

Draft revision of Patent and Utility Model Examination Guidelines to restrict multiple-multiple dependent claims in Japan - Effective from April 1, 2022 -

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Abstract

Multiple-multiple dependent claims¹ are acceptable under current Japanese patent and utility model practice. However, due to the necessity of international harmonization and improving examination efficiency, the Patent Law Enforcement Regulations, etc., will be revised by a Ministerial Ordinance² to introduce provisions that restrict multiple-multiple dependent claims. For that purpose, the JPO published on February 10, 2022, a “Draft Revision of Examination Guidelines in relation to Restrictions on Multiple-Multiple Dependent Claims” (hereinafter “Draft Revision of Examination Guidelines”), in which they announced specific rules and examination procedures relating thereto. The Draft Revision of Examination Guidelines will be applied to patent and utility model applications filed on or after April 1, 2022.

1. Overview

Based on legislative policy for restricting multiple-multiple dependent claims which was approved on December 15, 2021, by a working group of the Intellectual Property Subcommittee of the Industrial Structure Council, procedures for revising Patent Law Enforcement Regulations, etc., to introduce the restrictions, are underway. Specifically, the Patent Law Enforcement Regulations, Article 24-ter, referred to in Patent Law, Article 36, paragraph 6, item 4 (Ordinance of Ministry of Economy, Trade and Industry (METI)), will be revised to newly introduce item 5 which restricts multiple-multiple dependent claims as follows³.

Patent Law Enforcement Regulations, Article 24-ter.

Recitations of the claims in accordance with the Ordinance of METI set forth in Article 36, paragraph 6, item 4 of the Patent Law shall comply with the following items.

1 to 4 (Omitted)

5. When a claim refers to two or more other claims in alternative form, such other claims shall not refer to two or more other claims in alternative form.

¹ “Multiple-multiple dependent claim” means a dependent claim which refers to, in alternative form, two or more other claims that refer to two or more other claims in alternative form.

² Promulgated on February 25, 2022.

³ The same restrictions will also be introduced to utility model applications. Specifically, the Utility Model Law Enforcement Regulations, Article 4, which is referred to in the Utility Model Law, Article 5, Paragraph 6, Item 4, will also be revised in the same manner to introduce item 5 which restricts multiple-multiple dependent claims.

The main purpose of the revisions is to reduce the burden of monitoring third parties and improve the efficiency of substantive examination by Examiners, since multiple-multiple dependent claims are considered as causing undue confusion in determining the inventions derived from combinations actually included in the claims.

In that context, the JPO published on February 10, 2022, the Draft Revision of Examination Guidelines on their [website](#), in which they announced specific rules and examination procedures relating thereto.

2. Improper Multiple-Multiple Dependent Claims

According to the Draft Revision of Examination Guidelines, multiple-multiple dependent claims of any kind, which are, in general, categorized as the following types I to III, do not satisfy the requirements of Patent Law Enforcement Regulations, Article 24-ter, item 5 (hereinafter “*restrictions on multiple-multiple dependency*”) (Draft Revision of Examination Guidelines, Part II, Chapter 2, Section 5, item 2.2(5)).

1. A ball bearing having a specific structure.		
2. The ball bearing according to claim 1, having feature A.		
3. The ball bearing according to claim 1 or 2, having feature B.		
4. The ball bearing according to any one of claims 1 to 3, having feature C.	Improper Type I	Not examined
5. The ball bearing according to claim 4, having feature D.		Not examined
6. The ball bearing according to claim 4, having feature E.		Not examined
7. The ball bearing according to claim 5 or 6, having feature F.	Improper Type II	Not examined
8. A method of manufacturing a ball bearing according to any one of claims 1 to 7, having feature G.	Improper Type III	Not examined

Type I (typical example): Claim 4 does not satisfy the restrictions on multiple-multiple dependency, since it is a multiple-dependent claim which refers to another multiple-dependent claim 3. This is a typical type of improper multiple-multiple dependent claim.

Type II (indirect dependency): Although claims 5 and 6 are not multiple-dependent claims but singular-dependent claims, claim 7 does not satisfy the restrictions on multiple-multiple dependency, since claim 7, which is a multiple-dependent claim that refers to claims 5 and 6 in alternative form, indirectly refers to claim 4, which is another multiple-dependent claim.

Type III (different categories): Although the category of invention of claim 8 differs from that of claims 1 to 7, claim 8 does not satisfy the restrictions on multiple-multiple dependency, since it is a multiple-dependent claim which refers to other multiple-dependent claims 3, 4 and 7 in alternative form.

