Chapter 6 Amendments

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When examining a patent application for an invention, the **Specific Patent Agency** may, on its own initiative, notify the applicant to amend the description, claim(s), or drawing(s) within a specified time period. If the applicant believes that there are flaws or omissions in the application that require correction, he/she may also make requests to the Specific Patent Agency for amendments on his/her own. A.43

According to the first-to-file provisions of the Patent Act, where two or more patent applications are filed for the same invention, only the earliest application can be granted. In order to obtain the first filing status, an applicant often submits application documents including the description, claims, and drawings to the Specific Patent Agency soon after completing the invention. As a result, there may be errors, omissions, or unclear expressions in the description, claims, or drawings. Therefore, in order to achieve disclosure of the claimed invention in a clear and sufficient manner, the applicant may be allowed to amend the description, claims, or drawings.

In addition, if the Specific Patent Agency discovers that there exist unpatentable conditions, such as a need to amend the description, claims, or the drawings, or that the amendments proposed by the applicant do not meet the requirements, it should first notify the applicant to respond within a specified time period rather than inappropriately issuing a decision of rejection Yet in order to balance the interests between the applicant and the public, as well as taking into account the first-to-file principle and the stability of the grantedrights in the future, amendments should only be limited within the scope disclosed in the description, claims, and drawings as filed.

Amendments include general corrections and translation errors. However, the scope of discussion in this chapter excludes the correction for translation errors. The discussion of correction for translation errors is reserved for Chapter 8.

1. Timing for Amendments

The timing for amendments is as follows: A.43.I

When a patent application enters substantive examination and before

A.43.III

the issuance of an office action, the applicant may request for amendments. After the Specific Patent Agency issues an office action, the applicant may only make amendment(s) within the specified time period set in the notice.

For those apply for reexamination after the decision of rejection in the initial examination, amendments may still be made. However, upon issuance of a reexamination office action, the applicant may only make amendment(s) within the specified time period set in the notice.

2. Determining when amendments extend beyond the scope of original disclosure in the description, claims, or drawings as filed

Amendments to the description, claims, or drawings should first be reviewed to see whether they extend beyond the scope of content disclosed in the description, claims, or drawings as filed, before other patentability requirements are considered.

A.43.II

Although the description, claims, or drawings based on which the filing date was obtained may be amended, the result of the amendments shall not add matters that are not disclosed as filed before examination closed, i.e., no new matters shall be introduced. During examination, the amended description, claims, or drawings shall be compared with the description, claims, or drawings as filed. If the scope of the amended description, claims, or drawings extends beyond that as originally disclosed as filed , the applicant shall be notified by an office action that provides clear articulation of reasoning to respond within a specified time period. For those that fail to respond within the specified time period or amendments still extend beyond the scope of original disclosure after amendments, a decision of rejection will be issued.

The examination of amendments to the description, claims, or drawings is to determine whether the content of the amended description, claims, or drawing meets the requirement that amendments "shall not extend beyond the scope of content disclosed in the description, claims(s), or drawing(s) as filed." The “scope of content disclosed in the description, claim(s), or drawing(s) as filed” refers to all matters that have been clearly recited (obviously presented) in the description, claims, or drawings(except for the certified priority document) as filed on the date of filing, or a person ordinarily skilled in the art can directly and unambiguously understand from the matters recited in the description, claims, or drawings as filed, and therefore is not limited to the literal meaning of a word for word

interpretation of the description, claims, or drawings as filed. Those that can be directly and unambiguously understood by a person ordinarily skilled in the art from the matters recited in the description, claims, or drawings as filed means that, if a matter recited in the description, claims, or drawings as filed can be clearly deemed (without doubt) to have solely implied or collectively implied an inherent specific matter of the amended description, claims, or drawings without implying other matters, the inherent specific matter (e.g., a single technical feature, a plurality of technical features, technical effects, or embodiments) is deemed to be directly and unambiguously derivable. In addition, if an amended matter differs from the original recitation of the description, claims, and drawings as filedonly in terms of expression, yet both may be deemed to describe the same matter, the amended matter may be considered to be directly and unambiguously understandable by a person ordinarily skilled in the art from the matters recited in the description, claims, or drawingsas filed. However, if the matters recited in the description, claims, or drawings as filed may imply several interpretations, even if the matters after amendment belong to one or some of the interpretations, because the one or some interpretations are not specific matters that are clearly defined prior to the amendments, the amended matter may not be considered to be directly and unambiguously understandable by a person ordinarily skilled in the art from the matters recited in the description, claims, or drawings as filed. Amendments that extend beyond the scope of content disclosed as filed, which include introducing matters that are not recited in the description, claims, or drawings as filed (e.g., negative or newly introduced matters) and adding matters that cannot be directly and unambiguously derived by a person ordinarily skilled in the art from the description, claims, or drawings as filed, may be considered to be introducing new matters.

3. Documents to be Submitted for Amendments

When requesting to amend the description claim(s), or drawing(s) of a patent application for invention, a request form shall be submitted and accompanied by the following documents: R.36

1. the amended sheet(s) of the description or claim(s) on which the portions of the amendment are marked; the original disclosure to be deleted shall be presented by a strike line crossing out the deleted text(s); the added disclosure shall be presented by underlining the added text(s). However,

deleting claim(s) may be presented by annotation of descriptive text(s).

2. the replacement sheet(s) of description, claim(s), or drawing(s) after the amendment without marks; in case the page sequence, claim sequence, or drawing sequence of the description, claim(s), or drawing(s) are not continuous due to the amendment, a complete set of description, claim(s), or drawing(s) after the amendment shall be submitted.

The request form referred to in the preceding paragraph shall specify the following items:

1. where an amendment is made to the description, the page number(s), paragraph number(s), and line number(s) thereof and reasons for the amendment;

2. where an amendment is made to the claim(s), the number(s) thereof and reasons for the amendment;

3. where an amendment is made to the drawing(s), the designation(s) thereof and reasons for the amendment.

Where an amendment is made to the claim(s), if parts of the claims are deleted, number(s) of the remaining claim(s) should be rearranged with Arabic numeral(s) according to the claim sequence; where an amendment is made to the drawing(s), if parts of the drawings are deleted, the drawing designation(s) of the remaining drawing(s) should be rearranged according to the drawing sequence.

A 43.IV

In the event that the Specific Patent Agency has issued a final notice to the patent application for invention, the amendment reasons set forth in Subparagraph 2, Paragraph 2 of this Rule shall state the respective grounds prescribed under Paragraph 4, Article 43 of the Act.

4. Items of Amendments

4.1 Description

A26.IV

The content of the description includes the title of invention, technical field, prior art, summary of invention, brief description of drawing(s), description of embodiments, reference signs list, etc., which should be written in order and each of the parts shall be preceded by a heading. For applications that fail to comply with the order or fashion of recitation, the applicants shall be notified to respond or amend; if no response or amendment is made within the specified time period, a decision of refusal will be issued. However, if the nature of an claimed invention warrants a

clearer and fuller presentation of all the necessary technical features through other expressions, a written order or fashion different from that recited above may be applied, e.g., for a claimed invention that is an accidental discovery but of technicality in nature, or a pioneering invention, or is an invention of simple technology, whose recitation of description is deemed to be able to clearly and sufficiently present all the essential technical features by a person ordinarily skilled in the art through studying the description and the drawings as a whole.

The technical contents introduced into the description through amendments should be directly and unambiguously derivable by a person ordinarily skilled in the art from the material recited in the description, claims, or drawings as filed, so as to enable a person ordinarily skilled in the art to understand the content of the invention to carry out of the invention. Yet adding any new matter in a description during amendments is not allowed. A26.IV

When technical features of the claims are not recited in the description, the technical features should be introduced to the description or the claims should be amended so that the claims can be supported by the description. When the technical features or technical solutions disclosed in the drawings are not recited in the description, the recitation of the technical features or solutions into the description in written forms should be directly and unambiguously derivable by a person ordinarily skilled in the art from the content disclosed by the drawings.

If the description contains any commercial advertisement wording, untrue exaggeration, other emotional expressions, or usage descriptions that may be contrary to public order or morality, etc., amendments should be required. The amended content may be deemed to be within the scope of disclosure of the description, claims, or drawings as filed.

4.1.1 Title of Invention

The title of invention should concisely state the contents of the claimed inventions; irrelevant wording is not allowed. To designate a title in the "title of invention" field is for specifying the subject matter of the invention and reflecting the category thereof. If an amendment only involves formal corrections or wording modifications of the title without altering the subject matter or category, it may still be considered to be within the scope of disclosure of the description, claims, or drawings as filed. R.17

4.1.1.1 Amendments without Changing the Claimed Method or Product

For the method or product specified in the “title of invention” field, if it belongs to the same method or product after amendment, the amendment shall be deemed to be within the scope of disclosure of the description, claims, or drawings as filed. Examples are as follows:

(1) Deletion of irrelevant wordings in the title of methods or products. For example, the deletion of irrelevant wordings including, e.g., proper nouns such as trademarks, product names, human or geographical names, or any commercial advertisement wording, etc.

(2) Pure correction for foreign-originated language or foreign imported terminology. For example, amending the product name of “Pachinko” to “Pinball electronic game machine.”

(3) Specific expression of vague and unspecific terms. For example, amending "excavation apparatus" to "excavator;" "polymerization method" to "polymerization method using chain terminator."

(4) Modification of layman terminology to scientific name or professional term. For example, amending the product name from “cell” or “handheld” to “mobile phone;” “bike” or “bicycle” into “velocipede.”

4.1.1.2 Amendments for Conforming to the Subject Matter as Claimed

The extent of the protection conferred by an invention patent shall be determined by the claim(s). When the title of the method or product is inconsistent to the category of the claims, amendments that are clear and substantially align the title to the category of the claims shall be deemed to be within the scope of content disclosed in the description as filed.

For example, the content of the claim recites a manufacturing method for a certain product, yet the title of invention recites the method of using the product; or the content of the claim recites a rotary tool holder for lathe set, yet the title of invention recites a lathe set. Such titles of inventions are inconsistent with the contents recited in the claims and should be amended.

Amending the title of invention in response to the invention category of the claims after amendments includes, e.g., the claims include both “product” claim and “method” claim as filed and only “product” claim is retained after amendments. In this case, the “method” related recitation in the title of invention shall be deleted and retain only the “product” portion. Likewise, if the claims include only “method” claim as filed and “product” claims are added after amendments. In this case, “product” related recitation may be added to the title of invention in addition to the originally recited “method.”

