</p> <p>(Examination Guidelines Part IV, Chapter 1. Section 3.2) 4102</p>	<p>The amendment of the application documents shall not go beyond the scope of disclosure contained in the initial description and claims.</p> <p>The scope of disclosure contained in the initial description and claims includes the contents described in the initial description and claims, and the contents determined directly and unambiguously according to the contents described in the initial description and claims, and the drawings of the description.</p> <p>The contents described in the initial description and claims submitted by the applicant on the date of filing shall be taken as the basis of examining whether the amendment is in conformity with Article 33. (Examination Guidelines Part II Chapter 8. Section 5.2.1.1)</p>

	(Patent Act Article 17bis (5)) (iv)The amendment of claims which intends restriction of the claims and does not satisfy requirements for independent patentability shall be prohibited. (Patent Act Article 17bis (6))		
(3) Amendment period allowed			
(i) Voluntary amendment (self-amendment)	An applicant for a patent may amend the description, claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted, provided that the applicant has not received a notice of reasons for refusal., (Patent Act Article 17bis (1))	The self-amendment period refers to the time period before the commissioner of the Korean Intellectual Property Office delivers a certified copy of a decision to grant a patent during the amendment period designated under Article 47(1) of the Patent Act, except for the period under the subparagraphs of Article 47(1) of the Patent Act. In such a case, the time at which the commissioner of KIPO delivers a certified copy of a decision to grant a patent is when an examiner sends a certified copy of a decision of patent. Therefore, if an applicant submits an amendment before receiving a copy of a decision of patent which the examiner has sent out, the amendment shall not be recognized. The self-amendment period refers to the time period before an applicant receives a certified copy of a non-final notice of grounds for rejection which an examiner has delivered (Examination Guidelines Part IV, Chapter 1. Section 4.1) 4103	When requesting substantive examination, or within three months after receiving the notification of the patent administration department under the State Council on the entry into substantive examination, the applicant for a patent for invention may amend the application for a patent for invention on his or its own initiative. (Rule 51.1) Once said (rejection) decision or notification (to grant patent right) is issued, any observations, response or amendment from the applicant shall be no more considered. (Guidelines Part II Chapter 8 Section 6) Where an international application was amended in the international phase and the applicant requests that the examination be based on the amended application, the Chinese translation of the amendments shall be submitted within two months from the date of entry. Where the Chinese translation is not submitted within the said time limit, the amendments made in the international phase shall not be taken into consideration by the patent administration department under the State Council. (Rule 106) With regard to an international application for a patent for invention, Rule 51.1 shall apply. (Rule 112) Where the applicant finds that there are

			<p>mistakes in the Chinese translation of the description, the claims or the text matter in the drawings as filed, he or she may correct the translation in accordance with the international application as filed within the following time limits:</p> <p>(1) before the completion of technical preparations for publication of an application for a patent for invention by the patent administration department under the State Council;</p> <p>(2) within three months from the date of receipt of the notification sent by the patent administration department under the State Council, stating that the application for a patent for invention has entered into the substantive examination phase. (Rule 113)</p> <p>Where the amendments in the international phase have been referred to in the statement concerning basis for examination, the Chinese translation of the amendments shall be submitted within two months from the date of entry. If the documents have not been submitted at the expiration of the time limit, the amendments indicated in the statement shall not be taken into consideration, and the examiner shall issue the Notification of Non-consideration of the Amendment. (Guidelines Part III Chapter 1 Section 3.1.6)</p> <p>Where, according to the statement of the applicant, the claims amended under Article 19 of the Treaty are served as the basis for examination, and the international publication of the amendments is in a language other than Chinese, the applicant shall submit its translation at the time of entering the national phase, or at the latest within two months from the date of entry. In accordance with Rule 106, the amendments of which the translation is submitted after the said period shall not be taken into consideration. The examiner shall issue the</p>
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			<p>are errors in the Chinese translation of the claims, the description or the text matter of the drawings as filed, he may request to correct the errors within the following time limit:</p> <p>(1)before the completion of technical preparations for publication of an application for a patent for invention by the Patent Office;</p> <p>(2)within three months from the date of receipt of the Notification of Entering the Substantive Stage of the Application for Invention issued by the Patent Office.</p> <p>Where a divisional application is filed after the international application has entered the national phase, if, in the substantive examination stage, the applicant realizes by himself that the translation errors of the original application result in the translation errors of the divisional application, the applicant may go through the formalities of the correction of the translation errors, and correct the translation errors based on the international application text submitted at the time of filing the patent application. (Guidelines Part III Chapter 2 Section 5.7)</p>
<p>(ii) Amendment in response to office action (Period for argument submission)</p>	<p>The applicant who received a notice of reasons for refusal shall submit the amendment within the designated time limit under the Patent Act Article 48septies or the Patent Act Article 50. (Patent Act Article 17bis (1) (i)-(iii))</p> <p>In general, 60 days for domestic applicants, and 3 months for foreign applicants are designated by a patent examiner. (Formality Examination Manual 04.10)</p>	<p>If an applicant receives a non-final notice of grounds for rejection under Article 63 of the Patent Act or a notice of grounds for rejection other than rejection grounds (a final notice of grounds for rejection) under Article 47(1)(ii), the applicant may submit a written amendment to the specification, claims or drawing(s) only within the period designated for the submission of arguments in response to the notification of grounds for rejection concerned.</p> <p>Even where a notice of grounds for rejection (the final notice of grounds for rejection) under Article 47(1)(ii) of the Patent Act is present, an applicant may amend the specification, claims or drawing(s) only within the period designated for the submission of arguments. However, the scope of the amendment in this period shall be</p>	<p>Where the patent administration department under the State Council, after examination, finds that the application is not in conformity with this Law, the applicant should be notified and requested to submit, within a specified time limit, the reply or to amend the application. If, without any justified reason, the time limit for making response is not met, the application shall be deemed to have been withdrawn. (Article 37)</p> <p>The examiner shall specify the time limit for the applicant to submit the response in the Office Action. The time limit shall be decided by the examiner after taking the relevant factors of the application into consideration, including the quantity and nature of the observations, the workload</p>

		<p>further limited.</p> <p>(Examination Guidelines Part IV, Chapter 1. Section 4.2)</p>	<p>and the degree of complexity of the possible amendments and so on. The specified time limit for replying the first Office Action is four months.</p> <p>(Guidelines Part II Chapter 8 section 4.10.3)</p> <p>In order to accelerate the examination procedure, the conclusion of the examination of the application shall be indicated definitely in the further Office Action. The specified time limit of the response to the further Office Action is two months.(Guidelines Part II Chapter 8 section 4.11.3.2)</p>
<p>(iii) Request for reexamination or appeal</p>	<p>The applicant shall appeal against an examiner's decision of refusal within 3 months from the decision of the refusal, and the applicant can make an amendment at the same time as the request for the appeal.</p> <p>(Patent Act Article 17bis (1) (iv), Article 121)</p>	<p>An applicant shall request a reexamination within 30 days from the receipt of a certified copy of a decision of rejection and amend the specification, claims or drawing(s) attached to the application upon a request for reexamination.</p> <p>(Examination Guidelines Part IV, Chapter 1. Section 4.3)</p>	<p>Where an applicant for patent is not satisfied with the decision of the said department rejecting the application, the applicant may, within three months after receiving the rejection, request the Patent Reexamination Board to make a reexamination. The Patent Reexamination Board shall, after reexamination, make a decision and notify the applicant for patent. Where the applicant for patent is not satisfied with the decision of the Patent Reexamination Board, he may, within three months from the date of receipt of the notification, institute legal proceedings in the people's court.</p> <p>(Article 41)</p> <p>The Patent Reexamination Board shall send a copy of the request for invalidation of the patent right and copies of the relevant documents to the patentee and invite it or him to present its or his observations within a specified time limit. The patentee and the person making the request for invalidation shall, within the specified time limit, make responses to the notification concerning transmitted documents or the notification concerning the examination of the request for invalidation sent by the Patent Reexamination Board.</p> <p>(Rule 68)</p>

			<p>The petitioner may amend the application at the time of submitting the request for reexamination, responding to Notification of Reexamination (including Notification of Oral Proceedings for Request for Reexamination), or appearing in oral proceedings. (Guidelines Part IV Chapter 2 Section 4.2) The Patent Reexamination Board shall, if need be, transfer the relevant documents to the parties concerned. Where it is necessary to prescribe a time limit for submitting the response, the time limit shall be one month. If the party fails to make a response within the time limit, said party shall be deemed to have been aware of the facts, causes, and evidence contained in the transferred documents and does not raise any objection. (Guidelines Part IV Chapter 3 Section 4.4.1) In the invalidation procedure, the Patent Reexamination Board may issue Notification of Examination on Request for Invalidation to both parties concerned in any of the following circumstances. For the party to which the notification of examination is directed, it shall respond within one month from the date of receiving the notification. If no response is made within the time limit, the party shall be deemed to have been aware of the facts, causes and evidence contained in the notification and does not raise any objection. (Guidelines Part IV chapter3 section 4.4.3)</p>
(iv) Extension of amendment period	<p>The examiner who designated a time limit under the Article 48septies or the Article 50 of the Patent Act may, upon request, extend the time limit. (Patent Act Article 5 (1))</p> <p>If an applicant has a justifiable reason for not being able to respond within the</p>	<p>The period designated for the submission of arguments shall be commonly two months. However, the period shall be extended on a request for the extension of the designated period by the applicant according to Article 15(2) of the Patent Act. Where the period designated for submitting a written argument exceeds four months, the period may or may not</p>	<p>Where a time limit prescribed in the Patent Law or these Implementing Regulations or specified by the patent administration department under the State Council is not observed by a party concerned because of force majeure, resulting in loss of his or its rights, he or she may, within two months from the date on which the impediment is</p>

	<p>designated time limit, an extension of the time limit will be granted. There are two justifiable reasons, and they are as follows.</p> <p>(1) The need to conduct experimentation to compare the claimed invention with the cited prior art.</p> <p>(2) The need to translate the notice of the reasons for refusal issued by the JPO and the documents to be submitted to the JPO.</p> <p>If an applicant is a resident of Japan, the applicant who requests an extension due to Reason (1) will be granted a one-month extension to the designated time limit.</p> <p>If an applicant is a resident abroad, the applicant who requests an extension due to Reason (1) or (2) will be granted an extension to the designated time limit for response. One written request will result in an extension of the designated time limit by one month and up to three written requests may be submitted (maximum of a three-month extension). Only one written request may be submitted in the case of Reason (1).</p> <p>(Formality Examination Manual 04.10)</p>	<p>be extended based on whether an examiner permits the period extension or not. (Examination Guidelines Part IV, Chapter 1. Section 4.2)</p> <p>The period designated for an appeal against a decision of rejection can be extended if the requirements specified under Article 15(1) of the Patent Act are fulfilled. Therefore, an applicant shall amend the description, upon a request for reexamination, within the extended period for an appeal against a decision of rejection.</p> <p>(Examination Guidelines Part IV, Chapter 1. Section 4.3)</p>	<p>removed, at the latest within two years immediately following the expiration of that time limit request the patent administration department under the State Council to restore his or its rights.</p> <p>Except for circumstances prescribed in preceding paragraph, where a time limit prescribed in the Patent Law or these Implementing Regulations or specified by the patent administration department under the State Council is not observed by a party concerned because of any other justified reason, resulting in loss of his or its rights, he or she may, within two months from the date of receipt of a notification from the patent administration department under the State Council, request the patent administration department under the State Council to restore his or its rights.</p> <p>Where any party concerned requests to restore his or its right according to paragraph one or paragraph two of this Rule, he or she shall submit a request for restoration of his or its right, stating the reasons, attaching, if necessary, the relevant certifying documents, and go through the relevant formalities which should have been complied with before the loss of his or its right. Where the party concerned requests for restoration of his or its right according to paragraph two of this Rule, he or she shall pay the fee for request for restoration of right.</p> <p>Where the party concerned makes a request for an extension of a time limit specified by the patent administration department under the State Council, he or she shall, before the time limit expires, state the reasons to the patent administration department under the State Council and go through the relevant formalities.</p> <p>The provisions of paragraphs one and two of this Rule shall not be applicable to the time limit referred to in Articles 24,29,42</p>
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		<p>and 68 of the Patent Law. (Rule 6)</p> <p>In the course of the examination of a request for invalidation, the time limit specified by the Patent Reexamination Board shall not be extended. (Rule 71)</p> <p>The fee for request of extension of a time limit shall be paid before the expiration of the relevant time limit. If the fee is not paid or not paid in full within the time limit, the request shall be deemed not to have been made. (Rule 99.2)</p> <p>When termination of the procedure of an application results from that the application is deemed to be withdrawn because the time limit as prescribed in the Patent law and its Implementing Regulations or specified by the Patent Office is not observed due to force majeure or any justified reason, according to Rule 6.1-6.2, the applicant may request the Patent Office to resume the terminated procedure for substantive examination. Where the right is resumed, the Patent Office shall resume the procedure for substantive examination. (Guidelines Part II Chapter 8 Section 7.3)</p> <p>A party concerned may request to extend a time limit if he cannot perform or complete a certain act or procedure within the time limit with justified reasons. The request for the extension of time limits shall be limited only to the specified time limits. However, in the procedure of invalidation, the time limit specified by the Patent Reexamination Board shall not be extended.</p> <p>Where the extension of time limit is requested, the request for extension of time limit, with the reasons explained, shall be submitted and the fee for requesting the extension shall be paid before the expiration of the time limit. The fee for</p>
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			<p>such request shall be calculated by month. (Guidelines Part V chapter 7 section 4.1)</p> <p>The request for extension of time limit shall be examined and approved by the department that has made the corresponding notification or decision or the flow management department. Where the extension of time limit is less than one month, it shall be calculated as one month. The extension of time limit shall not exceed two months. In general, a time limit, which is specified in the same notification or decision, may be extended only once.</p> <p>Where the request does not meet the requirements, a Notification of Decision on Extension of Time Limit shall be issued and the reason for non-approval of the request for extension of the time limit shall be stated. Where the request meets the requirements, a Notification of Decision on Extension of Time Limit shall be issued and a change shall be made to the expiration date of the time limit in the computer system, which means the time limit shall be reestablished for being monitored. (Guidelines Part V Chapter 7 Section 4.2)</p>
3.Scope of Amendment			
(1) Original application			
(i) General practice (Scope of original application)	<p>Any amendment of the description, claims or drawings shall be made within the scope of the matters described in the description, claims or drawings originally attached to the application (Patent Act Article 17bis (3))</p> <p>In the case of divisional/converted applications, whether an amendment adds new matter is decided based on the description, etc. attached to the</p>	<p>The specification, claims or drawing(s) originally attached to the patent application shall be the subject of comparison of whether new matter is added to the amended specification, claims or drawing(s). In this context, the phrase 'originally attached to the patent application' refers to the submission of the specification, claims or drawing(s) along with the patent application by the filing date of the application.</p>	<p>The description and the claims are legal documents for setting forth an invention and for determining the extent of protection thereof.</p> <p>The abstract is a summary of the contents set forth in the description. It is just a sort of technical information with no legal effect.</p> <p>The contents of the abstract do not form a part of the initial disclosure of the invention. Therefore, they shall not serve</p>

	<p>divisional/converted applications.</p>	<p>In the case of divisional/ converted applications, 'matter described in the specification, claims or drawing(s) originally attached to the patent application' refers to the element described in the specification, claims or drawing(s) attached to the divisional/converted applications on the filing date of the divisional/converted applications. It does not refer to matter described in the specification, claims or drawing(s) in the original application which form the basis of divisional/converted applications. (Examination Guidelines Part IV, Chapter 2. Section 1.1(3))</p>	<p>as a basis for subsequent amendments to the description or claims, nor shall they be used to interpret the extent of protection of the patent right. (Examination Guidelines Part II Chapter 2. Section 1 and Section 2.4) The contents described in the initial description and claims submitted by the applicant on the date of filing shall be taken as the basis of examining whether the amendment is in conformity with Article 33. (Examination Guidelines Part II Chapter 8. Section 5.2.1.1) A divisional application filed in accordance with Rule 42 shall be entitled to the filing date and, if priority is claimed, the priority date of the initial application, provided that the divisional application does not go beyond the scope of disclosure contained in the initial application.(Rule 43)</p>
(ii) PCT applications	<p>The description of an international patent application in the Japanese language as of the international application date and translations of the description of an international patent application in the foreign language as of the international application date shall be deemed to be the description submitted with the application under the Patent Act Article 36 (2); claims of an international patent application in the Japanese language as of the international application date and a translation of the claims of an international patent application in the foreign language as of the international application date shall be deemed to be the claims submitted with the application under the Patent Act Article 36 (2); drawings of an international patent application in the Japanese language as of the international application date, drawings of an international patent application in the foreign language as of the international application date (except for the descriptive text in the drawings)</p>	<p>In the case of international patent applications, 'matters described in the specification, claims or drawing(s) originally attached to the application' shall be 'matters described in the description, claims and drawings submitted by the international filing date. (Patent Act Article 200 bis(2))</p>	<p>Where the international publication of an international application is in a language other than Chinese, the substantive examination shall be conducted according to its Chinese translation. The examiner, generally speaking, need not check the original one. Nevertheless, the international application documents as originally filed shall have legal effect and form the basis for later amendment For an international application, the original description and claims indicated in Article 33 refer to the claims, description and drawings of the international application as originally filed. (Examination Guidelines Part III Chapter 2. Section 3.3)</p>

	and a translation of the descriptive text in the drawings shall be deemed to be the drawings submitted with the application under the Patent Act Article 36 (2); and, the abstract of an international patent application in the Japanese language and a translation of the abstract of an international patent application in the foreign language shall be deemed to the abstract submitted with the application under the Patent Act Article 36 (2). (Patent Act Article 184sexies (2))		
(iii) Specifications written in foreign languages			The contents of the application documents in foreign language submitted by the applicant to the Patent Office shall not be taken as the basis to judge whether the amendment to the application documents meet the requirements of Article 33, except for the originally filed text in foreign language of an international application entering into the national phase. (Examination Guidelines Part II Chapter 8. Section 5.2.1.1)
(a) Legal status of specifications written in foreign language	A person requesting the grant of a patent may, in lieu of the description, claims, drawings (if any) and abstract as provided in the Patent Act Article 36 (2), attach to the application a document in foreign language as provided by Ordinance of the Ministry of Economy, Trade and Industry, stating matters required to be stated in the description or the claims under the Patent Act Article 36 (3)-(6), and drawings (if any) which contain any descriptive text in the said foreign language, and a document in the said foreign language stating matters required to be stated in the abstract under the Patent Act Article 36 (7). (Patent Act Article 36bis (1)) The translation of foreign language documents shall be deemed to be the description, claims and drawings	Applicants may write specification and drawings (limited to the part of explanation in drawings) not in Korean but in the language designated by Decree of the Ministry of Trade, Industry & Energy, if their purport is written on the patent application when they file the patent. (Patent Act Article 42ter(1))	Rule 3: Any document submitted in accordance with the provisions of the Patent Law and these Implementing Regulations shall be in Chinese. Some standard scientific and technical terms can be used if there is a prescribed one set forth by the State; where no generally accepted Chinese translation, a foreign name or scientific or technical term, shall be indicated. Where any certificate or certifying document submitted in accordance with the provisions of the Patent Law and these Implementing Regulations is in a foreign language, the patent administration department under the State Council may, when it deems necessary, request a Chinese translation of the certificate or the certifying document be submitted within a specified time limit; where the translation is not submitted within the specified time

	submitted with the application and the translation of foreign language abstract shall be deemed to be the abstract submitted with the application. (Patent Act Article 36bis (6))		limit, the certificate or certifying document shall be deemed not to have been submitted.
(b) Allowed foreign languages	Foreign language as provided by Ordinance of the Ministry of Economy, Trade and Industry is English for now. (Patent Act Article 25quater)	Language which is designated by Decree of the Ministry of Trade, Industry & Energy is English, for now.	Any document submitted in accordance with the provisions of the Patent Law and these Implementing Regulations shall be in Chinese. Some standard scientific and technical terms can be used if there is a prescribed one set forth by the State; where no generally accepted Chinese translation, a foreign name or scientific or technical term, shall be indicated. (Rule 3)
(c) Submission of translation	<p>The applicant with a foreign language application shall submit Japanese translations of the foreign language document and of the foreign language abstract within one year and two months from the filing date (when claiming a priority, from priority date) of the application.</p> <p>The translation shall be submitted by means of a written submission of the translation. It shall be stated in the column of "[Confirmation]" in the written submission of translation that the matters described in the foreign language document, etc. are translated into proper Japanese without excess nor shortage.</p> <p>The applicant shall submit, as a translation, a literal translation in proper Japanese (a word-by-word translation into proper Japanese in accordance with the context of the foreign language document).</p> <p>Examiner's approach to application lacking submission of translation is as follows (i) Translation of "Foreign Language Document (Except for Drawings)" A foreign language document, except for drawings, contains a main portion of</p>	<p>Korean translation should be submitted by 14 months from the filing date. As for the applications on priority claim under the treaty or on domestic priority claim, the publication time shall be reckoned from either the filing date of application in the country where the initial application is filed or the filing date of the earlier application (or the earliest filing date if the application involves more than 2 priority claims). (Patent Act Article 42ter(2))</p> <p>If, however, the request for examination is filed by a person who is not an applicant, the translation should be submitted by the earliest date between three months after receipt of notice and 14 months after the filing date.. (Patent Act Article 42ter(2))</p> <p>If Korean translation is submitted within the time limit, new Korean translation may be submitted before the deadline is expired. (Patent Act Article 42ter(3))</p> <p>When applicants submit the Korean translation, specification and drawings initially attached to patent application of application in foreign language are deemed to have been amended according to the Korean translation. If, however, multiple translations are submitted, amendment with the translations submitted</p>	<p>Rule 3: Any document submitted in accordance with the provisions of the Patent Law and these Implementing Regulations shall be in Chinese.</p> <p>Rule 104: When the applicant goes through the formalities for entering the Chinese national phase in accordance with Rule 103 of these Implementing Regulations, it or he shall fulfill the following requirements: (3) submitting the Chinese translation of the description and the claims of the initial international application where an international application is filed in a foreign language; (5) where the international application is filed in a foreign language, submitting the Chinese translation of the abstract; submitting a copy of the drawings and a copy of the drawing of the abstract where there are drawings and the drawing of the abstract; the text matter in the drawings, if any, shall be replaced by the corresponding text matter in Chinese; where the international application is filed in Chinese, submitting a copy of the abstract and the drawing of the abstract as appeared in the documents of international</p>

	<p>description of the contents of the invention for which a patent is sought. A translation thereof is legally regarded as the description and later becomes a subject of the examination and patent granting. Because of these, lack of a translation is equal to lack of the description attached to the request. Therefore such foreign language application is regarded as withdrawn.</p> <p>(ii) Translation of "Drawings in which Any Text Matter is stated in the Foreign Language"</p> <p>In the foreign language application system, it is required to submit the entire drawings as the translation even if no foreign language text matter is included in the drawings as of the filing date. If any of the drawings are not submitted as the translation, the missing drawings are deemed not to have been attached to the application although such application is not regarded withdrawn.</p> <p>It should be noted that no submission of a translation of drawings may result in failure to satisfy the description requirements for the description, claims or drawings, or the requirements for patentability and, therefore, the correction of mistranslation may become necessary.</p> <p>(iii) Translation of Foreign Language Abstract</p> <p>Since an abstract has no influence on any matter related to patent rights, an application will not be deemed to have been withdrawn even if a translation of the foreign language abstract is not submitted within one year and two months after the filing date of the application. However, the abstract is indispensable for publication of an unexamined application. Therefore, if a translation of the foreign language abstract is not submitted, such an application may be subject to an invitation to correct or the dismissal of procedure.</p>	<p>before the final Korean translation will be deemed to be invalid. (Patent Act Article 42ter(5))</p>	<p>publication;</p> <p>Where the requirements set forth in subparagraphs (1) to (3), paragraph one of this Rule are met, the patent administration department under the State Council shall issue the filing number, indicate clearly the date of entry of the international application into the Chinese national phase (hereafter referred to as the date of entry), and notify the applicant that its or his international application has entered into the Chinese national phase. Where, after entering the Chinese national phase, it is found that an international application does not meet the requirements as set forth in subparagraphs (4) to (7), paragraph one of this Rule, the patent administration department under the State Council shall notify the applicant to make rectification within the specified time limit. If the applicant fails to do so, the application shall be deemed to have been withdrawn.</p>
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	(Examination Guidelines Part VIII. Section 1.4 (1)-(4))		
(d) Correction of mistranslation	<p>For any amendment of procedures (except in the case of the payment of fees), written amendment shall be submitted in writing, except for cases provided by the Patent Act Article 17bis (2). (Patent Act Article 17 (4))</p> <p>Where an applicant of a foreign language written application amends the description, claims or drawings for the purpose of correcting an incorrect translation, the applicant shall submit the statement of correction of the incorrect translation, stating the grounds thereof. The applicant may correct the incorrect translation within the period or at the time when the applicant can amend the description, claims or drawings under the Patent Act Article 17bis (1). (Patent Act Article 17bis (2))</p>	<p>Applicants may correct mistranslation of the final Korean translation within the period of voluntary amendment or the deadline of written opinion about notice of ground for rejection before the commencement of the examination. (Patent Act Article 42ter(6))</p>	<p>Rule 113 :</p> <p>Where the applicant finds that there are mistakes in the Chinese translation of the description, the claims or the text matter in the drawings as filed, he or she may correct the translation in accordance with the international application as filed within the following time limits: (1) before the completion of technical preparations for publication of an application for a patent for invention by the patent administration department under the State Council; (2) within three months from the date of receipt of the notification sent by the patent administration department under the State Council, stating that the application for a patent for invention has entered into the substantive examination phase.</p> <p>Where the applicant intends to correct the mistakes in the translation, he or she shall file a written request and pay the prescribed fee for the correction of the translation.</p> <p>Where the applicant makes correction of the translation in accordance with the notification of the patent administration department under the State Council, he or she shall, within the specified time limit, go through the formalities prescribed in paragraph two of this Rule. If the prescribed formalities are not gone through at the expiration of the time limit, the international application shall be deemed to be withdrawn.</p>
(2) Prohibition of new matter			
(i) Relevant provision	<p>Any amendment of the description, claims or drawings shall be made within the scope of the matters described in the description, claims or drawings originally attached to the application. (Patent Act Article 17bis (3))</p>	<p>Article 47(2) of the Patent Act dictates that an amendment to the specification, claims or drawing(s) "shall be made within the scope of matters written in the specification or drawing(s) attached to the patent application." Therefore, the addition of new matter even in the amendment under the main sentence of</p>	<p>The amendment of the application documents shall not go beyond the scope of disclosure contained in the initial description and claims. The scope of disclosure contained in the initial description and claims includes the contents described in the initial description</p>

