

ESAKI & ASSOCIATES

MARK LIGHT TORANOMON
3-1, NISHISHIMBASHI 2-CHOME
MINATO-KU, TOKYO 105-0003, JAPAN
TEL: +81-3-3502-1476
FAX: +81-3-3503-9577
+81-3-3503-0238
E-Mail: reception@esakipat.co.jp

K. Esaki (Patent Attorney)
M. Kajisawa (Patent Attorney)
Y. Sakuma (Patent Attorney)
Y. Kaminishi (Patent Attorney)
I. Torayama (Patent Attorney, Ph. D)

E. Tazaki (Patent Attorney)
S. Nakamura (Patent Attorney, Ph. D)
M. Takahashi (Patent Attorney)
T. Ishida (Patent Attorney)
Y. Koizumi (Patent Attorney)

Tokyo, March 2022

Newsletter E-203

Prohibition of multiple-multiple dependent claims (follow-up)

As communicated in our previous Circular No. 202, as a result of a revision of the Enforcement Regulations of the Patent Law, multiple dependent claims depending on other multiple dependent claims (hereinafter referred to as "multiple-multiple dependent claims") will no longer be allowed for patent and utility model applications **filed on or after 1 April 2022**.

The JPO has now announced an overview of the revised Examination Guidelines according to the above revision.

1. Recommended actions with regard to the above revision and the revised Examination Guidelines

In view of the content of the revised Examination Guidelines, we strongly recommend for affected applications to amend the claims before the start of the examination so that multiple-multiple dependent claims are no longer included.

As indicated in Circular No. 202, the existence of a multiple-multiple dependent claim would result in an Office Action caused by a violation of the Ministerial Ordinance Requirements (Article 36(6)(iv) of the Patent Law). By amending the claims so that multiple-multiple dependent claims are no longer included, the reason for rejection could be resolved.

However, it should be noted that according to the revised Examination Guidelines, multiple-multiple dependent claims and claims referring back to them are not examined except with regard to the above Ministerial Ordinance Requirements.

Thus, a first office action would only indicate the violation of these Requirements for the claims concerned, but the examiner would not indicate whether the inventions of these claims fulfil the other requirements for patentability, such as novelty, inventive step, etc.

Thus, even if multiple-multiple dependent claims or claims referring back to them contain potentially patentable inventions, the examiner would not make an assessment in this respect in the first examination report.

Only after the multiple-multiple dependent claims have been amended in such a way that this reason for rejection is no longer present, the examination of the claims concerned with regard to the remaining requirements for patentability would begin. If a further ground for rejection is then found for one of the claims concerned (lack of novelty, inventive step, etc.), this would result in a further Office Action. If the examiner in this further Office Action communicates only this further reason for rejection, i.e. the found reason for rejection to the former multiple-multiple dependent claims, the respective further Office Action would be issued as a so-called "Final Notice of Reasons for Rejection", in the reply to which admissible amendments are subject to considerable restrictions. Typically, additions of new claims, changes to the categories of existing claims, and expansions or other non-restrictive changes of the scope of existing claims are not permitted.

Thus, if multiple-multiple dependent claims are included in the set of claims to be examined, there is a risk that an applicant will first learn of an assessment of the essential requirements for patentability of the subject-matter of multiple-multiple dependent claims (and claims subordinate thereto) in a "Final Notice of Reasons for Rejection", when amendments are only possible to a limited extent in the response thereto.

In order to avoid such a situation, it is highly advisable to make sure before the start of the examination that the claim set does not contain multiple-multiple dependent claims.

Since the exact time of the start of examination is difficult to predict, we recommend - after filing an application^{*1} and until the request for examination is filed (or shortly after the request for examination has been filed, at the latest) - to amend the claims so that multiple-multiple dependent claims are no longer included.

^{*1} We recommend, not only for forwarding PCT applications, but also for national applications under the Paris Convention, to file the application text containing multiple-multiple dependent claims with the JPO first and to make the necessary amendments only afterwards, i.e. not to reformulate the set of claims of the priority application containing such claims before the filing in Japan.

The reason for this is that when a claim set containing multiple-multiple dependent claims is reformulated, a - possibly considerable - part of the feature combinations contained in the original claims, is normally lost from the claim set. In particular, in order to avoid that originally claimed feature combinations which are not clearly indicated in the description are already completely removed when the application is filed, we consider it advisable to file such an application with the JPO first with the claim set containing multiple-multiple dependent claims, if any, i.e. with the complete original content, and to amend the claim set accordingly only afterwards.

Furthermore, the publication of the application in question would mean that its complete content, including the combinations of features contained in the multiple-multiple dependent claims, would be considered prior art against later patent applications and could exclude later applications based on its complete original content.

2. Conceivable typical example of required changes

For example, in the case of original claims phrased as shown below, our recommendation for amending the claims to remove multiple-multiple dependent claims would typically be to reformulate the claims so that the multiple-multiple dependent claims relate back only to claim 1, as shown below

Original 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+C ^{*2} , A+B+C)	Multiple dependent claim: PERMITTED
Claim 4 ^{*3}	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 ^{*3}	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>
Claim 6 ^{*3}	The composition according to claim 5, wherein said E is e1. (combination of features included in this claim: A+e1, A+B+e1, A+C+e1, A+B+C+e1, A+D+e1, A+B+D+e1, A+C+D+e1, A+B+C+D+e1)	

^{*2} In the previous circular, "A+B" was mentioned as the combination of characteristics. The correct combination is "A+C".

^{*3} If these claims are not amended, their examination would be limited to the above-mentioned requirements of the Ministerial Regulation.

Amended 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+C, A+B+C)	Multiple dependent claim: PERMITTED
Claim 4	The composition according to claim 1 any one of claims 1 to 3 , further comprising D. (combination of features included in this claim: A+D)	
Claim 5	The composition according to claim 1 any one of claims 1 to 4 , further comprising E. (combination of features included in this claim: A+E)	
Claim 6	The composition according to claim 5, wherein said E is e1. (combination of features included in this claim: A+e1)	

For example, the above amendment would remove from claim 4 the feature combinations A+B+D, A+C+D and A+B+C+D.

If the deleted feature combinations also contain important embodiments, these should be pursued in new subclaims.

For example, for the feature combination A+C+D, a new subclaim could read as follows:

Claim 7 The composition according to claim 1, further comprising C and D.
(combination of features included in this claim: A+C+D)

We recommend adding such subclaims at the same time as amending multiple-multiple dependent claims as shown above, since under Japanese law/practice the opportunities to file amendments after the start of examination are limited, and further, permissible amendments in response to a "Final Notice of Reasons for Rejection" or a Decision of Rejection are subject to extensive limitations, so that the addition of subclaims is then normally no longer possible.

3. Others

Even after the revision, the existence of multiple dependent claims or multiple-multiple dependent claims does not in itself cause additional costs. Multiple dependent claims and multiple-multiple dependent claims are counted as one (1) claim each. As before, the costs of requesting examination, filing an appeal, registration fees and renewal fees depend only on the number of claims.