4.1.2 Technical Field

If the description as filed did not recite the technical field, or the technical field recited is unclear, one may amend the technical field to make it consistent with the lowest hierarchical level of the International Patent Classification, provided that it does not extent beyond the scope of content disclosed in the description, claims, or drawings as filed, for example, amending the technical field from organic chemistry to the field of nitrogen-containing heterocyclic compounds.

When making amendments, the technical field should also be amended in correspondence with the amended claims, so as to reflect the subject matter as claimed.

4.1.3 Prior Art

When a particular prior art reference is cited in the description and drawings as filed but without detailed recitation of its content, supplemental addition of detailed contents of the reference does not constitute new matter.

For 2-part claims (Jepson Type claims), if an essential technical feature recited in the preamble that is common to the prior art is not disclosed in the description and drawings as filed, the technical features may be added to the description and drawings.

Adding content of prior art for purpose of carrying out, or for purpose of remedying the unclear or insufficient disclosure of the description as filed is not allowed.

One exception being, if a prior art reference more relevant to the claimed invention is found through searching, it is allowed to add the reference and remove the less relevant prior art(s). Because the type of amendments only involves prior arts and not the invention per se, it is allowed to add to the description and drawings the prior art information known to the public before application.

4.1.4 Summary of Invention

4.1.4.1 Problem to be Solved by the Invention

Except for an invention that is an accidental discovery but of technicality in nature, a pioneering invention, or an invention of simple technology where the recitation of problem to be solved may be omitted from the description, the amendments to the problem to be solved by the

invention as recited in the description as filed need to be based on what's recited in the description, claims, and drawingsas filed, or those can be directly and unambiguously derivable by a person ordinarily skilled in the art from the description, claims, or drawings as filed.

The content recited in the description regarding the problem to be solved does not correspond to the inventive effect or the technical solution, or does not reflect the subject matter of the claims, amendments for the problem to be solved by the invention should be required. For example, if claims directed to methods of increasing pressing strength are cancelled, and only claims directed to methods of increasing shear strength are retained, the recitation in the summary of invention "the present invention may solve the problem of insufficient pressing strength and shear strength exist in the prior art" should be correspondingly amended to "the present invention may solve the problem of insufficient shear strength exists in the prior art."

In principle, it is not allowed to alter the original problem to be solved by the invention in response to the prior art cited by the examiner, unless the problem to be solved by the invention as amended can be directly and unambiguously derived by a person ordinarily skilled in the art from the description, claims, or drawings as filed.

In addition, if the purpose of the invention is already stated in the summary of invention, it is allowed to amend the purpose of the invention to correspond to the problem to be solved by the invention and the technical solution.

4.1.4.2 Technical Solution to the Problem

Amendment to the technical solution, e.g., amendments to operating methods, operating conditions, reaction conditions, component structures, or implementation methods, or amendments in response to the claim amendments may be allowed, if such amendment is based on what's recited in the description, claims, and drawings as filed, or those can be directly and unambiguously derivable by a person ordinarily skilled in the art from the description, claims, or drawings as filed. For example, if an amendment regarding an "operation" is directly and unambiguously derivable by a person ordinarily skilled in the art from the functions and effects of the embodiments recited in the description, claims, or drawings as filed, such amendment may be allowed. In addition, if the description and drawings as filed do not recite the inherent melting point, analytical value and other physical and chemical properties of the compound, but nevertheless have

provided relevant information that can ascertain the compound, and the physical and chemical properties of the compound are commonly known to a person ordinarily skilled in the art as filed, such amendment may be allowed.

In addition, on the premise that the original technical solutions are not altered, textual modifications or amendments to unify technical term usage are allowed.

4.1.4.3 Technical Effects over the Prior Art

The amended technical effects over the prior art has to be based on what's recited in the description, claims, and drawings as filed, or those can be directly and unambiguously derivable by a person ordinarily skilled in the art from the description, claims, or drawings as filed. Therefore, amendments that add new functions or changes to different effects will generally extend beyond the scope of content disclosed in the description, claims, or drawings as filed. For example, the addition of new substances or unexpected effects of known substances or the synergistic effect of the combination may itself constitute a new use invention. Another example is that the original invention was directed to a method for cleaning wool fabrics, which mainly involves treating fabrics with a special liquid. At this time, adding description of benefits for protecting fabrics from moth damage would go beyond the scope of content disclosed in the description, claims, or drawings as filed, which constitutes new matter. On the other hand, for descriptions, claims, or drawings as filed that have clearly disclosed technical contents, e.g., the invention's structure, operation, and function, even if technical effects have not been (or sufficiently) mentioned, if it can be derived directly and unambiguously by a person ordinarily skilled in the art from the disclosed structure, operation, or function, the elaboration of technical effect does not constitute new matter.

Amendments of original numerical range or experimental data, or elaboration of the measurement method of the numerical range, the standards, equipment, and instruments applied, if can be directly and unambiguously derived by a person ordinarily skilled in the art from the description, claims, or drawings as filed, do not constitute new matter. However, if the description, claims, or drawings as filed did not recite experimental data on a certain effect, and new experimental data is introduced during amendments to prove efficacy, such new experimental data would extend beyond the scope of content disclosed in the description, claims, or drawings as filed, and will be deemed new matter.

When narrowing the claim scope and amending the problem to be solved by the invention, the effect of the invention may be amended and narrowed correspondingly. In addition, deletion of one or more application of unsatisfactory effect of a composition may be allowed. The result of deleting part of the originally recited effects will not extend beyond the scope of content disclosed in the description, claims, or drawings as filed. For example: for "a pesticide for extermination of cotton bollworms and corn aphids" whose effect in corn aphid eradication is unsatisfactory, amendments such as “a pesticide for extermination of cotton bollworms" may be accepted to reduce the scope of use.

4.1.5 Brief Description of Drawing(s)

When the description as filed has included drawings yet omitted the brief description of drawings, or when the brief description of the drawings is inconsistent with the summary of invention or the description of embodiments, the brief description of the drawings may be amended.

4.1.6 Description of Embodiments

While an invention’s description of embodiments may be expressed in the form of preferred embodiments, amendments for the description of embodiments should be directly and unambiguously derivable by a person ordinarily skilled in the art from the description, claims, or drawings as filed. For example, it is allowed to add recitation of chemical structures and compositions of known material expressed in trade names, or explanation of the standard measurement method (including the standard equipment and instruments used) of certain data. For another example, for embodiments that have been clearly recited in the claims but insufficiently disclosed in the description and the drawings, contents of the embodiment recited in the claims may be added to the description and drawings.

For descriptions that contain insufficient disclosure or provide too few embodiments as filed and the claims lack clear recitation or are overly vague, thereby failing to enable a person ordinarily skilled in the art to practice the content thereof or predict the results, the addition of new embodiments (even the best mode) for proving enablement of the claimed invention or efficacy of the invention should be deemed to extend beyond the scope of content disclosed in the description, claims, or drawings as filed. Because the added embodiments are not those directly and unambiguously derivable by a

person ordinarily skilled in the art from the description, claims, or drawings as filed, thus should be deemed new matter.

Amendments that add specific embodiments of material choices are usually those that extend beyond the scope of content disclosed in the description, claims, or drawings as filed. For example, for a rubber structure composed of several components, the addition of new description such as “other components may be added” is not allowed. Likewise, if the description, claims, or drawings as filed recites a device disposed on an elastic support yet fails to specifically disclose the type of elastic support, then an amendment that reads “a device disposed on a coil spring” is not allowed. However, if based on the drawings and common knowledge as filed, a person ordinarily skilled in the art can understand that the "elastic support" obviously refers to a "coil spring," it is allowed to amend "elastic support" to "coil spring."

The supplementation of information regarding the source of original embodiments may usually be deemed as not introducing new matter.

4.1.7 Reference Signs List

Reference signs or remarks that are directly or unambiguously obtainable from the summary of invention, description of embodiments, and drawings may be added to the reference signs list through amendments.

4.2 Claims

If the recitation of the claims contains issues that fail to meet the written requirements, e.g., indefiniteness in the claims (including inconsistency between the claims and the description, or indefiniteness due to terms of uncertainty in the claims), or due to other reasons (e.g., the applicant’s proactive narrowing of claim scope, for clarifying ambiguous statements, correcting errors, etc.) for which amendments are filed, the matter recited in the amended claims shall not extend beyond the scope disclosed in the description, claims, or drawings as filed, i.e., it should still be what’s recited in the description, claims, or drawings as filed, or directly and unambiguously derivable by a person ordinarily skilled in the art from the description, claims, or drawings as filed.

4.2.1 Permitted Addition

Situations where the addition does not extend beyond the scope disclosed in the description, claims, or drawings as filedusually include the following:

(1) Adding technical feature(s) into the claims to further narrow down the scope of claim(s), and the added technical features are supported by the description and drawings. That is, when adding limitations or additional technical features to a certain technical feature recited in the claims for further narrowing down the scope of claim(s), it is allowed to import technical features that have been disclosed by the description and drawings (including contents that have been formally recited and those that are not literally recited yet inherently disclosed) but not yet recited in the claims into the claims. It should be noted that the technical features with further limitations should be associated with the original problem to be solved by the invention.

For example, suppose the originally filed claim reads "causing reaction between A and B." If the description as filed has clearly recited the technical feature of causing reaction between A and B in the presence of C, and the presence of C is pertinent to the problem to be solved by the invention, then the claim may be amended to read “causing reaction between A and B in the presence of C.”

For another example: suppose the originally filed claim reads "an eraser disposed on one end of the pencil." Although the element “lead” has not been formally recited in the description, a person ordinarily skilled in the art may understand from the content of the description and drawings that a pencil by itself has inherently cradled the graphite lead without other implications, and writing being an inherent function of a graphite lead is well known to the public. Therefore, it is allowed to add the description of the element “graphite lead,” and the claim may be amended to read “the pencil includes a graphite lead therein, and an eraser disposed at one end thereof.”

(2) Adding technical features or technical solutions disclosed only in the drawings but not recited in the description into the originally filed claims in the form of writing or to form new claims, and the technical features or technical solutions are directly and unambiguously derivable from the originally filed drawings by a person ordinarily skilled in the art. This type of amendments should concurrently incorporate the technical features or technical solutions into the description.

(3) When the scope of the claim does not cover part of the subject matter or another embodiment disclosed in the description, incorporating the subject matter or embodiment into a claim, or adding one or more additional claims to enlarge claim scope. For example, if the claim recites a circuit that employs semiconductors, yet the description not only recites the use of semiconductor circuits, but also recites an embodiment that employs vacuum tube circuits, the unclaimed embodiment may be added to the claims.