		Article 47(1) and Article 47(1)(i) shall be prohibited. An amendment to the specification, claims or drawing(s) within the designated period has no limit to the scope of an amendment except for the prohibition of the addition of new matter. (Examination Guidelines Part IV, Chapter 2. Section 1.1)	and claims, and the contents determined directly and unambiguously according to the contents described in the initial description and claims, and the drawings of the description. If, after the addition, change and/or deletion of part of the contents of the application, the information as seen by a person skilled in the art is different from those described in the initial application and such information cannot be directly or unambiguously derived from those described in the initial application, such amendment shall not be allowable.
(ii) Explicit new matter	Making an amendment to not only “matters explicitly stated in the originally attached description, etc.” but also “matters obvious from the statement in the originally attached description, etc.” that are not explicitly stated does not introduce new technical matters and is permitted. (Examination Guidelines Part III. Chapter 1. Section 3. 1 (1))	‘New matter’ refers to an element which is out of the scope of the specification or drawing(s) attached to the patent application. In this context, matters in the specification or drawing(s) attached to the application (hereinafter referred to as ‘the original specification’) mean the elements which are explicitly described in the specification or drawing(s). (Examination Guidelines Part IV, Chapter 2. Section 1.1)	The principle is the amendment of the application documents shall not go beyond the scope of disclosure contained in the initial description and claims, which is substantially the same with “prohibition of new matter”.
(iii) Implicit new matter	Making an amendment to not only “matters explicitly stated in the originally attached description, etc.” but also “matters obvious from the statement in the originally attached description, etc.” that are not explicitly stated does not introduce new technical matters and is permitted. (a) In order to find that amended matters are “matters obvious from the statement in the originally attached description, etc.,” it is required that a person skilled in the art evidently understands them as if they were stated therein, in the light of the common general knowledge. (Examination Guidelines Part III. Chapter 1. Section 3. 1 (1), (2))	Even if elements described in the specification or drawing(s) are not expressly described, if it is obvious for a person skilled in the art through his/her assessment on the elements in the original application, claims or drawing(s) that the matters are written, such elements shall not be new matter. (Examination Guidelines Part IV, Chapter 2. Section 1.1)	same as 3. (2) (ii) Explicit new matter.
(iv) Assessment of new matter			
(a) General rule	Any amendment that includes contents	The subject of assessment in addition of new	As a principle, any amendment to the

	<p>beyond the scope of “matters stated in the originally attached description, etc.” (the amendment including new matter) is not permitted. “The matters stated in the description or drawings” mean technical matters which a person skilled in the art can understand, taking into account all statements in the description or drawings. Where an amendment does not add any new technical matters to the technical matter which can be understood in this manner, the amendment can be deemed to be made within “the scope of the matters stated in the description or drawings.”</p> <p>(Examination Guidelines Part III, Chapter 1, Section 3.)</p>	<p>matter shall be the amended specification, claims or drawing(s). The addition of new matter to any of the specification, claims or drawing(s) shall not be accepted.</p> <p>The specification, claims or drawing(s) originally attached to the patent application shall be the subject of comparison of whether new matter is added to the amended specification, claims or drawing(s).</p> <p>Whether new matter is added to the amended specification, claims or drawing(s) shall be determined by whether elements described in the amended specification, claims or drawing(s) (the subject of assessment) are in the scope of the elements described in the specification or drawing(s) (the subject of comparison).</p> <p>In this context, the phrase of ‘being in the scope of the elements described in the specification or drawing(s)’ does not mean being completely and externally the same within the scope of matters described in the specification, claims or drawing(s) originally attached to the patent application. Also, matters that is obvious for a person skilled in the art based on matters described in the specification, claims or drawing(s) originally attached to the patent application shall be deemed as being in the scope of matters described in the specification or drawing(s) .</p> <p>(Examination Guidelines Part IV, Chapter 2, Section 1.1)</p>	<p>description (and the drawings) and the claims that is not in conformity with Article 33 is not allowable.</p> <p>Specifically, if, after the addition, change and/or deletion of part of the contents of the application, the information as seen by a person skilled in the art is different from those described in the initial application and such information cannot be directly or unambiguously derived from those described in the initial application, such amendment shall not be allowable.</p> <p>The contents of the application refer to contents described in the initial description (and the drawings) and claims, not including the contents of any priority documents.</p> <p>(Examination Guidelines Part II Chapter 8, Section 5.2.3)</p>
(b) Application with priority claim	<p>A priority certificate (namely, a priority certificate in cases of priority under the Paris Convention or the like provided in the Patent Act Article 43 (2) and 43bis, and filing documents of an earlier application in case of a domestic priority provided in the Patent Act Article 41) cannot be the basis for determining whether new matter is added because the priority certificate is not included in the description, etc.</p>	<p>Since an application in the country where the application was initially filed, which forms the basis of the priority claim, or a prior application shall not correspond to the specification, claims or drawing(s) originally attached to the patent application, such applications shall not be used as the basis of assessment in addition of new matter.</p> <p>(Examination Guidelines Part IV, Chapter 2, Section 1.2)</p>	<p>The contents of the priority documents submitted by the applicant to the Patent Office shall not be taken as the basis to judge whether the amendment to the application documents meet the requirements of Article 33.</p> <p>(Examination Guidelines Part II Chapter 8, Section 5.2.1.1)</p>

	(Examination Guidelines Part III. Chapter 1. Section 3. 2 (1))		
(c) Application through PCT route	<p>(1) New matter beyond original text in the case of a foreign language written application and an international patent application in the foreign language It is prohibited to submit a translation which includes a matter beyond the foreign language document or beyond the description, etc. as of the international filing date, or to add new matter beyond the original text to the description, claims or drawings through subsequent amendments. As in the case where new matter is added to a regular Japanese application, the existence of "new matter beyond the original text" shall be deemed as a reason for refusal with regard to the foreign language written application and the foreign language PCT patent application (the Patent Act Article 49 (vi), Article 184 duodevicies). (Examination Guidelines Part VIII. Section 5.1.1)</p> <p>(2) New matter beyond translation in the case of a foreign language written application and an international patent application in the foreign language In cases where a regular amendment does not satisfy the requirements under the Patent Act Article 17bis (3), as in the following cases (i) or (ii), such an amendment is deemed to add new matter beyond translation: (i) Cases where any statement of correction of an incorrect translation has not been submitted, and where a regular amendment to the description, claims or drawings introduces a matter which is not disclosed in the translation considered to be the description, claims and drawings by virtue of the Patent Act Article 36bis (2); or (ii) Cases where a statement of correction</p>	An amendment to the specification or drawing(s) of an application through PCT route shall be made within the scope of matters written in the specification or drawing(s) originally attached to the international application, in other words, 'matters described in the description, claims and drawings submitted by the international filing date. (Patent Act Article 47(2); Article 200 bis (2))	The amendment of the application through PCT route shall not go beyond the scope of disclosure contained in the claims, description and drawings of the international application as originally filed.

	<p>of an incorrect translation has been submitted, and where a later regular amendment to the description, claims or drawings introduces a matter which is neither disclosed in the translation considered to be the description, claims and drawings by virtue of the Patent Act Article 36bis (2) nor is disclosed in the description, claims or drawings as corrected by the said statement of correction of the incorrect translation. When a regular amendment is made to add a new matter beyond the translation, such an amendment constitutes a reason for refusal (the Patent Act Article 17bis (3) and Article 49 (i)).</p> <p>The provisions concerning new matter beyond translation do not apply to the amendment made by a statement of correction of an incorrect translation.</p> <p>(3)Amendment in the case of an international patent application in the Japanese language An amendment to the description, claims or drawings of an international patent application in the Japanese language shall be made within the scope of matters written in the description, claims or drawings originally attached to the international application.</p>		
(d) Matters described in abstract	<p>Any amendment of the description, claims or drawings shall be made within the scope of the matters described in the description, claims or drawings originally attached to the application (Patent Act Article 17bis (3))</p> <p>Therefore the abstract cannot be used as a basis when determining whether new matter is added.</p>	<p>Since an abstract shall not correspond to a specification or drawing(s), an abstract shall not be included in the specification or drawing(s) which forms the basis of assessment in addition of new matter. Adding such matters disclosed only in an abstract to a specification through amendment shall not be allowed.</p> <p>(Examination Guidelines Part II, Chapter 2, Section 3; Part IV, Chapter 2. Section 1.2)</p>	<p>The abstract is a summary of the contents set forth in the description. It is just a sort of technical information with no legal effect.</p> <p>The contents of the abstract do not form a part of the initial disclosure of the invention. Therefore, they shall not serve as a basis for subsequent amendments to the description or claims, nor shall they be used to interpret the extent of protection of the patent right.</p> <p>(Examination Guidelines Part II Chapter 2. Section 1 and Section 2.4)</p>

(e) Amendment of abstract	<p>An applicant for a patent may amend the abstract attached to the application within one year and three months (except for the period after a request for laying open of application is filed) from the filing date (when claiming a priority, from priority date) of the patent application. (Patent Act Article 17ter)</p>	<p>When an abstract is poorly written without referring to the guideline for writing abstracts under Annexed Form No. 16 of the Enforcement Rules of the Patent Act, the abstract can be subject to request for amendment under Article 46 of the Patent Act.</p> <p>An applicant can amend an abstract of an application which is pending before KIPO. Therefore, if the application has been invalidated, withdrawn, abandoned, or a decision to reject the application has become final and binding, the amendment shall not be made. (Examination Guidelines Part II, Chapter 2. Section 3 ; Part IV, Chapter 1. Section 3.1)</p>	<p>As to the amendment of abstract it should indicate the title of the invention and the technical field to which the invention pertains, clearly reflect the technical problems to be solved, the essential contents of the technical solution for solving said problems; delete of the commercial advertising; change of the drawing of the abstract to make it best reflect the main technical features of the invention. (Examination Guidelines Part II Chapter 8. Section 5.2.2.2)</p>
(f) Completing an incomplete invention	<p>Since an amendment to complete an incomplete invention includes contents beyond the scope of "matters stated in the originally attached description, etc." (the amendment includes new matter), the amendment is not permitted.</p>	<p>In the case of completing an incomplete invention, the amendment shall be deemed to contain new matter. (Examination Guidelines Part IV, Chapter 2. Section 1.2)</p>	<p>Disallowable Additions :</p> <ul style="list-style-type: none"> i) The technical features which cannot be directly and definitely confirmed from the initial description (and the drawings) and/or claims are introduced into the claims and/or description. ii) The information which cannot be directly and unambiguously determined from the initial description (and the drawings) and/or claims is added to make the disclosed invention clear or the claims complete. iii) The contents added are the technical features relating to the parameter of size obtained by measuring the drawings. iv) The additional component which has not been mentioned in the initial application documents is introduced, which leads to special effects which do not exist in the initial application. (Examination Guidelines Part II Chapter 8. Section 5.2.3.1)
(g) Amending conflicting elements	<p>An amendment to add matters irrelevant to or inconsistent with matters stated in the originally attached description, etc. is not permitted.</p> <p>If two or more kinds of inconsistent statement are present in the description,</p>	<p>Where a person skilled in the art clearly understands which of more than two contrasting elements is right based on matters described in the specification or drawing(s), the amendment of writing the correct matters shall not be deemed as addition of new matter. (Examination Guidelines Part IV, Chapter 2.</p>	<p>Allowable Amendments :</p> <p>The content in the part of "Contents of Invention" which relates to the technical solution of the invention is amended to make it adapted to the claimed subject matter of the independent claim. If</p>

	<p>etc. and it is evident to a person skilled in the art from the statement of the originally attached description, etc., which of them is correct, an amendment to match it with the correct statement is permitted. Moreover, even if the statement is not in itself unclear, an amendment to make it clear is permitted if its inherent meaning is evident to a person skilled in the art from the statement of the originally attached description, etc.</p> <p>(Examination Guidelines Part III. Chapter 1. Section 5. 2 (4), (5))</p>	<p>Section 1.2)</p>	<p>amendments have been made to the independent claim which meet the requirements of the Patent Law and its Implementing Regulations, the corresponding amendments may be made in this part. If there is no amendment of the independent claim, such amendments as polishing of the language, standardization of the words and unifying the technical terms are allowable provided that the initial technical solution is not changed.</p> <p>(Examination Guidelines Part II Chapter 8. Section 5.2.2.2)</p>
<p>(h) Disclaimer claim</p>	<p>“Disclaimer” refers to claims explicitly stating exclusion of only part of matters included in the claimed inventions from matters stated in said claims, while leaving the expression of the statement of matters stated in the claims.</p> <p>“Disclaimer,” which excludes matters stated in the originally attached description, etc. through amendment while leaving the expression of the statement of matters stated in claims before amendment, is permitted if the “disclaimer” after exclusion is included within a scope of matters stated in the originally attached description, etc.</p> <p>The amendment to provide a “disclaimer” in the following (i) and (ii) does not introduce new technical matters, and the amendment is permitted.</p> <p>(i) If the claimed invention overlaps with the prior art and is thus likely to lose novelty, etc. (the Patent Act Article 29 (1) (iii), Article 29bis or Article 39), making an amendment to exclude only the overlap while leaving the expression of the statement of matters stated in claims before amendment.</p> <p>(ii) If the claimed invention includes the term “human being” and thus does not satisfy the requirement of the main paragraph of the Patent Act Article 29 (1),</p>	<p>An amendment to a so-called ‘disclaimer claim’ is not mostly deemed as addition of new matter. For example, where it is not specified whether the claimed invention regarding medical methods for humans or for animals, if the invention is obviously not limited only for particular animals, the amendment of deleting the parts related to humans shall not be deemed as addition of new matter.</p> <p>(Example) Where ‘treatment methods for mammals’ are amended into ‘treatment methods for mammals except for humans’ or ‘treatment methods for livestock’</p> <p>(Examination Guidelines Part IV, Chapter 2. Section 1.2)</p>	<p>If no other numerical value within the initial numerical range of a certain technical feature is described in the initial description and claims, while novelty and inventive step are prejudiced by the contents disclosed in reference documents, or the invention cannot be carried out when said feature adopts certain parts of the initial numerical range, in view of these two situations, the applicant has to use a specific “disclaimer” to exclude said parts from the initial numerical range so that the numerical range of the claimed technical solution does not include said parts obviously as a whole, such amendment shall not be allowed because the amendment has gone beyond the scope of disclosure contained in the initial description and claims, with the exception that the applicant can prove, in accordance with the contents described in the initial application, that the invention cannot be carried out when said feature adopts the “disclaimed” numerical value, or the invention possesses novelty and involves an inventive step when said feature adopts the numerical value after the “disclaimer”. For example, the numerical range in the claimed technical solution is X1=600-10000, the only difference between the technical contents disclosed in the</p>

	<p>or falls under unpatentable grounds provided Part III Amendment of Description, Claims and Drawings in the Patent Act Article 32, and said reason for refusal is eliminated by exclusion of the term “human being,” making an amendment to exclude only the term “human being” while leaving an expression of the statement of matters stated in claims before amendment. (Examination Guidelines Part III. Chapter 1. Section 4. 2 (4))</p>		<p>reference documents and said technical solution is that said numerical range in the former is X2=240-1500.As X1 and X2 overlap partially, the claim does not possess novelty. The applicant uses the specific “disclaimer” to amend X1,excluding from X1 the portion that X1 and X2 overlap, i.e.,600-1500,thus,said numerical range of the claimed technical solution is changed to be from X1 >1500 to X1=10000. If the applicant can neither prove that the inventions within the numerical range from X1>1500 to X1=10000 involve inventive step with reference to those within the X2=240-1500 range described in the reference documents based upon the initially disclosed contents and the prior art, nor prove that the invention cannot be carried out when X 1 is within 600-1500, such amendments shall not be allowed. (Examination Guidelines Part II Chapter 8. Section 5.2.3.3)</p>
<p>(i) Changing scope of numerical limitation</p>	<p>An amendment for adding numerical limitation is permitted if the numerical limitation is within a scope of matters stated in the originally attached description, etc.</p> <p>If examples of 24 degrees and 25 degrees are stated, this cannot be a direct basis for permitting an amendment of the numerical limitation of “24 to 25 degrees.” However, it may be found that a specific scope of 24 to 25 degrees was referred to in light of the whole statement of the originally attached description, etc. (in cases where, for example, 24 degrees and 25 degrees are found to be stated as border values of upper limit and lower limit, etc. of a certain consecutive numerical range in light of the statement of the problem, effect, etc.). In this case, unlike cases of absence of an example, it can be evaluated that the numerical limitation was stated originally, and new technical matter is not introduced. The amendment is, therefore,</p>	<p>If amended matters are not obvious from the originally attached description, etc., the amendment shall be deemed as addition of new matter. Such amendments are as follows: amendment of changing the scope of numerical limitation, amendment of changing features of an invention into a generic concept or subordinate concept, amendment of changing drawing(s), amendment of adding embodiments, or amendment of adding or changing purposes or effects of an invention. (Examination Guidelines Part IV, Chapter 2. Section 1.2)</p>	<p>As for the amendment to the numerical range of the claim which contains the technical feature defined by such range, it is allowable only when the two extreme values of the revised numerical range are really described in the initial description and/or claims and the revised numerical range is within the initial numerical range. For example, the range of temperature in the technical solution of the claim is 20°C-90°C. The difference between the technical contents disclosed in the reference documents and this technical solution is that the corresponding range of temperature disclosed in the reference documents is 0°C-100°C,and a specific numerical value of 40°Cis also disclosed in the reference documents. Therefore, the examiner shall indicate in the Office Action that said claim does not possess novelty. If the specific numerical values of 40°C, 60°C and 80°C in the range of 20°C-90°C are</p>

	<p>permitted.</p> <p>Moreover, if, for example, an amendment changes a minimum value of a numerical range stated in claims to provide a new numerical range, and the minimum value of the new numerical range was stated in the originally attached description, etc. and the numerical range after amendment is included in the numerical range stated in the originally attached description, etc. said amendment is permitted.</p> <p>(Examination Guidelines Part III. Chapter 1. Section 4. 2 (3))</p>		<p>also mentioned in the description or claims of the invention application, it is allowable for the applicant to change the range of temperature in the claim to 60°C-80°C or 60°C-90°C.</p> <p>(Examination Guidelines Part II Chapter 8. Section 5.2.2.1)</p>
<p>(j) Changing a subordinate concept into a generic concept in an invention</p>	<p>If, by amending a matter which specifies the invention of claims to a generic concept (including removing the matters used to specify the invention), matters other than those stated in the originally attached description, etc. are added, the amendment is not made within the scope of matters stated in the original description, etc. and is not permitted.</p> <p>If, by changing the matters used to specify the invention in claims adds, matters other than those stated in the original description, etc., are added, the amendment is not made within the scope of matters stated in the original description, etc. either and is not permitted.</p> <p>An amendment which removes part of the matters used to specify the invention in claims and amending them and makes them the generic concept does not introduce new technical matters when the amendment does not clearly add any new technical significance. This is the case even when the amended matter falls under neither "matters explicitly stated in originally attached description, etc." nor "matters obvious from the statement in</p>	<p>see above item</p>	<p>Disallowable changes: (1)The technical features of the claims are changed. Such amendment goes beyond the scope of disclosure contained in the initial claims and description.</p> <p>[Example 2] What is claimed in the initial claim is the component for manufacturing rubber. It cannot be replaced by the component for manufacturing elastic material, unless it is clearly indicated in the initial description.</p> <p>[Example 3] A kind of brake of bicycle is claimed in the initial claim, and the applicant amends it as a kind of brake of vehicle. This amended technical solution cannot be directly derived from the initial claims and description. Such amendment has also gone beyond the scope of disclosure contained in the initial claims and description.</p> <p>[Example 4] The component or part which has specific structure features is replaced by "functional term+means" which cannot be directly derived from the initial application</p>