Incidentally, claims which are dependent from claims that fall within any one of types I to III will not be examined, even if they are not multiple-dependent claims. In the above examples, singular-dependent claims 5 and 6, which are dependent from multiple-multiple dependent claim 4 (type I), will not be examined.

3. Handling of Multiple-Multiple Dependent Claims in Examination

(1) Determination of Subjects of Examination

Considering examination efficiency and fairness between applications which satisfy the restrictions on multiple-multiple dependency, the inventions of claims that do not satisfy the restrictions on multiple-multiple dependency, as well as claims that are dependent thereon will not be examined on the merits, in relation to requirements other than the restrictions on multiple-multiple dependency (Article 36, paragraph 6, item 4 of the Patent Law, and Article 24-ter, item 5 of the Patent Law Enforcement Regulations). In the above examples, none of the inventions of claims 4 to 8 will be examined in relation to other requirements, such as unity of invention, clarity, support requirement, enablement requirement, novelty, and inventive step, etc. (Draft Revision of Examination Guidelines, Part II, Chapter 2, Section 3, item 4, and Section 5, item 2.2).

(2) Notice of Reasons for Rejection

If the claims include multiple-multiple dependent claims, the recitations of the claims do not satisfy the restrictions on multiple-multiple dependency (Article 24-ter, item 5 of the Patent Law Enforcement Regulations), which will result in a reason for rejection based on not satisfying an ordinance of METI in relation to multiple-multiple dependency (Article 36, paragraph 6, item 4 of the Patent Law)⁴ (hereinafter “*multiple-multiple dependency rejection*”). Inventions which have not been examined and the reason therefor shall be explicitly indicated and stated in a Notice of Reasons for Rejection.

Multiple-multiple dependency rejections will be overcome by, for example, amending multiple-multiple claims or all the preceding claims (including both direct and indirect dependency) to claims which refer only one claim (singular-dependent claim)⁵. Incidentally, if it is necessary for combinations of inventions, which will be deleted in order to eliminate multiple-multiple dependency, to be examined thereafter, a new dependent claim(s) may be added therefor⁶.

⁴ Incidentally, not satisfying an ordinance of METI cannot be a ground for Post-Grant Oppositions or Invalidation Trials.

⁵ In the above examples, claim 4 may be amended so as to be dependent from “claims 1 or 2” in order to overcome a multiple-multiple dependency rejection for claim 4, and a new dependent claim which recites “The ball bearing according to claim 3, having feature C” may be added in order to cover the combination of feature C in claim 4 and feature B in claim 3.

⁶ However, if the number of claims (literal number of claims) after amendment is greater than that at the time of filing a request for examination, examination fees for the increased number of claims must be paid.

(3) Examination after Overcoming Multiple-Multiple Dependency Rejection

If a multiple-multiple dependency rejection is overcome by amending the claim dependency, inventions which had not been examined prior to amendment shall also be examined on the merits thereafter.

However, a second or any subsequent Office Action shall be *final*⁷, if it includes a reason(s) for rejection in relation to the newly-examined inventions *only* (Draft Revision of Examination Guidelines, Part I, Chapter 2, Section 3, item 3.2.1.c), since newly examining inventions that are set forth in the claims but had not been previously examined is substantially the same as examining claims newly added by an amendment.

4. Applications to which the Revised Examination Guidelines Apply

The Draft Revision of Examination Guidelines is available for public comments until March 11, 2022, and the revised Examination Guidelines will be applied to patent and utility model applications filed⁸ on or after April 1, 2022, which is the effective date of the Ministerial Ordinance.

5. Our Comments

Considering international harmonization and examination efficiency, etc., provisions which restrict multiple-multiple dependent claims will be introduced in Japan, as in the U.S., Korea and China. The specific rules and examination procedures are, however, relatively stricter in the other jurisdictions, in terms of no formality exceptions being accepted, and exclusion of inventions from substantial examination.

Accordingly, it would be advisable, in the case of patent/utility model applications filed in Japan, and international applications to be entered into Japan, to draft the claims such that they do not include multiple-multiple dependent claims at the time of filing, in order to avoid an unnecessary Office Action. Otherwise, it would be advisable to voluntarily amend the claims to eliminate multiple-multiple dependency at the time of filing a request for examination.

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⁷ In response to a final Office Action, the allowable scope of amendment of the claims is strictly limited to (a) cancellation of claim(s), (b) restriction of features already set forth in the claims, (c) correction of errors, or (d) clarification of an ambiguous description.

⁸ For divisional applications, this refers to the filing date of the original application. For applications claiming a priority, this refers to the actual filing date, not a priority date. For international applications entered into Japan, this refers to the international filing date, not the date of entry into Japanese domestic phase.