(4) Adding numerical limits. For example: if the value range of "24-25℃" has been clearly recited in the description, this value may be added to the claims.

(5) For Markush type claims, if the description and drawings as filed recite chemical substances in a combination of multiple groups of selections, and have described the use of a particular selection of combination, the particular selection of combination may be added to the claims.

(6) For product-by-process claims, if the description and drawings as filedrecite part of the physical and/or chemicalparameters for defining the product, the physical and/or chemical parameters may be added to the claims.

4.2.2 Permitted Deletion

Situations where the deletion does not extend beyond the scope disclosed in the description, claims, or drawings as filed usually include the following:

(1) Deleting one or more claims. The reasons for deletion may include: a claim reads on the prior art, two claims are substantially identical in scope and belong to the same category and thus fail to meet the requirements of conciseness, claims do not meet the unity of invention requirement, recitation in the description is unclear or insufficient to extend the content of the description to support a certain claim, or a claim fails to be supported by the description and drawings due to the narrowed summary of invention, etc. Nevertheless, attention should be paid to the consistency of the title of subject matter and category in the description upon claim deletion.

(2) Deleting an independent claim and rewriting its dependent claim into a new independent claim, or merging an independent claim and its dependent claim(s) into a new independent claim to further narrow original claim scope.

(3) Amendments that can still reflect the technical solutions of the claimed invention as a whole after partial deletion of recited technical features from the claims. However, in order to avoid the introduction of new matters as a result of deletion, the amendments should be considered to concurrently meet the following three requirements by a person ordinarily skilled in the art from the description and drawings as filed:

a. The removed feature was not explained as essential in the originally filed disclosure;

b. The function of the technical feature is not indispensable in solving the technical problem;

c. The removal of the technical feature requires no modification of one or more features to compensate for the change.

(4) When a claim is written in an alternative form (Markush type) and some selections are deleted from the claim, those that did not extend beyond the scope of content disclosed in the description, claims, or drawings as filed upon amendments.

(5) Deletion of commercial promotional wording and phraseology recited in the claims.

(6) Deleting unnecessary matters recited in the claims such as effects and uses that do not belong to technical features. In principle, each technical feature of the claim should be expressed in terms of structure, condition or step. Except for describing necessary technical features, unnecessary matters shall not be recited. Therefore, except for inventions of combination of plural technical features expressed in means-plus-function or step-plus-function language, and for product claims that can only be more clearly defined through its property, function, efficacy, and uses, if a claim describes unnecessary matters such as effects and uses that are not technical features, such matters may be deleted from the claims. However, the recitation of the effects and uses should be kept in the description to meet the disclosure requirements stipulated in the Patent Act, thus facilitating understanding of the disclosure and enabling practice of the invention by a person ordinarily skilled in the art.

(7) The exclusion from the claims of technical content that overlaps with the prior art may lead to introduction of new matter, because the excluded content may not be directly and unambiguously derivable from the description, claims, or drawings as filed. However, if the subject matter after exclusion cannot be clearly and concisely defined in a positive manner, a negative recitation of “disclaimer” may be used to exclude the

overlapping portion with the prior art, which will not be seen as introducing new matter.

For example, suppose a claim recites a generic technical feature, while the description correspondingly recites a multiple selection of specific technical features. If an invention that includes one of the recited selections is disclosed by prior art, in order to avoid overlapping with prior art, it is allowed to delete the disclosed selection from the description, and at the same time amend the claim in a manner that disclaims the selection (e.g., not comprising, not including, excluding), i.e., reciting the generic technical feature through negative expression. Although technical features not disclosed as filed, i.e., the technical feature which excludes the prior art, is added to the amended description and claims, it may nevertheless be exceptionally considered as not introducing new matter. In the above situation, although the description as fileddoes not disclose the prior art, it is still allowed to directly amend the generic technical features of the description and claims in a manner of negative expression that excludes the prior art. Although technical features that were not disclosed as filed are added to the amended description and claims, it may still be exceptionally deemed as not introducing new matter.

The above-mentioned amendment in the form of negative expression is limited to situations for overcoming citation documents of novelty, conflicting application, or inconsistency with the first-to-file principle. However, the exclusion type amendments are not applicable to citation documents of “the same filing date.” In addition, if a claimed invention includes "human beings" and is associated with inventions contrary to public order or morality, amendments may be allowed to exclude “human being.”

For applicants who voluntarily amend the claims using negative expressions to exclude overlapping scope with the prior arts before the issuing of anoffice action, if the content of exclusion was not disclosed in the description, claims, or drawings as filed, the applicant should submit the prior art to be excluded and state the reasons. For those that fail to submit such information, the amendment shall be deemed as introducing new matter.

4.2.3 Permitted Changes

Situations where changes do not extend beyond the scope of content disclosed in the description, claims, or drawings as filedusually include the following:

(1) Change into generic or specific concepts

Matters after amendments, aside from those that have been clearly recited in the description, claims, or drawings as filed, the following two scenarios can also be considered as amendments within the scope disclosed in the description, claims, or drawings as filed:

a. Scenarios where deletion of partial limitations from specific definition, while formally creates a generalization in concept, can be proven that the deleted limitation does not contain substantial technical meaning, and the result of such deletion clearly does not introduce new technical meaning, or the deleted limitation is a dispensable addition to the specific concept.

b. Scenarios where, upon reviewing the matters recited in the description, claims, or drawings as filed, such as through the recited embodiments and the technical problems to be solved by the invention, a person ordinarily skilled in the art can clearly understand the generic invention or the specific invention defined by the technical feature in the amended claims belongs to matters that have been disclosed by the description, claims, or drawings as filed.

If the result of generalization of the technical features defined in the claims includes matters not disclosed in the description, claims, or drawings as filed, for example: the description, claims, or drawings as filed only recite "copper," changing "copper" recited in the claims to a more generic genre "metal" would result in introducing metal elements other than “copper” into the claim scope. Likewise, if the result of specifying the technical features defined in the claims is directed to matters not disclosed in the description, claims, or drawings as filed, for example: the description, claims, or drawings as filed only recite "metal," changing "metal" recited in the claims to a more specific species "copper," while “metal” includes various elements such as “copper,” the description, claims, or drawings as filed did not refer “metal” to the specific element of “copper,” thus both of the above-mentioned amendments extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

Example 1: Claim amendment that changes the generic recitation “when

the control device is not set to normal operation" to specific recitation "when the control device is not set to normal operation and generates a negative signal." Because the description, claims, or drawings as filed only recite that when the control device is not set to normal operation lacks the presence of a positive signal for a period of time, a reset signal will be generated. The added limitation upon amendment "and generates a negative signal" would render the reset signal to be based on the generation of negative signal rather than an absence of positive signal, which is a matter not disclosed by the description and drawings. Thus, such amendment that changes the limitations for defining the invention is not allowed.

Example 2: Claim amendment that changes the specific recitation "from the dopant diffusion region that constitutes the source and the drain" to the generic recitation "from the dopant region that constitutes the source and the drain." Because the description, claims, or drawings as filedhave recited that the semiconductor layer in the active region of the present invention has a specific structure composed of a specific material, while the originally filed claim recites the specific concept that "dopant diffusion region" constitutes the source and drain, it is obvious that any dopant region is sufficient to represent the region that may constitute source and drain. Therefore, deleting the limiting term "diffusion" that is inherently included in the specific concept and changing to the generic recitation would not affect the technical meaning of the invention. And in this case, the specific limitation may be deemed to have disclosed the generic concept. Thus, such amendment that expands the limitations for defining the invention is allowed.

Example 3: Claim amendment changing the generic concept "a recording and reproducing apparatus" to the specific concept "a disc-type recording and reproducing apparatus." In the description, claims, or drawings as filed stated a reproducing apparatus intended for CD-ROMs. According to another statement in the descriptions as filed, e.g., the present invention is an invention having an object to reduce battery power comsumption by adjusting the power supply when the recording and reproducing apparatus receives no execution commands, it is

obvious that the invention may be applied to not only a reproducing apparatus intended for CD-ROMs, but also stuiable for any disk recording and reproducing apparatus. Therefore, such amendment for restricting part of the matters specifying the invention is permitted.

Example 4: Claim amendment that change the generic term “work piece” to a specific term “rectangular workpiece,” where the limitation “rectangular” is added. The description, claims, or drawings as filed recite glass substrates, wafers, and other workpieces to which thin films are applied by a coating device. What is stated as a specific example is only an approximately quadrate work piece, but the "rectangular shape" is obviously a typical shape of a typical glass substrate. Therefore, such amendment for restricting part of the matters specifying the invention is permitted.

(2) Changes in numerical limits of the claims

a. Restricting a broader claimed range to a preferred range defined in an embodiment. For example, the original method claim recites a chemical reaction condition of pH=6-12, while the embodiment of the description recites a preferred range of pH=6-8. If a reaction condition of pH=6-8 has been disclosed by prior arts, thus anticipating the wider pH range as originally claimed, it is allowed to amend the claims to recite the range of pH=6-8. However, it is not allowed to redefine the range of pH=6-9. This is because a range of pH=6-9 is not specifically recited in the description. In addition, for the description of n=1–x being positive integers, since the positive integers have been clearly reicted, it is permitted to limit the claimed range to a preferred range.

b. Expanding a narrower range to a preferred ranged defined in an embodiment. For example, the original claim recites an instant setting adhesive having an HLB (hydrophilic-lipophilic balance) value from 9 – 11. If the embodiment of the description recites several instant setting adhesives containing active ingredients X that have HLB value range of 7.5–11, it is allowed to amend the claim to redefine the HLB value range to 7.5–11.

c. Regarding amendments for the upper and/or lower limits of the claimed ranges, an amendment will be allowed and not deemed to be introducing new matter if the following two conditions are concurrently met. (i) The endpoint values of the amended numerical range have been

disclosed in the description, claims, or drawings as filed. (ii) The amended numerical range is included in the numerical range disclosed in the description, claims, or drawings as filed. For example, the original claim recites a temperature range of 20℃-90℃, and the description or the claims as filed further rectie specific temperature values 40℃, 60℃, and 80℃ within the 20℃-90℃ range. In this case, it is allowed to amend the claimed temperature range to 40℃-80℃, 60℃-80℃, or 60℃-90℃.

d. Amendments in a disclaimer for specific values. Numerical values that are not disclosed in the description, claims, or drawings as filed are new matters, unless, if the numerical value belongs to prior art, an exception of amendments through a disclaimer (e.g., not comprising, not including) is allowed. For example, the original claim recites a certain value X1=600-10000, and a range disclosed by prior art is X2=240-1500. When X1=600-1500 lacks novelty due to partially overlapping with X2, because the value 1500 was not disclosed in the description, claims, or drawings as filed, it is not allowed to include this value and amend the claim to recite X1=1500-10000. However, the exception allows the disclaimer of overlapping parts of the numerical range by amending the claim to recite "X1>1500-10000" or "X1=600-10000, but not including 600-1500."

e. Amendments of obvious errors in numerical values. (Please refer to Chapter 9 "3.3.1 correction of errors")

(3) Replacing certain technical feature of the claim(s) with the composition or structure rectied thoroughly as a whole in the description corresponding to the technical feature per se. For example: replace "traffic signal device" in the claim with "signal light composed of LED, panel, and countdown timer" correspondingly rectied in the description.