	<p>the originally attached description, etc.," and is permitted. (Examination Guidelines Part III. Chapter 1. Section 4. 2 (1))</p>		<p>documents. Such amendment has gone beyond the scope of disclosure contained in the initial claims and description.</p> <p>(4)Certain feature described in the description is changed to make the changed technical contents different from those described in the initial application documents. Such amendment goes beyond the scope of disclosure contained in the initial description and claims.</p> <p>[Example 2] The content of "such as helical springs supports" is described in the initial application documents, and after the amendment, said content in the description is altered to "resilient supports", which leads to the broadening of specific helical springs supports to all the possible resilient supports. Such amendment makes the technical contents go beyond the scope of disclosure contained in the initial description and claims. (Examination Guidelines Part II Chapter 8. Section 5.2.3.2)</p> <p>Under the following circumstances, even though the contents of the amendment do not go beyond the scope of disclosure contained in the initial description and claims, the amendment shall not be deemed to be made in answer to the defects as indicated in the Office Action, therefore the amendment shall be unacceptable.</p> <p>(2)The applicant has changed one or more of the technical features of the independent claim on his own initiative, which leads to the expanding of the extent of protection claimed in the claim.</p> <p>For example, the applicant has, on his own</p>
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			<p>initiative, replaced the technical feature "helical springs" by "resilient part". Although the technical feature of "resilient part" has been described in the initial description, it is not acceptable since such change will expand the extent of protection. (Examination Guidelines Part II Chapter 8. Section 5..2.1.3)</p>
(k) Changing a generic concept into a subordinate concept in an invention	<p>If, by amending a matter to a more specific concept (including adding the matters used to specify the invention), matters other than those stated in the original description, etc. are individuated, the amendment is not made within the scope of matters stated in the original description, etc. and is not permitted.</p> <p>If, by changing the matters used to specify the invention in claims adds matters other than those stated in the original description, etc., are added the amendment is not made within the scope of matters stated in the original description, etc. either and is not permitted.</p> <p>An amendment which limits part of the matters used to specify the invention in claims so that the limited matters fall under the generic concept of the matter stated in the original description does not introduce new technical matters when the amendment does not clearly add any new technical significance. This is the case even when the amended matter falls under neither "matters explicitly stated in originally attached description, etc." nor "matters obvious from the statement in the originally attached description, etc." and is permitted.</p> <p>(Examination Guidelines Part III. Chapter 1. Section 4. 2. (1))</p>	see above item	<p>Disallowable changes:</p> <p>(2)New contents are introduced by changing indefinite contents into definite and specific contents.</p> <p>For example, there is an invention application relating to the synthesis of a high molecular compound. It is just indicated in the initial application documents that the polymerization reaction is carried out at "higher temperature". When the applicant knows that it is indicated in a reference document cited by the examiner that the same reaction is carried out at the temperature of 40°C, he changes the "higher temperature" °C to "temperature higher than 40°C". Although "temperature higher than 40°C" falls into the scope of "higher temperature", a person skilled in the art is unable to draw a conclusion that "higher temperature" refers to "temperature higher than 40°C" from the initial application documents. Therefore, such amendment has introduced new contents.</p> <p>(Examination Guidelines Part II Chapter 8. Section 5..2.3.2)</p>
(l) Adding embodiments	Generally, adding an example of the invention or adding materials falls under	see above item	<p>Disallowable Additions :</p> <p>The specific mode for carrying out the</p>

	an amendment beyond the scope of matters stated in the originally attached description, etc. (Examination Guidelines Part III. Chapter 1. Section 5. 2. (2))		invention or embodiment is added to prove that the invention can be carried out in the extent of protection claimed in the claims (Examination Guidelines Part II Chapter 8. Section 5.2.3.1)
(m) Later submitted experimental data	Written opinions and reports of experiment results submitted in response to the notice of reasons for refusal cannot substitute for the description in the description, but if the applicant argue and prove thereby that the matters disclosed in the description or drawings as originally filed are correct and proper, the examiner should take into consideration of these particulars. (Examination Guidelines Part IX. Chapter 2. Section 4. 3. 2. (3))	see above item	Disallowable Additions : The experimental data for illustrating the advantageous effects of the invention is not allowable to add to the description. (Examination Guidelines Part II Chapter 8. Section 5.2.3.1)
(n) Amendment of the technical field of the invention		see above item	In order to enable the public and the examiner to clearly understand the invention and the relevant prior art, the applicant is allowed to amend the technical field of the invention to make it relevant to the corresponding field which is defined in the lowest classification position of the IPC. (Examination Guidelines Part II Chapter 8. Section 5.2.2.2)
(o) Changing or adding purpose or effect of an invention	Generally, an amendment to add effects of the invention falls under an amendment beyond the scope of matters stated in the originally attached description, etc. However, if the originally attached description, etc. explicitly states the structure, operation, or function of the invention and the said effect is an obvious matter from this statement, an amendment is permitted. (Examination Guidelines Part III. Chapter 1. Section 5. 2 (3))	see above item	Allowable Amendments : i) The content in the part of "Contents of Invention" which relates to the technical problem to be solved by the invention is amended to make it more consistent with the claimed subject matter, i.e., reflecting the technical problem to be solved by the technical solution of the invention with reference to the closest prior art. Of course, the amended contents shall not go beyond the scope of disclosure contained in the initial description and claims. ii) The content in the part of "Contents of Invention" which relates to the advantageous effects of the invention is amended. Such amendment is allowable only when the technical feature(s) is clearly described in the initial application

			documents, but its advantageous effect is not mentioned clearly, and it can be deduced directly and unambiguously by a person skilled in the art from the initial documents. (Examination Guidelines Part II Chapter 8. Section 5.2.2.2) Disallowable Additions : The useful effects which cannot be directly derived from the initial application by a person skilled in the art are added. (Examination Guidelines Part II Chapter 8. Section 5.2.3.1)
(p) Amendment from prior art stated in the specification	Pursuant to the Patent Act Article 36 (4) (ii), the prior art document information (name of publications in which the relevant invention was stated and location of other information of the inventions disclosed in the publication) is required to be stated. Therefore, an amendment to add the prior art document information in the detailed description of the invention and add contents stated in the document to "Background Art" of the description does not introduce new technical matter and is permitted. However, an amendment to add information on evaluation of the invention, such as comparison with the invention in the application or information on implementation of the invention, or an amendment to add contents stated in the prior art document to eliminate violation of the Patent Act Article 36 (4) (i) introduces new technical matter and is not permitted. (Examination Guidelines Part III. Chapter 1. Section 5. 2 (1))	An amendment of just adding the title of a prior art document is not deemed as adding new matter. However, an amendment of adding matters which were originally referred to, but were only described in the prior art documents other than the original specification shall be deemed as addition of new matter when such added matters is not obvious to a person skilled in the art based on the specification, claims or drawing(s) originally attached to the patent application.(Examination Guidelines Part IV, Chapter 2. Section 1.2)	The part of "Background Art" is amended to make it consistent with the claimed subject matter of the invention. Where the independent claim is drafted according to Rule 21,the relevant contents of the prior art described in the preamble portion of the claim shall be contained in the part of "Background Art" of the description, and the documents reflecting the background art shall be cited. If,through search, the examiner finds any reference documents which are even more related to the claimed subject matter of the invention than the prior art cited in the initial description by the applicant, the applicant shall be allowed to amend such part of the description by adding the contents of these documents and citing the documents. At the same time, the contents describing the unrelated prior art shall be deleted. It shall be noted that such amendment, in fact, has introduced the contents which are not contained in the initial claims and description. However, since the amendment relates just to the background art other than the invention per se, and the contents added are prior art already known to the public before the date of filing, it is allowable.(Examination Guidelines Part II Chapter 8. Section 5.2.2.2)
(q) Adding well-known prior arts	Making an amendment to not only "matters explicitly stated in the originally	Though the added matters through amendment are well-known prior arts, if it is not obvious for	It is allowed to add the public known technology in the background technology

	<p>attached description, etc.” but also “matters obvious from the statement in the originally attached description, etc.” which are not explicitly stated does not introduce new technical matters and is permitted.</p> <p>As for well-known art or commonly used art, the technology cannot sufficiently be considered as “matters obvious from the statement in the originally attached description, etc.” just because the technology itself is well-known art or commonly used art.</p> <p>(Examination Guidelines Part III. Chapter 1. Section 3. 1 (1) (b))</p>	<p>a person skilled in the art that the added matters are the same as the matters described in the specification or drawing(s), the amendment of adding such well-known prior arts shall be deemed as addition of new matter out of the scope of the matters described in the specification or drawing(s).</p> <p>(Examination Guidelines Part IV, Chapter 2. Section 1.2)</p>	<p>part of the specification (Guideline part 2 Chapter 8, section 5.2.2.2 sec(3)). However, if the adding refers to the invention itself, that is to say, the adding affects the technical problem, solution or technical effect, the adding is not allowed.</p>
(r) Adding later searched prior art not stated in the original application	<p>Pursuant to the Patent Act Article 36 (4) (ii), the prior art document information (name of publications in which the relevant invention was stated and location of other information of the inventions disclosed in the publication) is required to be stated. Therefore, an amendment to add the prior art document information in the detailed description of the invention and add contents stated in the document to “Background Art” of the detailed description of the invention does not introduce new technical matter and is permitted. However, an amendment to add information on evaluation of the invention, such as comparison with the invention in the application or information on implementation of the invention, or an amendment to add contents stated in the prior art document to eliminate violation of the Patent Act Article 36 (4) (i) introduces new technical matter and is not permitted.</p> <p>(Examination Guidelines Part III. Chapter 1. Section 5. 2 (1))</p>	<p>Just adding the titles of prior art documents to a description shall not be deemed as addition of new matter.</p> <p>However, an amendment based on the matters described in the prior art documents shall be deemed as addition of new matter when such added matters is not obvious to a person skilled in the art based on the specification, claims or drawing(s) originally attached to the patent application.</p> <p>(Examination Guidelines Part IV, Chapter 2. Section 1.2)</p>	<p>If, through search, the examiner finds any reference documents which are more relevant to the claimed subject matter of the invention than the prior art cited in the initial description by the applicant, the applicant shall be allowed to amend such part of the description by adding the contents of these documents and citing the documents. At the same time, the contents describing the unrelated prior art shall be deleted. It shall be noted that such amendment, in fact, has introduced the contents which are not contained in the initial claims and description. However, since the amendment relates just to the background art other than the invention per se, and the contents added are prior art already known to the public before the date of filing, it is allowable.</p> <p>(Examination Guidelines Part II Chapter 8. Section 5.2.2.2 (3))</p>
(3) Assessment of new matter regarding inventions of special fields			
(i) Bio-tech. inventions	<p>An amendment to convert or add an accession number of a microorganism is</p>	<p>Sequence listings of nucleic acids or amino acids - A person who intends to file a patent</p>	<p>Assessment of new matter shall apply to Chapter 8. Section 5.2.</p>

	<p>acceptable because it does not introduce any new technical matter, if microbiological characteristics of the microorganism are described in the description, claims or drawings as of filing, to the extent that the microorganism can be specified, and deposit of the microorganism can be specified based on the name of the depositary institution, etc.</p> <p>An amendment converting a storage number of a microorganism to an accession number based on the deposit of the microorganism with a depositary institution for the purpose of patent procedure, is acceptable because it does not introduce any new technical matter, if the microorganism used is stored at a reliable public culture collection, the storage number of the microorganism is explicitly stated in the description, claims or drawings as of the filing and it is clear that the identity of the microorganism is not lost.</p> <p>In such a case, the applicant should make an amendment of the accession number without delay.</p> <p>An amendment converting a reference number of a microorganism to a corresponding accession number is obviously acceptable, if the reference number issued by the depositary institution designated by the Commissioner of the Japan Patent Office is described in the description, claims or drawings as of the filing (A reference number corresponds to the number adding "A" to the head of an accession number in a depositary institution designated by the Commissioner of the Japan Patent Office).</p> <p>An amendment adding microbiological characteristics of a microorganism is not acceptable because it introduces new technical matter unless those</p>	<p>application including nucleic acid sequence or amino acid sequence (hereinafter referred to as 'sequence') shall attach the following documents to a patent application and submit them to the Commissioner of the Korean Intellectual Property Office.</p> <ul style="list-style-type: none"> - Where the sequence list is submitted to be attached to the specification after the notice of rejection, it shall be determined based on the provision of prohibition of addition of new matter. (Examination Guidelines Part II, Chapter 6, Section 5) <p>Deposit number and certificate of microorganism</p> <ul style="list-style-type: none"> - Where the initial specification of an application where a micro-organism is to be deposited did not state the deposit number and then the number is disclosed through amendment, it shall be deemed to be the addition of new matter. - Where a micro-organism is deposited and the deposit certificate is attached before filing the application and relevant facts such as deposit numbers in the specification, but the patent classification of the deposited micro-organism is adjusted and then its name is changed, if a copy of the evidential document issued by a depositary institution is submitted, it shall not be deemed to be the addition of new matter even though an amendment of changing the name of the concerned micro-organisms is made. However, where the scientific characteristic of the concerned micro-organism of the newly-adjusted patent classification which is not disclosed in the originally attached specification is stated, it shall be deemed to be the addition of new matter. (Examination Guidelines Part II, Chapter 6, Section 4) 	<p>It should be noted that the contents in the registration form do not belong to the disclosure contained in the initial description and claims. Therefore, it can neither be used as the basis to judge whether the description has sufficiently disclosed the claimed invention, nor as the basis to amend the description and claims. (Examination Guidelines Part II Chapter 10, Section 9.5.3))</p> <p>If the applicant submitted on time, the request, certificate of deposit and certificate of viability which complied with Rule 24, but failed to indicate the information about the deposit in the description, it is permitted for the applicant to add the relevant information in the request to the description in the stage of substantive examination. (Examination Guidelines Part II Chapter 10, Section 9.2.1)</p> <p>The "Sequence Listing" shall be arranged at the end of the description as a separate part of it. If the nucleotide or amino acid sequence listing recorded in computer-readable copy submitted by applicant is not consistent with that written sequence listing disclosed in the description and claims, the written sequence listing shall prevail. (Examination Guidelines Part II Chapter 10, Section 9.2.3)</p> <p>The contents in the registration form for Indicating Source of Genetic Resources do not belong to the disclosure contained in the initial description and claims. Therefore, it can neither be used as the basis to judge whether the description has sufficiently disclosed the claimed invention, nor as the basis to amend the description and claims. (Examination Guidelines Part II Chapter 10, Section 9.5.3)</p>
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	<p>characteristics are obvious from the statement in the description, claims or drawings as of the filing, even if the accession number of the microorganism stated in the description, claims or drawings as of the filing is not changed and microbiological characteristics of the microorganism are described in the description, claims or drawings as of the filing to the extent that the taxonomic species of the microorganism can be specified.</p> <p>Amendment of the description, claims or drawings relating to the deposit of microorganisms, plants and animals, etc. is handled as described above.</p> <p>(Examination Guidelines Part VII. Chapter 2 Section 2. 3)</p>		
(ii) Chemical compound inventions	<p>In a claim stated in an alternative form such as a Markush-type claim, an amendment for removing part of the alternatives is permitted if the remaining matters used to specify the invention are within a scope of matters stated in the description, etc. originally attached to the application.</p> <p>If a specific combination of alternatives is added in claims within a scope of many alternatives stated in the originally attached description, etc. or a combination of specific alternatives is left in claims as a result of the removal of alternatives stated in the originally attached description, etc., it may not be determined that the specific combination of alternatives was stated in the originally attached description, etc. In particular, if a substitute group which had several alternatives as of the filing has only one alternative as a result of the amendment, the amendment is not permitted because the original statement would not mean</p>	<p>As for chemical substance invention, the detailed manufacturing process of the chemical substance, let alone the description of the chemical substance itself, shall be described, except for the case where a person skilled in the art would easily understand the chemical reaction disclosed in the specification based on the level of technology at the time of the application filing.</p> <p>As for chemical substance invention, its embodiment shall include the detailed response conditions necessary for manufacturing the substance invention such as the starting material, temperature, pressure, inflow and outflow and the result of the direct experiment under such conditions.</p> <p>(Examination Guidelines Part II, Chapter 3. Section 2.3.2)</p> <p>If amended matters are not obvious based on the matters described in the specification or drawing(s), the amendment shall be deemed as addition of new matter. Such amendments are as follows: amendment of changing the scope of</p>	<p>Assessment of new matter shall apply to Chapter 8. Section 5.2.</p>

	<p>employing a specific alternative except when employing a combination of such specific alternatives has been stated in the originally attached description, etc. On the other hand, if alternatives supported by examples remain as result of removal of alternatives, the remaining alternatives may be found to be a matter stated in the originally attached description, etc. in view of the whole statement of the originally attached description, etc. For example, if a group of chemical substances in a form of a combination of substituted groups with alternatives is stated in the originally attached description, etc., a permissible amendment would be one that left only the statement of the (group of) chemical substances consisting of specific alternatives corresponding to “a single chemical substance” that was stated in an example, etc. in the originally attached description.</p> <p>(Examination Guidelines Part III. Chapter 1. Section 4. 2)</p>	<p>numerical limitation, amendment of changing features of an invention into a generic concept or subordinate concept, amendment of changing drawing(s), amendment of adding embodiments, or amendment of adding or changing purposes or effects of an invention. (Examination Guidelines Part IV, Chapter 2. Section 1.2)</p>	
(iii) Others	<p>“Program listings” can be submitted and filed as reference material. However, the description cannot be amended on the basis of such reference material. (Examination Guidelines Part VII. Chapter 1. Section 1. 2. 2 (3))</p>	<p>Computer programs When short program list written in language known to skilled person in the art has full explanation and helps to understand invention, it may be described in specification or drawings (The list is possibly submitted as reference materials. Specification, however, may not be amended based on the statement of reference materials). (Examination Guidelines Part IX, Chapter 1. Section 2.1.3)</p> <p>Foods Applicants may respond to the ground of rejection for violation of enablement requirements for food due to the physical safety by providing explanation of its safety in written opinion and its objective evidence. Amendment by adding clarification and document of the</p>	<p>In order to describe clearly, where necessary, the applicant may briefly extract some important parts from the computer source program, in marked program language that is customarily used, to serve as a reference. (Examination Guidelines Part II Chapter 9, Section 5.1)</p>

		<p>safety to details of invention should be carefully presented, since it possibly becomes the addition of new matter unless the explanation is evidently from the statement of the originally submitted specification. (Examination Guidelines Part IX, Chapter 4. Section 3)</p> <p>Alloy Invention of an alloy mainly includes invention defined by numerical limitation. Since the technical scope of invention defined by numerical limitation is quite clear, amendment to specification or drawings is most likely to be the addition of new matter. According to the specification initially attached to application, amendment such as deletion of component; addition of new component; change of scope of composition; and addition or expansion of new property or purpose is recognized as the addition of new matter in specification.</p> <p>If, however, there is no change of property and purpose by reducing the scope of composition, it will not be deemed as the addition of new matter. (Examination Guidelines Part IX, Chapter 7. Section 2)</p>	
4.Types of Amendment			
(1) Voluntary amendment (self-amendment)	An applicant for a patent may amend the description, claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted, provided that the applicant has not received a notice of reasons for refusal. (Patent Act Article 17bis (1))	A patent applicant may amend the specification or drawings attached to a patent application within the period before the commissioner of the Korean Intellectual Property Office delivers a certified copy of a decision to grant a patent. However, where an applicant receives a notice of grounds for rejection, an amendment shall be made within the period for submission of opinions following the relevant notice of grounds for rejection. (Patent Act Article 47(1))	When requesting substantive examination, or within three months after receiving the notification of the patent administration department under the State Council on the entry into substantive examination, the applicant for a patent for invention may amend the application for a patent for invention on his or its own initiative. (Rule 51.1) Where an international application was amended in the international phase and the applicant requests that the examination be based on the amended application, the Chinese translation of the

			<p>amendments shall be submitted within two months from the date of entry. Where the Chinese translation is not submitted within the said time limit, the amendments made in the international phase shall not be taken into consideration by the patent administration department under the State Council. (Rule 106) With regard to an international application for a patent for invention, Rule 51.1 shall apply. (Rule 112) Where the applicant finds that there are mistakes in the Chinese translation of the description, the claims or the text matter in the drawings as filed, he or she may correct the translation in accordance with the international application. Where the applicant intends to correct the mistakes in the translation, he or she shall file a written request and pay the prescribed fee for the correction of the translation. (Rule 113) When an international application enters the national phase, the applicant may also file amendments under Article 28 or 41 of the Treaty. (Guidelines Chapter III Part 1 Section 3.1.6)</p>
(i) Scope of the amendment	<p>Any amendment of the description, claims or drawings shall be made within the scope of the matters described in the description, claims or drawings originally attached to the application. (Patent Act Article 17bis (3))</p>	<p>Article 47(2) of the Patent Act dictates that an amendment to the specification, claims or drawing(s) "shall be made within the scope of matters written in the specification or drawing(s) attached to the patent application." Therefore, the addition of new matter even in the amendment under the main sentence of Article 47(1) and Article 47(1)(i) shall be prohibited.</p> <p>An amendment to the specification, claims or drawing(s) within the designated period has no limit to the scope of an amendment except for the prohibition of the addition of new matter. (Examination Guidelines Part IV, Chapter 2.</p>	<p>An applicant may amend his or its application for a patent, but the amendment to the application for a patent for invention may not go beyond the scope of disclosure contained in the initial description and claims (Article 33) Whether the applicant amends the application documents on his own initiative or in answer to the defects as indicated in the Office Action, the amendment of the application documents shall not go beyond the scope of disclosure contained in the initial description and claims. The scope of disclosure contained in the initial</p>

		Section 1)	<p>description and claims includes the contents described in the initial description and claims, and the contents determined directly and unambiguously according to the contents described in the initial description and claims, and the drawings of the description. The contents described in the initial description and claims submitted by the applicant on the date of filing shall be taken as the basis of examining whether the above-mentioned amendment is in conformity with Article 33. The contents of the application documents in foreign language and the priority documents submitted by the applicant to the Patent Office shall not be taken as the basis to judge whether the amendment to the application documents meet the requirements of Article 33, except for the originally filed text in foreign language of an international application entering into the national phase. For the legal effect thereof, see Chapter 2, Section 3.3 of Part III of these Guidelines.</p> <p>If the contents and scope of the amendment are not in conformity with Article 33, the amendment shall not be allowed.</p> <p>(Guidelines Part II Chapter 8 Section 5.2.1.1)</p> <p>The amendments made under Article 19 of the Treaty in the international phase, referred to in the statement concerning the basis for examination, shall have corresponding contents in the international publication document. The corresponding contents of the amendments made under Article 34 of the Treaty shall be attached to the international preliminary report on patentability. Where it is found that the amendments made in the international phase which is referred to in the statement concerning the basis for examination do not exist, the examiner shall issue the Notification to Make Rectification to notify the applicant to correct the relevant</p>
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		<p>contents in respect of basis for examination in the entering statement. (Guidelines Part III Chapter 1 Section 3.1.6)</p> <p>Where, according to the statement of the applicant, the claims amended under Article 19 of the Treaty are served as the basis for examination, and the international publication of the amendments is in a language other than Chinese, the applicant shall submit its translation at the time of entering the national phase, or at the latest within two months from the date of entry. In accordance with Rule 106, the amendments of which the translation is submitted after the said period shall not be taken into consideration. The examiner shall issue the Notification of Non-consideration of the Amendment. Where an international publication document contains the statement concerning amendments under Article 19(1) of the Treaty and the applicant requests the examiner to take the said statement into consideration, the applicant shall submit the translation of the statement at the same time when the translation of the amended claims is furnished.</p> <p>The translation of the amended claims (including amendment, addition or deletion of the claim (s)) shall be consistent with the content of the corresponding part recorded in the international publication document. For amendments which were submitted in the international phase but were refused by the International Bureau for not being inconformity with Rule 46 of the PCT Regulations, they shall not be submitted as amendments under Article 19 of the Treaty at the time of entering the national phase. The translation of the amendments shall be made in the form of the amendment sheet that can replace the corresponding part of the translation of the original application. The words "Claims (amended under Article</p>
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			<p>19 of the PCT)" shall be indicated on the top of the first page of the translation of the amended claims.</p> <p>For the translation of the amended documents which are submitted after entering the national phase, the Form to Supplement the Translation of Amended Document or the Amended Document shall be attached. The applicant shall indicate in the Form that he intends to use the amended contents as the basis for examination.</p> <p>The translation of the claims amended under Article 19 of the Treaty shall be published together with the translation of the claims of the original application. The translation of the amended claims shall meet the requirements concerning the form of publication as provided for in these Guidelines.</p> <p>Where the translation of the amended documents fails to meet the requirements, the examiner shall issue the Notification of Defects of the Amended Document to notify the applicant to make rectifications. If the applicant fails to submit the rectifications within the specified time limit, the examiner shall issue the Notification of Non-consideration of the Amendment.</p> <p>Where the claims amended under Article 19 of the Treaty is also used as the basis for international preliminary examination, and the applicant has submitted it as the translation of the annexes of the international preliminary report on patentability at the time of entering the national phase, the said translation shall not be published in the national publication.</p> <p>(Guidelines Part III Chapter 1 Section 4.1)</p> <p>Where, according to the statement of the applicant, the amendments made under Article 34 of the Treaty are served as the basis for examination, and the amendments are made in a language other than Chinese, the translation shall be submitted at the</p>
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		<p>time of entering the national phase, and at the latest within two months from the date of entry. The translation of the amended part submitted after the said period shall not be taken into consideration. The examiner shall issue the Notification of Non-consideration of the Amendment. The content of the translation of the amended part shall be consistent with the content of the amendment sheet attached to the international preliminary report on patentability transferred by the International Bureau. Where, in the international phase, the applicant declares that the amendments have been made under Article 34 of the Treaty, but the amendments fail to be accepted by the examiner, and thus have not been transferred as the annexes of the international preliminary report on patentability, the applicant shall not submit such contents to the Patent Office at the time of entering the national phase as amendments made under Article 34 of the Treaty.</p> <p>The translation of the amendments shall be made in the form of the amendment sheet that can replace the corresponding part of the translation of the original application. If, as the result of the amendment, there is an addition of the content in a page, one or more pages may be inserted after that page. The pages shall be numbered as "Xa", "Xb" or "X-1", "X-2". If, as the result of the amendment, there is a cancellation of an entire page, the indication shall be made in the explanation of the amendments.</p> <p>Where a certain claim is deleted from the claims, the original numbering may stay, with the word "deletion" indicated. The amended claims may also be renumbered in a continuous way, with explanation attached to illustrate it. Brief explanation of the amendments shall be attached in front of the translation of the</p>
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		<p>amendments. On top of that page, there shall indicate the words "translation of annexes of international preliminary report on patentability". Explanation of the amendments shall indicate only the parts where the amendments are involved. For the translation of the annexes of the international preliminary report on patentability submitted after entering the national phase, the Form to Supplement the Translation of Amended Document or the Amended Document shall be attached. The willing to use the amendments as the basis for examination shall be indicated in the said Form.</p> <p>Where the translation of the amended documents fails to meet the requirements, the examiner shall issue the Notification of Defects of the Amended Document to notify the applicant to make rectifications. If the rectifications are not submitted within the specified time limit, the examiner shall issue the Notification of Non-consideration of the Amendment. (Guidelines Part III Chapter 1 Section 4.2)</p> <p>According to Rule 112, the applicant may file requests to amend the patent application documents within the prescribed time limit after going through the formalities for entering the national phase, and such amendments are called the amendments in the national phase. For an international application pursuing a patent right for invention, the applicant may amend the application documents on his own initiative according to Rule 51.1. When an international application enters the national phase, if the applicant requests definitely that the amendments made under Article 28 or 41 of the Treaty serve as the basis of examination, the amendments may be submitted together with the translation of the original application, and such amendments are considered as the amendments submitted</p>
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			<p>on the applicant's own initiative according to Rule 112.</p> <p>The applicant shall enclose the detailed explanation of the amendments when submitting the amendments. The explanation may be in the form of a table of comparison on the contents before and after amendment or the marked notes of amendments on the copy of the original. Where the amendments are submitted at the time of entering the national phase, the words of "amendments made under Article 28(or 41)of the Treaty" shall be marked on top of the explanation of the amendments. The contents of the amendments shall be submitted in the form of replacement sheets. The contents of the replacement sheets shall correspond with those of the replaced sheets and shall be consistent with the context in meaning. (Guidelines Part III Chapter 1 Section 5.7)</p>
(ii) Treatment of multiple amendments		<p>The final specification to be examined shall be determined automatically through the Patent Net (Internal examination supporting tool) after reflecting amendment to the detailed specification, claims and drawings. An amendment to the full text of the specification shall be replaced as the final specification to be examined.</p> <p>In the case of voluntary amendment, every amendment submitted are reflected to the description, claims and drawings in a cumulative way until the examination begins. (Examination Guidelines Part V, Chapter 3. Section 6.3)</p>	<p>Where the applicant has made amendments to the invention application on his own initiative, when a request for substantive examination is made or within three months after the receipt of the Notification of Entering the Substantive Examination Stage of the Application issued by the Patent Office, the amended application documents submitted by the applicant shall be used as the examination basis no matter whether the content of amendments goes beyond the scope of disclosure contained in the initial description and claims.</p> <p>Where the applicant has made amendments to the application documents several times on his own initiative within the above-mentioned time limit, the application documents last submitted shall be used as the examination basis. Generally, the amendment of the application documents made by the applicant on his own initiative in time period other than the above-mentioned</p>

