

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))

#### 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.

Here, Regulations under the Patent Act Article 24ter(v) stipulates that in stating a claim by referring to a statement of two or more other claims in an alternative way, the claim which it refers shall not refer to a statement of two or more other claims in an alternative way.

With respect to a multiple dependent-form claim written in an alternative form, which refers to a claim stated by referring to a statement of two or more other claims in an alternative way (hereinafter referred to as "a multiple dependent-form claim in the alternative"), it causes difficulty in identifying an invention as they combine the statement of each cited claim, and thus causes the burden of monitoring by the third party and the workload of examination. In view of this, Regulations under the Patent Act Article 24ter(v) is provided as restriction of the description forms for claims.

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

##### 2.1 Types of violation of Regulations under the Patent Act Article 24ter(i) to Article 24ter(iv)

The following (1) to (4) are typical examples in which the statement of the scope of claims does not satisfy the support requirements violating Regulations under the Patent Act Article 24ter(i) to Article 24ter(iv):

(1) Where for each claim, the statement does not start on a new line, or one number is not assigned thereto (violating Regulations under the Patent Act 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 (violating Regulations under the Patent Act 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 (violating Regulations under the Patent Act 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 (violating Regulations under the Patent Act 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.

## 2.2 Violation of Regulations under the Patent Act Article 24ter(v)

The examiner shall not make inventions pertaining to claims that violate Regulations under the Patent Act Article 24ter(v) and inventions pertaining to claims that cite the said claims the subject to the examination for the requirements other than Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v).

(Explanation)

Regulations under the Patent Act Article 24ter(v) is provided as restriction of the description forms for claims for one of the purposes of reducing the examination workload. To make inventions pertaining to claims in violation of item 5 of the said Article the subject to the examination with respect to the requirements other than Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v) would not only be contrary to the purpose for which Regulations under the Patent Act Article 24ter(v) is provided, but would also contribute to impairing the fairness in the treatment of applications that have been filed in the appropriate description forms for claims and those that have not. Therefore, inventions pertaining to claims in violation of Regulations under the Patent Act Article 24ter(v) shall not be the subject to the examination with respect to requirements other than Article 36(6)(iv), and Regulations under the Patent Act Article 24ter(v).

In addition, even for claims that do not violate item 5 of the said Article, claims that refer to claims that violate item 5 of the said Article (for example, single dependent-form claims that refer to claims that violate item 5 of the said Article) are stated by referring to the statement of claims that violate item 5 of the said Article, and thus inventions pertaining to such claims, for the same reason as above, shall not be the subject to the examination with respect to the requirements other than Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v).

The following (5) is a typical example in which the statement of the scope of claims violates Regulations under the Patent Act Article 24ter(v) and thus violates Article 36(6)(iv).

(5) Where, when a claim is stated referring to a statement of two or more other claims in an alternative way, the claim which it refers is the one which refers to a statement of two or more other claims in an alternative way (violating Regulations under the Patent Act Article 24ter(v))

Example6:

[Claim 1] A ball bearing having a specific structure

[Claim 2] A ball bearing as defined in claim 1 where the inner race is stainless steel

[Claim 3] A ball bearing as defined either in claim 1 or 2 where the outer race is stainless steel

[Claim 4] A ball bearing as defined in any one of claim 1 to 3 that is provided with an annular cushion around the outer race

[Claim 5] A ball bearing as defined in claim 4 where the aforementioned annular cushion is rubber.

(Explain) Claim 4, which is a multiple dependent-form claim in the alternative, is a violation of Regulations under the Patent Act Article 24ter(v) because it refers to claim 3, which is another multiple dependent-form claim in the alternative. Although claim 5 is not a violation of Article 5 of the said Article, it is a claim that refers to claim 4, which violates Article 5 of the said Article. Therefore, the examiner shall not make claim 4 and claim 5 the subject to the examination for the requirements other than Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v).

Example7:

[Claim 1] A ball bearing having a specific structure

[Claim 2] A ball bearing as defined in claim 1 where the inner race is stainless steel

[Claim 3] A ball bearing as defined either in claim 1 or 2 where the outer race is stainless steel

[Claim 4] A process for producing a ball bearing as defined in any one of claims 1 to 3.

(Explain) Although the inventions in claim 3 and claim 4 are in different categories of inventions, claim 4, which is a multiple dependent-form claim in the alternative, is a violation of Regulations under the Patent Act Article 24ter(v) because it refers to claim 3, which is another multiple dependent-form claim in the alternative. The examiner shall not make claim 4 the subject to the examination for the requirements other than Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v).

Example8:

[Claim 1] A ball bearing having a specific structure

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

[Claim 3] A ball bearing as defined either in claim 1 or 2 where the inner race is stainless steel

[Claim 4] A ball bearing as described in claim 3 where the aforementioned stainless steel is ferritic stainless steel.

[Claim 5] A ball bearing as defined in claim 3 where the aforementioned stainless steel is a martensitic stainless steel

[Claim 6] A ball bearing as defined either in claim 4 or 5 where the outer race is stainless steel  
(Explain) Claim 6, which is a multiple dependent-form claim in the alternative, indirectly refers to claim 3, which is another multiple dependent-form claim in the alternative, and thus violates Regulations under the Patent Act Article 24ter(v). The examiner shall not make claim 6 the subject to the examination for the requirements other than Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v).

Example9:

[Claim 1] A bolt having a thread ridge of a specific structure

[Claim 2] A bolt as defined in claim 1 that is made of aluminum alloy

[Claim 3] A bolt as defined in either claim 1 or 2 further with a flange section

[Claim 4] A nut having a thread groove of a specific structure

[Claim 5] A nut as defined in claim 4 that is made of aluminum alloy

[Claim 6] A nut as defined in either claim 4 or 5 further with a flange section

[Claim 7] A fastening device comprising a bolt as defined in any one of claim 1 to 3, and a nut as defined in any one of claims 4 to 6.

(Explain) Claim 7, which is a multiple dependent-form claim in the alternative, is a violation of Regulations under the Patent Act Article 24ter(v) because it refers to claims 3 and 6, which are other multiple dependent-form claims in the alternative. The examiner shall not make claim 7 the subject to the examination for the requirements other than Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v).

In Example9 above, if claim 7 cites claims 3 and 6 only, claim 7 shall not be a violation of Regulations under the Patent Act Article 24ter(v) because it does not fall under the category of multiple dependent-form claims in the alternative.

### 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.

If the examiner determines that there are claims that violate Regulations under the Patent Act Article 24ter(v), the examiner shall, in addition to stating the reasons for refusal, clearly indicate in the Notice of Reasons for Refusal the inventions that are not the subject to the examination with respect to the requirements other than Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v), and state the reasons why they are not the subject to the examination.

In addition, where there is a claim referring to a claim that violates Regulations under the Patent Act Article 24ter(v), the reason for refusal of the claim shall not be notified, but the invention not being subject to examination with respect to the requirements other than Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v) shall be clearly indicated and the reason for not being subject to examination shall be stated.

### 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.