

Recent Changes in the Handling of “Disclaimer Claims” in Japan

— Impact on Addition of New Matter, Inventive Step, Clarity, Prior User’s Rights, etc. —

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1. INTRODUCTION

In Japan, there is a sign of significant changes in the handling of “disclaimer claims” in patent practice.

Generally, in patent practice in Japan, a “disclaimer claim” refers to a claim that excludes (disclaims) only certain subject matter otherwise encompassed by the claim, from the other subject matter recited in that claim, while retaining the original wording used to define the claimed invention. Typically, this is done by amending the claim to exclude certain subject matter, such as certain embodiments, compounds, compositions, numeric ranges or uses recited in a prior art document that have been cited in the reasons for refusal, opposition or invalidation trial. Typically, such an amendment uses the format of “excluding . . . ”¹.

While this type of claim is comparable with analogous claims, such as the “disclaimer claim” in European patent practice and claims containing negative limitations in the U.S. patent practice, the handling of disclaimer claims in Japan has been considerably more

friendly to rights holders as compared with the practices in major countries and regions. In particular, it has been understood that, even for the matters not explicitly recited in the original application as filed, it is possible to exclude these matters from the claims, as long as they are assessed as not introducing any new technical matter beyond the technical matters recited in the original description, drawings, and claims (hereinafter the “Description”) as filed.

As a result, in Japan, especially in the fields of chemistry, pharmaceuticals, food, and materials, disclaimer claims have been widely used as a means for excluding overlaps between broad-scope claims and the prior art². For example, with regard to Markush-type claims and/or composition claims covering a broad scope, there has been a practice of “list-and-exclusion” of the cited compounds, compositions, and examples specifically recited in the prior art documents, so as to circumvent reasons for refusal on the ground of lack of novelty, and furthermore, to assert inventive step for the residual scope of invention remaining after such exclusion.

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However, such practices have long been thought to have not a few problems. In fact, these problems extend to a variety of issues, which will be discussed in detail afterwards, and among these problems, a particular concern is that the grounds for invalidation based on clear lack of novelty or inventive step can be circumvented very easily. In other words, even in cases where it appears to be impossible to circumvent the ground for invalidation by ordinary amendment based on the matters recited in the original Description, by simply “disclaiming” such unfavorable matters described in the cited document, it is possible to overcome not only the lack of novelty, but also the lack of inventive step, and consequently, to maintain the patent.

In another particular example, there are some cases in which a claim individually identifies specific embodiments or the like that are recited in a prior art document, and exhaustively excludes this subject matter from the claim (sometimes more than 10 prior art embodiments), which eventually causes the remaining scope of the claimed invention to seemingly take on a worn-eaten state. Furthermore, in some extreme cases, with regard to an invention involving a numerical range, a claim recites pinpointed exclusions of specific numerical values corresponding to those cited in the prior art documents (for example, with regard to an invention comprising a claimed element of “ $B/A = 0.1 - 3$,” while retaining this wording, the claim further recites “except for cases where $B/A = 0.23, 0.74, \text{ and } 1.56$ ”). The aspect common to these claims is that, by excluding extremely limited and pinpointed examples recited in the prior art, it is possible to maintain the patent

substantially without any damage to the scope of rights. However, because of this handling practice, when third parties simply refer to the Patent Gazette or the Description of that patent, it becomes substantively difficult to predict the validity of or protected scope for working the patent.

In these circumstances, on April 3, 2025, the Examination Guidelines Section, Coordination Division of the JPO published a notification titled “Amendment in the Format of ‘Disclaimer Claims’” (hereinafter, also referred to as the “Notification”) (Note that the Notification has been updated several times after publication dated April 3, 2025, and the latest update of this webpage was dated March 30, 2026). Subsequently, the Working Group under the Examination Guidelines Expert Committee was launched³ for the revision of the Examination Guidelines related to “Amendment in the Format of ‘Disclaimer Claims’,” and the draft revision of the Examination Guidelines was published on April 8, 2026⁴ (the Draft Revision regarding Addition of New Matters related to a Disclaimer mentioned in “Part IV, Chapter 2, 3.3.1 (4);” hereinafter referred to as the “Examination Guidelines Draft Revision”). Public comments on this Draft were solicited until May 7, 2026, and by considering the feedback from the public comments, it was announced that a formal revision of the Examination Guidelines would become effective before long, and the revised Examination Guidelines⁵ were published on June 25, 2026. It is relatively rare that the Notification was published and changes in the handling of examination practice were announced prior to the formal revision of the Examination Guidelines, and this may

be understood to reflect the significant concern about recent handling of disclaimer claims.

The Notification is expected to have a significant impact because it explicitly states that disclaimer claims will no longer be handled as merely a convenient means for circumventing lack of novelty, and instead will require careful consideration in relation to inventive step, addition of new matter, clarity, and furthermore, interpretation of the technical scope of the patented invention⁶.

The details of the Notification will be discussed later, but in summary, it is clarified that, while admitting some cases where lack of novelty may be overcome by means of disclaimer claim, this kind of amendment does not automatically lead to overcoming of lack of inventive step. Consequently, with regard to an invention that is not significantly different from the cited invention in terms of technical concept, even if any matter overlapping with the cited invention is excluded, the invention may still be found to lack inventive step⁷.

Based on the above issues, this article will discuss changes in the handling of disclaimer claims in Japan, with the aim of introducing what is happening in this area to international readers. First, as the legal background for disclaimer claims in Japan, the authors will provide outlines of the judgment in *Solder Resist* case by the Grand Panel of the Intellectual Property High Court (the “IP High Court”), and the subsequent developments in the Examination Guidelines. Next, the authors will discuss the reasons why Japan’s conventional practice has created problems, from the perspectives of addition of new matter, inventive step, clarity, predictability by third parties, prior

user’s right, and international harmonization. Based on these aspects, the authors will then analyze the Notification and subsequent trends in the revision of the Examination Guidelines, and summarize recent case law and changes in examination practice. Finally, the authors will discuss how applicants, patent owners, and third parties should handle disclaimer claims from now on.

2. LEGAL BACKGROUND FOR DISCLAIMER CLAIMS IN JAPAN

To understand the handling of disclaimer claims in Japan, it will be necessary to consider the judgment in the *Solder Resist* case, handed down by the Grand Panel of the IP High Court.

Prior to this judgment, the practice regarding disclaimer claims tended to be used as a sort of exceptional treatment. This understanding may be explained that, with regard to an invention significantly different from publicly known technology or technical concept, and inherently satisfying inventive step, if that invention incidentally includes a matter overlapping with the publicly known technology, it was permitted to make an exception -- to exclude that overlapping matter from the claim of the invention. According to this understanding, for disclaimer claims to be permissible, it is at least necessary that the subject of exclusion is the matter overlapping with that of the prior art, and that the invention itself before exclusion is significantly different from the prior art in terms of the technical concept⁸.

In contrast, the judgment in *Solder Resist* case reframed the handling of disclaimer claims, not as an “exceptional” treatment, but as a problem of addition of

new matter in general, i.e. whether or not the amendment or correction is within the scope of matters recited in the original description or drawings as filed. According to this judgment, “matters recited in the Description” are technical matters derived from a comprehensive interpretation of the Description by persons skilled in the art, and if an amendment or correction does not introduce any new technical matter in addition to the technical matters derived in the above manner, it can be deemed that such an amendment or correction was done “within the scope of matters recited in the Description⁹.”

After this ruling, even for disclaimer claims, the mere fact that the subject matter of the amendment was not directly recited in the original Description as filed, does not instantly lead to the addition of new matter, and instead, the permissibility is to be assessed on the basis of whether or not they introduce any new technical matter in addition to the technical matter derived from the original Description. This change significantly broadened the permissible scope of disclaimer claims, and had a major impact on the subsequent patent practice in Japan.

Thereafter, the Examination Guidelines followed the rationale of judgment in the *Solder Resist* case, and clarified that, with regard to the amendment in the format of “disclaimer claims,” if an exclusion of a specific matter, falling under the content of the cited invention, is not deemed as causing any modification in the technical matters derived from the Description before that amendment, it will be treated as not introducing any new technical matter. However, the Examination Guidelines also clarify that, inventions eligible to be patented by means of

“disclaimer claim” are those significantly different from the cited invention in terms of technical concept and inherently satisfying the inventive step requirement, but incidentally including matters overlapping with matters described in the cited invention. Thus, at least in principle, disclaimer claims are regarded as a limited means for excluding incidental overlapping with the cited invention.