			<p>prescribed time limit shall not be accepted. The amended application documents submitted by the applicant shall not be used as the examination basis. The examiner shall state the reasons thereof in the Office Action and use the previous acceptable documents as the examination basis. Where, though the amendments made by the applicant is not in conformity with Rule 51.1, if the examiner thinks, after reading them, that the amended documents have eliminated the defects existing in the initial application documents and meet the requirements of Article 33, and taking the amended text as the basis for examination can help economize the examination procedure, such amended documents may be accepted.</p> <p>(Guidelines Part II Chapter 8 Section 4.1)</p> <p>The substantive examination of the international application in the national phase shall be performed, upon the request of the applicant, on the basis of the text indicated in the written entering statement and other texts submitted in a later stage which meet the relevant requirements. (Guidelines Part III Chapter 2 Section 3.1)</p> <p>The texts used as the basis for substantive examination may include:</p> <p>(2) where the international publication of an international application is in Chinese, the claims as amended and submitted under Article 19 of the Treaty; where the international publication of an international application is in a foreign language, the Chinese translation of the claims as amended and submitted under Article 19 of the Treaty;</p> <p>(3) where the international publication of an international application is in Chinese, the claims, description and drawings as amended and submitted under Article 34 of the Treaty; where the international publication of an international application</p>
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			<p>the basis for the examination at the time of entering the national phase, or where the Chinese translation of the amendments is not submitted according to the provisions although the indication has been made, it shall not be used as the basis for substantive examination.</p> <p>For the determination of the text to be used as the basis for the examination, Chapter 8, Section 4.1 of Part II of these Guidelines shall apply. For the examination on abovementioned amended document or the amended document submitted according to Rule 51, Chapter 8, Section 5.2 of Part II of these Guidelines shall apply.</p> <p>(Guidelines Part III Chapter 2 Section 3.2)</p>
<p>(iii) Amendment made during international phase under PCT Art.19 or Art. 34</p>	<p>(1)Amendment under the PCT Article19 with regard to an international patent application in the Japanese language</p> <p>Where a copy of a written amendment under the PCT Article19 (1) has been submitted, an amendment to the claims shall be deemed to have been made under the Patent Act Article 17bis (1) by the said copy of the written amendment. (Patent Act Article 184septies (2))</p> <p>(2)Amendment under the PCT Article34 with regard to an international patent application in the Japanese language</p> <p>Where a copy of the written amendment under the PCT Article34 (2) (b) has been submitted, an amendment to the description, claims or drawings shall be deemed to have been made under the Patent Act Article 17bis (1) by the copy of the written amendment. (Patent Act Article 184octies (2))</p> <p>(3)Amendment under the PCT Article19 with regard to an international patent application in the foreign language</p> <p>Where the applicant of the international</p>		<p>When an international application enters the national phase, in addition to the original application documents, it may contain one or more amended texts. The applicant shall indicate the text which shall serve as the basis text for subsequent procedures in the entering statement, i.e., make a statement concerning the basis for examination.</p> <p>Where there have been some amendments either in the international phase or at the time of entering the national phase and the amendments have been indicated in the statement concerning the basis for examination, the text to be used for examination shall be the original application having the corresponding part replaced by the amended documents.</p> <p>Where the amendments have been made in the international phase but have not been indicated in the statement concerning the basis for examination, the amendments shall be regarded as being abandoned and shall not be taken into consideration by the Patent Office.</p> <p>(Guidelines Part III Chapter 1 Section 3.1.6)</p> <p>The translation of the description and the claims shall be consistent with the contents of the description and the claims in the</p>

	<p>patent application in the foreign language has made an amendment under the PCT Article 19 (1), the applicant may, in lieu of the translation of original claims, submit a translation of the amended claims. (Patent Act Article 184quarter (2))</p> <p>Where an amendment under the PCT Article 19 (1) has been made, an applicant who has submitted the translation of original claims may further submit a Japanese translation of the said amended claims no later than the date on which the Time Limit for the Submission of National Documents expires. (Patent Act Article 184quarter (6))</p> <p>Where a translation of the amended claims under the PCT Article 19 (1) is submitted, notwithstanding the Patent Act Article 184sexies (2), a translation of the said amended claims shall be deemed to be the claims submitted with the application. (Patent Act Article 184sexies (3))</p> <p>(4)Amendment under the PCT Article34 with regard to an international patent application in the foreign language</p> <p>Where a translation of the written amendment under the PCT Article34 (2) (b) has been submitted, an amendment to the description, claims or drawings shall be deemed to have been made under the Patent Act Article 17bis (1) by the translation of the written amendment. (Patent Act Article 184octies (2))</p> <p>Where an amendment under the PCT Article34 (2) (b) to the description, claims or drawings with regard to an international patent application in the foreign language has been deemed to have been made under the Patent Act Article 17bis (1), such amendment shall be deemed to have been made by submitting</p>		<p>international publication document transferred by the International Bureau. The translation shall be complete and authentic to the original. The applicant shall not add any content of the amendment in the translation of the original. (Guidelines Part III Chapter 1 Section 3.2.1)</p> <p>The translation of the abstract shall be consistent with the content of the abstract on the front page of the international publication document. Where the examiner of the International Search Authority has amended the abstract submitted by the applicant, the translation of the amended abstract shall be submitted. For example, where the international search report is contained in the re-published international publication document A3 later rather than in the first published international publication document A2, and the content of the abstract on the front page of international publication document A3 is different from that of the international publication document A2, the translation shall be made on the basis of the content of the abstract in the international publication document A3. (Guidelines Part III Chapter 1 Section 3.2.2)</p> <p>According to the PCT Regulations, where some elements or parts, which are missing when the applicant files the international application, they may be incorporated by reference of the corresponding parts in the earlier application, and the original filing date shall be retained. Here, "elements" refer to all the description or claims, and "parts" refer to part of the description, part of claims or all or part of drawings. As China makes reservations to the above provisions of the Treaty and its Regulations, when the international applications enters the Chinese national phase, where the original international</p>
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	<p>the statement of correction of an incorrect translation. (Patent Act Article 184octies (4))</p>		<p>filing date is retained through incorporating the missing elements or parts by reference from earlier application, the Patent Office shall not recognized it. (Guidelines Part III Chapter 1 Section 5.3)</p> <p>In accordance with the provisions of the Treaty, an international application shall have the effect of a regular national application in each designated State from the international filing date. Thus, the international application transferred by the International Bureau to the designated Office or the elected Office is the text which has the legal effect. Where, on the basis of the said text, it is found that there are translation errors submitted at the time of entering the national phase, the applicant shall be allowed to correct the translation errors provided that Rule 113 are fulfilled. The translation errors refer to cases where terms, sentences or paragraphs of the translation text are omitted or inaccurate compared with the original text transferred by the International Bureau. Where the obvious inconsistency appears between the translation text and the original text transferred by the International Bureau, the rectification in the form of correcting the translation errors shall not be allowed. The applicant may go through the formalities for correcting the translation errors before the completion of technical preparations for publication of the application for the patent for invention by the Patent Office.</p> <p>At the time of correcting the translation errors, in addition to submitting the corrected sheet, the applicant shall file a written request for correcting the translation errors and pay the prescribed handling fee for correction of the translation. If the requirements are not complied with, the examiner shall issue the Notification that Request Deemed Not to Have Been Submitted.</p>
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			<p>the corrected translation is still inconsistent with the original, the examiner shall notify the applicant to submit the corrected translation in conformity with the original.</p> <p>Where a divisional application is filed after the international application has entered the national phase, if, in the substantive examination stage, the applicant realizes by himself that the translation errors of the original application result in the translation errors of the divisional application, the applicant may go through the formalities of the correction of the translation errors, and correct the translation errors based on the international application text submitted at the time of filing the patent application. The examiner shall conduct the examination to the corrected translation text in accordance with above-mentioned provisions.</p> <p>(Guidelines Part III Chapter 2 Section 5.7)</p>
(2) Amendment in response to non-final notice of rejection	<p>The applicant who received a notice of reasons for refusal shall submit the amendment within the designated time limit under the Patent Act Article 48septies or the Patent Act Article 50. (Patent Act Article 17bis (1) (i), (ii))</p>	<p>A patent applicant may amend the specification or drawings attached to a patent application within the period before the commissioner of the Korean Intellectual Property Office delivers a certified copy of a decision to grant a patent. However, where an applicant receives a notice of grounds for rejection, an amendment shall be made within the period for submission of opinions following the relevant notice of grounds for rejection.</p> <p>(Patent Act Article 47(1)(i))</p>	<p>Where the applicant amends the application after receiving the notification of opinions of the examination as to substance of the patent administration department under the State Council, he or she shall make the amendment directed to the defects pointed out by the notification. (Rule 51.3)</p> <p>Where the applicant makes correction of the translation in accordance with the notification of the patent administration department under the State Council, he or she shall, within the specified time limit, go through the formalities prescribed in paragraph two of this Rule. If the prescribed formalities are not gone through at the expiration of the time limit, the international application shall be deemed to be withdrawn. (Rule 113)</p>
(i) Scope of the amendment	<p>Any amendment of the description, claims or drawings shall be made within the scope of the matters described in the</p>	<p>Article 47(2) of the Patent Act dictates that an amendment to the specification, claims or drawing(s) "shall be made within the scope of</p>	<p>In accordance with Rule 51.3, when replying the Office Action, the amendment, if there is, shall be made in answer to the</p>

	<p>description, claims or drawings originally attached to the application. (Patent Act Article 17bis (3))</p> <p>Where any amendment of the claims is made in the cases listed in the items of the Patent Act Article 17bis (1), the invention for which determination on its patentability is stated in the notice of reasons for refusal received prior to making the amendment and the invention constituted by the matters described in the amended claims shall be of a group of inventions recognized as fulfilling the requirements of unity of invention set forth in the Patent Act Article 37. (Patent Act Article 17bis (4))</p>	<p>matters written in the specification or drawing(s) attached to the patent application.” Therefore, the addition of new matter even in the amendment under the main sentence of Article 47(1) and Article 47(1)(i) shall be prohibited.</p> <p>An amendment to the specification, claims or drawing(s) within the designated period has no limit to the scope of an amendment except for the prohibition of the addition of new matter. (Examination Guidelines Part IV, Chapter 2. Section 1)</p>	<p>defects as indicated in the Office Action. If the manner of the amendment is not in conformity with Rule 51.3 the amendment shall generally be unacceptable. However, where the manner for making amendment does not meet the requirements of Rule 51.3, but the contents and scope of the amendment are in conformity with Article 33, the amendment may be deemed to be made in answer to the defects as indicated in the Office Action and the application documents amended in this way may be acceptable, provided that the defects existed in the initial application documents are eliminated and there is prospect for the application to be granted. By doing so, it is beneficial to economize the examination procedure. (Guidelines Part II Chapter 8 Section 5.2.1.3)</p>
(ii) Treatment of multiple amendments		<p>When multiple amendments are submitted within the designated period according to one notification of ground of rejection, the way of the process is different between applications under Old Patent Law (The law before Act 11654 amended on March 22, 2013) and under New Patent Law (Act 11654, announced on March 22, 2013 and enforced in July. 1, 2013).</p> <p>a. For the application filed before June. 30, 2013 under Old Patent Law, each amendment will be accumulatively reflected if several amendments are submitted within the designated period according to notification of ground for the first rejection.</p> <p>b. For the applications filed before July. 1, 2013 under New Patent Law, every amendment submitted before the last amendment will be deemed to be withdrawn if several amendments are submitted within the designated period according to notification of ground for rejection.</p> <p>(Examination Guidelines Part V, Chapter 3. Section 6.3.1)</p>	<p>After the response to the first Office Action has been submitted, the examiner shall continue the examination and consider the reply and/or amendments. The same standard of examination shall be applied at the various stages of the examination. (Guidelines Part II chapter 8 section 4.11)</p>
(iii) Others			After the response of the first Office Action

		<p>has been submitted by the applicant, the examiner shall continue the examination of that application and consider the observations and/or amendments made by the applicant. The same standard of examination shall be applied by the examiner at the various stages of the examination.</p> <p>Where the applicant submits the revised description and/or revised claims simultaneously, the examiner shall, according to Article 33 and Rule 51.3, examine respectively whether the amendments go beyond the scope of disclosure contained in the initial description and claims, and whether the amendments have been made based on the requirements of the Office Action (see Section 5.2 of this Chapter). (Guidelines Part II chapter 8 section 4.11)</p> <p>The response of the applicant may include the observations only, the revised application documents (replacement sheet and/or rectification) may be also included. Where the applicant states in his response the objection to the observations in the Office Action or makes amendments to his application, he shall state his opinions in detail in the observations, or explain whether the amendments are in compliance with the corresponding provisions and how the defects existing in the initial application documents have been overcome. For example, where the applicant introduces a new technical feature into the amended claim to overcome the defect of lack of inventive step indicated in the Office Action, the applicant shall specifically indicate in his observations the part of the description from which the new technical feature is derivable, and state the reasons for which the amended claim involves an inventive step. (Guidelines Part II chapter 8, Section 5.1) The applicant shall respond to the Office</p>
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			<p>Action within the specified time limit in the form of observations or rectifications as required by the Patent Office (see Chapter 1, Section 4 of Part V of these Guidelines). The observations or rectifications without any specific content of response submitted by the applicant is also the formal response from the applicant, for which the examiner shall think that the applicant does not give any specific objections to the opinions given in the Office Action and does not overcome the defects existing in the application documents indicated in the Office Action. (Guidelines Part II chapter 8, Section 5.1.1)</p> <p>The translation [of the abstract] shall be brief on condition that the content of the original application is not changed. So long as there are no unnecessary words or sentences, the examiner shall not request the applicant to amend or amend ex officio the translation on the grounds of not complying with the requirement on the number of words in the abstract as provided for in Rule 23.2.</p> <p>Where the international publication document contains no abstract, the applicant shall submit the translation of the original abstract of the international application at the time of entering the national phase. (Guidelines Part III chapter 1, Section 3.2.3)</p> <p>Where the international publication of an international application is in a foreign language, the substantive examination shall be conducted according to its Chinese translation. The examiner, generally speaking, need not check the original one. However, where the examiner finds, in the course of substantive examination, that defects due to translation errors do not exist in the international application as originally filed or in the original which has been amended in the international phase,</p>
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			but exist in the translation, he shall indicate the existing defects in the Office Action, for example, the description is not in conformity with Article 26.3, or the claims are not in conformity with Article 26.4, and invite the applicant to clarify or go through the formalities of request for correction of the translation errors. Where the applicant submits the amended text beyond the scope described in the original Chinese translation when replying, but fails to go through the formalities of request for correction of the translation errors, the examiner shall issue the Notification of Correcting Translation Errors. Where the applicant fails to go through the formalities of correcting the translation errors within the prescribed time limit, the application shall be deemed withdrawn. (Guidelines Part III chapter 2, Section 5.7)
(3) Amendment in response to final notice of rejection, on request for reexamination or appeal	The applicant who received a notice of reasons for refusal shall submit the amendment within the designated time limit under the Patent Act Article 50 or at the same time as the request for an appeal. (Patent Act Article 17bis (1) (iii), (iv))	(Examination Guidelines Part II, Chapter 3. Section 2.3.2)	
(i) Scope of the amendment	Any amendment of the description, claims or drawings under the Patent Act Article 17bis (1) shall be made within the scope of the matters described in the description, claims or drawings originally attached to the application. (Patent Act Article 17bis (3)) Where any amendment of the claims is made in the cases listed in the items of the Patent Act Article 17bis (1), the invention for which determination on its patentability is stated in the notice of reasons for refusal received prior to making the amendment and the invention constituted by the matters described in the amended claims shall be of a group of	An amendment in reply to the final notice of grounds for rejection or carried out upon a request for reexamination shall additionally satisfy Article 47(3), along with Article 47(2) of the Patent Act (prohibition of new matter) (Examination Guidelines Part IV, Chapter 2. Section 2) An amendment to the scope of claims, from among amendments pursuant to paragraph (1) 2 and 3, may be made only where it falls under any of the following subparagraphs: <Amended by Act No. 9381, Jan. 30, 2009> 1. Where the scope of claims for a patent is reduced by limiting, deleting, adding claims; 2. Where wrong description is corrected;	The person making the request may amend its or his patent application at the time when it or he requests reexamination or makes responses to the notification of reexamination of the Patent Reexamination Board. However, the amendments shall be limited only to remove the defects pointed out in the decision of rejection of the application or in the notification of reexamination. (Rule 61) The petitioner may amend the application at the time of submitting the request for reexamination, responding to Notification of Reexamination (including Notification of Oral Proceedings for Request for Reexamination), or appearing in oral

	<p>inventions recognized as fulfilling the requirements of unity of invention set forth in the Patent Act Article 37. (Patent Act Article 17bis (4))</p> <p>The amendment of the claims shall be limited to those for the following purposes:</p> <ul style="list-style-type: none"> (i) the deletion of a claim or claims as provided in the Patent Act Article 36 (5); (ii) restriction of the claims (limited to the cases where the restriction is to restrict matters required to identify the invention stated in a claim or claims under the Patent Act Article 36 (5), and the industrial applicability and the problem to be solved of the invention stated in the said claim or claims prior to the amendment are identical with those after the amendment.); (iii) the correction of errors; and (iv) the clarification of an ambiguous statement (limited to the matters stated in the reasons for refusal in the notice of reasons for refusal). <p>(Patent Act Article 17bis (5))</p> <p>In the case of amendment for the purpose as provided in the Patent Act Article 17bis (5) (ii), an invention constituted by the matters described in the amended claims must be one which could have been patented independently at the time of filing of the patent application. (Patent Act Article 17bis (6))</p>	<p>3. Where ambiguous description is made clear;</p> <p>4. With regard to an amendment beyond the scope referred to in paragraph (2), where returning to the scope of claims made prior to the amendment, or amending the scope of claims pursuant to subparagraph 1 through 3 in the course of returning to the said scope of claims.</p>	<p>proceedings. Any amendment, however, shall meet the requirements of Article 33 and Rule 61.1.</p> <p>According to Rule 61.1, amendments by the petitioner shall be limited only to overcome the defects indicated in the decision of rejection or by the panel. (Guidelines Part IV Chapter 2 Section 4.2)</p> <p>The Patent Reexamination Board shall send a copy of the request for invalidation of the patent right and copies of the relevant documents to the patentee and invite it or him to present its or his observations within a specified time limit. The patentee and the person making the request for invalidation shall, within the specified time limit, make responses to the notification concerning transmitted documents or the notification concerning the examination of the request for invalidation sent by the Patent Reexamination Board. (Rule 68)</p> <p>In the course of the examination of the request for invalidation, the patentee for the patent for invention concerned may amend its or his claims, but may not broaden the scope of patent protection. The patentee for the patent for invention concerned may not amend its or his description or drawings. (Rule 69)</p> <p>In the invalidation procedure, the Patent Reexamination Board may issue Notification of Examination on Request for Invalidation to both parties concerned in any of the following circumstances. For the party to which the notification of examination is directed, it shall respond within one month from the date of receiving the notification. If no response is made within the time limit, the party shall be deemed to have been aware of the facts,</p>
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			causes and evidence contained in the notification and does not raise any objection. (Guidelines Part IV chapter3 section 4.4.3)
(ii) Treatment of multiple amendments	<p>When several amendments to the description, claims, or drawings are made within a period for responding to a final notice of reasons for refusal, the description, claims, or drawings as a basis when determining if the second and subsequent amendment satisfies the Patent Act Article 17bis (5) and (6) shall be the ones to which amendments were legally made immediately before the second and subsequent amendment. However, as for the Patent Act Article 17bis (3), the basis shall be the original description, claims, or drawings. (Examination Guidelines Part III. Chapter 3. Section 4. 4)</p>	<p>When multiple amendments are submitted within the designated period according to one notification of ground of rejection, the way of the process is different between applications under Old Patent Law (The law before Act 11654 amended on March 22. 2013) and under New Patent Law (Act 11654, announced on March 22. 2013 and enforced in July. 1. 2013).</p> <p>a. For the applications filed before June. 30. 2013 under Old Patent Law, only amendments granted by examiners among amendments will be accumulatively reflected if several amendments are submitted within the designated period according to notification of ground for the final rejection.</p> <p>b. For the applications filed before July. 1. 2013 under New Patent Law, every amendment submitted before the last amendment will be deemed to be withdrawn if several amendments are submitted within the designated period according to notification of ground for rejection. (Examination Guidelines Part V, Chapter 3. Section 6.3.1)</p> <p>Where the amendment stating the purport for the reexamination request dated on the same day is submitted a multiple times, any amendment from the second submission shall not be deemed to be submitted within the prescribed period (Articles 47, 67 bis (1) of the Patent Act). Since an examiner regards the subsequent amendments following the first submission as documents submitted after the statutory period according to the Patent Act or the Enforcement Decree of the Patent Act (the Enforcement Rules of the Patent Act Article 11), he/she gives an opportunity for an explanation and returns the subsequent amendments. (Examination Guidelines Part V Chapter 4.</p>	