(4) Changing the category, subject matter title, or technical feature of independent claims in correspondence with other related amendments.

(5) Changing the dependency or the body of a dependent claim, so as to comply with relevant regulations of the Enforcement Rules of the Patent Act, and to accurately reflect the embodiments or examples recited in the description as filed.

(6) For an independent claim that is formed from another independent claim by further reciting a certain technical feature in detail or reciting an additional technical feature, changing such independent claim into a dependent form for clarity and brevity.

(7) For two independent claims that satisify the unity requirements, changing one of them into recitation by reference format independent claim by referring to the sequentially preceeding claim, so as to make the recitation of claims clear and concise.

(8) Changing 2-part claim into regular type, or changing regular type claim into 2-part type.

(9) For 2-part claims, moving partial technical features that are in common with the prior art from the body portion of the claim to the preamble portion; or moving partial technical features that are distinguishable over the prior art from the preamble portion to the body portion.

(10) When the original claim expresses a structure, material, or acts of a technical feature through specific functions, i.e., using means-plus-function or steps-plus-function language to define the claim scope, changing the functional limitation to recite the structure, material, or act that has been clearly recited in the desctription corresponding to that function, with exception of the supplemented embodiments.

(11) Replacing a technical feature of the claim with a technical feature disclosed in the description (including those that are explicitly recited or literally unrecited yet subtantailly implied).

(12) Regarding claims for chemical composition inventions that originally recited in open transitional phrases, amending to recite closed transitional phrases.

4.3 Abstract

An abstract shall concisely state the disclosure of the invention, and be limited to the technical problem(s) it intends to solve, the technical solution adopted to solve the problem(s), and the principal use of the invention; in principle, the text of abstract is not to exceed 250 words; for an invention involving chemical formula, its abstract shall disclose the formula that can best characterize the inventive feature(s). In addition, an abstract may not contain any commercial advertisement wording. For an abstract failing to comply with the preceding two paragraphs, the Specific Patent Agency may notify the applicant to make an amendment within a specified time period, or notify the applicant of the amendment being made ex officio. R.21.I R.21.II R.21.III

The amendments of the abstract should not extend beyond the scope of content disclosed in the description, claims, or drawings as filed. For example, if the description already disclosed various chemical formluas, the abstract may be amended to include the chemical formula that can best

refelct the invention's charactersitcs.

4.4 Drawings

The applicant shall designate a representative drawing that can best characterize the technical feature(s) of the invention and list the primary reference sign(s) in the representative drawing accompanied by brief description(s). When the manner of disclosure for the drawings does not meet the statutory requirements or the content disclosed is insufficient, the applicant shall be notified by office action to submit a response within a specified time period. If the applicant amends the drawing, the amendments shall not extend beyond the scope of content disclosed in the description, claims, or drawing as filed. For example, the description, claims, or drawings as filed only disclose the frontal shape of a laser pen, but do not disclose the transverse cross-sectional shape of the pen tip. Because the transverse cross-section of the laser pen tip may have various shapes such as circular, arc, star, etc., causing the emitted laser light to show different patterns, however, the description, claims, or drawings as filed did not reveal these shapes. Thus, a drawings amendment that illustrates a transverse cross-sectional shape of a laser pen in arc-shape would extend beyond the scope of content disclosed in the description, claims, or drawings as filed. Another example, the claim has clearly recited the dimensions of the semiconductor components, and the description also recties the equipment used and the location at which the measurement is taken. If a person ordinarily skilled in the art recognizes that there is significant correlation between the numerical value of the dimension and the equipment used and the location at which the measurement is taken, it is allowed to add a drawing showing the equipment used and its location. R.21.IV

The exemplary amendments listed below do not extend beyond the scope of content disclosed in the description, claims, or drawings as filed:

(1) Adding into the drawings the technical feature or embodiment that had been recited in the claims or the description, but had not been disclosed in the drawings.

(2) When the prior art cited in the description as filed is allowed to be amended to be the closer prior art to the claimed invention, amending the prior art figures to the drawings of the closer prior art correspondingly.

(3) When the description as filed, without involving the invention per se, is amended to additionally recite a prior art that is known to the public before the application, adding relevant figures of the prior art to the drawings

correspondingly.

(4) When drawings are not made in compliance with engineering drawingmethods, amending the drawings to make them comply with the rules.

(5) The amended portion of the drawings is already expressed literally with clarity in the description as filed.

(6) For those that the literal expression of the description as filed lacks clarity, or for those whose text expression is insufficient to convey the content of the description, yet a person ordinarily skilled in the art can directly and unambiguously understand from the literal recitation of the description as filed, the drawings may be amended to facilitate direct understanding of each technical feature and the constituent technical means of the invention.

(7) For reference sign(s) in the drawings that is inconsistent with the description as filed or as amended, renumbering the reference sign(s).

(8) For reference sign(s) in the drawings that is inconsistent with the brief description of the drawings of the description as filed or as amended, renumbering the reference sign(s).

(9) Adding textual contents relevant to that disclosed by the drawings to the description, or deleting unnecessary wordings or annotations from the drawings.

(10) If the drawings (or photo) is too small, under the condition that the description offers clear recitation, adding enlarged view showing partial structure details or replacing old drawings with enlarged full picture in order to enhance the clarity of the drawings (or photos).

(11) Deleting corresponding figures from the drawings due to partial content deletion during the amendments of the description. However, the contents may be kept if it is difficult to delete the corresponding reduent portions from the drawings.

(12) Amending drawing lable “FIG. 1” to “1st Figure,” “Figure 1,” or “First Figure.”

(13) Rearranging the orientation of the figures.

5. Amendments that are not Permitted

5.1 Unpermitted Addition

(1) The disclosure of the description, claims, or drawings as filed has been clear and sufficient, nonetheless additional technical means that are not recited in the description, claims, or drawings as filed are added. For

example, when applying for an invention patent on the structure of a certain object, the description, claims, or drawings as filed only clearly and fully discloses the external shape of the object; yet upon amendments, descriptions for the internal structure of the object are added. For another example, the description as filed clearly and fully disclosed a chemical substance, but did not recite the preparation method for the chemical substance; yet upon amendments, the preparation method thereof was added.

(2) For content that is unclear or insufficiently disclosed in the description, claims, or drawings as filed, adding clear and fully disclosed technical contents so as to be carried out by the description, claims, or drawing as filed, yet the added technical contents cannot be derived directly and unambiguously from the description, claims, or drawings as filed by a person ordinarily skilled in the art, thus resulting in the introduction of new matter.

(3) Adding technical content of common knowledge, yet the added content is not recited in the description, claims, or drawings as filed, and cannot be derived directly and unambiguously by a person ordinarily skilled in the art from the description, claims, or drawings as filed.

For example: a portable ladder for climbing telephone poles. The ladder can be moved by twisting the ladder body. It has been modified to add a special structure of a hook member at the top thereof so that it can clamp onto or be loosened from the telephone pole when the ladder body is twisted, thereby enhancing user safety. Although the hook member belongs to common knowledge, it is not recited in the description, claims, or drawings as filed, nor is it directly and unambiguously derivable by a person ordinarily skilled in the art. Thus, adding the hook member still results in introducing new matter.

(4) Adding uses or effects that is not directly and unambiguously derivable by a person ordinarily skilled in the art from the description, claims, or drawings as filed.

For example, for an invention "an insecticidal pesticide" whose description, claims, or drawings as filed did not recite the invention’s use as a herbicide, yet the application is amended to recite “an insecticidal pesticide and herbicide.”

(5) Adding additional ingredients not mentioned in the description, claims, or drawings as filed, resulting in the introduction of special effects that were not available at the time of application as filed.

(6) Adding technical features that are values obtained through making measurement from the drawings.

(7) Adding drawings that express contents that are not disclosed in the description as filed.

5.2 Unpermitted Deletion

(1) Deleting certain contents from the description that changes the invention's subject matter, thereby extending the scope beyond that disclosed in the description, claims, or drawings as filed.
For example, for an application directed to a multi-layer laminate whose description recites embodiments of a structure having polyethylene as outer layer. The deletion of description that the outer layer is polyethylene will render the amended liminate completely different from the laminate as origally disclosed.
(2) Partially deleting the technical features of an original claim, reducing limitations, yet the deleted technical feature is clearly deemed to be essential for the claimed invention in the description, claims, or drawings as filed, thus resulting in the alterantion of the claimed subject matter, extending beyond the scope of disclosure of the description, claims, or drwingas as filed.
(3) For claims expressed in means-plus-function or step-plus-function language and those claims that can only be clearly defined by the property, function, effects, or uses, deleting the property, function, effects, or uses that have been clearly deemed essential to the claimed invention, resulting in the alteration of the claimed subject matter, extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

5.3 Unpermitted Changes

(1) Changing a generic concept invention to a specific concept invention, yet the specific concept invention is not recited in the description, claims, or drawings as filed, and is not directly and unambiguously derivable by a person ordinarily skilled in the art from the description, claims, or drawings as filed.
For example, changing the generic concept "irradiating with wave motion" recited in the description as filed to a specific concept "irradiating with low dose X-rays," yet the description, claims, or drawings as filed only recites measuring the distribution of concentrated stress in the material using a wave motion generating device without reciting "irradiating with low dose X-rays." Moreover, irradiating with wave motion may also imply other forms of irradiation besides low does X-ray, e.g., using ultrasonic scanning

microscopes. Thus, “irradiating with low does X-rays” is not a clearly defined specific matter prior to the amendment, and does not belong to those that can be directly and unambiguously derived.

(2) Changing the category of the invention, yet the different category of the invention is not recited in the description, claims, or drawings as filed, and is not directly and unambiguously derivable by a person ordinarily skilled in the art from the description, claims, or drawings as filed.