The judgment in *Solder Resist* case was related to Article 29*bis* of the Patent Act and did not involve an assessment of inventive step. Furthermore, the Examination Guidelines also prescribe two types of “disclaimer claims” that do not introduce new technical matter after exclusion, namely, “(i) in cases where novelty, etc. (Article 29(1)(iii), Article 29*bis*, or Article 39) is likely to be negated because of an overlapping matter between the claimed invention and the cited invention, making amendment to exclude the overlapping matter;” and “(ii) in cases where a claimed invention encompasses ‘humans’ and does not satisfy the requirement under the main paragraph of Article 29(1) or falls under unpatentable matters prescribed in Article 32, making amendment to exclude ‘humans’ only.” Therefore, disclaimer claims have been considered as being effective for overcoming lack of novelty (Article 29(1)(iii), Article 29*bis*, or Article 39), but ineffective for overcoming lack of inventive step.

However, in actual examination and appeal practice, while the aspect of “permissive as long as not introducing any new technical matter” under *Solder Resist* case has been emphasized, the limited stance of “invention incidentally including matters overlapping with the cited invention” has not always functioned

sufficiently. As a result, exclusion of a number of inconvenient specific matters described in the cited document has been permitted, and disclaimer claims have become firmly established in practice as an extremely convenient tool that can overcome every reason for refusal easily, including overcoming lack of inventive step. In fact, according to the statistics in 2021, when disclaimer claims had become significantly widespread, the ratio of cases between those in which introduction of disclaimer claims were permitted and those not permitted was 97 : 3 (1,087 cases : 35 cases), and the ratio of cases between those in which assertion of inventive step based on amendment by disclaimer claims were permitted and those not permitted, was 88 : 12 (699 cases : 92 cases)¹⁰.

Moreover, with regard to the subject of exclusion by disclaimer claim, the scope of permitted amendment expanded without limit, from the matters initially envisaged by the Examination Guidelines, i.e. the matters identical with the prior art, to whatever matters, as long as they do not introduce any new technical matter¹¹. As a result, the necessity of investigation with regard to the permissive scope of amendment or correction increased considerably in all contexts, including the requirements of inventive step, clarity, supporting requirement and other invalidation grounds, and prior user's rights, as well as in relation to predictability by third parties¹².

3. ISSUES WITH CONVENTIONAL PRACTICE IN JAPAN

(1) Introduction

In the Notification, in consideration

of the comments from users as to appropriate examination, JPO announced updates regarding amendments in the form of disclaimer claim, from the perspectives of inventive step, addition of new matter, and clarity¹³.

This implies that the issues with disclaimer claims involve not only a mere amendment technique, but also those affecting the very foundation of the patent system in Japan. In fact, there are diverse issues surrounding disclaimer claims, and it is necessary to discuss from multiple perspectives described below.

(2) Potential for Circumventing

Addition of New Matter

First, disclaimer claims raise issues from the perspective of the addition of new matter.

In a typical format of disclaimer claims, subject matter not recited at all in the original Description, is added to a claim. However, this does not actively recite the scope of protection, but instead, does passively recite the subject of exclusion, and therefore, this format tends to be permissible¹⁴.

However, this treatment involves a fundamental problem. While matters not recited at all in the original Description cannot be "added," if they can be "excluded (disclaimed)," it would be possible to use specific subject matter taught in the cited document or embodiments of third parties discovered after the filing of the subject application, to subsequently define the scope of the claims. Furthermore, by carefully drafting the content of the "disclaimer," it is substantially possible to define the scope of the claim as something equivalent to what could be defined as an "addition."

Although this may superficially

appear to be a limitation of the scope of the claim, this substantially constitutes a redefinition of the outer boundary of the claim by using the matter not recited in the original Description, and therefore, involves the risk of circumventing the principle of prohibiting the addition of new matter.

(3) Perspective from Inventive Step

Second, disclaimer claims also raise issues in relation to assessing the inventive step.

Under conventional practice, at least lack of novelty is overcome by excluding specific subject matter described in a cited document, and thereafter, inventive step is asserted for the residual subject matter remaining after exclusion. However, as described above, even for the circumvention of lack of inventive step, disclaimer claims have been widely used, and in many of these cases the inventive step has been affirmed. (In other words, as long as a specific matter described in the cited document is excluded in the format of disclaimer claims, the requirements of both novelty and inventive step may be satisfied.)

With regard to this issue, the Notification further explains that, while admitting that there are some cases in which reasons for refusal such as lack of novelty may be overcome by means of disclaimer claim, if there is no significant difference from the cited invention in terms of technical concept, it is almost impossible to overcome the reasons for refusal on the ground of lack of inventive step, by means of disclaimer claim. This may be understood as a clear warning against the use of disclaimer claims as a mere superficial means for circumventing prior art¹⁵.

(4) Predictability by Third Parties

Third, disclaimer claims significantly impair predictability by third parties.

For example, when investigating the validity of a patent, third parties typically determine whether or not the patent satisfies the requirements of novelty, inventive step, supporting requirement, clarity, etc., on the basis of claims, description, drawings and the state of the art at the time of filing of that patent application. And, in relation to the prior art, if there is any evident ground for invalidation such as lack of novelty or inventive step, that cannot be overcome even by correction of matters recited in the original Description, then the third parties will conclude that there are strong doubts regarding the validity of that patent.

However, if disclaimer claims are commonly accepted, it will become extremely difficult to reach this conclusion. In other words, even in cases where the grounds for invalidation cannot be overcome based on the matters recited in the original Description, if any specific example, composition, numerical range, or the like described in the cited document submitted during an invalidation trial or opposition procedure is subsequently “disclaimed” by the patentee, there remains a possibility of superficially circumventing lack of novelty, and maintaining the patent.

In such cases, if third parties simply read the Patent Gazette and the Description, it will be impossible for them to predict what document will be cited, and what subject matter from that document will be excluded, and thus what residual subject matter will be maintained in the patent in the future. This scenario will undermine the fundamental functions of the patent system, in that claims are

supposed to serve to publicly announce the scope of rights, and to clarify the domain of free working by third parties.

(5) Perspective from Clarity of Scope of Rights

Fourth, disclaimer claims raise issues in relation to clarity of scope of rights.

A claim defines the technical scope of the patented invention, and functions to publicly announce to third parties the boundary to which the scope of rights extends, and from which boundary the domain to freely practice begins. Article 70(2) of the Patent Act prescribes that, when determining the technical scope of a patented invention, the meaning of terms used in the claims are to be interpreted in consideration of the statements in the description and drawings attached to the written application¹⁶.

However, if the subject of “disclaimer” in the disclaimer claim is not recited in the original Description, but recited based on other Patent Gazettes or non-patent literature cited in the reasons for refusal or invalidation trial, the significance of the relevant matter to be excluded cannot be understood from the description or drawing of the present patent. In this case, third parties can only grasp the scope of patent right in question after consulting not only the Patent Gazette of the subject patent, but also through interpreting the contents of other Patent Gazettes and literature¹⁷.

For example, if a claim recites that “excluding compounds recited in examples 1 through 10 of the cited document 1,” third parties will have to check the corresponding cited document, and identify what compounds are recited in the examples 1 through 10. Furthermore, with regard to these compounds, further issues

may arise, such as whether or not the claim includes salts, solvates, hydrates, crystals, stereoisomers or tautomers of these compounds.

In such cases, the boundary of the scope of rights depends on the interpretation of another party’s Patent Gazette or literature, not just on the Description of the present patent. This situation also raises significant concerns, since Article 70(2) of the Patent Act envisages that the terms used in the claims are to be interpreted in consideration of the statements in the description and drawings attached to the subject patent.

(6) Perspective from Prior User’s Rights

Fifth, disclaimer claims also raise serious issues in relation to prior user’s rights.

Under the system of prior user’s rights, if a person has been working or making preparation for working an invention prior to the filing date of the patent application in question, the commercial interests of that person will be protected. This is because, if a person has been independently working the invention prior to the filing date of a patent application by a third party, it would be unfair to prohibit that working due to a subsequently granted patent. Therefore, a non-exclusive license would be granted to that person of a certain scope.

Regarding this issue, several European court decisions tend to secure relatively stable protection for prior users. For example, according to the judgment of BGH (Bundesgerichtshof: German Federal Court of Justice) dated June 20, 2023, X ZR 61/21 “*Faserstoffbahn*” case, regarding the working of the subject of prior use that comprises all the elements of

an independent claim, if any matter is subsequently added to a dependent claim and is asserted by the patent owner, the prior use rights should still cover this modification of the subject of prior use. This judgment is remarkable for demonstrating an approach to secure the status of prior user rights to work the subject, acquired before the filing date of the patent application in question against the automatic lapse of rights due to subsequent correction of claims¹⁸.