<p>(iii) Restriction of amendment on claims</p>	<p>Where any amendment of the claims is made in the cases listed in the items of the Patent Act Article 17bis (1), the invention for which determination on its patentability is stated in the notice of reasons for refusal received prior to making the amendment and the invention constituted by the matters described in the amended claims shall be of a group of inventions recognized as fulfilling the requirements of unity of invention set forth in the Patent Act Article 37. (Patent Act Article 17bis (4))</p> <p>The amendment of the claims shall be limited to those for the following purposes:</p> <ul style="list-style-type: none"> (i) the deletion of a claim or claims as provided in the Patent Act Article 36 (5); (ii) restriction of the claims (limited to the cases where the restriction is to restrict matters required to identify the invention stated in a claim or claims under the Patent Act Article 36 (5), and the industrial applicability and the problem to be solved of the invention stated in the said claim or claims prior to the amendment are identical with those after the amendment.); (iii) the correction of errors; and (iv) the clarification of an ambiguous statement (limited to the matters stated in the reasons for refusal in the notice of reasons for refusal). (Patent Act Article 17bis (5)) <p>In the case of amendment for the purpose as provided in the Patent Act Article 17bis (5) (ii), an invention constituted by the matters described in the amended claims must be one which could have been patented independently at the time of filing of the patent application. (Patent Act Article 17bis (6))</p>	<p>Section 3)</p> <p>An amendment to claims among the amendments in response to the final notice of grounds for rejection or upon a request for reexamination in accordance with Article 47(3) of the Patent Act shall be one of the followings: reduction of scope of claims by limiting claims, correction of clerical errors, clarification of ambiguous descriptions, or deletion of new matter.</p> <p>Amendment requirements under Article 47(3) of the Patent Act shall be applied only to the amended claims. In this case, if an independent clause is amended, the dependent clause which refers to the independent clause shall be deemed to be amended. (Examination Guidelines Part IV, Chapter 2. Section 2.)</p>	<p>The person making the request may amend its or his patent application at the time when it or he requests reexamination or makes responses to the notification of reexamination of the Patent Reexamination Board. However, the amendments shall be limited only to remove the defects pointed out in the decision of rejection of the application or in the notification of reexamination. (Rule 61)</p> <p>The petitioner may amend the application at the time of submitting the request for reexamination, responding to Notification of Reexamination (including Notification of Oral Proceedings for Request for Reexamination), or appearing in oral proceedings. Any amendment, however, shall meet the requirements of Article 33 and Rule 61.1.</p> <p>According to Rule 61.1, amendments by the petitioner shall be limited only to overcome the defects indicated in the decision of rejection or by the panel. Generally, the above requirement is not considered to be met in the following cases:</p> <ul style="list-style-type: none"> (1)where a claim amended extend the extent of protection as compared with the claim rejected in the decision of rejection; (2)where a claim in the amendment is derived from the technical solution that lacks unity with the claims rejected in the decision of rejection; (3)where the type of a claim is altered, or the number of claims is increased; or (4)where the amendments are directed to the claims or the description that were not involved in the decision of rejection, unless they are intended merely to correct obvious clerical errors or to amend the defects of the same nature with that indicated in the decision of rejection. (Guidelines Part IV Chapter 2 Section 4.2)
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			<p>In the course of the examination of the request for invalidation, the patentee for the patent for invention concerned may amend its or his claims, but may not broaden the scope of patent protection. (Rule 69)</p> <p>Any amendment to the patent documents of a patent for invention shall be limited to the claims only, and shall follow the following principles: (1)the title of the subject matter of a claim can not be changed; (2)the extent of protection can not be extended as compared with that in the granted patent; (3)the amendment shall not go beyond the scope of disclosure contained in the initial description and claims; and (4) addition of technical features not included in the claims as granted is generally not allowed. (Guidelines Part IV Chapter 3 Section 4.6.1)</p> <p>Subject to the above principles of amendments, the specific manners of amendment are generally limited to deletion of a claim, combination of claims, and deletion of a technical solution. Deletion of a claim means one(or more) claim, such as an independent claim or a dependent claim, is removed from the claims.</p> <p>Combination of claims means that two or more claims dependent on a same independent claim and having no relation of dependency are combined together. Under this circumstance, all the technical features of the combined dependent claims constitute a new claim. The new claim shall contain all the technical features of each of the dependent claims thus combined. The dependent claims subordinated to a same independent claim shall not be combined together unless the independent claim is</p>
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			<p>amended. Deletion of a technical solution means to remove one or more technical solutions from several parallel technical solutions defined in the same claim. (Guidelines Part IV Chapter 3 Section 4.6.2)</p> <p>Before the Patent Reexamination Board makes a decision on the request for invalidation, the patentee may either delete a claim or delete a technical solution contained in a claim. The patentee may amend the claims by the way of combination within the time limit for response only in one of the following circumstances: (1)in response to the request for invalidation; (2)in response to causes for invalidation or evidence added by the petitioner; (3)in response to causes for invalidation or evidence not mentioned by the petitioner but introduced by the Patent Reexamination Board. (Guidelines Part IV Chapter 3 Section 4.6.3)</p>
(iv) Others		<p>To which of the abovementioned cases an amendment of amending claims corresponds shall be determined by comparing the claim which is the subject of an examination upon the final notice of grounds for rejection with the claim with the same number. However, if a claim after an amendment is obvious to be the same as the amended claim with the different number, the validity of the amendment shall be assessed through comparison with the claim of the different number.</p> <p>Regardless of whether an applicant amends one word or the whole claim, if an amendment of the claim falls under any of the subparagraphs of Article 47(3), the amendment shall be deemed as an amendment under Article 47(3) of the Patent Act. However, even in the aforementioned case, if one claim contains more</p>	<p>Once said (rejection) decision or notification (to grant patent right) is issued, any observations, response or amendment from the applicant shall not be considered. (Guidelines Part II Chapter 8 Section 6)</p> <p>In reexamination procedure, if the application document submitted by the petitioner is not in conformity with Rule 61.1, the panel will generally refuse to accept it; and the panel should explain why the amended document is unacceptable in Notification of Reexamination and examine the previous accepted document. If part of the content of the amended document is in conformity with Rule 61.1, the panel may provide examination opinions on this part, and notify the petitioner that he should amend other part of the text which is not in</p>

		than two inventions (a Markush-type claim or a claim citing multiple claims), such inventions shall be assessed individually. (Examination Guidelines Part IV, Chapter 2. Section 2.)	conformity Rule 61.1 and submit document which is in conformity with the provisions, otherwise the panel will take the previous accepted text as the basis for examination. (Guidelines Part IV Chapter 2 Section 4.2)
(4) Others	Where the examiner intends to give a notice of reasons for refusal for a patent application under the Patent Act Article 50, and these reasons for refusal are the same as the reasons for refusal stated in the previous notice under the Patent Act Article 50 with regard to another patent application (limited to the case where both patent applications are deemed to have been filed simultaneously by applying the provision of the Patent Act Article 44 (2) to either or both of them) (except for such a notice of reasons for refusal of which the applicant of the patent application could have never known the content prior to the filing of a request for examination of the patent application), the examiner shall also give a notice to that effect. (Patent Act Article 50bis)		A divisional application filed in accordance with Rule 42 shall be entitled to the filing date and, if priority is claimed, the priority date of the initial application, provided that the divisional application does not go beyond the scope of disclosure contained in the initial application. (Rule 43.1)
5. Supplemental Communication Means			
(1) Written opinions/statements of applicants			Where the patent administration department under the State Council, after examination, finds that the application is not in conformity with this Law, the applicant should be notified and requested to submit, within a specified time limit, the reply or to amend the application. If, without any justified reason, the time limit for making response is not met, the application shall be deemed to have been withdrawn. (Article 37) The response of the applicant may include the arguments only, the revised application documents (replacement sheet and/or rectification) may be also included. Where the applicant states in his response the

			<p>objection to the Office Action or makes amendments to his application, he shall state his opinions in detail, or explain whether the amendments are in compliance with the corresponding provisions and how the defects existing in the initial application documents have been overcome. For example, where the applicant introduces a new technical feature into the amended claim to overcome the defect of lack of inventive step indicated in the Office Action, the applicant shall specifically indicate in his arguments the part of the description from which the new technical feature is derivable, and state the reasons for which the amended claim involves an inventive step. (Guidelines Part II chapter 8, Section 5.1)</p>
<p>(i) Legal status of the communication</p>	<p>Where the examiner intends to render an examiner's decision to the effect that an application is to be refused, the examiner shall notify the applicant for the patent of the reasons therefor and give the said applicant an opportunity to submit a written opinion, designating an adequate time limit for such purpose. (Patent Act Article 50)</p> <p>Where the examiner recognizes that a patent application does not comply with the requirements as provided in the Patent Act Article 36 (4) (ii), the examiner may notify the applicant of the patent thereof and give the said applicant an opportunity to submit a written opinion, designating an adequate time limit for such purpose. (Patent Act Article 48septies)</p> <p>Written opinions and reports of experiment results submitted in response to the notice of reasons for refusal cannot substitute for the description, but if the applicant argue and prove thereby that the matters disclosed in the description or</p>	<p>A written argument in response to the notification of the grounds for rejection shall not be a part of the specification of the application.</p> <p>Where an applicant insists matters to be amended in a written argument but fails to submit an amendment, an examination shall be made on the detailed description and claims upon the notification of the ground for rejection. Also, where contents of amendments having insisted in a written argument and the actual amendments show discrepancy, an examination shall be made based on the actual amendments to the detailed description and claims (Examination Guidelines Part V, Chapter 3. Section 6.2)</p>	<p>The arguments or rectifications without any specific content of response submitted by the applicant is also the formal response from the applicant, for which the examiner shall think that the applicant does not give any specific objections to the opinions given in the Office Action and does not overcome the defects existing in the application documents indicated in the Office Action. (Guidelines Part II chapter 8, Section 5.1.1)</p>

	drawings as originally filed are correct and proper, the examiner should take into consideration of these particulars. (Examination Guidelines Part IX. Chapter 2. Section 4. 3. 2 (3))		
(ii) Later submitted experimental data	Written opinions and reports of experiment results submitted in response to the notice of reasons for refusal cannot substitute for the detailed description of the invention in the description, but if the applicant argue and prove thereby that the matters disclosed in the description or drawings as originally filed are correct and proper, the examiner should take into consideration of these particulars. (Examination Guidelines Part IX. Chapter 2. Section 4. 3. 2 (3))	Experiment results in response to the notification of the grounds for rejection shall not be a part of the specification of the application. However, as these documents are submitted to clarify or verify the legitimacy of matters in the detailed description, an examiner may refer them to decide the patentability of the concerned application. (Examination Guidelines Part V, Chapter 3. Section 6.2)	The later submitted experimental data is not allowable to add to the description. However, in case that the later submitted experimental data is described in the written opinion, an examiner should consider the data during examination. But it should be noted that, the fact determined from the original application should NOT be changed from the later submitted experimental data.
(iii) Others			
(2) Telephone, facsimile, mail, meeting, etc.			
(i) Legal status of the communication	Technical explanation or interview is the supplementary means for securing communication with the applicant. Where it is considered to contribute to the prompt and precise examination, communication with the applicant through an interview, telephone or facsimile should be used. An interview etc. should be performed based on the "Interview Guideline," and in order to secure transparency in an interview procedure, the examiner should keep an interview record or a response record and contribute to benefit for the access of the public. (Examination Guidelines Part IX. Chapter 2. Section 4. 4 (2))	Where an applicant or his/her attorney (hereinafter 'the party') requests or where an examiner considers necessary for a prompt and fair examination, an examiner may have a personal interview with the party as ancillary method for examination. (Examination Guidelines Part V., Chapter 3. Section 10)	Where the applicant has made amendments according to the observations of the examiner, eliminated the defect which may lead to rejection of the application so that the patent right may be granted to the revised application, if there are still some defects in the application, the examiner shall invite the applicant again to eliminate these defects. Where necessary, the examiner may accelerate the examination by an interview with the applicant (see Section 4.12 of this Chapter).If possible, the examiner may have discussion with the applicant by telephone in the way as described in Section 4.13 of this Chapter. However, no matter in what form the amendment is proposed, the basis for the examination shall be the written amendments formally submitted by the applicant except that the examiner makes amendments to the obvious mistakes ex officio (see Sections 5.2.4.2 and 6.2.2 of this Chapter)

			<p>(Guidelines Part II Chapter 8 Section 4.11.1(1))</p> <p>Under some circumstances, such as the circumstances described in Section 4.11.1(1) of this Chapter, the examiner may invite the applicant to have an interview so as to accelerate the examination procedure. The applicant may also request for an interview. In this situation, if the examiner believes that a useful purpose will be served by such an interview, the request shall be granted; otherwise, the request may be refused.</p> <p>(Guidelines Part II Chapter 8 Section 4.12)</p> <p>The Record of Interview shall not substitute the formal response to the Office Action or the amendment of the applicant. Even though the agreement on how to make the amendment has been reached by both parties in the interview, the applicant still has to submit the formal amended documents and the examiner cannot make any amendment on the applicants behalf. Where no agreement on the amendment of the application documents is reached in the interview, the examination shall be continued by issuing a further written action.</p> <p>When the interview is over and the applicant is required to re-submit the amended documents or written observations, if the watch on the initial specified time limit still exists, the time limit may not need to change because of the interview, or the time limit may be extended for one month depending upon the situation. If the watch on the initial specified time limit exists no more, the examiner shall specify another time limit for submitting the amendments or observations in the Record of Interview. The amendments or observations submitted within this time limit shall be deemed as the response to the Office</p>
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			<p>Action. If the applicant fails to respond in due time, the application shall be deemed to be withdrawn.</p> <p>If the amendment documents submitted by the applicant in the interview are not received by the examiner before the interview, the examiner may decide to suspend the interview. (Guidelines Part II Chapter 8 Section 4.12.3)</p> <p>The examiner may discuss the problems in the application documents with the applicant by telephone. However, the telephone communication shall only apply to minor or non-misleading issues concerning the formal defects. The examiner shall record the matters discussed and keep it in the application file. For the amendments agreed by the examiner in the telephone conversation, the applicant shall usually submit the formal revised documents in written form. The examiner shall make conclusion according to such written documents. Where the contents of the amendments agreed by the examiner in the telephone conversation fall into the scope as described in Sections 5.2.4.2 and 6.2.2 of this Chapter, the examiner may correct the obvious mistakes ex-officio. (Guidelines Part II Chapter 8 Section 4.13)</p>
(ii) Others			<p>The conditions for holding an interview are as follows:</p> <p>(1)the examiner has issued the first Office Action; and</p> <p>(2)at the time of or after submitting the response to the Office Action, the applicant files a request for interview; or when the examiner thinks it necessary to invite the applicant to have an interview.</p> <p>No matter invited by the examiner or requested by the applicant, the interview shall be arranged in advance by issuing Notification of Interview or by telephone. The duplicate copy of the Notification of</p>

		<p>Interview or the Minutes of Telephone Communication Concerning Appointment of Interview shall be included in the application file. It shall be indicated clearly in said notification or the minutes the contents, time and place of the interview confirmed by the examiner. If a new document is to be put forward in the interview by the examiner or by the applicant, it shall be submitted to the other party before the interview.</p> <p>Generally, the date of the interview shall not be changed once it is fixed. If it has to be changed, the other party shall be notified in advance. If, without any justified reason, the applicant fails to take part in the interview, the examiner may refuse to arrange a new interview, and continue the examination by sending a further written action.</p> <p>(Guidelines Part II Chapter 8 Section 4.12.1)</p> <p>The interview shall be held in the place designated by the Patent Office. With regard to the application, the examiner shall not interview the applicant in any other place.</p> <p>The interview shall be presided over by the examiner responsible for the examination of the application. Where necessary, other experienced examiners may be invited to provide assistance. Where an interview is presided over by a trainee examiner, the instructor examiner shall be present at the spot.</p> <p>Where a patent agent is appointed by the applicant, the patent agent shall participate in the interview and shall produce his certificate of patent agent.</p> <p>Where the applicant changes the patent agent, the applicant shall go through the formality for a change of the bibliographic data and the new patent agent shall participate in the interview after said formality is qualified.</p>
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			<p>be given to the applicant and the other shall be kept in the application file. Usually, the matters discussed, the conclusions reached or amendments agreed shall be indicated in the Record of Interview.</p> <p>If the interview concerned many matters, such as novelty, inventive step, or whether the amendment introduces new contents, the examiner shall make a full record of the matters discussed and any agreement reached.</p> <p>The Record of Interview shall not replace the formal response to the Office Action or the amendment of the applicant. Even though the agreement on how to make the amendment has been reached by both parties in the interview, the applicant still has to submit the formal amended documents and the examiner cannot make any amendment on the applicant's behalf. Where no agreement on the amendment of the application documents is reached in the interview, the examination shall be continued by sending a further written action.</p> <p>When the interview is over and the applicant is required to re-submit the amended documents or written observations, if the watch on the initial specified time limit still exists, the time limit may not need to change because of the interview, or the time limit may extend one month depending upon the situation. If the watch on the initial specified time limit exists no more, the examiner shall specify another time limit for submitting the amendments or observations in the Record of Interview. The amendments or observations submitted within this time limit shall be deemed as the response to the Office Action. If the applicant fails to make response in due time, the application shall be deemed to be withdrawn.</p> <p>If the new documents submitted by the applicant in the interview are not received</p>
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			<p>by the examiner before the interview, the examiner may decide to suspend the interview. (Guidelines Part II Chapter 8 Section 4.12.3)</p> <p>Generally speaking, since the main responsibility of the examiner is to point out to the applicant the problems of the application which are not in conformity with the Patent Law and its Implementing Regulations, it is not necessary for the examiner to request the applicant to provide evidence in the procedure for substantive examination. If the applicant does not accept the views of the examiner, then it is for the applicant to decide whether he wishes to produce evidence in support of his case. If so, he shall be given an appropriate opportunity to produce any evidence which is likely to be relevant, unless the examiner convinced that no useful purpose will be served by it. The evidence provided by the applicant may be either written documents or a model. For example, the applicant may provide materials concerning merits of the technology of the invention to prove the inventive step of the application. For another example, the applicant may make a demonstration of the model to prove the practical applicability of the application and so on.</p> <p>Where an application involves problems that can be solved only by an on-spot investigation of the examiner, a request shall be made by the applicant. The on-spot investigation of the examiner shall be carried out only when the request is approved by the Director General of the relevant department of substantive examination. All the costs of the investigation shall be borne by the Patent Office. (Guidelines Part II Chapter 8 Section 4.14)</p>
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			<p>The applicant shall submit electronic application documents in accordance with the prescribed file format, data standard, operation specification, and transmission mode. If the requirements are met, an electronic application return receipt of the documents received shall be sent; if the requirements are not met, the electronic documents shall be refused.</p> <p>Where any entity or individual believes that a patent application shall be handled as secret patent application, it should not be submitted through Electronic Patent Application System.</p> <p>(Guideline Part V Chapter 11 Section 4.1)</p>
<p>(3) Suggestion of amendment by the examiner</p>	<p>In a notice of reasons for refusal, the examiner can make a suggestion about amendment or divisional application, etc. if it enables applicants to easily respond to the notice of reasons for refusal and thus contributes to the prompt and precise examination. However, this suggestion makes no legal effects. Amendment, divisional application, etc. should be made on responsibility of the applicant.</p> <p>(Examination Guidelines Part IX. Chapter 2. Section 4. 4 (1))</p>	<p>Requirements</p> <p>Examiners may allow applicants to secure their right properly and quickly by suggesting the direction of amendment along with notice of ground for rejection when applications meet the following requirements 1) ~ 3).</p> <ol style="list-style-type: none"> 1) If it is possible to understand the content of invention, 2) If prior art research is fully conducted, 3) If the invention of application has a technical feature which is distinguished from prior art. <p>To present the direction of amendment is implemented regardless of representative on the premise that the deficiency in the specification may be corrected.</p> <p>Methods</p> <ol style="list-style-type: none"> a. Novelty or inventive step Patentable dependent claim or technical structure written in details of invention shall be specified to explain the ground. The direction of amendment that adds or limits the structure shall be presented to the claim which needs amendment. b. Deficiency in the specification The direction of amendment including deletion of the deficiency or change of expression, etc. should be clearly presented. <p>(Examination Guidelines Part II, Chapter 3. Section 2.3.2)</p>	<p>Where, although the patent right may be granted to an application, there still exist some minor defects, in order to accelerate the examination procedure, the examiner may provide specific suggestion in the Office Action, or directly make some suggestive amendments in the copy of the application documents which are used as the appendix of the Office Action, and state the reasons for such suggestion. Then it shall be pointed out that if the applicant agrees with the suggestive amendments of the examiner, he shall formally submit the amended document or the replacement sheet of the amendment.</p> <p>(Guidelines Part II Chapter 8 Section 4.10.2.2(2))</p>

6. Dismissal of Amendment			
(1) Relevant provisions in patent law and implementing regulations	<p>Article 53 (Dismissal of amendments) Article 17bis (Amendment of Description, Claim or Drawing attached to the application) Article 37 (Unity of invention) Article 50 (Notice of reasons for refusal) Article 126 (Trial for correction)</p>	<p>Patent Act Article 47 (Amendment of Patent Application) Article 51 (Rejection of Amendment) Article 63 (Notice of Grounds for rejection) Article 67 (Formalities for Decision of Patentability) Article 132ter (Trial against Decision to reject patent application)</p>	<p>When requesting substantive examination, or within three months after receiving the notification of the patent administration department under the State Council on the entry into substantive examination, the applicant for a patent for invention may amend the application for a patent for invention on his or its own initiative. (Rule 51.1) Where the applicant amends the application after receiving the notification of opinions of the substantive examination of the patent administration department under the State Council, he or she shall make the amendment according to the defects indicated by the notification. (Rule 51.3) The person making the request may amend its or his patent application at the time when it or he requests reexamination or makes responses to the notification of reexamination of the Patent Reexamination Board. However, the amendments shall be limited only to remove the defects pointed out in the decision of rejection of the application or in the notification of reexamination. (Rule 61.1)</p>
(2) Reasons for dismissal of amendment	<p>In the case of the Patent Act Article 17bis (1) (i) or 17bis (1) (iii) (in the case of the Patent Act Article 17bis (1) (i), limited to the case where the examiner has given a notice under the Patent Act Article 50bis along with the notice of reasons for refusal), where, prior to the service of the certified copy of the examiner's decision notifying to the effect that a patent is to be granted, an amendment made to the description, claims or drawings is found not to comply with the Patent Act Article 17bis (3)-(6), the examiner shall dismiss the amendment by a ruling. (Patent Act Article 53) Any amendment of the description, claims</p>	<p>If an amendment in the period for submitting a written statement of arguments in reply to the final notice of grounds for rejection or an amendment upon a request for reexamination is in violation of Article 47(2) and (3) of the Patent Act or if it is recognized that a new rejection ground is raised due to the amendment, the amendment shall be rejected in accordance with Article 51(1). In this context, “the case where a new ground for rejection is raised due to the amendment” means where a ground for rejection which did not exist before is newly-created due to the submission of the amendment (where deficiencies in description are raised due to the amendment or where rejection grounds of</p>	<p>According to Rule 51.3, when replying the Office Action, the amendment, if there is, shall be made to eliminate the defects indicated in the Office Action. If the amendment manner is not in conformity with Rule 51.3, the amendment generally is unacceptable. However, where the manner for making amendment does not meet the requirements of Rule 51.3, but the contents and scope of the amendment are in conformity with Article 33, the amendment may be deemed to be made in answer to the defects as indicated in the Office Action and the application documents amended in this way may be acceptable, provided that the defects existed in the initial application</p>

	<p>or drawings under the Patent Act Article 17bis (1) shall be made within the scope of the matters described in the description, claims or drawings originally attached to the application. (Patent Act Article 17bis (3))</p> <p>Where any amendment of the claims is made in the cases listed in the items of the Patent Act Article 17bis (1), the invention for which determination on its patentability is stated in the notice of reasons for refusal received prior to making the amendment and the invention constituted by the matters described in the amended claims shall be of a group of inventions recognized as fulfilling the requirements of unity of invention set forth in the Patent Act Article 37. (Patent Act Article 17bis (4))</p> <p>The amendment of the claims shall be limited to those for the following purposes: (i) the deletion of a claim or claims as provided in the Patent Act Article 36 (5); (ii) restriction of the claims (limited to the cases where the restriction is to restrict matters required to identify the invention stated in a claim or claims under the Patent Act Article 36 (5), and the industrial applicability and the problem to be solved of the invention stated in the said claim or claims prior to the amendment are identical with those after the amendment.); (iii) the correction of errors; and (iv) the clarification of an ambiguous statement (limited to the matters stated in the reasons for refusal in the notice of reasons for refusal). (Patent Act Article 17bis (5))</p> <p>In the case of amendment for any of the purposes as provided in the Patent Act Article 17bis (5) (ii), an invention constituted by the matters described in the</p>	<p>novelty and inventive step are newly found and so on). Rejection grounds that were in the description before the amendment but were not notified as well as grounds for rejection which were notified before the concerned amendment shall not be deemed as new grounds for rejection. (Examination Guidelines Part IV, Chapter 2. Section 2)</p>	<p>documents are eliminated and there is prospect for the application to be granted. By doing so, it is beneficial to economize the examination procedure. Nevertheless, under the following situations, even though the amendment does not go beyond the scope of the initial application, the amendment shall not be deemed to be made in answer to the defects indicated in the Office Action, therefore the amendment shall be unacceptable.</p> <p>(1)The applicant has deleted one or more technical features from the independent claim on his own initiative, which leads to the expansion of the protection scope. For example, the applicant has, on his own initiative, removed from the independent claim a technical feature, or a relevant technical term, or a technical feature which is used to define the specific application scope, even though the contents of the amendment do not go beyond the scope of disclosure contained in the initial description and claims, such amendment shall not be accepted as long as it leads to the expanding of the extent of protection claimed in the claim.</p> <p>(2)The applicant has changed one or more of the technical features of the independent claim on his own initiative, which leads to the expanding of the extent of protection claimed in the claim. For example, the applicant has, on his own initiative, replaced the technical feature "helical springs" by "resilient part". Although the technical feature of "resilient part" has been described in the initial description, it is not acceptable since such change will expand the extent of protection. For another example, in Example 1 to Example 4 of Section 5.2.3.2(1) of this Chapter, although the contents of said four changes are described in the initial description, it is not acceptable since such changes may lead to the expanding of the extent of protection.</p>
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	<p>amended claims must be one which could have been patented independently at the time of filing of the patent application. (Patent Act Article 17bis (6))</p>		<p>(3)The applicant has taken the technical content which is only described in the description and lacks unity with the initial claimed subject matter as the subject matter of the revised claim on his own initiative. For example, the applicant has described not only a new handle but also other parts in the description of an invention application concerning the new handle of a bicycle, such as the saddle of the bicycle. It is found that the new handle defined by the claim does not involve an inventive step after substantive examination. Then the applicant, on his own initiative, makes the saddle as the subject matter of the claim. As there is no unity between the revised subject matter and the initial claimed subject matter, such amendment is not acceptable.</p> <p>(4)The applicant has added a new independent claim on his own initiative, and the technical solution defined is not present in the initial claims.</p> <p>(5)The applicant has added a new dependent claim on his own initiative, and the technical solution defined by it is not present in the initial claims.</p> <p>Where the amended text submitted by the applicant in response to the Office Action is not made in answer to the defects as indicated in the Office Action but belongs to the above-mentioned unacceptable situations, the examiner shall issue an Office Action, state the reason for not accepting the amendment, and invite the applicant to submit an amendment complying with Rule 51.3 within the specified time limit. In the meanwhile, it shall be indicated that, when the specified time limit is expired, if the text of amendment submitted by the applicant is still not in conformity with Rule 51.3 or the amendment has other contents which are not in conformity with Rule 51.3, the examiner shall continue to examine the</p>
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			<p>text submitted before the amendment is made, for example, to make a decision to grant or to reject.</p> <p>If the examiner has new opinions on parts of the current amended text, which is in accordance with the requirements of Rule 51.3, the opinions can be stated in this Office Action.</p> <p>(Guidelines Part II Chapter 8 Section 5.2.1.3)</p> <p>The petitioner may amend the application at the time of submitting the request for reexamination, responding to Notification of Reexamination (including Notification of Oral Proceedings for Request for Reexamination), or appearing in oral proceedings. Any amendment, however, shall meet the requirements of Article 33 and Rule 61.1.</p> <p>According to Rule 61.1, amendments by the petitioner shall be limited only to overcome the defects indicated in the decision of rejection or by the panel. Generally, the above requirement is not considered to be met in the following cases:</p> <p>(1)where a claim amended extend the extent of protection as compared with the claim rejected in the decision of rejection;</p> <p>(2)where a claim in the amendment is derived from the technical solution that lacks unity with the claims rejected in the decision of rejection;</p> <p>(3)where the type of a claim is altered, or the number of claims is increased; or</p> <p>(4)where the amendments are directed to the claims or the description that were not involved in the decision of rejection, unless they are intended merely to correct obvious clerical errors or to amend the defects of the same nature with that indicated in the decision of rejection.</p> <p>(Guidelines Part IV Chapter 2 Section 4.2)</p>
(3) Treatment of multiple amendments	When several amendments to the description, claims, or drawings are made within a period for responding to a final		Where the applicant has made amendments to the invention application on his own initiative, when a request for