(3) Partially changing the technical feature in the description or the claims, making the amended technical content extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

For example, for a coal ash ceramsite sintering kiln equipment, the description, claims, or drawings as filed only rectied that "the kiln wall is a wall having an insulating layer between the inner and outer walls.” Upon amendment, the insultaing layer is changed to recite “high temperature steam channel.” However, a person ordinarily skilled in the art cannot directly and unambiguously understands from the description, claims, or drawings as filed that the insulating layer between the inner and the outer walls is in fact a high temperature steam channel.

For another example, for the structure of an automatic can sealing device, the description, claims, or drawings as filed only recite that “matching the eight rolling arm device with a four-layer cam device in the upper center of the turntable.” Upon amendment, the number is changed to recite “three-layer cam device” and “six rolling arm device.” Because the cam device and the rolling arm device may include a combination of different number, newly introduced matter “three-layer cam device” and “six rolling arm device” does not belong to those that are directly and unambiguously derivable by a person ordinarily skilled in the art from the description, claims, or drawings as filed.

(4) Partially replacing the technical terminology in the claims to matters that extend beyond the scope of content disclosed in the description, claims, or drawings as filed; even though the replacement belongs to prior art of the technical field to which the invention pertains, it is not a specific matter that is recited in or implied by the description, claims, or drawings as filed. Such replacement results in the change of claimed subject matter and the problem to be solved by the invention.

For example, the description, claims, or drawings as filed only recites “metal,” yet the term “metal” is replaced with “carbon filber composite” in an amendment. While the latter belongs to the prior art, but it’s not a

specific matter that is clearly recited or implied by the former. Despite the description, claims, or drawings as filed recited "metal and composite materials of comaparable strength," because composite materials of comparable strength may further include glass fiber, boron fiber, and other materials in addition to carbon fiber, "carbon fiber composite" does not belong to specific matters that is clearly recited or implied. Therefor, replacing "metal" with "carbon fiber composite" will result in the introduction of new matter.

(5) Changing a non-technological invention (i.e., those whose problem to be solved by the invention do not involve technical means in the technical field and thus fail to meet the definition of invention) into a technological invention.

(6) Amending the technical content of a disclosed invention that can not be enabled into an exploited one. For example, for an application of a hand tool invention that cannot be operated according to the contents recited in the description and drawings as filed. Amendments are introduced to change the disclosure into operable and exploitable steps, yet the content of change was not recited in the description, claims, or drawings as filed, and does not belong to those that are directly and unambiguously derivable by a person ordinarily skilled in the art from the description, claims, or drawings as filed.

(7) Introducing new matter as a result of clarifying indefinite issues.

For example, for an application of a synthetic polymer compound invention, the description as filed only recites that the polymerization reaction was carried out under a "higher temperature" condition. When the applicant learned from the office action that the cited reference has disclosed the same polymerization reaction under 50℃ condition, the applicant amended the "higher termperature condition" in the description to "higher than 50℃." Although "higher than 50℃" can be considered within the realm of "higher temperature condition," a person ordinarily skilled in the art cannot understand a higher temperature condition only implicitly limits the temperature range of "higher than 50℃." Therefore, this kind of amendments will introduce new matter.

(8) For invetnions related to chemical substance, those that were originally defined in terms of its physical or chemical properties and later obtained the chemical formula of that chemical substance, further adding the chemical formula thereof.

(9) Amending and narrowing the scope of the claims in order to distinguish over cited prior art, yet the amended claims, while not extending beyond the

scope of content disclosed in the description, claims, or drawings as filed, cannot be supported by the description as filed, or is in conflict with parts of the content of the description, claims, or drawings as filed.

6. Notes for Examination

(1) When two or more inconsistent matters are recited in the description, claims, or drawings as filed, if a person ordinarily skilled in the art can obviously understand which one is correct from the description, claims, or drawings as filed, amendments may be allowed to correct the incorrect matter. Furthermore, if there is inconsistency between the description and the drawings, amendments should be introduced to restore consistency.

(2) If the description, claims, or drawings of an application is filed in a foreign language, and a Chinese translation not extending beyond the scope of the foreign language version is submitted within the specified time period (please refer to Chapter 8, Section 2.2), the Chinese version shall be the comparing basis for the determination of introduction of new matter for subsequent amendments to the Chinese translation extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

(3) If the amendment proposed by the applicant extends beyond the scope disclosed in the description, claims, or drawings as filed, the applicant shall be notified by an office action. If the applicant's response is unfounded or no further amendment is submitted, a decision of rejection may be issued based on amendments extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

(4) When applicant merely submits amendments without providing remarks that clarify the reasoning for the amended contents or clear indication on where in the description, claims, or drawings as filed, and the examiner is unable to acertain the coorespondence between the amended contents and the description, claims, or drawings as filed, the amendments may be deemed to be extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

(5) When applicant submits multiple amendments to the description, claims, or drawings, the most recent amendment should be used to compare with the description, claims, or drawings as filed for the determination of whether or not the amendment extends beyond the scope of content disclosed in the description, claims, or drawings as filed. However, if applicant submits multiple amendment pages of different amended locations on multiple occasions, they shall be examined one by one.

(6) Matters recorded in the priority certification documents are not part of the description, claims, or drawings as filed, thus cannot serve as the comparision basis for determining whether amendments extend beyond the scope of content disclosed in the description, claims, or drawings as filed.
(7) Matters added by the applicant during amendments, such as new effects, new use, new experimental data, new embodiments of the invention, or amendments that are not directed to the description, claims, or drawings per se, but rather provide supplementary information relevant to the technical contents, may not be introduced to the description, claims, or drwings as filed to serve as the basis for claim amendments. Neither can such matters be considered the items for amendment as set forth in this Chapter. Such information may only serve as reference for examining patentability requirements.

7. Exemplary Cases

Example 1. Claim Amendments – Changing Generic Concept to Specific Concept

Description and Claim(s) before Amendment

[Title of Invention]

Oil-based solid cosmetic composition

[Claim(s)]

1. An oil-based solid cosmetic composition, which comprises main ingredients as follows: oil-soluble polymer materials, volatile oil solutions with boiling points below 280℃, and solid lubricating oils.
2. The composition as claimed in claim 1, wherein the oil-soluble polymer materials is a copolymer of ethylene monomer and long-chain alkyl groups of C8 or above.
3. The composition as claimed in claim 1, wherein the oil-soluble polymer material is selected from the group of rubber-like oil-based polymer materials consisting of polyisoprene, ethylene propylene rubber, ethylene-vinylacetate copolymer, and polybutadiene.

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

An oil-based cosmetic composition, which comprises oil-soluble polymer materials, volatile oil solutions with boiling points below 280℃, and solid lubricating oils as main ingredients, wherein the

oil-soluble polymer materials is a copolymer of ethylene monomer and long-chain alkyl groups of C8 or above, and is selected from the group of rubber-like oil-based polymer materials consisting of polyisoprene, ethylene propylene rubber, ethylene-vinylacetate copolymer, and polybutadiene.

[Conclusion]

Does not extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The matters recited in the amended claim were already recited in the claims prior to amendments. The "oil-soluble polymer" is the invention subject matter recited in claim 1 before the amendment, and “copolymer of ethylene monomer and long-chain alkyl groups of C8 or above” and “selected from the group of rubber-like oil-based polymer materials consisting of polyisoprene, ethylene propylene rubber, ethylene-vinylacetate copolymer, and polybutadiene” have been respectively recited in claim 2 and claim 3 prior to amendments, therefore no new matter is introduced by this amendment.

Example 2. Claim Amendments - Changing Generic Concept to Specific Concept

Description and Claim(s) before Amendment

[Title of Invention]

Thermoplastic resin composition

[Claim(s)]

A flame-resistant thermoplastic resin composition, comprising 100 parts by weight of thermoplastic resin and 50-200 parts by weight of phosphate.

[Description]

...The phosphate in the instant disclosure can effectively improve the flame resistance of the thermoplastic resin.... Exemplary thermoplastic resins are polyester resin and polyamide resin.

Description and Claim(s) after Amendments

[Title of Invention]

(Same)

[Claim(s)]

A flame-resistant thermoplastic resin composition, comprising 100 parts by weight of condensation thermoplastic resin and 50-200 parts by weight of phosphate.

[Description]

(Same)

[Conclusion]

Extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The amendment of the claim changes the generic concept "thermoplastic resin" to the specific concept "condensation thermoplastic resin" that was not recited in the description as filed. However, "thermoplastic" further includes additive thermoplastic resin in addition to "condensation thermoplastic resin," and the generic concept of "polyester resin and polyamide resin" further include chain thermoplastic resins, thermoplastic synthetic resins, etc. Therefore, the "condensation thermoplastic" as amended cannot be deemed directly and unambiguously derivable from the "thermoplastic" and "polyester resin and polyamide resin" rectied in the description as filed. Therefore, this amendment is deemed to have introduced new matter.

Example 3. Amendments of the Description – Changing Generic Concept to Specific Concept

Description and Claim(s) before Amendment

[Title of Invention]

Electronically controlled game console

[Claim(s)]

An electronic game console,...

[Description]

...When operating a traditional game console, the user plays the game by inserting game media (such as tokens and steel balls), and the game console can spit out the game media as prizes.

...For the game console of the instant disclosure, by inserting game media (such as tokens and others)… the embodiment is a coin-slot-operated game console that uses tokens, the game console may also use steel balls as game media.

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

(Same)

[Description]

...When operating a traditional game console, the user plays the game by inserting game media (such as tokens and steel balls), and the game console can spit out the game media as prizes.

...For the game console of the instant disclosure, by inserting game media (such as tokens and others)… the embodiment is a coin-slot-operated game console that uses tokens, the game console may also use steel balls or game cards that store cash value as game media.

[Conclusion]

Extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The term of generic concept "game media" recited in the description as filed only exemplifies tokens and steel balls. However, subdivision of the term "game media" may include meanings such as memory cards that store banknotes, token amounts, and cash values, or game cards that stores token amounts, steel ball, cash values. However, it cannot be understood or directly and unambiguously derived from the generic concept "game media" recited in the description as filed that its meaning is only limited to the specific concept of “using steel balls or using game cards that store cash values as game media” as amended.