Furthermore, according to a recent judgment by the UPC Court of Appeal in *Fujifilm v Kodak*, the court tends to secure relatively stable protection for prior users on the premise that, at least in Germany, an issue of whether the prior user's rights are recognized or not is to be determined under the national law of the country in question. In the present judgment, the original infringement ruling by Mannheim Local Division was reversed on appeal, and the defense for prior user's rights was upheld as for Germany. In particular, the UPC Court of Appeal opined that if prior use falls within the scope of claim as granted, the prior user's rights are established, and the right to continue such prior use does not lapse automatically even by subsequent narrowing of the scope of the claim¹⁹.

In contrast, Japanese case law does not, at least currently, tend to grant wider protection of prior user's rights similar to the above cases. In the judgment of IP High Court dated September 30, 2020, Case No. 2020 (Ne) 10004 [*Light Irradiation* case], the court ruled that, with regard to the establishment of prior user's rights, it is natural to interpret "such an invention" prescribed in Article 79 of the Patent Act as "an invention pertaining to the patent application," and the invention

pertaining to the prior user's rights must be identical with or at least a part of the patented invention. On this premise, the court further ruled that, upon the finalization of the decision of correction trial, the patent application and registration are deemed to have been recorded according to the scope of claims after correction, and therefore, even in a case where the subject of prior use falls within the technical scope of invention before that correction, the prior user's rights may not be established, as long as that subject does not fall within the technical scope of invention after correction²⁰.

This ruling may be said to negate the so-called "cut-in" (in Japanese language, "*kuikomi*"). In other words, even if a product or method worked by a prior user before the filing date of the patent application in question, had been encompassed by the broader scope of claim before correction, if that product or method falls outside the narrower scope of claim after that correction, the establishment of prior user's rights will be negated. In this respect, the Japanese case law stands in contrast to the recent trends in Europe and Germany where stable protection of prior user rights is sought with reference to the scope of claim at the time of grant of patent or before correction²¹.

The issues with disclaimer claims will become more problematic when considering these issues based on the interpretation of Japanese case law discussed above. While Article 79 of the Patent Act requires "identity" between the invention achieved before the priority date (the object of prior use) and the invention recited in the embodiment, in practical situations, there is almost no case where the embodiment and the subject of prior

use are exactly identical with each other, and it is natural that some modifications have been made. Consequently, if a patent owner can exclude only the subject of prior use, as the subject of “disclaimer” by subsequent correction, it is possible to negate the establishment of prior user’s rights, and therefore, it is further possible to allege infringement on the ground that the subject of prior use falls within the scope of the invention after that correction. Thus, disclaimer claims can also function as a means for retroactively disable the prior user’s rights of third parties that have been used before the filing date, in addition to a means for merely circumventing overlap with the prior art.

(7) Perspective from International Harmonization

Sixth, the conventional practice in Japan is also problematic from the perspective of international harmonization.

According to the practice in the United States, a “negative limitation” raises issues in relation to the written description requirement. A mere silence about a specific subject matter in the Description is not sufficient as a ground for expressing exclusion of that specific matter. It is necessary that persons skilled in the art could understand from the Description as filed that the patent owner possessed the invention encompassing the relevant negative limitation²².

In Europe, although disclaimer is permitted under certain situations, the scope of permission is limited. Disclaimer of an undisclosed matter is only permitted in limited situations, such as to avoid accidental prior art, unpatentable grounds under EPC, or conflict with earlier application under Article 54(3) of EPC. Moreover, disclaimer must be limited to

the minimum necessity, and any disclaimer affecting the assessment on the novelty and the sufficient disclosure requirement is not permitted. Therefore, disclaimer trying to subsequently exclude inconvenient examples described in the cited document, so as to support inventive step, that is, a so-called “cherry-picking” disclaimer, is extremely risky in patent practice in Europe²³.

In China, corrections are strictly limited, especially in an invalidation procedure. Generally, the subject of correction must be the claims, and corrections of the description or drawings are not permitted. Moreover, there is also a strict limitation against subsequent addition of technical features not encompassed in the claims at the time of registration. Under such a strict system, there is almost no room for subsequently introducing a specific matter derived from the cited document as the subject of a “disclaimer” and then maintaining the broad residual scope that remains after that exclusion, such as is the conventional practice in Japan²⁴.

In view of these practices in other systems, the conventional practice in Japan may be said to have been exceptionally friendly to patent owners, at least from the viewpoint that subsequent exclusion of a relatively broad scope of undisclosed subject matter has been permitted. In light of the trending increasing demand for international harmonization of patent systems, a revision of the disclaimer claims practice in Japan is inevitable given the desire for consistency with practices in other major countries and regions.

(8) Summary

As discussed above, disclaimer

claims involve multi-perspective issues that go beyond a mere technique of amendment and/or correction.

Of course, disclaimer claims are not always inappropriate, and in cases where overlap with a cited invention occurred only incidentally, it can be a useful means for amendment or correction that enables distinction from the cited invention in a flexible manner. However, practices that go beyond these limited situations and subsequently exclude inconvenient specific examples described in a cited document so as to maintain the broad residual scope remaining after that exclusion will inevitably create tension with the fundamental principles of the patent system.

Therefore, it is rather natural that stakeholders raised numerous critical opinions against disclaimer claims and demanded that the JPO conduct an appropriate evaluation. Standing against the above background, the Notification indeed serves as an opportunity to review the handling of disclaimer claims.

4. PROCESS AND SUBSTANCE OF THE AMENDMENT TO THE EXAMINATION GUIDELINES

As discussed above, on April 3, 2025, the Examination Guidelines Section, Coordination Division, of the JPO published a notification titled “Amendment in the Format of ‘Disclaimer Claims’” (the “Notification”). Subsequently, the Working Group under the Examination Guidelines Expert Committee discussed the revision of the Examination Guidelines related to “Amendment in the Format of ‘Disclaimer Claims’,” and the Examination Guidelines Draft Revision was published on April 8, 2026. While the

Notification is superficially a reminder about amendments in the examination phase, the content of the Notification in fact points out some important problems with the conventional practice surrounding disclaimer claims, and the content of the Examination Guidelines Draft Revision is in line with the Notification.

The first significant point of the Notification is that, in cases where the subject of “disclaimer (exclusion)” of a disclaimer claim is recited based on a matter not explicitly recited in the original Description, then, unlike general specific matters of invention, the meaning of that subject of exclusion cannot be interpreted with reference to the description and drawings. This straightforwardly points out the instability in interpreting the scope of rights under disclaimer claims, and this is also extremely important in relation to Article 70(2) of the Patent Act²⁵.

The second significant point of the Notification is clarification of the relationship between disclaimer claims and novelty/inventive step requirements. While admitting some cases in which the reasons for refusal on the ground of lack of novelty may be overcome by means of disclaimer claim, the Notification explains that inventions entitled to be patented by disclaimer claims are those that are significantly different from cited inventions in terms of technical concept, and inherently satisfy the inventive step requirement, but incidentally overlap with the cited inventions. From this standpoint, the Notification further states that, if there is no significant difference from the cited invention in terms of technical concept, it will be almost impossible to overcome the reasons for refusal on the ground of lack of inventive step, even by amendment in the format of disclaimer claims.

Thus, also in the Examination Guidelines Draft Revision, one of two types of disclaimer claim are generally permitted, namely type (i), which has been revised to: “(i) in cases where novelty, etc. (Article 29(1)(iii), Article 29*bis*, or Article 39) is likely to be negated because of an incidentally overlapping matter between claimed invention and cited invention, making amendment to exclude the overlapping matter, so as to clarify not including any invention significantly different from the claimed invention in terms of technical concept” (underlined text indicates the revised portions), suggests that requirements for accepting such an amendment will become stricter. Moreover, the Notification also adds a precaution that “(1) When applicants make amendment in the format of ‘disclaimer claims’ because of falling under this type, it is not sufficient to merely assert, as the basis of explanation, that the claimed invention and the cited invention are significantly different in terms of technical concept. It is required that the applicant explain that exclusion has been made for the invention that is understood by persons skilled in the art, when considering problems to be solved by the claimed invention and the state of the art at the time of filing the application, as being almost impossible to envisage that such an invention was included as the technical concept of the claimed invention at the time of filing the application,” and this precaution suggests that the situations in which disclaimer claims can be used will be further limited.

Based on these discussions, the revised Examination Guideline²⁶ updated on June 25, 2026, adopted the approach outlined in the Examination Guidelines Draft Revision, and the revised Examination

Handbook²⁷ which was updated on the same day as the Examination Guideline also adopted the same approach²⁸ and explicitly stipulated that even if an invention claimed in a claim is amended to exclude the overlap with the prior art, this alone does not establish inventive step; rather, a determination must be made as to whether the amended invention -as defined by the claim after such exclusion- possesses inventive step relative to the prior art, taking into account the design changes made from the prior art and taking away.

