Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part II   Chapter 2   Section 5   Ministerial Ordinance Requirement on Statement of Claims

Section 5   Ministerial Ordinance Requirement on Statement of Claims
(Patent Act Article 36(6)(iv))

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1. Overview

Patent Act Article (36(6)(iv)) refers to the legal requirements regarding technical rules on the statement of claims to Regulations under the Patent Act Article 24ter.

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2. Determination of Article 36(6)(iv)

The following (1) to (4) are typical examples in which the statement of the scope of claims does not satisfy the support requirements:

(1) Where for each claim, the statement does not start on a new line, or one number is not assigned thereto (non-compliance with the provision of Regulations Article 24ter(i))

Example 1:
  [Claim 1] A ball bearing having a specific structure [Claim 2] The ball bearing as defined in claim 1 that is provided with an annular cushion around the outer race
    (Explain) Claim 2 does not start on a new line.

Example 2:
  [Claim] A ball bearing having a specific structure
  [Claim] A ball bearing that is provided with an annular cushion around the outer race
    (Explain) One number is not assigned to each claim

(2) Where claims are not numbered consecutively (non-compliance with the provision of Regulations Article 24ter(ii))

Example3:
  [Claim 1] A ball bearing having a specific structure
  [Claim 3] The ball bearing as defined in claim 1 that is provided with an annular cushion around the outer race

(Explain) Claim 3 starts immediately after claim 1; that is, claims are not numbered consecutively.

(3) Where in the statement of claims, reference to the statement of other claims is not made by the numbers assigned thereto (non-compliance with the provision of Regulations Article 24ter(iii))

Example4:

[Claim 1] A ball bearing having a specific structure

[Claim 2] A process for producing the aforementioned ball bearing by use of a specific method

(Explain) With regard to "the aforementioned ball bearing" in claim 2, reference is not made by the number assigned to the claim 1.

(4) Where, when a claim refers to a statement of another claim, the claim precedes the other claim to which it refers (non-compliance with the provision of Regulations Article 24ter(iv))

Example5:

[Claim 1] The ball bearing as defined in claim 2 that is provided with an annular cushion around the outer race

[Claim 2] A ball bearing having a specific structure

(Explain) Claim 1 referring to claim 2 precedes claim 2.

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3. Procedure of Examination for Determination of Requirement under the Provision of Article 36(6)(iv)

3.1   Notice of reason for refusal

Where the examiner determines that the statement of claims does not comply with the requirement under the provision of Article 36(6)(iv) and conveys that effect in the notice of reason for refusal, the claim concerned and the reason for such determination shall be explained specifically.

It is inappropriate to describe only "the statement of claims does not comply with the requirement under the provision of Article 36(6)(iv)" without explaining the specific reason, because it is difficult for the applicant to file an effectual response and

to understand the direction for amendments to overcome the reason for refusal.

3.2   Argument and clarification of applicant

The applicant may make an argument or clarification by filing a written argument and the like against the notice of reason on the non-compliance with the requirement under the provision of Article 36(6)(iv).

3.3   Handling of examiner on argument, clarification of applicant and so on

Where the examiner comes to be convinced that the statement of claims complies with the requirement under the provision of Article 36(6)(iv) by argument and clarification (see 3.2), the reason for refusal will be overcome. Otherwise, the decision of refusal shall be issued based on the reason for refusal that the statement of claims does not comply with this requirement.