Example 4. Claim Amendments – Change of Generic and Specific Concepts

Description and Claim(s) before Amendment

[Title of Invention]

Digestive organ medicine

[Claim(s)]

1. A digestive organ medicine composed of a cimetidine antagonist.

2. The digestive organ medicine as claimed in claim 1, consisting of a histamine H_2 receptor antagonist.

[Description]

... The medicine in accordance with the instant disclosure can exert its effect on digestive organs, and its usage is the same as that of histamine H_2 receptor antagonists.

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

A digestive organ peptic ulcer medicine composed of a cimetidine antagonist.

[Description]

(Same)

[Conclusion]

Extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The "peptic ulcer medicine" recited in the amended claim is a specific concept to the "digestive organ medicine" prior to the amendment. Because "digestive organ medication" simultaneously includes drugs that aid gastrointestinal digestion and drugs that relieve pain caused by gastrointestinal ulcers, yet the description, claims, or drawings as filed did not disclose the efficacy or use, a person ordinarily skilled in the art wouldnot be able to directly and unambiguously derive the specific concept "peptic ulcer medince" from the generic concept "digestive organ medicine."

Although the "peptic ulcer medication" recited in the amended claim is a generic concept to the "histamine H_2 receptor antagonist" prior to the amendment, other drugs such as "gastric secretion inhibitors" are also genric concept to the "histamine H2 receptor antagonists." Moreover, "gastric secretion inhibitiors" are not matters that were disclosed in the description, claims, or drawings as filed. Therefore, a person ordinarily skilled in the art would not be able to directly and unambiguously derive the specific concept "histamine H2 receptor antagonists" from the generic concept "peptic ulcer medication."

Example 5. Amendments of the Description – Changing Specific Concept to Generic Concept

Description and Claim(s) before Amendment

[Title of Invention]

Coil spring support

[Claim(s)]

A coil spring support,….

[Description]

…, a support member of coil spring….

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

(Same)

[Description]

…, a support member of elastic elements including coil spring….

[Conclusion]

Extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

Although the claim(s) and drawings have not changed before and after the amendment, the "coil spring support" (specific concept) recited in the description as filed has been changed to “support member of elastic elements including coil springs" (generic concept) after the amendment, which is an amendment that changes an invention of specific concept to an invention of generic concept. Although the content of the claim(s) and drawings are still limited to the specific coil spring support, the content of the invention is broadened from the coil spring support member as oringally disclosed to every conceivable elastic supporting member, thus may be deemed to have introduced new matter.

Example 6. Amendment of 2-Part Claims

Description and Claim(s) before Amendment

[Title of Invention]

◯◯ device

[Claim(s)]

A ◯◯ device, comprising A, B, and C,

wherein,

A is… (specific description of element A’s contents and connection relationship), the improvement comprising:

B is… (specific description of element B’s contents and connection relationship); and

C is… (specific description of element C’s contents and connection relationship).

[Description]

… (specific description of elements A, B, and C’s contents and connection relationship), ….

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

A ◯◯ device, comprising A, B, and C,

wherein,

A is… (specific description of element A's contents and connection relationship);

B is… (specific description of element B's contents and connection relationship), the improvement comprising:

C is… (specific description of element C's contents and connection relationship).

[Description]

(Same)

[Conclusion]

Does not extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The amended claim moves a feature originally recited in the body portion to the preamble portion, thus the amendment does not introduce new matter.

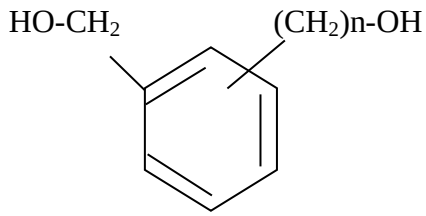
Example 7. Change of Numerical Value Limitations – Amendments of Markush Type Claims

Description and Claim(s) before Amendment

[Title of Invention]

Fluorobenzyl alcohol

[Claim(s)]



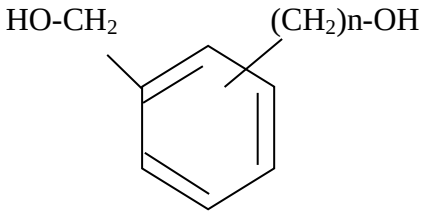
… wherein n is an integer from 2 to 5.

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]



… wherein n is an integer from 3 to 5.

[Conclusion]

Does not extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

While the literal expression of “n is an integer from 2 to 5” differs from “n is 2, 3, 4, or 5,” they convey idtentical meanings. Similarly, “n is an integer from 3 to 5” and “n is 3, 4, or 5” carry the same meaning. In this example, amending the recitation of “n is 2, 3, 4, or 5” to “n is 3, 4, or 5” is only a partial deletion of multiple options. The matter after deletion can be deemed to have been recited in the description before amendments. Therefore, changing “n is an integer from 2 to 5” to “n is an integer from 3 to 5” does not introduce new matter.

Example 8. Change of Numerical Value Limitaitons – Amendments of the Claim(s)

Description and Claim(s) before Amendment

[Title of Invention]

Hollow micro body

[Claim(s)]

A hollow and extremely tiny glass sphere, comprising substantially regular diameter of 200 to 10000 μm and substantially regular thickness of 0.1 to 1000 μm.

[Description]

…The extremely tiny glass spheres may have different diameters and thicknesses depending on the final needs. The diameter may be 200 to 10000 μm, and preferably 500 to 6000 μm; the thickness may be 0.1 to 1000 μm, and preferably 0.5 to 400 μm.

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

A hollow and extremely tiny glass sphere, comprising substantially regular diameter of 500 to 6000 μm and substantially regular thickness of 0.5 to 400 μm.

[Description]

(Same)

[Conclusion]

Does not extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The numerical range of the diameter and thickness of the hollow micro glass sphere as originally claimed were amended to the "preferred range" that had been clearly recited in the description as originally filed. Because the numerical ranges as amended are consistent with what was originally recited in the description before amendment, no new matter is introduced.

Example 9. Change of Numerical Value Limitaitons – Amendments of the Claim(s)

Description and Claim(s) before Amendment

[Title of Invention]

Stabilized resorein compounding agent

[Claim(s)]

A stabilized resorcinol compounding agent, comprising a resorcinol mixture formed by adding 0.001 to 2 wt% lactic acid to a viscous mineral as a base.

[Description]

...As a lactic acid mixture, a value of 0.05 to 2wt% is expected. (The values of 0.1wt % and 1wt % are not recited)

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

A stabilized resorcinol compounding agent, comprising a resorcinol mixture formed by adding 0. 1 to 1 wt% lactic acid to a viscous mineral as a base.

[Description]

(Same)

[Conclusion]

Extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

Neither 0.1wt% nor 1wt% was recited in the description, claims, or drawings before the amendment, and the numerical range of "0.1 – 1wt%" was not originally specified. Since the numerical limitation of 0.1 to 1wt% cannot be directly and unambiguously known from the matters disclosed in the description, claims, or drawings before the amendment, the amendment introduces new matters.

Example 10. Change of Numerical Value Limitaitons – Amendments of the Claim(s)

Description and Claim(s) before Amendment

[Title of Invention]

Pressure sensitive adhesive composition

[Claim(s)]

A pressure sensitive adhesive composition, comrpsing a cross-linkable acrylic polymer; a multi-functional cross-linking agent; and a multi-functional acrylate.

[Description]

...The pressure sensitive adhesive composition a as described in Enbodiment 1 has a viscosity of 3,500 cP measured at room temperature; the pressure sensitive adhesive composition b as described in Enbodiment 2 has a viscosity of 10,000 cP measured at room temperature.

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

A pressure sensitive adhesive composition, comrpsing a cross-linkable acrylic polymer; a multi-functional cross-linking agent; and a multi-functional acrylate, wherein a viscosity thereof is 3,500cP – 10,000cP measured at room temperature.

[Description]

(Same)

[Conclusion]

Extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

Although the pre-amended description, claims, or drawings rectied two embodiments of adhesive compositions having viscosities of 3,500cP and 10,000CP, respectively, the viscosity range of the adhesive composition was not disclosed. Since the numerical range limitation of 3,500cP to 10,000cP cannot be directly and unambiguously known from the matters disclosed in the description, claims, or drawings before the amendment, the amendment introduces new matters.

Example 11. Change of Numerical Value Limitaitons – Amendments of the Claim(s)

Description and Claim(s) before Amendment

[Title of Invention]

Pressure sensitive adhesive composition

[Claim(s)]

A pressure sensitive adhesive composition, comrpsing a cross-linkable acrylic polymer; a multi-functional cross-linking agent; and a multi-functional acrylate, wherein a viscosity thereof is 3,500cP – 10,000cP measured at room temperature.

[Description]

...the viscosity range of the recited pressure sensitive adhesive composition measured at room temperature is 3,500cP to 10,000cP; there are other embodiments reciting a viscosity of the pressure sensitive adhesive composition measured at room temperature being 12,000cP.

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

A pressure sensitive adhesive composition, comrpsing a cross-linkable acrylic polymer; a multi-functional cross-linking agent; and a multi-functional acrylate, wherein a viscosity thereof is 3,500cP – 12,000cP measured at room temperature.

[Description]

(Same)

[Conclusion]

Extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The description, claims, or drawings before amendment recites that a viscosity range of the adhesive composition measured at room temperature is 3,500cP to 10,000cP, as well as reciting embodiments where a viscosity of the adhesive composition is 12,000cP measured at room temperature. However, the numerical range of 10,000cP to 12,000cP is not included in the numerical range disclosed in the description, claims, or drawings as filed, and such numerical range cannot be derived directly and unambiguously from the matters disclosed in the description, claims, or drawings before amendment. Therefore, amending the viscosity range of 3,500cP to 10,000cP with 3,500cP to 12,000cP will result in introduction of new matter.

Exmaple 12. Changing Structures thus Increase Efficacy – Amendments to the Claims and the Description

Description and Claim(s) before Amendment

[Title of Invention]

Pinball counting device

[Claim(s)]

A pinball counting device, comprising: an inserted element, wherein through each pulling action of the element, the element enables a pinball in a cylindrical channel to fall through a hole arranged at a middle section having a diameter slightly larger than that of the pinball, thereby enabling calculation of a frequency of pulling action of the element.

[Description]

...In the present invention, the pinball passes through a cylindrical channel, the cylindarical channel is provided with a small hole at a middle section. The small hole as a diameter slightly greater than the diameter of the pinball, and is blocked by a movable element. When each pinball passes through the small hole, a downward pulling action on the element will cause the pinball to fall ino the small hole. Accordingly, accurate counting may be achieved.

In the embodiment, since the top of the element being pulled down is formed with a slope, the pinball would not be scratched easily.