The third significant point of the Notification is the clarification of the responsibility of explanation regarding the addition of new matter. According to the Notification, when applicants assert that reasons for refusal on the ground of lack of inventive step are overcome by means of disclaimer claim, there is a possibility that the technical concept of the claimed invention has been transferred, from the invention not significantly different from the technical concept of the cited invention, to the invention significantly different from the cited invention, and this raises doubts that a new technical matter could have been introduced by that amendment. Therefore, when making an amendment in the format of disclaimer claims, the Notification requests applicants to explain in an argument that the technical concept has not been changed by the amendment in question, and that the present amendment is made for the purpose of overcoming the reasons for refusal on the ground of lack of novelty, and the present invention has been satisfying the inventive step requirement even before the amendment²⁹.

In this respect, the Examination Guidelines Draft Revision further notes

that, “(2) When applicants assert that the reasons for refusal on the ground of lack of inventive step are overcome by means of ‘disclaimer claim,’ the Examiner is required to consider whether or not the amendment in question is free from introduction of any new technical matter. Thus, when it is found that the invention inherently lacking inventive step before amendment has been transferred to the invention satisfying the inventive step requirement by means of that amendment, it should be borne in mind that such amendment could be determined as introducing the new technical matter,” and this suggests that further weight is added to the responsibility of explanation. However, in this regard, the assessment of inventive step will be intermingled with the assessment of the addition of new matter, and there are concerns that this could lead to confusion in examination practice. Furthermore, there are also concerns that if the Examiner determines that the issue involves the addition of new matter rather than a lack of inventive step, since an amendment to delete disclaimer claims would fall within “amendment beyond the scope of the purpose” prohibited in the final notice of rejection in Japanese Examination practice, leaving the applicant with “no recourse,” this would result in a significantly greater disadvantage compared to a situation where the Examiner finds a lack of inventive step³⁰.

Based on these discussions, the revised Examination Guideline updated on June 25, 2026, adopted the approach outlined in the Examination Guidelines Draft Revision, placing greater emphasis on preventing problems arising from the abuse of disclaimer claims than on the potential disadvantages of intermingling

the assessment of inventive step with that of addition of new matter. On the other hand, the revised Examination Handbook stipulates that, regarding issues arising from the concerns mentioned above, if an appropriate limitation is made along with an amendment to delete disclaimer claims and a patent grant decision is issued, the amendment will not be rejected, but the patent will be granted as an exception to the rule against amendments beyond the scope of application³¹. Besides, regarding the concerns mentioned above, in our opinion, since disclaimer claims are, by their very nature, amendments intended to assert inventive step over prior art, it is unavoidable that, during the examination of such claims, “the assessment of inventive step will be intermingled with the assessment of addition of new matter.” The fourth significant point of the Notification is the reference to the clarity requirement. The Notification points out that, if the subject of the “disclaimer” covers the major part of the invention or involves multiple matters, there will be some cases where a single invention cannot be grasped from a single claim. The Notification further states that, if the subject of the “disclaimer” is recited by borrowing an expression in the document cited in the reasons for refusal, there will be some cases where the content to be specified by that recital cannot be grasped unambiguously without actually confirming the content in the corresponding document, even by considering the state of the art at the time of filing the application.

The Examination Guideline Draft Revision further states that, “if the subject of the ‘disclaimer’ covers the major part of invention or involves multiple matters, there will be some cases where a single invention cannot be grasped from a single

claim, and therefore, the Examiner should bear this point in mind when assessing the clarity requirement,” and that “if the definition of the subject of the ‘disclaimer’ is not recited in the Description of the present application, or if it is different from that defined in the Description of the present application, the Examiner should also bear these points in mind,” which suggests that if the subject of the “disclaimer” is recited in the above manner, the Examiner may point out issues with the clarity requirement.

Based on these discussions, the revised Examination Guideline and the revised Examination Handbook adopted the approach outlined in the Examination Guidelines Draft Revision, and the revised Examination Handbook, which was updated on the same day as the Examination Guideline, also adopted the same approach. Furthermore, the Revised Examination Handbook, which was revised on the same day, states: “It should be noted that a violation of the clarity requirement occurs when, even considering the description in the specification and the drawings, as well as common knowledge at the time of filing, in addition to the wording of the claims of the application, the meaning of the term ‘A’ cannot be said to be described in a manner that would enable a person skilled in the art to understand it, and the meaning of the term ‘A’ becomes clear only through the citation of other documents in the claims.” Considering the above context, the Notification may be regarded as not a mere reminder, but as the starting point for repositioning the handling of disclaimer claims in Japan, from a flexible means for adjusting the claim scope to a stricter exceptional means³². In fact, the revised Examination Guideline adopted the

approach outlined in the Notification and the Examination Guidelines Draft Revision. Furthermore, the Revised Examination Guidelines Handbook stipulates: ‘When issuing a notice of reasons for refusal or similar, the Examiner should initiatively suggest an amendment if it is possible for the applicant to overcome the reasons for refusal by that amendment other than “disclaimer claims”.’ This reflects the view that disclaimer claims are an exceptional means. However, in the Japan Patent Office’s comments on the above proposed Examination Guidelines Draft Revision³³, it is stated on page 8 and elsewhere: “The recent revision of the revised Examination Guidelines regarding ‘disclaimer claims’ does not change the practice; it merely seeks to clarify the guidelines and provide a more concrete explanation of the approach taken during examination. Regarding 3.3.1 (4) (i) as well, it does not establish any new requirements, and we do not consider it to be inconsistent with the rule of *Solder Resist* case.” Since similar statements have been repeatedly provided in responses, the Japan Patent Office has explained that the purpose of this revision is to curb inappropriate examinations based on an inaccurate understanding of the rule of *Solder Resist* case, and to reaffirm the strictness originally intended by that rule.”³⁴

Although the perspectives discussed here are related to the requirements of inventive step, addition of new matter, and clarity, it is natural that the imposition of certain restrictions on the handling of disclaimer claims also holds significant implications from the perspectives of predictability by third parties and international harmonization³⁵. Further-

more, while there are still a few cases apparently involving disputes over circumvention of prior user's rights by means of disclaimer claim, precautions for the addition of new matter and clarity will be generally applicable to this issue, and therefore, it seems it may become more difficult to deploy such tactics to easily disable prior user's rights.

5. RECENT COURT PRECEDENTS AND TRENDS IN PATENT PRACTICE

(1) Practice in Application Examination and Appeal against Decision of Refusal

After the Notification, with regard to practices in application examination and appeal against decision of refusal, it is observed that the attitude of Examiners and Appeal Examiners toward disclaimer claims is changing.

As discussed above, in the past, in cases where a specific matter described in the cited document was amended in the format of a "disclaimer," and where not only lack of novelty, but also inventive step became questioned, then the inventive step had often been affirmed leniently based on the difference from the subject of exclusion, and this trend was clearly reflected in the statistics in 2021 discussed above.

However, recently, there is an increasing number of cases in which, in response to an amendment, a more detailed explanation is requested on the points that no new matter is added by the amendment in question, the invention after exclusion still satisfies the inventive step requirement against the cited invention, and the remaining scope after exclusion is clear. This trend is partially

reflected by the authors' practical experience, but there is a growing sense in practice, with regard to amendments by means of disclaimer claim in the phases of examination and appeal against decision of refusal, that the number of cases has been increasing in which the explanation is requested from the perspective of addition of new matter, not overcoming of lack of inventive step, and clarity. Of course, this trend is not specific to the practice of our firm in response to office actions from the JPO, as we also frequently hear similar feedback from other firms regarding responses to the office actions³⁶. As an example, since April 3, 2025 (the date of publication of the Notification), there was a case in which, during the examination phase of an application, although an amendment had been accepted before the date of the Notification, that amendment was subsequently suddenly pointed out as violating amendment requirements. Furthermore, even in cases where amendment is permitted, the assessment of inventive step has become clearly stricter, and the number of cases is increasing, in which an explanation is requested on the points that the technical concept of the present invention has not been changed after exclusion, and that the present invention satisfies the inventive step requirement against the cited invention even before the amendment.

Considering the situations discussed above, from now on, when using disclaimer claims, it will be insufficient to merely state that "since the invention described in the cited document was excluded, the lack of novelty has been overcome." There has been an increasing demand for explaining specifically in an argument, at least about the technical

relationship between the subject of exclusion and the scope of the residual remaining after exclusion, and also that the technical concept of the present invention has not been changed after exclusion, and that the present invention satisfies the inventive step requirement against the cited invention even before the amendment, and that the scope of invention after exclusion is clear.

