

Newsletter / IP Japan

Multi-Multi Claims would be rejected under a new regulation in Japan

As you may know, in Japan, for a patent application and a utility model application as filed before April 1, 2022, a Multi-Multi claim as such would not be a reason for rejection. However, for a patent application and a utility model application filed on or after April 1, 2022 (except a divisional application of which the precedent application was filed before April 1, 2022), Multi-Multi claims would be rejected under a new regulation in Japan.

The new regulation is stipulated in an Article 24-3(5) of the ordinance for Enforcement of the Patent Act as follows:

○ **When a claim is stated by alternatively referring to statements of two or more other claims, the referred claim shall not alternatively refer to statements of the other two or more claims.**

The new regulation is to lighten the burden of the Examiners examining such Multi-Multi claims and to lighten the burden of a third party monitoring Multi-Multi claims in competitor's applications.

Types of claims are exemplified below.

Claim 1. A device comprising A.
Claim 2. The device according to claim 1, further comprising B.
Claim 3. The device according to claim 1 or 2 further comprising C. **(Multi-Claim)**
Claim 4. The device according to any one of claims 1 to 3, further comprising D. **(Multi-Multi Claim)**
Claim 5. The device according to claim 4, wherein the D is (d1). **(A claim dependent upon a Multi-Multi Claim)**

We will hereinafter explain in more detail the regulation.

(1) Any Multi-Multi claim in an application as filed on or after April 1, 2022 would be rejected by the Examiner during the course of examination before the JPO. Even if the application can enjoy the benefit of priority whose priority date is before April 1, 2022, when any Multi-Multi claim is included in the application whose actual filing date is on or after April 1, 2022, such Multi-Multi claims would be rejected.

(2) If any Multi-Multi claim is included in a divisional application of which a precedent application (any of parent, grand-parent and so on) was filed before April 1, 2022, such Multi-Multi claims would not be rejected.

(3) For any Multi-Multi claim included in an international application whose international filing date is before April 1, 2022, such Multi-Multi claims would not be rejected.

(4) When any Multi-Multi claim is found during the course of examination, an Office Action is issued and such claims shall be rejected because of violation for Article 36(6)(iv) of Patent Act. Claims that are found to be a Multi-Multi claim are excluded from the subject of the examination regarding unity of inventions, novelty, inventive step, prior art effect, double patenting, enablement/support requirement, and/or clarity. This is because examining the novelty etc. of Multi-Multi claims would be contrary to the purpose of the new regulation, which is to lighten the burden of the examination.

(note) Violation for Article 36(6)(iv) of Patent Act would not constitute any reason for opposition or invalidation trial. Therefore, even if Multi-Multi claims are overlooked during the course of examination, no objection or invalidation trial can be requested for that reason.

(5) Any claim that depends on a Multi-Multi claim but is not stated by alternatively referring to statements of two or more other claims (such as the claim 5 of the above example) would not be rejected because of violation for Article 36(6)(iv) of Patent Act. However, such a claim is also excluded from the subject of the examination regarding novelty etc., like Multi-Multi claims.

(note) At international phase of PCT application filed with the JPO as a Receiving Office, Multi-Multi claims are subject to International Search and International Preliminary Examination.

(6) Regarding a claim other than the Multi-Multi claims such as an independent claim, if reason(s) for rejection such as lack of novelty is(are) found in such a claim, reason(s) for rejection will be noticed at the same time as the notification of violation of the rules related to Multi-Multi claims in the (first) office action.

(7) If Multi-Multi claims are rejected by the Examiner in the first Office Action, the second Office Action may usually be a final Office Action against the application. After such a final Office Action, an amendment for avoiding a final rejection is limited. In addition, there is concern that the number of responses to the Office Action will increase by the presence of Multi-Multi claims.

Therefore, we would recommend you to avoid such rejection of Multi-Multi claims, especially in cases where early granting of patent rights is desired. For this purpose, we would recommend you to revise a set of claims in the application and amend such Multi-Multi claims if any at the time of entering into the national phase in Japan of your PCT application or the time of filing a Request for Examination. The JPO also recommends filing an Amendment by the time of filing a Request for Examination, if your application includes any Multi-Multi claim.

< Other Notes >

The JPO has announced the revision for handling of Multi-Multi claims. Please also refer to the following website (JPO). (<https://www.jpo.go.jp/e/system/patent/shinsa/multimulticlaims.html>)

The JPO releases a Multi-Multi claim detection tool which can be operated in an offline environment. (<https://www.jpo.go.jp/system/patent/shinsa/letter/multimultichecker.html>)

If you have any questions in the matter, please feel free to contact us (Contact persons: Takashi Sue (Dr) and Yoshiko Morita in Tokyo Office and Kansai Office, respectively (e-mail: t-sue@tsukuni.gr.jp and morita-y@tsukuni.gr.jp)

(end of letter)

TSUKUNI & ASSOCIATES:

[TOKYO OFFICE]

KOJIMACHI BUSINESS CENTER, 2F, 3-1, Kojimachi 5-chome,
Chiyoda-ku, Tokyo, 102-0083, JAPAN
Telephone: +81 (3) 6261 3750 (main)
Facsimile: +81 (3) 3263 5650

[KANSAI OFFICE]

Shin Osaka Doi Building 5F, 7-5-25 Nishinakajima,
Yodogawa-ku, Osaka 532-0011, JAPAN
Telephone: +81-6-4806-1350
Facsimile: +81-6-4806-1351

Email: jp-firm@tsukuni.gr.jp

Website: <http://www.tsukuni.gr.jp/en/>

This newsletter should not be interpreted as a legal/technical opinion for a specific case and the contents should not be taken as complete statements. Should you require more advice or information, please contact us. Your feedback would be always appreciated.