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

A pinball counting device, comprising: an inserted element, <u>wherein a top portion of the element that contacts a pinball is formed with a slope,</u>

wherein through each pulling action of the element, the element enables a pinball in a cylindrical channel to fall through a hole arranged at a middle section having a diameter slightly larger than that of the pinball, thereby enabling calculation of a frequency of pulling action of the element.

[Description]

...In the present invention, the pinball passes through a cylindrical channel, the cylindarical channel is provided with a small hole at a middle section. The small hole as a diameter slightly greater than the diameter of the pinball, and is blocked by a movable element. When each pinball passes through the small hole, a downward pulling action on the element will cause the pinball to fall ino the small hole. Accordingly, accurate counting may be achieved. Since the top of the element being pulled down is formed with a slope, the pinball would not be scratched easily.

[Conclusion]

Does not extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The amendment is to include matters recited in the embodiment of the description as filed into the claim as the claimed invention. In addition, although there are adjustments to the effects of the invention described in the embodiment upon amendments, they have been recited in the description before the amendment, therefore such amendments do not introduce new matter.

Example 13. Adding Efficacy – Amendment to the Description

Description and Claim(s) before Amendment

[Title of invention]

Car windshield with antenna

[Claim(s)]

A car windshield with antenna, comprising: a transparent conductive film having functions of an antenna, covering an entire windshield surface and being connected to a power supply of car radio and antenna booster.

[Description]

...As mentioned above, the transparent conductive film has the dual functions of antenna and heater.

Description and Claim(s) after Amendment

[Title of invention]

(Same)

[Claim(s)]

(Same)

[Description]

...As mentioned above, the transparent conductive film has the functions of antenna, heater, and heat insulator.

[Conclusion]

Extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The amended description adds that the transparent conductive sheet also has heat-insulating effect. However, even if the transparent conductive film is known to possess heat-insulating effect, this feature is not disclosed in the pre-amended description, claims, or drawings. Therefore, the added matter cannot be considered to be directly and unambiguously derivable from the description, claims, or drawings before amendment. The amendment therefore introduces new matter.

Example 14. Adding Structures and Efficacy – Amendment to the Description

Description and Claim(s) before Amendment

[Title of Invention]

Thermal welding method

[Claim(s)]

A thermal welding method, comprising: arranging a protruding surface having a conical hole on a thermoplastic resin substrate; embedding a stop plate in the protruding surface portion; and pressing the stop plate into the heating frame of the protruding surface portion of the conical hole, thereby establishing press-joining.

[Description]

...Because the present invention possesses the aforementioned technical contents, the protruding surface portion of the conical hole of the thermoplastic resin substrate may be softened and crimped to fix the stop plate, so that the stop plate on the thermoplastic resin substrate can be firmly fixed.

[Figures]

... (The protruding surface portion of the heating frame is shown to have a ring-shaped portion)

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

(Same)

[Description]

...Because the present invention possesses the aforementioned technical contents, the protruding surface portion of the conical hole of the thermoplastic resin substrate may be softened and crimped to fix the stop plate, so that the stop plate on the thermoplastic resin substrate can be firmly fixed. In addition, due to the arrangement of an annular portion around the circumference of the protruding portion of the heating frame, the pressing of the heating frame may achieve a uniform deformation effect of the protrusions.

[Figures]

(Same)

[Conclusion]

Does not extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The amended description adds recitation of the structure and function of the annular portion of the heating frame, which can produce special effects not disclosed in the description as filed. Although the description as filed did not literally recite the function of the annular portion, the heating frame in the original drawing are shown to possess the annular portion, so that a person ordinarily skilled in the art can directly and unambiguously understand the structure and functions from the drawings. Therefore, there is no introduction of new matter.

Example 15. Adding Structure – Amendment to the Claim

Description and Claim(s) before Amendment

[Title of Invention]

Pile driving and pile extracting machine

[Claim(s)]

A pile driving and extracting machine, comprising a main body that clamps previously driven piles and continuously drives new piles to form a pile line, and a guiding plate coupled to the main body and having a guiding surface placed in a direction aligned to the direction of the pile line, so as to guide new piles to be driven along the guiding surface.

[Description]

...The main body of the pile driving and pile extracting machine includes clamps for clamping piles that have been driven into position, and a pressing plate for driving a new steel pile. In addition, the main body is provided with a guiding plate for guiding the driving of new piles, where one side of the guiding plate is a guiding surface, which is arranged in a same direction as that of a predetermined pile line, and the new piles are driven along the guiding surface into the soil. A laser vibrometer is installed at the front end of the guiding plate. The laser vibrometer can emit laser light. The numerical value is marked on the predetermined pile line, and a target is arranged at the end of the pile line to receive laser light like a camera.

In the instant case, the guiding plate is positioned on the main body so that laser light emitted by the laser vibrometer can illuminate the target. The guiding plate is aligned to the pile line so that the guiding surface can guide the pile driving.

...The laser light emitted from the laser vibrometer moves in a straight line, and the utilization of such characteristics allows the driven piles to be easily and accurately maintained in the correct direction of the pile line through the fixed guide plate...

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

A pile driving and extracting machine, comprising a main body that clamps previously driven piles and continuously drives new piles to form a pile line, and a guiding plate coupled to the main body <u>for guiding new pile driving, and with a laser vibrometer installed on the guiding plate, which is characterized in that a coupling location of the guiding plate and the main body is selectable to enable laser illumination of a target defined at an end of the pile line</u>.

[Description]

(Same)

[Conclusion]

Does not extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The description before amendment recites "the laser light emitted from the laser vibrometer moves in a straight line, and the utilization of such

characteristics allows the driven piles to be easily and accurately maintained in the correct direction of the pile line through the fixed guide plate." This description allows a person ordinarily skilled in the art to understand this function by comparing the (amended) laser vibrometer installed on the guiding plate (regardless of the location of installation). Therefore, it can be considered that both the amended claims and the pre-amneded description have considered "a laser vibrometer is installed at the front end of the guiding plate."

In addition, since the pre-amended description can be regarded to recite "a laser vibrator installed on the guiding plate," the subject matter rectied in the amended claim belongs to that had already disclosed in the pre-amended description, thus the amendment does not introduce new matter.

Example 16. Adding Structures – Amendment to the Description

Description before Amendment

[Title of Invention]

Paper delivery device

[Description]

..., the paper can be grabbed and transported between the roller on the shaft and the guiding member opposite to the roller. The paper is sent from the outer periphery of the axial roller to the inside through the guiding member to form a wavy and stretched state.

[Drawings]

... (Illustraging the rollers and guiding members are arranged interleavingly in the axial direction)

Description after Amendment

[Title of Invention]

(Same)

[Description]

..., the paper can be grabbed and transported between the roller on the shaft and the guiding member opposite to the roller. The paper is sent, via rollers and guiding members that are arranged interleavingly in the axial direction, from the outer periphery of the axial roller to the inside through the guiding member to form a wavy and stretched state.

[Drawings]

(Same)

[Conclusion]

Does not extend beyond the scope of content disclosed in the

description, claims, or drawings as filed.

[Remark]

The added recitation in the amended description "via rollers and guiding members that are arranged interleavingly in the axial direction" can be derived directly and unambiguously from the pre-amended drawing that dislcoses "the rollers and guiding members are arranged interleavingly in the axial direction" and the description that states "the paper is sent from the outer periphery of the axial roller to the inside through the guiding member to form a wavy… state." Therefore, there is no introduction of new matter.

Example 17. Adding Structures – Amendments to the Claim(s) and the Description

Description and Claim(s) before Amendment

[Title of invention]

Automatic flashing switch device

[Claim(s)]

An automatic flashing switch device, comprising: using a relay to drive a contact piece, in order to turn on/off a light bulb circuit, and through a delayed photoconductive element to receive part of the light from the light bulb to control the relay.

[Description]

... (Es) is a DC power supply, and different flashing switches pass through a dual metal plate switching valve, which does not require mechanical contact, so it is less likely to cause errors. And, by changing the reaction properties of the photoconductive element or the relay, the time interval of the flashing can be changed...

Description and Claim(s) after Amendment

[Title of invention]

(Same)

[Claim(s)]

An automatic flashing switch device, comprising: using a relay <u>parallel with a variable capacitor</u> to drive a contact piece, in order to turn on/off a light bulb circuit, through a delayed photoconductive element to receive part of the light from the light bulb to control the relay.

[Description]

... (Es) is a DC power supply, and different flashing switches passing through a dual metal plate switching valve, which does not require mechanical contact, so it is less likely to cause errors. And, by changing

the reaction properties of the photoconductive element or the relay, the time interval of the flashing can be changed.... In addition, when a variable capacitor is paralleled with the relay, it (the flashing time interval) can be easily adjusted by controlling the capacitance.

[Conclusion]

Extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The amended description adds "when a variable capacitor is paralleled with the relay, it (the flashing time interval) can be easily adjusted by controlling the capacitance." Although a person ordinarily skilled in the art may know that, in order to change the time interval of the flashing, the conventional effect of easy adjustment may be obtained by parallel connecting the variable capacitor and the relay to change its reaction properties, however, because the description, claims, or drawings as filed did not disclose parallel connection with a variable capacitor, the amendment will introduce new matter.

Example 18. Changing Structures – Amendment to the Claim(s) and Description

Description and Claim(s) before Amendment

[Title of Invention]

Buffer

[Claim(s)]

A buffer, comprising: a curved protrusion made of buffer material composed of artificial resin to form a predetermined shape, and a device capable of retaining the curved shape, so as to maintain the predetermined shape of the buffer.

[Description]

...The curved portion of the curved protrusion is made of soft artificial resin, and its shape is maintained by a device that can retain the curved shape.

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

A buffer, comprising: a curved protrusion made of buffer material composed of artificial resin to form a predetermined shape, and an adhesive

tape applied at the curved portion.

[Description]

...The curved portion of the curved protrusion is made of soft artificial resin, and an adhesive tape applied at the curved portion.

[Conclusion]

Extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The amended description and claim limit the device for retaining the curved shape to the "adhesive tape," but did not point out the specific device used for maintaining its curved shape. Although adhesive tape is a well-known technology that can be used to retain shapes, it is not the only means for fixing shapes. Because "adhesive tape" cannot be directly and unambiguously derived from the "device that can retain the curved shape" as disclosed by the description, claims, or drawing as filed, the amendment will introduce new matter.