At present, because only a short time has passed since the changes in handling based on the Notification, we do not yet have statistical data to illustrate the above trend. Furthermore, there seems to be a certain gap between the Examination Department and the Trial and Appeal Department of JPO, with regard to the degree of strictness for applying the Notification.

In contrast, with regard to the question of trends concerning how a patent, once granted by means of disclaimer claim, will be assessed in an opposition or invalidation trial, there have been no remarkable indications at present. Probably also because not much time has passed since the publication of the Notification, when comparing between the phases of examination/appeal against decision of refusal before grant of a patent, and the phases of opposition/invalidation trial after grant of a patent, the latter phase appears to be treated more carefully (i.e. more favorable to patent owners).

Thus, although changes in practice are by no means simple, at least when the statistical data that include the period following issuance of the Notification are provided, it is highly expected that the trend will be changed significantly from that in 2021.

(2) Recent Court Precedents

The Notification was published by the Examination Guidelines Section, Coordination Division of the JPO, and since it is not a legal statute, the Notification does not bind the courts. Nevertheless, since the Notification was published to ensure fairness of examinations and improvement of quality in response to the demands from users for appropriate examination, and given that the practice in the JPO has been actually changing, it is unlikely that the courts can ignore these trends.

However, after publication of the Notification dated April 3, 2025, it cannot be said that sufficient precedents have been accumulated in trial decision revocation cases explicitly applying the above approach. At present, as compared with the practices in examination of application and appeal against decision of refusal, it is difficult to appreciate that the approach in trial proceedings and court proceedings for revocation of trial decision has been clearly reflecting changes after the Notification in the form of published rulings. Nevertheless, among recent court precedents before the date of the Notification, there are some cases anticipating these trends. A few of these precedents will be discussed below³⁷.

For example, in the judgment of the IP High Court dated October 30, 2024, Case No. 2024 (Gyo-Ke) 10012 [*Milk Enzyme Processed Product* case], with regard to the invention after amendment, recited as “bovine-derived milk (excluding bovine colostrum)”, to exclude “bovine colostrum” that was described in the main cited invention, the court upheld the original appeal decision refusing the application, holding that the invention after exclusion could still be achieved

easily based on the cited document and the state of art. In this case, the applicant asserted that the “bovine colostrum” in the cited invention was an essential element, and that an inhibiting factor was created by disclaimer of this element, but the IP High Court upheld the easy achievement (obviousness) on the basis of the cited document and the state of the art³⁸.

This ruling is important because it demonstrated that, inhibiting factors or inventive step should not be affirmed based only on a mere exclusion of a specific element of the cited invention, and that, with regard to the invention after exclusion, obviousness based on the cited invention and the state of the art should also be substantially assessed. This is consistent with the views stated in the Notification, that is, if there is no significant difference from the cited invention in terms of technical concept, it is almost impossible to overcome the reasons for refusal on the ground of lack of inventive step by means of a disclaimer claim.

Moreover, in the judgment of the IP High Court dated December 5, 2023, Case No. 2023 (Gyo-Ke) 10011 [*Mobile Terminal Remote Control Device* case], with regard to an element of “an image displayed on a mobile terminal (excluding an image captured by a camera),” the court refused to adopt the assertion that capturing images described in the cited invention was an essential element, and negated the inventive step based on well-known technologies such as screen mirroring. This case also demonstrates that, even by using disclaimer claims, it is necessary to substantially examine whether or not the subject of exclusion is truly an indispensable element in relation to the problem to be solved, functions, and

effects of the cited invention, and whether the invention after exclusion can be regarded as significantly different in terms of technical concept³⁹.

In contrast, recently there are some precedents of the IP High Court taking a more friendly approach to patent owners than rulings by the JPO, permitting corrections by means of a disclaimer claim. For example, in the judgment of the IP High Court dated October 5, 2023, Case No. 2022 (Gyo-Ke) 10125 [*Heat Transmission Composition* case] discussed above, with regard to a correction by means of disclaimer claim that had not been permitted in the patent invalidation trial on the ground of addition of new matter, the court vacated the original trial decision, and held that the correction did not constitute the addition of new matter. In this judgment, with regard to a correction to an open claim by excluding compositions containing specific substances in an amount exceeding a predetermined value, the court assessed that this correction did not actively specify that the relevant substance must be included in an amount under the predetermined value, but narrowed the scope of the claim⁴⁰.

Furthermore, the Judgment of the IP High Court dated March 9, 2023, Case No. 2022 (Gyo-Ke) 10030 [*Layered Body* case] was also a case in which it was contested whether a correction by means of disclaimer claim constituted the narrowing of the scope of claim. Although the JPO had held that the correction did not constitute the narrowing of the scope of claim, the court vacated the original JPO decision. These precedents demonstrate that, under the general standards established by the judgment in *Solder Resist* case, corrections by means of disclaimer claim may still be permitted in

a relatively flexible manner⁴¹.

As discussed above, with regard to recent precedents, while some do not superficially affirm inventive step when excluding a specific element of the cited invention by means of disclaimer claim, others permit disclaimer claims in a manner relatively friendly to patent owners, in the context of correction requirements and addition of new matter. Of course, given the differences specific to the respective cases, it cannot be categorically concluded that these rulings are contradictory at all, but it is a fact that there is a gap in leniency in court rulings regarding the permissibility of disclaimer claims, and this fact can be seen as the background for the JPO to underscore, by publishing the Notification, the need for clarifying the handling of disclaimer claims from the perspectives of inventive step, novelty, addition of new matter, and clarity.

From these considerations, the accumulation of future court precedents and published appeal/trial decisions related to disclaimer claims is awaited, and this is also the subject for future analysis.

6. IMPLICATIONS FOR PRACTICE

(1) Response Strategies for Applicants and Patent Owners

The above situation does not mean that disclaimer claims cannot be used anymore. In cases where the overlap with the cited invention occurred only incidentally, and where there is no change in terms of technical concept of the present invention or present application even by excluding the overlapping matter in question, then, disclaimer claims can still

be an effective means for amendment and correction.

However, when using disclaimer claims, more careful consideration is required than ever.

First, the subject of exclusion should be specified unambiguously as much as possible, and in particular, recital in the format of reference to another Patent Gazette is undesirable from the perspective of clarity of scope of rights. Chemical structures, ingredients, composition ratios, numerical ranges, and the like, should be specified directly in the claims as much as possible⁴².

Second, it is necessary to explain that the technical concept of the invention after exclusion is not changed from the technical concept recited in the original Description as filed. It is also necessary to organize the relationship with the problems to be solved, functions and effects, examples, and general explanations recited in the Description, in order to avoid any risk of unfavorable assessment, such as that the exclusion created a new residual scope that was not recited in the original Description.

Third, with regard to inventive step, it is necessary to explain not only the difference from the subject of exclusion, but also that the invention as a whole after exclusion is not obvious from the cited invention and the state of art. In particular, if the cited invention discloses A1 to A10 as specific examples, and also suggests Group A in general as a whole citation, then, even by excluding A1 to A10, there is still a high possibility of being assessed that the residual scope from A11 onward stands along the same line as the technical concept of the cited invention. In this regard, the revised Examination Guidelines and the revised Examination

Handbook added numerous specific examples, which are highly informative for applicants.

Furthermore, under the Examination Guidelines before the revision, in cases where a patent is granted after “disclaimer claims,” or after issuance of the final notification of reasons for refusal in the examination phase stating that the amendment constituted addition of new matter, in cases where the reasons for refusal regarding addition of new matter become issues, then, there was a risk of running into a ‘cul-de-sac’ unless the reasons for refusal can be overcome⁴³.

Not only was this extremely disadvantageous to applicants, but examiners, fearing such running into a ‘cul-de-sac’, were often unable to issue reasons for refusal—such as requiring the addition of new matter against disclaimer claims⁴⁴. Consequently, this led to a structural problem in which disclaimer claims—which should not have been permitted—became widespread.

However, as mentioned in Section 4, regarding this point, the Revised Examination Guidelines Handbook now stipulates that, provided an amendment involving the deletion of an exclusionary claim is accompanied by appropriate limitations and a patent grant decision is issued, the amendment will not be rejected but rather the patent will be granted as an exception to the rule against amendments beyond the scope of the application. Thus, while the requirements for amendments involving exclusionary claims have been tightened, sufficient measures have been taken to address the risks that were once considered unreasonable by many practitioners; in this respect, favorable amendments for applicants have been made regarding amendments involving

exclusionary claims. Through this change in practice, it can be said that the Japan Patent Office has clarified that “exclusion claims” are strictly an exceptional measure, while also making clear its position that such amendments will be accepted if they constitute “exclusion claims” in the true sense of the term. Therefore, as a general rule, an applicant should claim disclaimer claims if they can be considered disclaimer claims in the true sense (such as the generally permissible type (i) mentioned above), and refrain from doing so otherwise.