	<p>notice of reasons for refusal, the description, claims, or drawings as a basis when determining if the second and subsequent amendment satisfies the Patent Act Article 17bis (5) and (6) shall be the ones to which amendments were legally made immediately before the second and subsequent amendment. However, as for the Patent Act Article 17bis (3), the basis shall be the original description, claims, or drawings. (Examination Guidelines Part III. Chapter 3. Section 4. 4)</p>		<p>substantive examination is made or within three months after the receipt of the Notification of Entering the Substantive Examination Stage of the Application issued by the Patent Office, the amended application documents submitted by the applicant shall be used as the examination basis no matter whether the content of amendments goes beyond the scope of disclosure contained in the initial description and claims. Where the applicant has made amendments to the application documents several times on his own initiative within the above-mentioned time limit, the application documents last submitted shall be used as the examination basis. (Guidelines Part II Chapter 8 Section 4.1)</p> <p>After the response of the first Office Action has been submitted by the applicant, the examiner shall continue the examination of that application and consider the observations and/or amendments made by the applicant. The same standard of examination shall be applied by the examiner at the various stages of the examination. (Guidelines Part II Chapter 8 Section 4.11)</p> <p>After the Patent Office receives the response of the applicant, the subsequent examination procedure may be initiated. After the notifications or decisions of the subsequent examination procedure are issued, the examiner shall not consider later responses submitted by the applicant within the initial time limit of response. (Guidelines Part II Chapter 8 Section 5.1)</p>
(4) Procedure of dismissing amendments	(1) The examiner should determine whether new matters are added to the description, claims or drawings by the amendment in response to “the final notice of reasons for refusal”. The examiner should determine whether the claims	Whether an amendment carried out after the final notice of grounds for rejection or an amendment upon a reexamination request meets the requirements shall be assessed regardless of an order of amendment requirements. If multiple requirements are not	Where the amendment in response to the Office Action is not made in answer to the defects indicated in the Office Action but belongs to the above-mentioned unacceptable situations, the examiner shall issue an Office Action, state the reason for

	<p>include new matters on a claim-by claim basis. With regard to the claims to which new matters have been added, the examiner shall not judge whether these claims fall under the cases prescribed in the Patent Act Article 17bis (5) or (6).</p> <p>(2) Then, the examiner shall determine whether the inventions in other claims to which no new matter has been added are “inventions that change a special technical feature.” With regard to “inventions that change a special technical feature,” the examiner shall not judge whether these claims fall under the cases prescribed in the Patent Act Article 17bis (5) or (6).</p> <p>(3) With regard to the claims to which no new matter has been added and which are not “inventions that change a special technical feature,” the examiner shall further determine whether the amendment to each of these claims has been made for any of the purposes prescribed in the Patent Act Article 17bis (5) (i) to (iv).</p> <p>(4) After the determination with respect to the Patent Act Article 17bis (5) (i) to (iv) in the aforementioned (3), where there are amended claims falling under the Patent Act Article 17bis (5) (ii) (restriction of claims), the examiner should determine whether it should meet requirements of the Patent Act Article 17bis (6).</p> <p>(5) Where there are amendments which are determined to be illegal by following aforementioned (1) to (4), the examiner should indicate reasons to all such amendments and rule the dismissal of the amendment. (Examination Guidelines Part IX. Chapter 2. Section 6.2.2)</p>	<p>satisfied, an examiner shall point out as many unsatisfied requirements as possible and reject the concerned amendment. (Examination Guidelines Part IV, Chapter 3. Section 3)</p>	<p>not accepting the amendment, and invite the applicant to submit an amendment complying with Rule 51.3 within the specified time limit. In the meanwhile, it shall be indicated that, when the specified time limit is expired, if the amendment is still not in conformity with Rule 51.3 or the amendment has other contents which are not in conformity with Rule 51.3, the examiner shall continue to examine the text submitted before the amendment is made, for example, to make a decision to grant or to reject. If the examiner has new opinions on parts of the current amended text, which is in accordance with the requirements of Rule 51.3, the opinions can be stated in this Office Action. (Guidelines Part II chapter 8 Section 5.2.1.3)</p> <p>In reexamination procedure, if the application document submitted by the petitioner is not in conformity with Rule 61.1, the panel will generally refuse to accept it; and the panel should explain why the amended document is unacceptable in Notification of Reexamination and examine the previous acceptable document. If part of the content of the amended document is in conformity with Rule 61.1, the panel may provide examination opinions on this part, and notify the petitioner that he should amend other part of the text which is not in conformity with Rule 61.1 and submit document which is in conformity with the provisions, otherwise the panel will take the previous acceptable text as the basis of examination. (Guidelines Part IV Chapter 2 Section 4.2)</p>
(5) Appeal for amendment dismissal	The ruling dismissing an amendment	Since methods of an appeal regarding a decision	Where the applicant for patent is not

	<p>under the Patent Act Article 53 (1) shall not be subject to appeal; provided, however, that where a request for an appeal against an examiner's decision of refusal has been filed, this shall not apply to the appeal made in the proceeding in the said appeal against an examiners' decision of refusal. (Patent Act Article 53 (3))</p>	<p>to decline an amendment are not readily arranged, a decision to grant or reject a patent or a notice of rejection grounds shall be made after re-examining the description before the amendment, along with dismissal of an amendment.</p> <p>Legality of decision on dismissal of amendment is determined at the same time when a trial against decision of rejection decides whether decision of rejection is legitimate or not. (Examination Guidelines Part IV, Chapter 3. Section 3)</p>	<p>satisfied with the decision of the Patent Reexamination Board, he may, within three months from the date of receipt of the notification, institute legal proceedings in the people's court. (Article 41.2)</p> <p>According to implementation rule 44、 53、 65, rule 51 can not be used as the reason to reject during the preliminary examination or substantive examination, neither it can be the reason to invalidate the patent.</p>
7. Ex-Officio Amendment			
(1) Background and purpose of the ex-officio amendment		<p>The amendment ex officio by the concerned examiner is therefore introduced to solve the aforementioned problems. When an examiner during the examination discovers only obvious errors such as misspells, omissions, or inconsistent reference signs, the examiner is allowed to amend ex officio the clearly erroneous matters instead of notifying the ground for rejection, which accordingly prevents the examination delays and makes the description of registration without deficiency.</p> <p><input type="checkbox"/> The amendment ex officio shall be applied within the limited scope as a supplementary exception for the applicant's self-amendment.</p> <p>(Examination Guidelines Part VIII, Chapter 2. Section 1)</p>	
(2) Scope of the ex-officio amendment	<p>The examiner can make an ex-officio amendment when there is inappropriate description in the description, claims or drawings, in case the said inappropriate description is not determined as the reasons for refusal.</p>	<p>「Matters that are clearly erroneous」 in the specification, drawing(s), or abstract according to the Article 66bis of the Patent Act refers to the matters that do not fall under the grounds for rejection and do not influence the substantive scope of right in the patent application, provided however, that the matters shall have no possibility of arguments in the interpretation from the context, in the confirming of the claim scope, and in the working of the invention.</p>	<p>The patent administration department under the State Council may, on its own initiative, can correct the obvious clerical mistakes and symbol mistakes in the documents of application for a patent. Where the patent administration department under the State Council corrects mistakes on its own initiative, it shall notify the applicant. (Rule 51.4)</p> <p>The obvious mistakes which can be discerned by a person skilled in the art, i.e., grammar, wording, or typing mistakes are</p>

		<p>Matters for amendment ex officio are misspelling or missing word according to standard Korean or its grammar, or inconsistent use of sign in drawing(s). (Examination Guidelines Part VIII, Chapter 2. Section 2)</p>	<p>corrected. The amendment to such mistakes shall be the only correct solution deduced by said person from the whole and the context of the description. (Guideline Part II Chapter 8 Section 5.2.2.2(11))</p> <p>The examiner is allowed to make the following amendments or rectifications to the text to which the patent right shall be granted ex officio before the Notification to Grant Patent Right is issued (see Section 5.2.4.2 of this Chapter):</p> <p>(1)the description: amendment of the obviously inappropriate title of the invention and/or technical fields to which the invention pertains; rectification of wrongly written characters and errors in symbols, marks, etc.; amendment of the terms that are obviously non-standard; addition of the missing titles of the various part of the description; and the deletion of the unnecessary explanatory notes in the drawings;</p> <p>(2) the claims: rectification of wrongly written characters and errors in punctuation marks or in the reference signs of the drawings; the enclosing of the reference signs of the drawings with brackets, etc. However, any amendment that may lead to the change of the scope of protection does not fall into the range of amendments ex officio;</p> <p>(3) the abstract: rectification of the inappropriate contents and obvious mistakes in the abstract.</p> <p>(Guideline Part II Chapter 8 section 6.2.2) According to Rule 51.4, the examiner may make amendment ex officio to the obvious clerical mistakes and symbol mistakes in the documents of patent application for invention before the application is qualified to pass the preliminary examination, and notify the applicant accordingly. The usual circumstances of amendment ex officio include the following:</p> <p>(1)request: amend the omission, error or</p>
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			<p>repetition of the names of the province (autonomous region, the municipality directly under the Central Government), the names of the municipality, the postcode and other information in the address of the applicant or contact person;</p> <p>(2) claims and description: correct the obvious clerical mistakes and punctuation mistakes, amend the obvious editorial mistakes, and delete the obviously unnecessary information. However, any amendment likely to cause the change of the scope of the disclosure contained in the initial application documents falls outside the scope of amendment ex-officio; and</p> <p>(3) abstract: add content obviously missing, correct the obvious clerical mistakes and punctuation mistakes, delete the obviously unnecessary information, and specify the figure accompanying the abstract.</p> <p>(Guidelines Part I chapter 1, Section 8)</p>
<p>(3) Procedure of ex-officio amendment</p>	<p>In principle, the examiner makes an ex-officio amendment only when he has found no reasons for refusal.</p> <p>On the other hand, when the examiner notices the reasons for refusal because of the other reasons he found, the examiner makes a note about the inappropriate description in the description, claims or drawings in the notice of reasons for refusal.</p> <p>In principle, the examiner makes a phone call to the applicant or the patent attorney prior to the ex-officio amendment for confirming content of the amendment.</p> <p>(Examination Handbook 51.01)</p>	<p>(1) The examiner intending to amend ex officio shall notify the matters to be amended to the applicant with a certified copy of the decision to patentability.</p> <p>(2) When the applicant opposes to accept the amendment ex officio in whole or part, he/she shall submit the written statement of argument before the payment of patent fee, whereby the examiner may make selective decision for the amendment ex officio.</p> <p>(3) Where the applicant submits the written statement of argument regarding the amendment ex officio, the concerned matter under the amendment ex officio shall be deemed never to have existed. The description is digitized and published in the patent gazette except for the matter that the applicant rejects to accept the amendment ex officio.</p> <p>(Examination Guidelines Part VIII, Chapter 2, Section 4)</p>	<p>However, the amendment can only be formally submitted in written form, except the examiner amends the obvious mistakes ex officio (see Sections 5.2.4.2 and 6.2.2 of this Chapter)</p> <p>(Guideline Part II Chapter 8 section 4.11.1(1))</p> <p>Usually, the amendments to the application shall be submitted by the applicant in the form of formal documents. Such as the alteration, addition or deletion of few words or marks, as well as the amendments to the obvious mistakes with the invention title or the abstract (see Sections 5.2.2.2 (11) and 6.2.2 of this Chapter), the examiner may carry out ex-officio amendment and inform the applicant. At this time, the examiner shall use a pen, signature pen or ball-pen, rather than a pencil, to make clear and distinct amendments.</p> <p>(Guideline Part II Chapter 8 section 5.2.4.2)</p> <p>The above-mentioned amendments or</p>

			<p>rectifications made by the examiner shall be notified to the applicant.</p> <p>Where the title of the invention has been amended by the applicant, the right of priority has been changed after verification, or after verification the IPC symbols has been rectified, it is also necessary to fill in the Notification of Change in Bibliographic Data in duplicate, one is bound before the front page of the first binding strip of the file, and the other is put in the folder of the inner cover.</p> <p>(Guideline Part II Chapter 8 section 6.2.2)</p> <p>According to Rule 51.4, the examiner may make amendment ex officio to the obvious clerical mistakes and symbol mistakes in the documents of patent application for invention before the application is qualified to pass the preliminary examination, and notify the applicant accordingly.</p> <p>(Guidelines Part I chapter 1, Section 8)</p>
(4) Others		<p>The matters to be amended ex officio are limited to self-evident error. When an examiner amends ex officio, he/she should not alter the scope of the claim, and the amendment ex officio shall not be allowed if there arises any possibility of different interpretation.</p> <p>(Examination Guidelines Part VIII, Chapter 2. Section 3)</p> <p>Where the examiner amends the matter which does not fall under the category of the amendment ex officio and the applicant also overlooking such an illegitimate amendment by the examiner publishes the description in the patent gazette, the concerned matter having amended ex officio shall be deemed never to have existed unless the amendment is recognized as legitimate afterward. This is designed to prevent unexpected losses in patentees or the 3rd parties due to an illegitimate amendment by the examiner.</p> <p>(Examination Guidelines Part VIII, Chapter 2. Section 4)</p>	<p>Any amendment that may lead to the change of the scope of protection does not fall into the range of amendments ex officio.</p> <p>(Guidelines Part II chapter 8, Section 6.2.2)</p>

JPO – KIPO – SIPO

COMPARATIVE STUDY ANALYSIS

ON

AMENDMENT OF SPECIFICATION, CLAIMS OR DRAWINGS

November 2014

1. Legal Bases Concerning the Amendment of Specification, Claims or Drawing

(1) Relevant provisions in laws and implementing regulations

The lists of the relevant provisions in laws and implementing regulations are shown in the Comparison Outline.

(2) Examination guidelines, manuals, standards, etc.

The items of the examination guidelines, manuals, standards, etc. relevant to amendment in each of three Offices are shown in the Comparison Outline.

(3) Background

KIPO: The amendment system of the specification or drawing(s)/ description

JPO: The amendment within the description, scope of claims or drawings attached to the application

SIPO: The amendment should not go beyond the scope of the original application

KIPO, JPO, and SIPO state that the first-to-file rule should be secured.

KIPO and JPO state that the third party is prevented from unexpected damage through the amendment (the limited scope of amendment-KIPO).

KIPO describes that the amendment is to address incompleteness of a specification and shall take effect retroactively to the original filing date. Also, amendments shall be freely carried out. According to KIPO, it is very important the amendment is made before or after the start of examination. To prevent invalidation of examination results and examination delay, the amendment period is strictly limited.

JPO describes that the amendment within the description, claims or drawings secures sufficient disclosure of the invention, guarantees an immediate grant of the right, and ensures fairness between an application which sufficiently discloses the invention as of the filing and an application which does not sufficiently disclose the invention as of the filing.

SIPO states that if two or more applicants file applications for the identical invention-creation, the patent shall be granted to the applicant who files first.

2. Overview of Amendment

(1) Main provision in the patent law and implementing regulations

KIPO – See, Article 46, 47, and 51

JPO – See, Patent Act Article 17bis, 48septies, 50, 53, and 126

SIPO – See, Article 33, 37, 38, and 41; Rule 6, 43.1, 51.1, 51.3, 51.4, 52, 53, 61, 65, 68,69, 99, 104, 106, 112.2, and 113

(2) Requirements for amendment

(i) Procedural Requirements

In all three offices, for amendment, the patent application shall be pending and the time limit should be kept.

In SIPO, for an international patent application, a translation of amendment should be submitted.

According to KIPO and JPO, even though there are two or more applicants for the same application, amendment proceedings may be done individually.

According to SIPO, when requesting substantive examination, or within 3 months after receiving the notification of the entry into substantive examination, the applicant may amend the application on his own initiative. Where the applicant amends the application after receiving the OA, he or she shall make the amendment according to the defects indicated.

In JPO, for any amendment of procedures, written amendment shall be submitted in writing.

(ii) Substantive Requirement

KIPO, SIPO and JPO state that the scope of the amendment shall be restricted.

KIPO describes that the scope of the amendment may be different depending on the amendment periods. The scope of the amendment shall be further restricted by only allowing the reduction of scope of claims, etc. as well as the prohibition of the addition of new matter to the application where an amendment is made within the period of submitting arguments on a final notice of grounds for rejection or where an amendment is made upon a request for reexamination.

SIPO describes that the amendment shall not go beyond the scope of the original application. Besides claims and specification, the scope of the original application also includes the contents determined directly and unambiguously from the application. The original application is the examination basis. The scope of amendment varies at the different examination stage.

In JPO, the scope of the amendment is different depending on the timing of the amendment.

(3) Amendment period allowed

(i) Voluntary amendment (self-amendment)

In KIPO and JPO, an amendment before receiving a certified copy of a decision to grant a patent is recognized.

In SIPO, once the application is granted or rejected, amendment from the applicant will not be accepted.

In KIPO, the self-amendment period refers to the time period before the commissioner of the Korean Intellectual Property Office delivers a certified copy of a decision to grant a patent during the amendment period designated under Article 47(1) of the Patent Act, except for the period under the subparagraphs of Article 47(1) of the Patent Act and the time period before an applicant receives a certified copy of non-final notice of grounds for rejection which an examiner has delivered.

In JPO, an applicant for a patent may amend the description, claims, or drawings attached to the application, before transmittal of certified copy of decision to grant a patent, provided that the applicant has not received the first notice under Article 50.

In SIPO, when request for substantive examination or within three months after the receipt of the notification of the entry into substantive examination stage, an applicant may amend the application document on his/her own initiative. For international application in the international phase, the Chinese translation of the amendments shall be submitted within two months from the date of entry. The time limit to submit documents such as application, amendments or translations shall be kept.

(ii) Amendment in response to office action (Period for argument submission)

All 3 offices state that if an applicant receives a non-final notice of grounds for rejection or a notice of grounds for rejection other than rejection grounds, the applicant may submit a written amendment only within a designated period in response to the notification of grounds for rejection concerned.

In KIPO, within the period designated for the submission of arguments, the scope of the amendment shall be further limited.

In SIPO, where examiner finds that the application is not complied with the Law after examination, applicant should be notified and requested to submit the reply or to amend the application within a time limit. The time limit shall be decided by the examiner after taking the relevant factors into account. The time limit for replying the first OA is four months, for further OA is two months.

(iii) Request for reexamination or appeal

KIPO and SIPO describe that applicant/petitioner amends the application upon a request for reexamination.

JPO describes that an applicant can amend the description, claims, or drawings attached to the application at the same time as the request for the appeal against an examiner's decision of refusal. KIPO states that an applicant shall request a reexamination within 30 days from the receipt of a certified copy of a decision of rejection.

According to SIPO, within three months after receiving the rejection, the applicant may file a reexamination request with the Patent Reexamination Board. If the applicant is not satisfied with the decision made by the Patent Reexamination Board, he may institute a legal proceeding in the

people's court within three months.

(iv) Extension of amendment period

KIPO, JPO and SIPO state that the period shall be extended on a request for the extension of the designated period. For JPO and SIPO, an applicant who requests extension shall state justifiable reasons for that.

KIPO states that the period designated for an amendment or an appeal against a decision of rejection can be extended.

In KIPO, a request for the extension of the designated period is made by an applicant according to Article 15(2) of the Patent Act. Commonly the period designated for the submission of arguments shall be two months. Where the period designated for submitting a written argument exceeds four months, the period may or may not be extended based on whether an examiner permits the period extension or not.

In JPO, where the examiner has designated a time limit by which procedures are to be undertaken under this Act, he may, upon request or ex-officio, extend the time limit.

JPO states that an applicant shall have two justifiable reasons for not being able to respond within the designated period. The period to be extended and the required reason for the extension are different based on the applicants. A resident of Japan will be granted a one-month extension to the designated period for response with the reason that the need to conduct experimentation to compare the claimed invention with the cited invention stated in the notice of reasons for refusal (hereinafter referred to as Reason 1), on the other hand, a resident abroad will be granted a one-month extension basically, but up to three-month extension will be granted if the applicant submits three written requests. The reason for request of a resident abroad shall be not only the experimentation for comparing inventions, but also translation of the notice of reasons for refusal issued by the JPO and the documents to be submitted to the JPO, such as the written opinion and written amendments. For a resident abroad, only one written request may be submitted in the case of Reason 1.

JPO describes that two-month and three-month extensions require the submission of two written requests and three written requests, respectively. More than one written request may be submitted at the same time. For the period of response to notices other than a notice of reasons for refusal, an applicant living abroad may obtain a three-month extension with one written request, and no extension will be granted to an applicant living in Japan.

In SIPO, the time limits for amendment can be extended once applicant request. IF the fee for extension is paid, normally the time limit can be 1-2 months. And as to each reply, applicant can only get one chance to extend the time limit. But as to the reexamination and invalidation, there is no chance to get the extension as to time limit.

3. Scope of Amendment

(1) Original application

(i) General Practice (Scope of original application)

KIPO, JPO and SIPO state that amendment shall be made within the specification (description), claims or drawing(s) originally attached to the patent application.

KIPO describes that the matter added to the specification, claims or drawing(s) through an amendment after the filing date of the application shall not be the elements described in the specification, claims or drawing(s) originally attached to the application.

According to KIPO, in the case of divisional/converted applications, matters described in the specification, claims or drawing(s) originally attached to the patent application refers to the element described in the specification, claims or drawing(s) attached to the divisional/converted applications on the filing date of the divisional/converted applications. It does not refer to matter described in the specification, claims or drawing(s) in the original application which form the basis of divisional/converted applications.

According to JPO, in the case of divisional/converted applications, whether an amendment adds new matter is decided based on the description, etc. attached to the divisional/converted applications.

JPO states that if an amendment does not meet the requirement, an application falls under a reason for refusal or a ground for invalidation. An amendment in response to a final notice of reasons for refusal or an amendment made when filing an appeal against an examiner's decision of refusal can be subject to a dismissal of amendment when the amendment does not satisfy the requirement.

SIPO describes the scope of the original application includes the content of the specification and claims without abstract, since the abstract has no legal effect, so the amendment can only be made base on the original specification and claims

In SIPO, the amendment of a divisional application cannot go beyond the scope of the original application.

(ii) PCT applications

In KIPO, JPO, and SIPO, in the case of international patent applications, matters described in the specification (description), claims or drawing(s) originally attached to the application shall be matters described in the description, claims and drawings submitted by the international filing date.

In JPO, the description of an international patent application in the Japanese language as of the international application date and translations of the description of an international patent application in the foreign language as of the international application date shall be deemed to be the description submitted with the application under the Patent Act Article 36 (2); claims of an international patent application in the Japanese language as of the international application date and a translation of the claims of an international patent application in the foreign language as of the international application date shall be deemed to be the claims submitted with the application under the Patent Act Article 36 (2); drawings of an international patent application in the Japanese language as of the international application date, drawings of an international patent application in the foreign language as of the international application date (except for the descriptive text in the drawings) and a translation of the

descriptive text in the drawings shall be deemed to be the drawings submitted with the application under the Patent Act Article 36 (2); and, the abstract of an international patent application in the Japanese language and a translation of the abstract of an international patent application in the foreign language shall be deemed to the abstract submitted with the application under the Patent Act Article 36 (2).