Example 19. Reducing Steps – Amendment to the Claim(s)

Description and Claim(s) before Amendment

[Title of Invention]

Preparation method of steroids

[Claim(s)]

A preparation method of delta-methyl-and-rosterone-4-ethoxy-17β-ol-3-one, which is based on the reaction of delta-methyl-and-rosterone-17β-ol-3-one and lead tetraacetate, and subsequently produced by acid or alkali treatment.

[Description]

….

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

A preparation method of delta-methyl-and-rosterone-4-ethoxy-17β-ol-3-one, which is based on the reaction of delta-methyl-and-rosterone-17β-ol-3-one and lead tetraacetate.

[Description]

(Same)

[Conclusion]

Does not extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The pre-amended claim recites a method that includes a first and a second step. After amendment, the method only recites the first step. Since the first step had already been recited in the pre-amended description, the amendment does not introduce new matter.

Example 20. Expanding Use – Amendments to the Title of Invention, Claim(s), and the Description

Description and Claim(s) before Amendment

[Title of Invention]

Rotary shaft seal for pumps

[Claim(s)]

A rotary shaft seal for a pump, ...

[Desicription] 〔manual〕

…a rotary shaft seal for a pump,….

Description and Claim(s) after Amendment

[Title of Invention]

Rotary shaft seal

[Scope of patent application]

A rotary shaft seal, ….

[Description]

...a rotary shaft seal that can be universally applied in fluidic machinery...

[Conclusion]

Extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The pre-amended claim recites "rotary shaft seal for pumps..." (invention of specific purpose), yet the amended claim recites "rotary shaft seal...," and the amended description states that the rotary shaft seal can be universially applied in fluidic machinery (inention adoptable for other uses).

The description, claims, or drawings before amendment only disclosed a single specific purpose. Thus, amending the rotary shaft seal dedicated to pumps (invention of specific purpose) to a rotary shaft seal suitable for other purposes (invention adoptable for other purposes) leads to the introduction of new matter.

Example 21. Changing Embodiments – Amendment to the Description

Description and Claim(s) before Amendment

[Title of Invention]

Multilayer laminate

[Claim(s)]

A multi-layer laminate, ….

[Description]

….

(Does not recite polypropylene-related technical contents)

Emobodiment

...The material of the outer layer material of the multi-layer laminate is polyethylene, ...

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

(Same)

[Description]

….

Emobodiment

...The material of the outer layer material of the multi-layer laminate is polypropylene, ...

[Conclusion]

Extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The pre-amended description recites that the outer layer material of the multi-layer laminate was polyethylene. After amendment, it was changed to recite polypropylene. However, the outer layer material of the laminate after amendment is completely different from the outer layer material of the laminate disclosed in the description as filed, thus leads to introduction of new matter in the description.

Example 22. Adding Embodiments – Amendment to the Description

Description and Claim(s) before Amendment

[Title of Invention]

Multilayer laminate

[Claim(s)]

A multi-layer laminate, ….

[Description]

….

Emobodiment

...The material of the outer layer of the multi-layer laminate is polyethylene, ...

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

(Same)

[Description]

….

Emobodiment 1

...The material of the outer layer of the multi-layer laminate is polyethylene, ...

Embodiment 2

...or the outer layer is unnecessary….

[Conclusion]

Extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The pre-amended description recites the outer layer of the multi-layer laminate is polyethylene, yet the amended description adds an embodiment in which the outer layer is not needed. The outer layer of the laminate as amended differs from that disclosed in the description as filed, thus leading to introduction of new matter.

Example 23. Adding Emobodiments – Amendment to the Description

Description and Claim(s) before Amendment

[Title of Invention]

Computer device

[Claim(s)]

A computer device, comprising: a signal distributor arranged between a host computer and a keyboard via an RS232C interface cable, and connecting other input/output (I/O) devices to the signal distributor.

[Description]

...A signal distributor is arranged between the host computer and the keyboard, and is connected to each other through a RS232C interface cable. Another input/output (I/O) device such as printer can be connected to the signal distributor, so that a PC device with only one port can connect a keyboard and a printer simultaneously.

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

(Same)

[Description]

...A signal distributor is arranged between the host computer and the keyboard, and is connected to each other through a RS232C interface cable. Another input/output (I/O) device such as printer can be connected to the signal distributor, so that a PC device with only one port can connect a keyboard and a printer simultaneously.

In addition, a mouse can be connected to the signal distributor and the printer via an RS232C interface cable for easy operation. In this way, the mouse can be used to operate the personal computer host without making any changes.

[Conclusion]

Extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The description as filed only recites “aother input/output (I/O) devices such as printers can be connected to the signal distributor." Besides for the printer and mouse devicees, the use of the term "input/output (I/O) device" may also include picture tube display (CRT), floppy disk device (FDD), and other similar terms. Therefore, it cannot be directly and unambiguously known from the description, claims, or drawings as filed that "aother input/output (I/O) device" refers specifically to a “mouse.”

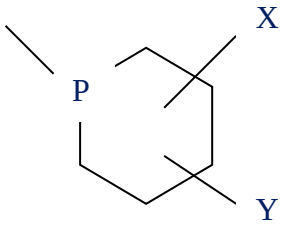
Example 24. Adding Embodiments – Amendment to the Description

Description and Claim(s) before Amendment

[Title of Invention]

Phosphine derivatives

[Claim(s)]

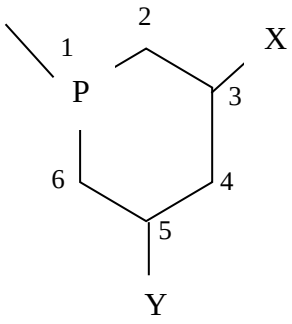


X = alkyl or alkenyl

Y = phynyl or alkoxy

[Description]

… preferably:



Description and Claim(s) after Amendment

[Title of Invention]

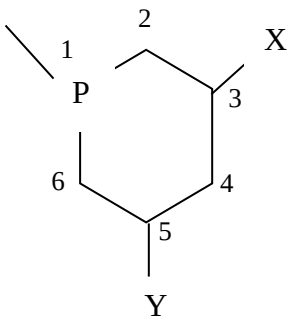
(Same)

[Claim(s)]

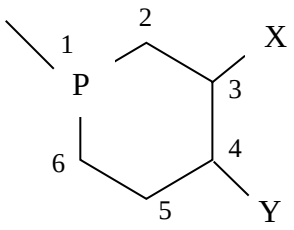
(Same)

[Description]

… preferably…



or



[Conclusion]

Extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

The pre-amended description only specifically describes phosphine derivatives of 3-X and 5-Y, but did not describe 3-X and 4-Y. The matters recited in the pre-amended claim did not clearly indicate the substitution position but merely pointed out unspecified positions, which include 13 possibilities for the X and Y position combination. Because the substitution of 3-X and 4-Y positions cannot be directly and unambiguously known from the original contents as filed, the amendment introduces new matter.

Example 25. Adding Operational Functions – Amendment to the Description

Description and Claim(s) before Amendment

[Title of Invention]

Oscillating polishing tool

[Description]

An oscillating polishing tool... a component capapble of causing oscillation of the polishing instrument is arranged above the rear portion of the main body. The component is rotatble by ejecting compressed air from its onboard nozzle. As the component rotates, its center of gravity changes due to a position shift of a rotation center point, causing the polishing part located at the front end of the main body into a swing movement.

[Drawings]

... (Shows the nozzle of the oscillating component above the rear poration of the main body toward the frontal direction)

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Description]

An oscillating polishing tool... a component capable of causing

oscillation of the polishing instrument is arranged above the rear portion of the main body. The component is rotatable by ejecting compressed air from its onboard nozzle. As the component rotates, its center of gravity changes due to a position shift of a rotation center point, causing the polishing part located at the front end of the main body into a swing movement. In addition, during operating of the tool, compressed air is sprayed from the nozzle to the polishing part, which is enough to remove dust generated from the polishing part.

[Drawings]

(Same)

[Conclusion]

Extending beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

One may see from the drawings prior to the amendment that the nozzle is arranged toward the same direction as the polishging part, thus it may seem that the ejected compressed air may have the effect of dust removal. However, the nozzle is located above the rear poration of the main body, and the ejected compressed air cannot practically reach the front end dead corner of the polishging part of the main body. Therefore, it cannot be concluded that the operation "…which is enough to remove dust generated from the polishing part…" added after the amendment is directly and unambiguously derivable from the description, claims, or drawings before amendment.

Example 26. Amendment through Disclaimer – Amendment to the Claim(s)

Description and Claim(s) before Amendment

[Title of Invention]

Photosensitive lithographic printing plate

[Claim(s)]

A photosensitive lithographic printing plate having a photosensitive layer, comprising partially saponified polyethyl acetate with a saponification value of 60 to 80 molar percentage, and more than one photopolymerizable monomer combined with ethylenically unsaturated combinations, the photosensitive layer containing 1 to 100 weight percent nitrogen-containing heterocyclic carboxylic acid relative to the partially saponified polyethyl acetate.

[Description]

...The nitrogen-containing heterocyclic carboxylic acids used in the present invention include 2-picolinic acid, 4-picolinic acid and their analogs...

(Prior art reference that describes "3-pyridinecarboxylic acid" as the "nitrogen-containing heterocyclic carboxylic acid" had been found.)

Description and Claim(s) after Amendment

[Title of Invention]

(Same)

[Claim(s)]

A photosensitive lithographic printing plate having a photosensitive layer, comprising partially saponified polyethyl acetate with a saponification value of 60 to 80 molar percentage, and more than one photopolymerizable monomer combined with ethylenically unsaturated combinations, the photosensitive layer containing 1 to 100 weight percent nitrogen-containing heterocyclic carboxylic acid relative to the partially saponified polyethyl acetate (excluding 3-pyridinecarboxylic acid).

[Description]

(Same)

[Conclusion]

Does not extend beyond the scope of content disclosed in the description, claims, or drawings as filed.

[Remark]

Since 3-picolinic acid recited in the prior art reference reads on the nitrogen-containing heterocyclic carboxylic acid recited in the claim, yet the technical feature of 3-pyridinecarboxylic acid is not recited in the claim, one cannot directly delete 3-pyridinecarboxylic acid from the claim. Thus, amending the claim to recite “nitrogen-containing heterocyclic carboxylic acid… (excluding 3-pyridinecarboxylic acid)” through disclaiming of prior art disclosed subject matter is in compliance with the “amendment through disclaimer” as set forth in section 4.2.2(7) of this Chapter.

Although the matter recited in the amended claim is not a matter that can be directly and unambiguously known from the description as filed, it will be deemed as an exception that no new matter has been introduced.