However, it is inevitable that overcoming the reasons for refusal by means of disclaimer claim will become more difficult than before, and no matter how carefully the preparation was made, it is impossible to completely eliminate such risk. Thus, it is important to avoid reliance on disclaimer claims as much as possible, and instead, to try amending the claims based on what is recited in the Description. It will be prudent to use disclaimer claims only as the last resort when there is no other means available, or as a part of divisional application.

(2) Response by Third Parties

With regard to patents that have already been granted by means of a disclaimer claim, or patents for which correction has become final, careful consideration is also required on the part of third parties.

From the perspective of third parties, even in cases where a patent is maintained by a disclaimer claim, it is not necessary to immediately assume validity. Rather, third parties should investigate the clarity of the subject of exclusion, support for the residual scope after exclusion, addition of new matter after exclusion, and inventive

step after exclusion. In particular, if the subject of exclusion depends on the content of the cited document or other Patent Gazettes, then, in relation to Article 70(2) of the Patent Act, there will be an opportunity for raising objections on how the subject of exclusion in question should be interpreted, or whether the scope of rights can be clearly understood or not.

Moreover, even in cases where a correction by means of a disclaimer claim has been affirmed in the past, this does not automatically mean that the invention after exclusion satisfies the inventive step or other requirements⁴⁵. In a defense for invalidation in an invalidation trial or infringement lawsuit, third parties should actively assert that the scope of the residual subject matter after exclusion is obvious from the cited invention and the state of the art, the problem to be solved by the entire residual scope cannot be recognized from the original Description as filed, and the subject of exclusion is ambiguous.

Furthermore, in relation to prior user's rights, it is necessary to investigate carefully whether or not a correction by means of disclaimer claim will not result in undue prejudice against the protection of prior user's rights. From the perspective of third parties, it is desirable to organize a map at an early stage on how its embodiments prior to the application filing date are positioned in relation to the claim after correction, and how the protection range of prior user's rights should be assessed in relation to the claim after correction.

7. CONCLUSION

So far, the handling of disclaimer claims in Japan has functioned as an

extremely flexible remedy for applicants and patent owners. In particular, after the judgment in *Solder Resist* case, disclaimer claims have been understood as having the potential to be accepted even if there is no explicit recital in the original Description, as long as no new technical matter is introduced at all.

However, thereafter, since the handling of disclaimer claims has been friendly to patent owners almost without limit, the use of disclaimer claims has become very popular, and as a result, disclaimer claims have begun to create serious issues with the predictability of third parties, clarity of scope of rights, interrelationship between disclosure in the Description and monopoly, international harmonization, and consistency with the system of prior user's rights.

The Notification and the trends in the revision of the Examination Guidelines may be understood as an important rectification to the heretofore conventional handling described above. Going forward, it is expected that disclaimer claims will be shifting to a position, not as mere convenient tactics to circumvent reasons for refusal or invalidation, but as a limited means for excluding incidental overlaps to the minimum necessary, while simultaneously maintaining the technical concept recited in the original Description.

The authors hope that future trends in patent practice will become clearer by revision of the Examination Guidelines that makes the Notification more specific, and also by statistics of examination and appeal/trial practices, and by accumulation of future appeal/trial decisions and court precedents.

(Notes)

- ¹ “Amendment in the Format of ‘Disclaimer Claims’” (April 3, 2025), published by the Examination Guidelines Section, Coordination Division, Japan Patent Office, defines a “disclaimer claim” as a “claim explicitly excluding only certain matters encompassed in the claimed invention, from the other matters recited in that claim, while retaining the original wording of the matters recited in the claim.” <https://www.jpo.go.jp/system/patent/shinsa/letter/nozoku.html>
- ² “Yorozu Chizai Consulting Blog,” YOROZU Hidenori, article dated March 14, 2022, titled “Disclaimer Claims” states that, according to statistics sorted by technical fields, disclaimer claims are frequently used especially in the fields of chemistry, pharmaceuticals and biotechnology. Furthermore, the Blog also states that, according to the statistics in 2021, over 1,000 disclaimer claims were granted in the examination and/or appeal procedures of JPO, and that, when disclaimer claims are used, the chance of success becomes significantly higher as compared with the case of not using disclaimer claims. <https://yoroziuipsc.com/blog/4130957>
- ³ See, Working Group under the Examination Guidelines Expert Committee, Subcommittee on the Patent System, Intellectual Property Committee, Industrial Structure Council, 19th Meeting, as a representative. Handout “Revision of the Examination Guidelines Regarding Amendments in the Format of ‘Disclaimer Claims’” (published on March 18, 2026). https://www.jpo.go.jp/resources/shingikai/sangyo-kouzou/shousai/kijun_wg/document/19-shiryu/003.pdf
- ⁴ Invitation for Public Comments on the Draft Revision of “the Examination Guidelines for Patent and Utility Model in Japan,” e-Gov Public Comment: <https://public-comment.e-gov.go.jp/pcm/1040?CLASSNAME=PCM1040&id=630226002&Mode=1>
- ⁵ The Examination Guidelines Section, Coordination Division, JPO https://www.jpo.go.jp/system/laws/rule/guideline/patent/tukujitu_kijun/kaitei2/r8_shinsa_kijun_kaitei.html
- ⁶ *Ibid*, Footnote 1, the Examination Guidelines Section, Coordination Division, JPO. The Notification draws attention to the relationship between the disclaimer claims, and the inventive step, addition of new matter, clarity, and Article 70(2) of the Patent Act.
- ⁷ *Ibid*, Footnote 1, the Examination Guidelines Section, Coordination Division, JPO. The Notification explains that, an invention that is patentable by disclaimer in response to reasons for refusal on the ground of novelty, is the invention inherently satisfying the inventive step requirement significantly different in terms of technical concept from the invention of prior art cited in the reasons for refusal, and is the invention that incidentally includes a matter overlapping with the cited invention.
- ⁸ Judgment of the IP High Court dated June 20, 2006, Case No. 2005 (Gyo-Ke) 10608. According to this judgment, with regard to disclaimer claims, if a correction, etc., does not introduce any new technical matter in addition to originally disclosed technical matters, that correction is done “within the scope of matters recited in the description, claims and drawings,” and does not constitute the addition of new matter.
- ⁹ Judgment of the IP High Court dated May 30, 2008, Case No. 2006 (Gyo-Ke) 10563 (*Solder Resist* case).
- ¹⁰ “Study on the Limit of Disclaimer Claims,” 2023 Patent Committee, 2nd Subcommittee, Team 1 (TANAKA Kenji et al.), Patent, Vol. 78, No. 7, pp. 88-89 (2025).
- ¹¹ With regard to this point, the judgment of the IP High Court dated October 5, 2023, Case No. 2022 (Gyo-Ke) 10125 [*Heat Transmission Composition* case] ruled on a correction by means of disclaimer claim. The court held that “it has been understood that any correction of a claim under Article 134bis(1) of the Patent Act must be done within the scope of matters recited in the description, claims and drawings, and must not substantially broaden or change the scope of claims (Article 134bis(9), Article 126(5) and (6) of the Patent Act). However, there is no further requirement, such as that the correction must be done by excluding only the matters identical with the invention of earlier application, or by excluding only the matters identical with the prior art publicly known before filing of the present patent application.” Therefore, it is not required to exclude only the matters identical with the invention of earlier application, and as long as not introducing any new technical matter, the correction is permitted as satisfying the requirements, not constituting addition of new matter.
- ¹² The trends in the IP High Court permitting an amendment or correction in the format of disclaimer claims in a relatively flexible manner may be seen, for example, the judgment of the IP High Court dated March 31, 2009, Case No. 2008 (Gyo-Ke) 10358; the judgment of the IP High Court dated March 31, 2009, Case No. 2008 (Gyo-Ke) 10065; and the judgment of the

IP High Court dated September 25, 2014, Case No. 2013 (Gyo-Ke) 10266. In contrast, some judgments may be understood as ruling the limit to the scope of permissive disclaimer claim because of issues with the clarity of excluded matter or the relationship with the recited matters in the Description, such as the judgment of the IP High Court dated March 11, 2015, Case No. 2014 (Gyo-Ke) 10204; the judgment of the IP High Court dated March 30, 2016, Case No. 2014 (Ne) 10080; and the judgment of the IP High Court dated July 12, 2017, Case No. 2016 (Gyo-Ke) 10160.

