

“Some Multiple Dependent Claims Will Be Rejected in Japan - What is the Influence on Foreign Applicants?”

Due to the upcoming revision of the Enforcement Regulations of Japan’s Patent Law and Utility Model Law, a patent application or a utility model application which is filed on or after April 1, 2022 and includes **a multiple dependent claim referring to another multiple dependent claim (“improper multiple dependent claim”)** will be rejected as a violation of Art. 36(6)(iv) of the Patent Law. However, this violation will only be a reason for refusal, not a reason for invalidation or opposition.

One of the purposes of this revision is to promote “international harmonization” considering that the majority of patent applications from Japan to foreign countries (about $\frac{3}{4}$) are to the U.S., China and South Korea, where improper multiple dependent claims are already not allowed. The revision is also intended to reduce the burden of monitoring by third parties and that of examination.

For example, the following are some hypothetical claims:

Claim 1. A product comprising X, Y and Z.

Claim 2. A product according to Claim 1, wherein...

Claim 3. A product according to Claim 1 or 2, wherein...

Claim 4. A product according to any one of Claims 1 to 3, wherein...

Claim 5. A method of manufacturing the product according to any one of Claims 1 to 4, wherein...

In the case above, Claim 1 is an independent claim. Claim 2 refers only to Claim 1 so it is not a multiple dependent claim. Claim 3 is a multiple dependent claim referring to Claim 1 or 2, but it will still be acceptable. **Claims 4 and 5 are improper multiple dependent claims** since they refer to other multiple dependent claims (Claims 3 and 4). Although the category of Claim 5 (method) is different from the categories of Claims 1 to 4 (product), it does not matter. Claims such as Claim 4 and 5 above will no longer be acceptable in Japan.

The above applies only to applications with a filing date on or after April 1, 2022. Here, care should be taken in interpreting the “filing date”. For a divisional application whose first parent application is filed before April 1, 2022, the rejection above will **NOT** be applied. An application claiming a priority under the Paris Convention whose filing date in Japan is on or after April 1, 2022, **will be subjected to the rejection even if its priority date is before April 1, 2022**. As for PCT applications, the rejection above will **NOT** be applied if the international filing date is before April 1, 2022, regardless of the date of the entry into the national phase.

For improper multiple dependent claims, other requirements such as novelty and inventive step will not be examined, but only the fact that they are improper multiple dependent claims will be pointed out. Please note that a Final Notification of Reasons for Refusal will be issued when only rejections that are required to be notified as a result of an amendment that eliminates improper multiple dependent claims should be notified. This severely limits the possible amendments and can be significantly disadvantageous for the applicant (Art. 17^{bis}(5) of the Patent Law).

Therefore, this revision will have a significant impact on applications from Europe, where such claim formats are widely used. When filing applications in Japan on or after April 1, 2022, we advise the use of voluntary amendments to eliminate improper multiple dependent claims, just like when filing in the US.

For further information and inquiries, please contact Jun Ito, the author of this newsletter at: jun-ito@se1910.com.

(Published March 8, 2022)

Sonderhoff & Einsel Law and Patent Office routinely provides legal advice related to data-related regulation, including the Act, public comments, compliance, contract drafting and amendment, negotiations, employee training, response to authorities, litigation and arbitration, and other related legal service.

The information provided in this document is only general information and does not provide specific professional advice. The views expressed in this newsletter for your convenience and do not constitute a legal opinion of the firm.

Sonderhoff & Einsel Law and Patent Office
100-0005 1-6-2 Marunouchi, Chiyoda-ku, Tokyo
Shin-Marunouchi Center Building 18th Floor
<http://se1910.com/>

Tel +81-3-5220-6500
Fax +81-3-5220-6583