SIPO states that where the international application is in a language other than Chinese, the substantive examination shall be conducted based on its Chinese translation and the examiner does not have to check the original one. Nevertheless, the international application has legal effect and form the basis for the later amendment.

(iii) Specification written in foreign languages

Only SIPO mentions that they only accept applications in Chinese. However, PCT international application(in foreign language) has legal effect, it can be the basis for the later amendment.

(a) Legal status of specifications written in foreign language

KIPO and JPO state that applicants may write description, claims and drawings in foreign language in the language designated by Decree of the Ministry of Trade, Industry & Energy/ Ordinance of the Ministry of Economy, Trade and Industry, for KIPO, if their purport is written on the patent application when they file the patent.

In JPO, the applicant for a patent application with the document and abstract in foreign language shall submit to the Commissioner of the Japan Patent Office Japanese translations of the document and the abstract in foreign language within one year and two months from the date of filing (when claiming a priority, from the priority date)of the patent application. The translation of foreign language documents shall be deemed to be the description, claims and drawings submitted with the application and the translation of foreign language abstract shall be deemed to be the abstract submitted with the application.

In SIPO, any document submitted shall be in Chinese. Some standard scientific and technical terms can be used. Where there is no generally accepted Chinese translation, a foreign name or scientific or technical term should be indicated. Where any certificate or certifying document is submitted in a foreign language, they should be translated and submitted within a specified time limit.

(b) Allowed foreign languages

KIPO and JPO describe that designated foreign language is English now.

In SIPO, any document shall be submitted in Chinese.

(c) Submission of translation

In KIPO, Korean translation should be submitted by 14 months from the filing date.

In JPO, the applicant with a foreign language application shall submit Japanese translations of the foreign language document and of the foreign language abstract within one year and two months after the filing date (when claiming a priority, the priority date) of the application.

In SIPO, any document submitted shall be in Chinese. The translation of an application should be submitted when the foreign PCT application enters into the Chinese national phase.

KIPO states that as for the applications on priority claim under the treaty or on domestic priority claim, the publication time shall be reckoned from either the filing date of application in the country where the initial application is filed or the filing date of the earlier application or the earliest filing date if the application involves more than 2 priority claims. If the request for examination is filed by a person who is not an applicant, the translation should be submitted by the earliest date between three months after receipt of notice and 14 months after the day of application. If Korean translation is submitted within the time limit, new Korean translation may be submitted before the deadline is expired. When applicants submit the Korean translation, specification and drawings initially attached to patent application of application in foreign language are deemed to have been amended according to the Korean translation. If multiple translations are submitted, amendment with the translations submitted before the final Korean translation will be deemed to be invalid.

JPO states that, in the column of "[Confirmation]" in the written submission of translation, it shall be stated that the matters described in the foreign language document, etc. are translated into proper Japanese without excess nor shortage. The applicant shall submit a literal translation in proper Japanese in accordance with the context of the foreign language document. For foreign language document (except for drawings) containing a main portion of description of the contents of the invention, a translation is legally regarded as the description and later becomes a subject of the examination and patent granting. Therefore, when lack of a translation is equal to lack of the description attached to the application, such foreign language application is regarded as withdrawn. For translation of drawings, it is required to be submitted as the translation even if no foreign language text matter is included in it as of the filing date in the foreign language application system. Without a translation of drawings submitted, the missing drawings are deemed not to have been attached to the application although such application is not regarded withdrawn. No submission of a translation of drawings may result in failure to satisfy the description requirements for the description claims or drawings or the requirements for patentability and the correction of mistranslation may become necessary. An abstract has no influence on any matter related to patent rights. However, the abstract is indispensable for publication of an unexamined application. If a translation of the foreign language abstract is not submitted, such an application may be subject to an invitation to correct or the dismissal of procedure.

SIPO describes that the translation of claims and specification is compulsory when PCT application enters into Chinese national phase.

Where, after entering the Chinese national phase, if the translation of the abstract, and the drawing of the abstract fails to meet the requirement, the applicant should submit the amended abstract and its drawings within the specified time limit. If the applicant fails to do so, the application shall be deemed to have been withdrawn.

(d) Correction of mistranslation

All three offices state that applicants may correct mistranslation of the final translation including the description, the claims or the text matter in the drawings as filed within the time limit.

In KIPO, the applicant may correct the incorrect translation within the period of voluntary amendment or the deadline of written opinion about notice of ground for rejection before the commencement of the examination.

In SIPO, The applicant may correct the incorrect translation before the publication of an application or within three months from receipt of the notification of an application entering into the substantive examination phase. The correction of mistranslation can be submitted.

In JPO, where an applicant of a written application in foreign language amends the description, claims or drawings for the purpose of correcting an incorrect translation, the applicant shall submit the statement of correction of the incorrect translation, stating the grounds thereof. The applicant may correct the incorrect translation within the period or at the time when the applicant can amend the description, claims or drawings under the Patent Act Article 17bis (1).

In SIPO, the applicant should correct the mistranslation according to the OA.

(2) Prohibition of new matter

(i) Relevant provision

KIPO, JPO and SIPO state that the addition of new matter shall be prohibited. Actually, SIPO states the amendment should not go beyond the scope of the original application, so far it seems this principle is equal to “prohibition of new matter” of the JPO and KIPO.

According to JPO, if new matter is added to the amendment of the description, of claims or drawings, an application falls under a reason for refusal or a ground for invalidation and an amendment in response to a final notice of reasons for refusal or an amendment made when filing an appeal against an examiner’s decision of refusal can be subject to a dismissal of amendment.

In SIPO, the scope of disclosure contained in the initial description and claims includes the contents described in the initial description and claims, and the contents determined directly and unambiguously from the original application.

(ii) Explicit new matter

In KIPO and JPO, making an amendment to not only “matters explicitly stated in the originally attached description, etc.” but also “matters obvious from the statement in the originally attached description, etc.” that are not explicitly stated does not introduce new technical matters and is permitted.

In SIPO, the principle is the amendment of the application documents shall not go beyond the scope of disclosure contained in the initial description and claims, which is substantially the same with “prohibition of new matter”.

(iii) Implicit new matter

KIPO, JPO, SIPO – same as 3. (2) (ii) Explicit new matter

(iv) Assessment of new matter

(a) General rule

KIPO, JPO and SIPO state that the addition of new matter to any of the specification (description), claims or drawing(s) shall not be accepted.

In KIPO, to find out whether new matter is added to the amended specification, claims or drawing(s), the specification, claims or drawing(s) originally attached to the patent application shall be the subject of comparison. Determining the addition of new matter shall be done by checking that elements in the amended documents are in the scope of the elements in the original documents of application. The phrase of 'being in the scope of the elements described in the specification or drawing(s)' does not mean being completely and eternally the same within the scope of matters in the specification, claims or drawing(s) originally attached to the patent application. Matters obvious for a person skilled in the art based on matters in the specification, claims or drawing(s) originally attached to the patent application shall be deemed as being in the scope of matters in the specification or drawing(s).

In JPO, "the matters stated in the description or drawings" mean technical matters which a person skilled in the art can understand, taking into account all statements in the description or drawings. Where an amendment does not add any new technical matters to the technical matter which can be understood in this manner, the amendment can be deemed to be made within "the scope of the matters stated in the description or drawings".

SIPO states that after the amendment, if a person skilled in the art understands it becomes a different invention from the original one, and it can't be directly and unambiguously determined from the original application, then the amendment is not acceptable. The scope of the original application doesn't include the contents of any priority documents.

(b) Application with priority claim

In KIPO, JPO and SIPO, an application forming the basis of the priority claim, or a prior application shall not be used as the basis of assessment in addition of new matter since it shall not correspond to the specification, claims or drawing(s) originally attached to the patent application.

(c) Application through PCT route

KIPO and SIPO state that an amendment to the specification or drawing(s) of an application through PCT route shall be made within the scope of matters in the description, claims and drawings submitted on the international filing date.

In JPO, it is prohibited to submit a translation which includes a matter beyond the description, etc. as

of the international filing date, or to add new matter beyond the original text to the description, claims or drawings through subsequent amendments. The existence of "new matter beyond the original text" shall be deemed as a reason for refusal with regard to the foreign language PCT patent application. Moreover, in the case of an international patent application in the foreign language, an amendment to add new matter beyond the translation is prohibited.

An amendment to the description, claims or drawings of an international patent application in the Japanese language shall be made within the scope of matters written in the description, claims or drawings originally attached to the international application.

(d) Matters described in abstract

In KIPO, SIPO and JPO, since an abstract shall not correspond to a specification or drawing(s), an abstract shall not serve as a basis for assessment of addition of new matter.

KIPO describes that adding the matters disclosed only in an abstract to a specification through amendment shall not be allowed.

SIPO describes that the abstract has no legal effect, it doesn't belong to the scope of the original application.

(e) Amendment of abstract

KIPO, JPO and SIPO state that an abstract may be amended under some restrictions.

KIPO states that when an abstract is poorly written without referring to the guideline for writing abstracts, the abstract can be subject to request for amendment. An amendment of an abstract shall be made when an application is pending before KIPO. In other words, if the application has been invalidated, withdrawn, abandoned, or a decision to reject the application has become final and binding, the amendment shall not be made.

JPO states that the amendment of the abstract may be made within one year and three months from the filing date (when claiming a priority, from the priority date) of the patent application excluding the period after a request for laying open of application is filed.

SIPO states, as to the amendment of abstract, it should indicate the title of the invention and the technical field to which the invention pertains, clearly reflect the technical problems to be solved, the essential contents of the technical solution for solving said problems, delete the commercial advertising, change the drawing of the abstract to make it best reflect the main technical features of the invention

(f) Completing an incomplete invention

In KIPO, in the case of completing an incomplete invention, the amendment generally shall be deemed to contain new matter.

In SIPO, additions are not allowed if it can't be directly and unambiguously determined from the initial description, claims and drawings.

In JPO, since an amendment to complete an incomplete invention includes contents beyond the scope of "matters stated in the originally attached description, etc." (the amendment including new matter), the amendment is not permitted.

(g) Amending conflicting elements

KIPO and JPO state that where a person skilled in the art clearly understands which of more than two contrasting elements is right based on matters described in the specification (description) or drawing(s), the amendment of writing the correct matters is permitted.

JPO states that addition of irrelevant or inconsistent matters is not permitted. If two or more kinds of inconsistent statement are present in the description, etc. and it is evident to a person skilled in the art from the statement of the originally attached description, etc., which of them is correct, an amendment to match it with the correct statement is permitted. Moreover, even if the statement is not in itself unclear, an amendment to make it clear is permitted if its inherent meaning is evident to a person skilled in the art from the statement of the originally attached to the description, etc.

In SIPO the general principle is the amendment should not go beyond the scope of the original application. Polishing languages, standardization of words, unifying technical terms are allowed provided that initial technical solution is not changed

(h) Disclaimer claim

KIPO and JPO state that an amendment to a disclaimer claim is not mostly deemed as addition of new matter.

JPO states that after exclusion, the disclaimer shall be included within a scope of matter state in the originally attached description, etc.

In JPO, (1) if the claimed invention overlaps with the prior art and is thus likely to lose novelty, etc., an amendment to exclude only the overlap is made while leaving the expression of the statement of matters stated in claims before the amendment. Amending claims to provide the disclaimer makes them patentable if the invention is remarkably different from the prior art as the technical idea, and inherently involves an inventive step but accidentally overlaps with the prior art. If parts of disclaimer occupy a major portion of the claimed invention or extend many portions, an invention may not be clearly identified from one claim. (2) If the claimed invention includes the term "human being" and does not satisfy the requirement of the main paragraph of Article 29(1) or falls under unpatentable grounds, and the said reason for refusal is eliminated by exclusion of the term "human being", an amendment to exclude only the term "human being" is made while leaving an expression of the statement of matters stated in claims before amendment. Since both (1) and (2) do not introduce any new technical matters, the amendment is permitted.

In SIPO, disclaimer amendment is usually deemed as addition of new matter when excluding certain numerical value from the original claims, except that:

when applicant can, according to the originally attached description(OAD), prove that the invention can't be carried out with the disclaimed numerical value, or

when applicant can, according to the OAD, prove that the invention is novel and involves an inventive step after excluding

(i) Changing scope of numerical limitation

JPO describes that an amendment for adding numerical limitation (range) is permitted if the numerical limitation (range) is within a scope of matters stated in the originally attached description, etc.

SIPO describes that the amendment to the numerical range of the claim is allowable only when the two extreme values of the revised numerical range are really described in the initial description and/or claims and the revised numerical range is within the initial numerical range.

KIPO states that if amended matters by changing the scope of numerical limitation are not obvious based on the matters described in the specification or drawing(s), it shall be deemed as addition of new matter.

(j) Changing a subordinate concept into a generic concept in an invention

JPO and SIPO describe that the amendment shall be within the scope of the original application.

KIPO states that if amended matters are not obvious based on the matters described in the specification or drawing(s), the amendment of changing features of an invention into a generic concept or subordinate concept shall be deemed as addition of new matter.

In JPO, the amendment which is not made within the scope of matters stated in the original description, etc. is not permitted,

if by amending a matter that specifies the invention of claims to a generic concept including removing the matters used to specify the invention, matters other than those stated in the originally attached description, etc. are added, or

if by amending it to a more specific concept including adding the matters used to specify the invention, matters other than those stated in the original description, etc. are individuated.

In JPO, however, the amendment does not introduce new technical matters when the amendment does not clearly add any new technical significance,

if removing part of the matters used to specify the invention in claims and amending them to make the generic concept conceptually, or

if limiting part of the matters used to specify the invention in claims so that the limited matters fall under the generic concept conceptually of the matter stated in the original description.

This is even the case when the amended matter does not fall under either matters explicitly stated in originally attached description, etc. or matters obvious from the statement in the originally attached description, etc. and this amendment is permitted.

SIPO states that when amend the subordinate concept into a generic concept in an invention , if the amended invention go beyond the scope of the original application, then it is not accepted.

(k) Changing a generic concept into a subordinate concept in an invention

In KIPO, if amended matters are not obvious based on the matters described in the specification or drawing(s), the amendment of changing features of an invention into a generic concept or subordinate concept shall be deemed as addition of new matter.

JPO – Same as 3. (2) (iv) (j)

SIPO states that new contents introduced by changing indefinite contents into definite and specific contents are not allowed.

(l) Adding embodiments

In KIPO, if amended matters are not obvious based on the matters described in the specification or drawing(s), the amendment of adding embodiments shall be deemed as addition of new matter.

In JPO, since adding an example of the invention or adding materials falls under amendment beyond the scope of matters stated in the originally attached to description, etc., such an amendment to add embodiments is not permitted.

In SIPO, it is not allowed to add a specific mode or embodiment to prove that the invention can be carried out.

(m) Later submitted experimental data

KIPO states that if amended matters are not obvious based on the matters described in the specification or drawing(s), the amendment shall be deemed as addition of new matter.

JPO states that written opinions and reports of experiment results submitted in response to the notice of reasons for refusal cannot substitute for the detailed description of the invention in the description, but if the applicant argues and proves thereby that the matters disclosed in the description or drawings as originally filed are correct and proper, the examiner should take into consideration of these particulars.

In JPO, upon receiving a notice of reasons for refusal, the applicant may make an argument or clarification by submitting a written opinion, certificate of experimental results, and the like. However, if the violation is based on the deficiency of the matters stated in the detailed explanation of the invention, the reasons for refusal cannot be overcome.

SIPO states that it is not allowed to add the experimental data into the description to illustrate the advantageous effects of the invention. But it doesn't mean it is no use submitting the later experiment data or embodiments to persuade examiner as an evidence.

(n) Amendment of the technical field of the invention

KIPO states that if amended matters are not obvious based on the matters described in the specification or drawing(s), the amendment shall be deemed as addition of new matter.

SIPO states that in order to enable the public and the examiner to clearly understand the invention and the relevant prior art, the applicant is allowed to amend technical field of the invention to make it relevant to the corresponding field which is defined in the lowest classification position of the IPC.

JPO –No mention

(o) Changing or adding purpose or effect of an invention

JPO and SIPO describe that when the technical feature(s) such as the structure, operation, or function of the invention and the effect is clearly described in the initial application documents, the amendment is permitted.

KIPO describes that if amended matters are not obvious based on the matters described in the specification or drawing(s), the amendment of adding or changing purposes or effects of an invention shall be deemed as addition of new matter.

In JPO, generally an amendment to add effects of the invention falls under an amendment beyond the scope of matters stated in the originally attached description, etc.

In SIPO, only when the advantageous effect can be directly and unambiguously determined from the original application, it can be added to "Contents of Invention"

(p) Amendment from prior art stated in the specification

KIPO states that the amendment shall be deemed as addition of new matter when such added matters cannot be obvious to a person skilled in the art based on the specification, claims or drawing(s) originally attached to the patent application.

SIPO states adding prior art to the "Background Art" is permitted since it only amends the background art other than the invention per se, and the contents added are already known to the public

In JPO, an amendment to add the prior art document information (name of publications in which the relevant invention was stated and location of other information of the inventions disclosed in the publication) in the detailed description of the invention and to add contents stated in the document to "Background Art" of the description does not introduce new technical matter and is permitted. However, an amendment to add information on evaluation of the invention, such as comparison with the invention in the application or information on implementation of the invention introduces new technical matter and is not permitted.

(q) Adding well-known prior arts

KIPO states that though the added matters through amendment are well-known prior arts, if it is not obvious for a person skilled in the art whether the added matters are the same as the matters described in the specification or drawing(s), the amendment of adding such well-known prior arts shall be deemed as addition of new matter out of the scope of the matters described in the specification or drawing(s)

In JPO, making an amendment to “matters obvious from the statement in the originally attached description, etc.” does not introduce new technical matters and is permitted. However, the technology in well-known art or commonly used art cannot sufficiently be considered as “matters obvious from the statement in the originally attached description, etc.” just because the technology itself is well-known art or commonly used art. Therefore, adding well-known arts or commonly used art is considered as addition of new matter and is not permitted.

In SIPO, the fundamental principle as to amendment is “not go beyond the scope of the original application”. If the added well-known art can be directly and unambiguously determined from the original application, then the adding is allowed, however if the adding leads to an improved invention, then it is not allowed.

(r) Adding later searched prior art not stated in the original application

KIPO describes that just adding the titles of prior art documents to a description shall not be deemed as addition of new matter. However, an amendment based on the matters described in the prior art documents shall be deemed as addition of new matter when such added matters cannot be obvious to a person skilled in the art based on the specification, claims or drawing(s) originally attached to the patent application.

SIPO states that if examiners find more relevant documents, the applicant shall be allowed to amend the Background art by adding the contents of the documents or citing the documents.

JPO –Same as 3. (2) (iv) (p)

(3) Assessment of new matter regarding inventions of special fields

(i) Bio-tech inventions

a. Deposition of Microorganism

The JPO and KIPO state that an amendment of adding microbiological characteristics of a microorganism which is not disclosed explicitly or inherently in the original description shall be deemed to be the addition of new matter.

The JPO and KIPO also described that converting some information about a microorganism is allowable as long as the identity of the microorganism is secured.

- Converting the name of the microorganism according to the reclassification (KIPO)
- Converting a storage number or a reference number to an accession number (JPO)

The JPO further states that an amendment to convert or add an accession number is acceptable, if microbiological characteristics of the microorganism are described in the description etc. to the extent that the microorganism can be specified and deposit of the microorganism can be specified based on the name of the depository institution.

In the contrary, KIPO states that where a deposit number is not disclosed in the initial specification, an amendment of adding the deposit number shall be deemed to be the addition of new matter.

SIPO states that if an applicant submits a request, certificate of deposit and certificate of viability which complied with Rule 24, on time, adding relevant information to the description is allowed at the stage of substantive examination.

b. Sequence Listings

KIPO states that where the sequence list is not described in the initial specification, an amendment of adding the sequence list shall be deemed to be the addition of new matter.

In SIPO, The "Sequence Listing" shall be arranged at the end of the description as a separate part. If the nucleotide or amino acid sequence listing recorded in computer-readable copy submitted by applicant is not consistent with that written sequence listing disclosed in the description and claims, the written sequence listing shall prevail.

c. Registration form for disclosure of genetic resources

SIPO states that the contents in the registration form do not belong to the scope of the original application. Thus, it cannot be used as the basis for amending the specification.

(ii) Chemical compound inventions

KIPO and SIPO coincide in that the amended matters are not clearly acknowledged based on the initial specification or drawing(s), such amendment shall be deemed as addition of new matter, so that it is not allowable.

JPO explains that in claims in Markush-type, an amendment for removing part of the alternatives is permitted if the remaining matters used to specify the invention are within a scope of matters stated in the original description, etc.

JPO further states that if the original description, etc. includes several alternatives for describing a chemical substance, it may not be determined that a specific combination of alternatives was stated in the original description, etc. In particular, if a substitute group that had several alternatives as of the filing has only one alternative as a result of the amendment and has no room for change, the

amendment is not permitted because the original statement would not mean employing a specific alternative except when employing a combination of such specific alternatives has been stated in the original description, etc.

JPO also states that, on the other hand, if an alternative has been removed so that an alternative accompanied by an example statement is all that remains, the remaining alternative may be found to be a matter stated in the original description in view of the whole statement of the original description, etc.

For example, if a group of chemical substances in a form of a combination of substituted groups with alternatives is stated in the originally attached description, etc., a permissible amendment would be one that left only the statement of the (group of) chemical substances consisting of specific alternatives corresponding to “a single chemical substance” that was stated in an example, etc. in the originally attached description.

(iii) Others

The JPO, SIPO and KIPO coincide in that program listings are allowed to be included in the specification or drawing provided that they are short and written in a computer language generally known to a person skilled in the art and helpful for understanding the invention. Program listings can be submitted and filed as reference materials, which cannot be the basis of amendments of a specification.

4. Types of Amendment

(1) Voluntary amendment (self-amendment)

In KIPO, the voluntary amendment or the self-amendment refers to the amendment made within the time period before the commissioner of the Korean Intellectual Property Office delivers a certified copy of a decision to grant a patent, excluding an amendment which is made to a notice of grounds for rejection and shall be within the period for submission of opinions following the relevant notice.

In SIPO, when requesting for substantive examination, or, within 3 months after receiving the notification on the entry into substantive examination, the applicant may amend the application on his own initiative, and the examiner shall accept the amendment. When an application is pending, the applicant may amend the application. And the same applies to an international application.

In JPO, an applicant for a patent may amend the description, claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted, provided that the applicant has not received a notice of reasons for refusal.

(i) Scope of the amendment

Three offices coincides in that an amendment to the description, claims or drawing(s) shall be made within the scope of matters written in the original description, etc.

SIPO states that the contents of the application documents in foreign language shall not be taken as the basis to judge an amendment meets the said criteria, except for the originally filed text in foreign language of an international application entering into the national phase. SIPO also states, as to the amendment made during the international phase, it should comply with Article 19 or Article 34 of the PCT.

JPO state that in the case of a foreign language written application, the translation of the foreign language document that is deemed to be the description, etc. (in the case where the amendment to the description, etc. has been made through the submission of the statement of correction of an incorrect translation, said translation or the amended description, etc.) would be the scope of the matters described in the original description, etc.

KIPO states that in the case of an application written in a foreign language, an amendment shall be made within both the original specification or drawing(s), and the final Korean translation or drawing(s) which is initially attached to the application (excluding the explanation of drawing(s)).

(ii) Treatment of multiple amendments

KIPO and SIPO coincide in that the voluntary amendment (complied with Rule 51.1 in SIPO) is not the subject of dismissal, i.e. the application amended by voluntary amendment shall be used as the text of examination no matter whether the amendments go beyond the scope of disclosure contained in the initial description and claims, but it doesn't mean that the voluntary amendment can go beyond the scope of the original application.

KIPO states that in the case of voluntary amendment, every amendment submitted is reflected to the description, claims and drawings in a cumulative way until the examination begins.

SIPO states that where there are voluntary amendments submitted several times within the time limit(Rule 51.1), the last submitted application shall be used as the examination basis.

SIPO further states that the voluntary amendment which is not submitted within the time limit(Rule 51.1) shall not be accepted, except where, though the amendment did not meet the time limit, if the examiner thinks that the amended documents have eliminated the defects and meet the requirements of the provisions of Article 33, and accepting the amendment can speed up the examination, such amendment can be accepted.

(iii) Others

SIPO states that where an international application was amended in the international phase and the applicant requests that the examination be based on the amended application, the Chinese translation of the amendments shall be submitted within two months from the date of entry. Where the Chinese translation is not submitted within the said time limit, the amendments made in the international phase shall not be taken into consideration.(Rule 106)

(2) Amendment in response to non-final notice of rejection

In KIPO and SIPO, an applicant may amend the application within the specified time limit.

