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The JPO announced plans for a revision of the Enforcement Regulations of the Patent Law (effective date: 1 April 2022).

Prohibition of multiple-multiple dependent claims

1. Outline of the Revision

As a result of the above revision, multiple dependent claims depending on other multiple dependent claims (hereinafter referred to as "multiple-multiple dependent claims") will no longer be allowed.

The existence of a multiple-multiple dependent claim constitutes a violation of the Ministerial Ordinance Requirements (Article 36(6)(iv) of the Patent Law). At present, it is planned that this will be a reason for refusal but not a reason for invalidation or opposition.

2. Example of multiple-multiple dependent claims

Claim 1	A composition comprising A.	
Claim 2	The composition according to claim 1, further comprising B. (combination of features included in this claim: A+B)	
Claim 3	The composition according to claim 1 or 2, further comprising C. (combination of features included in this claim: A+B, A+B+C)	Multiple dependent claim: PERMITTED
Claim 4	The composition according to any one of claims 1 to 3, further comprising D. (combination of features included in this claim: A+D, A+B+D, A+C+D, A+B+C+D)	<u>Multiple-multiple dependent claim:</u> <u>NOT PERMITTED</u>
Claim 5	The composition according to any one of claims 1 to 4, further comprising E. (combination of features included in this claim: A+E, A+B+E, A+C+E, A+B+C+E, A+D+E, A+B+D+E, A+C+D+E, A+B+C+D+E)	<u>Multiple-multiple dependent claim:</u> <u>NOT PERMITTED</u>

3. Possible actions

At present, it is planned that, if multiple-multiple dependent claims are present, an Office Action will be issued due to the violation of the Ministerial Ordinance Requirements (Article 36(6)(iv) of the Patent Law).

In such a case, in response to the Office Action, the applicant may amend the claim set in a manner that multiple-multiple dependent claims are no longer included, which will resolve the reason for refusal.

In addition, in order to avoid an Office Action as mentioned above, the applicant may amend the claim set accordingly by voluntary amendment before the commencement of examination, e.g. immediately after filing the application (or immediately after entry into the national phase in the case of a PCT application) or at the time of requesting examination.

With regard to the above amendment, for example, if claim 4 in the above table is amended to read "The composition according to claim 1, further comprising D.", then combinations "A+B+D", "A+C+D" and "A+B+C +D" will be removed from claim 4. If there are important combinations among these deleted combinations, it is recommended to add new sub-claims for these combinations at the time of the above-mentioned amendment, so that these combinations are not lost from the claim set.

4. Affected applications

The revisions apply to patent applications whose filing date (or international filing date in the case of PCT applications) is 1 April 2022 or later.

Thus, the existence of multiple-multiple dependent claims is allowed for patent applications filed before and including 31 March 2022.

The revision will also apply to utility models.

At present, no information is available as to whether or not, under the revised regulations, the existence of multiple-dependent or multiple-multiple dependent claims will also lead to increased official fees.

(Under the current regulations, whether a claim is phrased as an independent claim or as a single-, multiple-, or multiple-multiple dependent claim has no impact on any official fees.)

We will inform you when we have more concrete information with regard to the implementation of the revised regulations.

Supplement to our Newsletter E-201 of 21 December 2021:

The intended increase of the official fees for registration fees and annuities/renewal fees for patents and trademarks paid on or after 1 April 2022 mentioned under point III of our previous newsletter of 21 December 2021 has been decided in the meantime.

The increased official fees for patents apply if the request for examination for the matter in question was filed on or after 1 April 2004. If the request for examination was filed earlier, the current official fees will continue to apply.