¹³ *Ibid*, Footnote 1, the Examination Guidelines Section, Coordination Division, JPO. The Notification states, as supplementary versions in January and March 2026, that “we received a number of comments from users, demanding appropriate examination with regard to the cases amended in the form of ‘disclaimer claim.’ In the light of these comments, JPO is working to ensure appropriate examination practice and improvement of the quality of examination.”

¹⁴ Judgment of the IP High Court dated March 9, 2023, Case No. 2022 (Gyo-Ke) 10030 [*Layered Body* case] ruled that, “according to the Defendant’s assertion ... the Corrected Matter 2 first adds a new technical matter by adding a means for solving the problem of cited document, that is, ‘a vapor-deposited film of inorganic oxide is provided on the layered body, and a gas-barrier coating film is provided on the vapor-deposited film,’ and then, based on this added matter as a precondition, this matter is excluded, and therefore, the Corrected Matter 2 constitutes addition of new matter. However, with reference to the technical matters remaining after exclusion of the Corrected Matter 2, there is no newly added matter as compared with those before the present Correction, the Defendant’s assertion cannot be accepted.”

¹⁵ *Ibid*, Footnote 1, the Examination Guidelines Section, Coordination Division, JPO.

¹⁶ Article 70(2) of the Patent Act prescribes that “in the case referred to in the preceding paragraph, the meaning of terms used in the claims are to be interpreted in consideration of the statements in the description and drawings attached to the written application.”

¹⁷ *Ibid*, Footnote 1, the Examination Guidelines Section, Coordination Division, JPO. The Notification states that, if the subject of “disclaimer” is recited by borrowing an expression in the document cited in the reasons for refusal, there will be some cases where the content to be specified by that recital cannot be grasped unambiguously without actually confirming the content in the corresponding document.

¹⁸ BGH, Urteil vom 20. Juni 2023, X ZR 61/21 – Faserstoffbahn. Although this case concerns a utility model, it appears to be applicable analogously to patents, as a precedent involving the scope of prior user’s rights under Gebr MG § 13 and PatG § 12. This judgment is understood that, with regard to working of a subject of prior use covering all elements of an independent claim, even in a case where subject matter was subsequently added to a dependent claim asserted by the patent owner, a certain modification of the subject of prior use may be covered by the prior use.

¹⁹ UPC Court of Appeal, 2 June 2026, *Fujifilm v Kodak*, UPC-CoA-312/2025, UPC-CoA-333/2025, UPC-CoA-880/2025 and UPC-CoA-882/2025. With regard to the present case, EIP reported that UPC Court of Appeal reversed the original infringement ruling by Mannheim Local Division for both Germany and UK, and the defense of prior user’s rights was upheld as for Germany. EIP, “UPC Court of Appeal reverses infringement ruling in both Germany and UK” (5 June 2026): <https://www.eip.com/uk/case-reports/upc-court-of-appeal-fujifilm-v-kodak-infringement-reversed>

²⁰ Judgment of the IP High Court dated September 30, 2020, Case No. 2020 (Ne) 10004 [*Light Irradiation* case]. The present judgment is understood that, on the premise that, upon the finalization of correction trial decision, the patent application and registration are deemed to have been recorded according to the scope of claims after correction, even in a case where the subject of prior use falls within the technical scope of invention before that correction, the prior user’s rights may not be established, as long as that subject does not fall within the technical scope of invention after the correction.

²¹ “Cut-in” is a term used in patent practice, for referring to a problem that, if a subject of prior use does not fall within the technical scope of the patented invention itself but has a certain overlap with the broader scope of the claim before correction or at the time of filing the application, whether or not the protection under the prior user’s rights is recognized. In this article, this term is used focusing on situations in which the subject of prior use falls within the scope of claim before correction but does not fall within the scope of claim after that correction.

²² In patent practice in the United States, a negative limitation is examined from the perspective of the written description requirement, and normally, silence in the Description about the subject of a negative limitation does not provide written description

- support for the negative limitation. See USPTO, MPEP § 2173.05 (i).
- ²³ With regard to undisclosed disclaimer in Europe, see decisions of EPO Enlarged Board of Appeal in G 1/03, G 2/03, G 2/10 and G 1/16. Undisclosed disclaimers are principally permitted in limited situations for avoiding earlier application under Article 54(3) of EPC, incidentally conflicting with prior art, or unpatentable grounds due to non-technical reasons, and it is understood that, disclaimers related to inventive step of the sufficient disclosure requirement are not permitted in principle.
- ²⁴ In patent practice in China, the subject of an amendment in an invalidation procedure must in principle be the claims, whereas amendments to the description or drawings are not permitted. Moreover, it is understood that the format of amendment is limited to deletion of claims, deletion of technical solutions, further limitation of claims, correction of obvious clerical errors, or the like. See CNIPA Patent Examination Guidelines, Part 4, Chapter III, 4.6.
- ²⁵ *Ibid*, Footnote 1, the Examination Guidelines Section, Coordination Division, JPO.
- ²⁶ *Ibid*, the Examination Guidelines Section, Coordination Division, JPO.
https://www.jpo.go.jp/system/laws/rule/guideline/patent/tukujitu_kijun/kaitei2/r8_shinsa_kijun_kaitei.html
- ²⁷ https://www.jpo.go.jp/system/laws/rule/guideline/patent/handbook_shinsa/kaitei/document/202606/12.pdf#page=2
- ²⁸ In the Revised Examination Guidelines Handbook, examples are provided of cases where the addition of a new matter does not constitute a “disclaimer claim”—even if the case does not fall under (i) above—such as:
- (a) when the fact that does not include the excluded matter is “a matter explicitly described in the original specification, etc.”;
 - (b) when the fact that does not include the excluded matter is “obvious from the disclosure in the original specification, etc.”;
 - (c) when, in accordance with the approach applied to amendments that sub-conceptualize or serially add elements that specify the invention in the claims, it is clear that the amendment constituting an “disclaimer claim” does not add any new technical significance in relation to the “matter disclosed in the original specification, etc.”
 - (d) when, in accordance with the approach applied to amendments that delete some alternatives in alternative-form claims (such as Markush-type claims), if a determination based on the overall disclosure of the original specification, including the examples, it is deemed that the amendment constituting a “disclaimer claim” does not add any new technical significance in relation to the “matter disclosed in the original specification, etc.”
- ²⁹ *Ibid*, Footnote 1, the Examination Guidelines Section, Coordination Division, JPO. The Notification draws attention to the notion that, when applicants assert that the reasons for refusal on the ground of lack of inventive step are overcome by means of disclaimer claim, there is a possibility that the technical concept of the claimed invention has been changed by making amendment, which raises doubts that a new technical matter could have been introduced, and therefore, applicants are requested to explain in an Argument about the ground that the present amendment does not constitute addition of new matter.
- ³⁰ TANAKA Kenji (Patent Attorney), “Chizai Jitsumu Joho Lab.® (IP Practice Information Lab.),” article updated on April 25, 2026, “My Personal Views on the Examination Guidelines Draft Revision: How Should Addition of New Matter by ‘Disclaimer Claim’ be Assessed?” He states that “I feel uneasy because the wording of the Draft has some anxious expressions, which might cause interminglement of the assessment of inventive step with the assessment of novelty, and because of additional ambiguity what is meant by the wording ‘inherently lacking inventive step,’ I fear that this would lead to confusion in examination practice,” and also states that “If in response to a lack of inventive step cited in the initial notification of reasons for refusal, an amendment is made to specify ‘disclaimer claims,’ and a final notification of reasons for refusal is then issued on the grounds that the amendment constitutes the addition of new matter, an amendment to delete excluded clause is often considered an amendment beyond the scope of the application. As a result, it is not uncommon for the applicant to find themselves with ‘running into a cul-de-sac’—if the assessment of novelty and the assessment of inventive step are intermingled as described above, this could lead to a situation that ‘it depends on the Examiner to determine which reasons for refusal should be issued,’ and there is a possibility that only applicants, to whom the addition of new matter has been pointed out, will suffer from serious disadvantages.”
<https://chizai-jj-lab.com/2026/04/21/0418-2/>
- ³¹ Regarding the concern in Note 28 above that “it is unclear what is meant by the wording ‘inherently lacking inventive step’”, the Revised Examination Handbook explains: “The word ‘inherently lacking inventive step’ means cases where, although the invention differs significantly from the prior art in terms of technical concept, it overlaps with the prior art

in terms of wording, resulting in notification of reasons for refusal citing both lack of novelty and lack of inventive step.” Besides in our opinion, regarding the above concern, as stated in (2) of the Revised Examination Guidelines—which stipulates, “when it is found that the invention inherently lacking inventive step before amendment has been transferred to the invention satisfying the inventive step requirement by means of that amendment, it should be bear in mind that such amendment could be determined as introducing the new technical matter, —thus, if the amended invention possesses inventive step, it is, in principle, deemed an addition of ne matter, on the other hand if the amended invention does not possess inventive step, it is, in principle, deemed to lack inventive step. Therefore, it is considered unlikely that a situation would arise where ‘it depends on the Examiner to determine which reasons for refusal should be issued.’