KIPO states that where an applicant receives a notice of grounds for rejection, an amendment shall be made within the period for submission of opinions following the relevant notice of grounds for rejection.

SIPO describes that where the applicant amends the application after receiving the OA, he or she shall amend according to the defects indicated by the OA.

In JPO, the applicant who received a notice of reasons for refusal shall submit the amendment within the designated time limit under the Patent Act Article 48septies or the Patent Act Article 50.

(i) Scope of the amendment

KIPO and JPO states that an amendment to the specification (description), claims or drawing(s) shall be made within the scope of matters written in the specification (description), claims or drawing(s) originally attached to the patent application.

In KIPO, an amendment to the specification, claims or drawing(s) within the designated period has no limit to the scope of an amendment except for the prohibition of the addition of new matter.

JPO states that in addition to prohibition of an amendment to add new matter, so-called a “shift amendment” is not allowed. According to Patent Act Article 17bis (4), the invention for which determination on its patentability is stated in the notice of reasons for refusal received prior to making the amendment and the invention constituted by the matters described in the amended claims shall be of a group of inventions recognized as fulfilling the requirements of unity of invention.

In SIPO, the amendment shall be made in answer to the defects indicated in the Office Action. If the manner of the amendment is not in conformity with the Rule 51.3, the amendment shall generally be unacceptable. However, where the contents and scope of the amendment are in conformity with the provisions of Article 33, the application documents amended in this way may be acceptable, provided that the defects existed in the initial application documents are eliminated and there is prospect for the application to be granted.

(ii) Treatment of multiple amendments

KIPO states that when multiple amendments are submitted within the designated period according to one notification of ground of rejection, the way of the process is different between applications under Old Patent Law and under New Patent Law. For the application filed under Old Patent Law, each amendment will be accumulatively reflected if several amendments are submitted within the designated period according to notification of ground for the first rejection. For the application filed under New Patent Law, every amendment submitted before the last amendment will be deemed to be withdrawn if several amendments are submitted within the designated period according to notification of ground for rejection.

SIPO describes that after the response to the first Office Action has been submitted. The examiner shall continue the examination and consider the reply and/or amendments. The same standard of examination shall be applied at the various stages of the examination.

JPO – No mention

(iii) Others

SIPO states that reply without any specific content submitted by the applicant is also the formal responses, for which the examiner shall think that the applicant does not give any specific objections to the opinions of the Office Action and does not overcome the defects indicated in the application.

If examiner finds a defect which is caused by the poor translation, he needs to indicate the defect in the OA. If applicant wants to amend the application to erase this defect, but the amendment will lead to “go beyond the scope of the original application” (new matter), then the examiner will issue a notice for applicant to correct the translation, then amend the application to erase the defect. If applicant fails to reply and not correct the translation on time, then the application will be deemed to have been withdrawn.

KIPO and JPO – No mention

(3) Amendment in response to final notice of rejection or on request for reexamination or appeal

(i) Scope of the amendment

In KIPO, an amendment in reply to the final notice of grounds for rejection or carried out upon a request for reexamination shall additionally satisfy the Article 47(3), along with Article 47(2) of the Patent Act (prohibition of new matter).

According to the Article 47(2), the amendment to the claims shall be limited to those for the following purposes: 1. Where the scope of claims for a patent is reduced by limiting, deleting, adding claims; 2. Where wrong description is corrected; 3. Where ambiguous description is made clear; 4. With regard to an amendment beyond the scope referred to in paragraph (2), where returning to the scope of claims made prior to the amendment, or amending the scope of claims pursuant to subparagraphs 1 through 3 in the course of returning to the said scope of claims.

JPO states that in addition to the prohibition of addition of new matter and shift amendment, the amendment to the claims shall be limited to those for the following purposes: (i) the deletion of a claim or claims; (ii) restriction of the claims; (iii) the correction of errors; and (iv) the clarification of an ambiguous statement. Moreover, in the case of amendment for the purpose as provided the above (ii), an invention constituted by the matters described in the amended claims must be one which could have been patented independently at the time of filing of the patent application. And amendment in response to a final notice of reasons for refusal or an amendment made when filing an appeal against an examiner’s decision of refusal can be subject to a dismissal of amendment when the amendment does not satisfy the requirement.

In SIPO, the person making the request may amend its or his patent application at the time when it or he requests reexamination or responds to the notification of reexamination of the Patent Reexamination Board. However, the amendments shall be limited only to eliminate the defects pointed out in the rejection decision or in the notification of reexamination. Amendments by the petitioner shall be limited only to overcome the defects indicated in the rejection decision or by the panel.

In the course of requesting for invalidation, the patentee may amend its or his claims, but may not broaden the scope of patent. The patentee may not amend its or his description or drawings.

(ii) Treatment of multiple amendments

KIPO states that when multiple amendments are submitted within the designated period according to one notification of ground of rejection, the way of the process is different between applications under Old Patent Law and under New Patent Law. For the application filed under Old Patent Law, only amendments granted by examiners among amendments will be accumulatively reflected if several amendments are submitted within the designated period according to notification of ground for the final rejection. For the applications filed under New Patent Law, every amendment submitted before the last amendment will be deemed to be withdrawn if several amendments are submitted within the designated period according to notification of ground for rejection. Where the amendment stating the purport for the reexamination request dated on the same day is submitted a multiple times, any amendment from the second submission shall not be deemed to be submitted within the prescribed period. Since an examiner regards the subsequent following the first submission as documents submitted after the statutory period according to the Patent Act or the Enforcement Decree of the Patent Act, he/she gives an opportunity for an explanation and returns the subsequent amendments.

JPO states that when several amendments to the description, claims, or drawings are made within a period for responding to a final notice of reasons for refusal, the description, claims, or drawings as a basis when determining if the second and subsequent amendment satisfies the Article 17bis (5) and (6) shall be the ones to which amendments were legally made immediately before the second and subsequent amendment. However, as for the Patent Act Article 17bis (3), the basis shall be the original description, claims, or drawings.

SIPO – NO mention

(iii) Restriction of amendment on claims

KIPO, JPO and SIPO state that the manners of an amendment to claims shall be limited to reduction of scope of claims by limiting claims, correction of clerical errors, clarification of ambiguous descriptions, or deletion of new matter (JPO - deletion of the claim, restriction of the claims, correction of errors in the description, and clarification of an ambiguous description).

In KIPO, amendment requirements shall be applied only to the amended claims. In this case, if an independent claim is amended, the dependent claims which refer to the independent claim shall be deemed to be amended.

JPO describes that if the claims amended in response to “the final notice of reason for refusal” includes “the invention that a special technical feature”, the examiner will dismiss the amendment. The amendment to the claims which does not satisfy requirements for the purposes of independent patentability is also subject to a dismissal of amendment.

In SIPO, the petitioner may amend the application at the time of submitting the request for reexamination, responding to Notification of Reexamination (including Notification of Oral Proceedings for Request for Reexamination), or appearing in oral proceedings. Any amendment shall meet the requirements of Article 33 and Rule 61.1. Generally the requirement is not considered to be met where a claim amended extends the extent of protection as compared with the claim rejected in the decision of rejection; where a claim in the amendment is derived from the technical solution that lacks unity with the claims rejected in the decision of rejection; where the type of a claim is altered, or the number of claims is increased; or where the amendments are directed to the claims or the description that were not involved in the decision of rejection, unless they are intended merely to correct obvious clerical errors or to amend the defects of the same nature indicated in the decision of rejection. In the course of the examination of the request for invalidation, the patentee may amend its or his claims, but may not broaden the scope of patent. Any amendment to the patent documents shall be limited to the claims only, and shall follow the principles that the title of the subject matter of a claim cannot be changed; the extent of protection cannot be extended as compared with the granted patent; the amendment shall not go beyond the scope of disclosure contained in the initial description and claims; and addition of technical features not included in the claims as granted is generally not allowed. Before the Patent Reexamination Board makes a decision on the request for invalidation, the patentee may either delete a claim or delete a technical solution contained in a claim. The patentee may amend the claims by the way of combination within the time limit in the following 3 situations: 1. responding to the request for invalidation; 2. responding to causes for invalidation or evidence added by the petitioner; 3. responding to invalidation or evidence not mentioned by the petitioner but introduced by the Patent Reexamination Board

(iv) Others

KIPO states that to which of the abovementioned cases an amendment of amending claims corresponds shall be determined by comparing the claim which is the subject of an examination upon the final notice of grounds for rejection with the claim with the same number. However, if a claim after an amendment is obvious to be the same as the amended claim with the different number, the validity of the amendment shall be assessed through comparison with the claim of the different number. Regardless of whether an applicant amends one word or the whole claim, if an amendment of the claim falls under any of the subparagraphs of Article 47(3), the amendment shall be deemed as an amendment under Article 47(3) of the Patent Act. However, even in the aforementioned case, if one claim contains more than two inventions (a Markush-type claim or a claim multiple claims), such inventions shall be assessed individually.

In SIPO, once said (rejection) decision or notification (to grant patent right) is issued, any observations, response or amendment from the applicant shall not be considered. In reexamination procedure, if the application submitted by the petitioner is not in conformity with Rule 61.1, the panel will generally refuse to accept it; and the panel should explain why the amended document is unacceptable in Notification of Reexamination and examine the previous accepted document. If part of the content of the amended document is in conformity with Rule 61.1, the panel may provide examination opinions on this part, and notify the petitioner that he should amend other part of the text

which is not in conformity with Rule 61.1 and submit document which is in conformity with the provisions, otherwise the panel will take the previous accepted text as the basis for examination.

(4) Others

In JPO, where the examiner intends to give a notice of reasons for refusal for a patent application under the Patent Act Article 50, and these reasons for refusal are the same as the reasons for refusal stated in the previous notice under the Patent Act Article 50 with regard to another patent application (limited to the case where both patent applications are deemed to have been filed simultaneously by applying the provision of the Patent Act Article 44 (2) to either or both of them) (except for such a notice of reasons for refusal of which the applicant of the patent application could have never known the content prior to the filing of a request for examination of the patent application), the examiner shall also give a notice to that effect.

SIPO states that a divisional application should not go beyond the scope of disclosure contained in the initial application.

KIPO – NO mention

5. Supplemental Communication Means

(1) Written opinions/statements of applicants

In SIPO, the response of the applicant may include the arguments only. The revised application (replacement sheet and/or rectification) may be also included. Where the applicant states the objection to the Office Action or makes amendments, he shall state his opinions in detail, or explain whether the amendments are in compliance with the corresponding provisions and how the defects have been overcome.

KIPO and JPO –No mention

(i) Legal status of the communication

KIPO states that a written argument in response to the notification of the grounds for rejection shall not be a part of the specification of the application. Where an applicant insists matters to be amended in a written argument but fails to submit an amendment, an examination shall be made on the detailed description and claims upon the notification of the ground for rejection. Also, where contents of amendments having insisted in a written argument and the actual amendments show discrepancy, an examination shall be made based on the actual amendments to the detailed description and claims.

JPO states that where the examiner intends to render an examiner's decision to the effect that an application is to be refused, the examiner shall notify the applicant for the patent of the reasons therefor and give the said applicant an opportunity to submit a written opinion, designating an adequate time limit for such purpose. Written opinions and reports of experiment results submitted in response to the notice of reasons for refusal cannot substitute for the description, but if the applicant

argue and prove thereby that the matters disclosed in the description or drawings as originally filed are correct and proper, the examiner should take into consideration of these particulars.

SIPO states if applicant replies without responding to the defects indicated in the OA, then it is deemed that applicant agrees with the examiner, and the defects indicated are not be overcome.

(ii) Later submitted experimental data

In KIPO, experiment results in response to the notification of the grounds for rejection shall not be a part of the specification of the application. However, as these documents are submitted to clarify or verify the legitimacy of matters in the detailed description, an examiner may refer them to decide the patentability of the concerned application.

In SIPO, the later submitted experimental data is not allowable to be added to the description. However, in case that the later submitted experimental data is described in the written opinion, an examiner should consider the data during examination. The later submitted experiment data and embodiment can be deemed as evidence to argue that the invention is either inventive or it is fully disclosed, or supported by the specification. The examiner may accept this evidence and grant.

JPO – Same as 3. (2) (iv) (m)

(iii) Others

KIPO, SIPO and JPO– No mention

(2) Telephone, facsimile, mail, meeting, etc.

(i) Legal status of the communication

KIPO and SIPO state that where an applicant or his/her attorney (the party) requests or where an examiner considers for a prompt and fair examination, an examiner may have a personal interview with the party. The examiner may communicate with the applicants through a telephone.

In JPO, technical explanation or interview is the supplementary means for securing communication with the applicant. Where it is considered to contribute to the prompt and precise examination, communication with the applicant through an interview, telephone or facsimile should be used. An interview etc. should be performed based on the "Interview Guideline," and in order to secure transparency in an interview procedure, the examiner should keep an interview record or a response record and contribute to benefit for the access of the public.

In SIPO, if there still exist some defects after amending, the applicant shall be informed again to eliminate the defects. The examiner may discuss with the applicant by telephone. This telephone communication shall only apply to minor or non-misleading issues concerning the formal defects. The examiner shall record the matters discussed and keep it in the application file. For the amendments

agreed by both sides, the applicant shall submit the revised written documents. The examiner shall make conclusion according to such written documents. The basis for the examination shall be the written amendments formally submitted by the applicant except that the examiner amends the obvious mistakes ex officio. The request for interview is granted when an examiner think it is helpful. The record of interview shall not substitute the formal response to the Office Action or the amendment. Where no agreement regarding the amendment is reached in the interview, the examination shall be continued by issuing a further written action. If the initial specified time limit still exists, the time limit may not need to change because of interview, or depending on the situation, the time limit may be extended for one month. The examiner shall specify another time limit for submitting the amendments or observations in the record of interview where the initial specified time limit no more exists. The amendments or observations submitted within the time limit shall be deemed as the response to the Office Action. If the applicant fails to respond in due time, the application shall be deemed to have been withdrawn. If the amended documents submitted by the applicant have not been received by the examiner by the interview, the examiner can decide to suspend the interview.

(ii) Others

In SIPO, where the examiner has issued the first Office Action and the applicant files a request for interview at the time of or after submitting the response to the office Action, or where the examiner thinks it necessary to invite the applicant to have an interview, an interview is held. The date of the interview shall not be changed once it is fixed. If it has to be changed, the other party shall be notified in advance. If, without any justified reason, the applicant fails to take part in the interview, the examiner may refuse to arrange a new interview, and continue the examination by sending a further written action. The interview shall be held in the place designated by the Patent Office, and presided over by the examiner responsible for the examination of the application. Other experienced examiners may be invited to provide assistance. Where a patent agency is appointed by the applicant, the patent agent shall participate in the interview. The total number of the applicants or patent agents present in the interview shall be usually no more than two. If the interview concerned many matters, such as novelty, inventive step, or whether the amendment introduces new contents, the examiner shall make a full record of the matters discussed and agreement reached. Even though the agreement on how to make the amendment has been reached by both parties in the interview, the applicant still has to submit the formal amended documents and the examiner cannot make any amendment on the applicant's behalf. Without agreement on the amendment, the examination shall be continued by sending a further written action. The main responsibility of the examiner is to point out to the applicant the problems of the application which are not in conformity with the provisions of the Patent Law and its Implementing Regulations. If the applicant decides to produce evidence in support of his case, the evidence may be either written documents or a model.

KIPO and JPO – No mention

(3) Suggestion of amendment by examiner

In KIPO, JPO and SIPO, examiners may suggest amendment to prevent applications from being refused.

For KIPO, suggestion of amendment may be implemented if it is possible to understand the content of

invention; if prior art research is fully conducted; or if the invention of application has a technical feature which is distinguished from prior art. To present the direction of amendment is implemented regardless of representative on the premise that the deficiency in the specification may be corrected. In respect to novelty or inventive step, patentable dependent claim or technical structure written in details of invention shall be specified to explain the ground. The direction of amendment that adds or limits the structure shall be presented to the claim which needs amendment. The direction of amendment including deletion of the deficiency or change of expression, etc. should be clearly presented.

In JPO, suggestion of amendment is to enable applicants to easily respond to the reasons for refusal and contribute prompt and precise examination. The suggestion has no legal effects. Amendment, divisional application, etc. should be made on responsibility of the applicant.

SIPO states that examiner can suggest the applicant how to amend, however, it is still up to the applicant to decide whether to accept the suggestion or not.

6. Dismissal of Amendment

(1) Relevant provisions in patent law and implementing regulations

KIPO – See, Patent Act

Article 47 Amendment of Patent Application

Article 51 Rejection of Amendment

Article 63 Notice of Grounds for rejection

Article 67 Formalities for Decision of Patentability

Article 132ter Trial against Decision to reject patent application

JPO – See, Patent Act

Article 53 (Dismissal of amendments)

Article 17bis (Amendment of Description, Claim or Drawing attached to the application)

Article 37 (Unity of invention)

Article 50 (Notice of reasons for refusal)

Article 126 (Trial for correction)

Examination Guidelines Part IX. Chapter2. Section 6.2 Examination of Amendment

SIPO – See, Rule 51.1

Rule 51.3

Rule 61.1

In JPO, where, prior to the service of the certified copy of the examiner's decision notifying to the effect that a patent is to be granted, and amendment made to the description, scope of claims or drawings attached to the application is found not to comply with paragraphs (3) to (6) of Article 17bis, the examiner shall dismiss the amendment by a ruling. The ruling dismissing an amendment shall be made in writing and state the seasons therefor. The ruling dismissing an amendment shall not be subject to appeal.

(2) Reasons for dismissal of amendment

In KIPO, JPO and SIPO, an amendment shall follow its Rule not to be dismissed.

KIPO states that an amendment in the period for submitting a written statement of arguments in reply to the final notice of grounds for rejection or an amendment upon a request for reexamination is in violation of Article 47(2) and (3) of the Patent Act or if it is recognized that a new rejection ground is raised due to the amendment, the amendment shall be dismissed.

JPO describes that where amendment which adds new matters; amendment to claims which changes a special technical feature of an invention, has the purpose other than the purposes provided in Article 17bis (5), or does not satisfy requirements for independent patentability, the amendment is to be dismissed.

SIPO states, according to Rule 51.3, when replying the Office Action, the amendment shall be made to eliminate the defects indicated in the Office Action. If the amendment manner is not in conformity with Rule 51.3, the amendment generally is unacceptable.

The following situations, even though the amendment does not go beyond the scope of original application, the amendment shall not be deemed to be made in answer to the defects indicated in the Office Action, therefore the amendment shall be unacceptable. (1)The applicant has deleted one or more technical features from the independent claim on his own initiative, which leads to the expansion of the protection scope. (2)The applicant has changed one or more technical features of the independent claim on his own initiative, which leads to the expansion of the protection scope. (3)The applicant has taken the technical content which is only described in the description and lacks unity with the initial claimed subject matter as the subject matter of the revised claim on his own initiative. (4)The applicant has added a new independent claim on his own initiative, and the technical solution defined is not present in the initial claims.(5)The applicant has added a new dependent claim on his own initiative, and the technical solution defined is not present in the initial claims.

(3) Treatment of multiple amendments

KIPO SIPO - no mention

JPO – Same as 4. (3) (ii)

(4) Procedure of dismissing amendments

In KIPO, whether an amendment carried out after the final notice of grounds for rejection or an

amendment upon a reexamination request meets the requirements shall be assessed regardless of an order of amendment requirements. If multiple requirements are not satisfied, an examiner shall point out as many unsatisfied requirements as possible and reject the concerned amendment.

In JPO, the examiner should determine whether new matters are added to the description, claims or drawings by the amendment in response to the final notice of reasons for refusal, then the examiner shall determine whether the inventions in other claims to which no new matter has been added are inventions that change a special technical feature. With regard to the claims to which no new matter has been added and which are not inventions that change a special technical feature, the examiner shall further determine whether the amendment to each of these claims has been made for any of the purposes prescribed in Article 17bis(5) (i) to (iv). After the determination, where there are amended claims falling under Patent Act Article 17bis (5) (ii), the examiner should determine whether it should meet requirements of Article 17bis (6). Where there are amendments which are determined to be illegal, the examiner should indicate reasons to all such amendments and decide the dismissal of the amendment.

In SIPO, if applicant doesn't amend according to the defects indicated in non-final OA, then examiner should issue another OA and explain the reasons why the amendment can't be accepted, and ask applicant to submit the amended application complied with Rule 51.3 within time limit. At the same time, examiner should notify applicant that if the amendment is still not complied with Rule 51.3, then he/she will continue the examination with the previous application and ignore the amendment, then make the decision to grant or reject.

(5) Appeal for amendment dismissal

The JPO and KIPO don't have procedures to appeal to the amendment dismissal.

KIPO states that since an appeal regarding a decision to decline an amendment are not readily arranged, a decision to grant or reject a patent or a notice of rejection grounds shall be made after re-examining the description before the amendment, along with dismissal of an amendment. Legality of decision on dismissal of amendment is determined at the same time when a trial against decision of rejection decides whether decision of rejection is legitimate or not.

In SIPO, where the applicant for patent is not satisfied with the decision of the Patent Reexamination Board, it or he may institute a legal proceeding in the people's court within three months from the date of receipt of the notification.

In SIPO, Rule 51(amendment dismissal) is not a reason to reject during the preliminary or substantive examination period, neither can it be the reason to invalidate the patent. The examiner may issue an OA, state the reason for not accepting the amendment, and invite the applicant to submit the amendment complying with Rule 51.3 within the specified time limit.

In JPO, the ruling dismissing an amendment under the Patent Act Article 53 (1) shall not be subject to appeal; provided, however, that where a request for an appeal against an examiner's decision of refusal has been filed, this shall not apply to the appeal made in the proceeding in the said appeal against an examiners' decision of refusal.

7. Ex-officio Amendment

(1) Background and purpose of the ex-officio amendment

In KIPO, when an examiner during the examination discovers only obvious errors such as misspells, omissions, or inconsistent reference signs, the examiner is allowed to amend ex-officio the clearly erroneous matters instead of notifying the ground for rejection, which accordingly prevents the examination delays and makes the description of registration without deficiency. The amendment ex-officio shall be applied within the limited scope as a supplementary exception for the applicant's self-amendment.

JPO –No mention

SIPO – to speed up the examination and polish the application.

(2) Scope of the ex-officio amendment

In KIPO and SIPO, grammar, misspelling or missing word are included in matters (the obvious mistakes) for amendment ex-officio.

In KIPO, clearly erroneous matters that do not fall under the grounds for rejection and do not influence the substantive scope of right in the patent application, provided however, that the matters shall have no possibility of arguments in the interpretation from the context, in the confirming of the claim scope, and in the working of the invention. Inconsistent use of sign in drawing(s) is also included in the matters for amendment ex-officio.

SIPO states that examiners, on their own initiative, can correct the obvious clerical mistakes and symbol mistakes of an application and shall notify the applicant. The ex-officio amendments or rectifications apply to the description, the claims, and the abstract.

In JPO, the examiner can make an ex-officio amendment when there is inappropriate description in the description, claims or drawings, in case the said inappropriate description is not determined as the reasons for refusal.

(3) Procedure of ex-officio amendment

KIPO and SIPO state that the examiner intending to amend ex-officio shall notify the matters to be amended to the applicant.

KIPO states that when the applicant opposes to accept the amendment ex-officio in whole or part, he/she shall submit the written statement of argument before the payment of patent fee, whereby the examiner may make selective decision for the amendment ex-officio. Where the applicant submits the written statement of argument regarding the amendment ex-officio, the concerned matter under the amendment ex-officio shall be deemed never to have existed. The description is digitized and published in the patent gazette except for the matter that the applicant rejects to accept the amendment ex-officio.

In SIPO, the amendment can only be formally submitted in written form except the examiner

amends the obvious mistakes ex-officio. Such as alteration, addition or deletion of few words or marks, as well as amendments to the obvious mistakes with the invention title or the abstract, the examiner may carry out ex-officio amendment and inform the applicant.

In JPO, in principle, the examiner makes an ex-officio amendment only when he has found no reasons for refusal and the examiner makes a phone call to the applicant or the patent attorney prior to the ex-officio amendment for confirming content of the substantial amendment. On the other hand, when the examiner notices the reasons for refusal because of the other reasons he found, the examiner makes a note about the inappropriate description in the description, claims or drawings in the notice of reasons for refusal.

(4) Others

KIPO describes that the matters to be amended ex-officio are limited to self-evident error. When an examiner amends ex-officio, he/she should not alter the scope of the claim, and the amendment ex-officio shall not be allowed if there arises any possibility of different interpretation. Where the examiner amends the matter which does not fall under the category of the amendment ex-officio and the applicant also overlooking such an illegitimate amendment by the examiner published the description in the patent gazette, the concerned matter having amended ex-officio shall be deemed never to have existed unless the amendment is recognized as legitimate afterward. This is designed to prevent unexpected losses in patentees or the third parties due to an illegitimate amendment by the examiner.

JPO and SIPO –ex-officio amendment only applies to minor and obvious errors, and should not change the claimed invention.