³² See, Working Group under the Examination Guidelines Expert Committee, Subcommittee on the Patent System, Intellectual Property Committee, Industrial Structure Council, 18th Meeting, Material 3, “Approach to Amendment in the Format of ‘Disclaimer Claims’” (published on November 14, 2025). Furthermore, at the 19th Meeting, the direction for the revision of the Examination Guidelines related to disclaimer claims was discussed. https://www.jpo.go.jp/resources/shingikai/sangyo-kouzou/shousai/kijun_wg/18-shiryu.html

³³ Ibid, Footnote 26, the Examination Guidelines Section, Coordination Division, JPO.

³⁴ However, regarding the aforementioned initiative suggestion of amendments and the aforementioned exceptions to amendments outside the scope of the application, it appears that a practice clearly different from the previous one is anticipated. In our opinion, it is considered that the aspects that differ from conventional practices were compiled in the revised Examination Handbook, while only the aspects that remain unchanged from conventional practices were included in the revised Examination Guidelines.

³⁵ As a major change introduced by the revised Examination Guidelines updated on June 25, 2026, in addition to the point concerning “disclaimer claims,” the following statement regarding teaching away is stipulated: “However, the Examiner shall bear in mind that, even where teaching away such as those described below are present, there are differences in the extent to which they impact on the denial of inventive step.” “The existence of descriptions in the prior art that would prevent one from readily conceiving the claimed invention also constitutes teaching

away, preventing establishing a logical connection and, therefore, serves as a factor affirming inventive step. However, as in (1), the mere existence of such teaching away does not automatically lead to affirming inventive step. Rather, the examiner should make a comprehensive evaluation—including factors that could deny inventive step—and then determine whether a logical justification can be provided. Thus, such decision-making methods are clearly specified, and international harmonization is also being pursued in the area regarding teaching away. Furthermore, in the assessment of inventive step in the [Case Study] titled “Examination of Applications in the Form of ‘Disclaimer Claims’” in the Revised Examination Handbook, the determination is made in accordance with the aforementioned process for assessing teaching away. In the section titled “(3)Teaching Away” under “1. Considerations for Determining Inventive Step,” it is explicitly described that “If an amendment is made that excludes elements deemed essential to the cited invention, and if it is argued in a written opinion that there are teaching away from conceiving the invention claimed in the amended claims, the examiner should reexamine the description of the cited document and evaluate the extent of such teaching away (For a related court judgment, see the judgment of the IP High Court dated September 29, 2025, Case No. 2024 (Gyo-Ke) 10081 [*Pet Matching System and Pet Matching Method* case]. In such cases, the examiner should not limit his or her consideration to matters explicitly described in the prior art, but rather examine teaching away by constantly considering how a person skilled in the art, faced with that prior art, would conceive. Therefore, for the clarification of the methodology for examining such teaching away as a result of international harmonization, it appears that it has become even more difficult to assert inventive step by disclaimer claims.

Besides, regarding teaching away, according to *Ibid* Footnote 26, the Examination Guidelines Section, Coordination Division, JP, it is stated on page 1, and similar responses have been provided repeatedly that “Accordingly, the revised Examination Guideline does not introduce a new concept of ‘differences in degree’ into the assessment of teaching away; rather, by explicitly stating that examiners must appropriately assess differences in the degree of teaching away, it is intended to clarify current practices and encourage assessments of inventive step in accordance with the Examination Guidelines.”

³⁶ TANAKA Kenji (Patent Attorney), *ibid*, Footnote 30, also states that “with regard to

examination of ‘disclaimer claims,’ the internal practice in the JPO has been clearly changing since around 2025, and I hear feedback frequently that amendments by means of ‘disclaimer claim,’ that have been permitted previously, are no longer permitted because of being regarded as addition of new matter ... for example, when an amendment is made in the format of ‘disclaimer claims’ in order to overcome lack of novelty and lack of inventive step, there are three major patterns of reasons for refusal, namely: (a) addition of new matter; (b) not overcoming of lack of novelty or inventive step; and (c) violation of description requirements such as clarity and supporting requirement. Among these patterns, based on the scope of observation by the author as of April 2026, the pattern (a) ‘addition of new matter’ seems to be most frequently issued to reject the amendment at the initial stage.”

- ³⁷ The Notification is a reminder related to amendments in the examination phase, and it is expected to take some time until the impact of this Notification on the practice in examination and appeal proceedings becomes apparent in court precedents. As of the time of drafting this article, the authors could not find sufficient accumulation of judgments of the IP High Court to which the Notification was explicitly applied.
- ³⁸ Judgment of the IP High Court dated October 30, 2024, Case No. 2024 (Gyo-Ke) 10012 [*Milk Enzyme Processed Product* case]. The invention after amendment was “a method for manufacturing a milk enzyme processed product, comprising a step of causing milk in contact with β -galactosidase and sialidase, wherein the milk is bovine-derived milk (excluding bovine colostrum),” and the inventive step of the amended invention by disclaiming “bovine colostrum” of the cited invention was contested. The IP High Court upheld the original appeal decision finding lack of inventive step in the appeal against the decision of refusal.
- ³⁹ Judgment of the IP High Court dated December 5, 2023, Case No. 2023 (Gyo-Ke) 10011 [*Mobile Terminal Remote Control Device* case]. In this case, with regard to an element of “an image displayed on a mobile terminal (excluding an image captured by a camera),” whether or not the capturing of images described in the cited invention was an essential element, and whether or not the invention after disclaimer was obvious, were contested.
- ⁴⁰ *Ibid*, judgment of the IP High Court dated October 5, 2023, Case No. 2022 (Gyo-Ke) 10125 [*Heat Transmission Composition* case]. This judgment is understood that, with regard to corrections by means of disclaimer claim, that had not been permitted in the patent invalidation

trial on the ground of addition of new matter, the court vacated the trial decision, and held that the correction did not constitute addition of new matter.

- ⁴¹ *Ibid*, judgment of the IP High Court dated March 9, 2023, Case No. 2022 (Gyo-Ke) 10030 [*Layered Body* case]. In this case, it was contested whether or not a correction by means of disclaimer claim constituted the narrowing of the scope of the claim. It is understood that, although JPO had held that the correction did not constitute the narrowing of the scope of claim, the court vacated the original decision of JPO.
- ⁴² *Ibid*, Footnote 1, the Examination Guidelines Section, Coordination Division, JPO. The Notification points out that, if the subject of disclaimer is recited by borrowing an expression in the document cited in the reasons for refusal, there will be some cases where the content to be specified by that recital cannot be grasped unambiguously without actually confirming the content in the corresponding document. Therefore, in practice, instead of specifying with reference to the example number of another document, it is desirable to specify by chemical structures, ingredients, composition ratios, numerical ranges, and the like as many as possible, directly in the claims.
- ⁴³ TANAKA Kenji (patent attorney), *ibid*, Footnote 30, also states that “after making amendment in the format of ‘disclaimer claims’ in response to the first notification of reasons for refusal regarding lack of inventive step, if the final notification of reasons for refusal is issued, pointing out that such amendment constitutes addition of new matter, then, it is not uncommon to run into a cul-de-sac.” He also states that “in a divisional application, if an amendment in the format of ‘disclaimer claims’ is determined as constituting addition of new matter, this will also constitute a violation of the requirements for divisional application, and unless the reasons for refusal regarding the addition of new matter can be overcome, all the subsequent divisional applications will also constitute a violation of the requirements for divisional application,” and that “similar problems may arise as for patents previously granted by means of ‘disclaimer claim’.”
- ⁴⁴ Furthermore, based on the authors’ experience, this trend can also be observed at the trial stage, such as in opposition proceedings; it appears that reasons for revocation—such as requirements regarding the description that are deemed impossible to amend—are rarely upheld in opposition proceedings.
- ⁴⁵ *Ibid*, Footnote 26, the Examination Guidelines Section, Coordination Division, JPO. JPO takes the position that the present revision does not

change the practice, but merely seeks clarification and presents the approach in examination more concretely, and is consistent with the judgment in *Solder Resist* case. Furthermore, the judgment of the IP High Court dated November 11, 2005, Case No. 2005 (Gyo-Ke) 10042 [Polarizing Film case]. According to the judgment, while the case directly concerned a violation of the support requirement, it does not matter whether the Examination Guidelines were in effect before or after the revision, if it is consistent with the correct interpretation of the law.