

38-01 P

Group of Claims

1. Group of Claims

A group of (1) a claim whose statement is corrected and (2) dependent form claims (dependent claims) are referred to as a "group of claims." The relation forming a group of claims is provided in Patent Act Article 120-5 (4) and Regulations under the Patent Act Article 45-4.

In order to identify a "group of claims," it is first necessary to identify a claim whose statement is corrected out of the claims before the correction and then to identify all the dependent form claims (dependent claims) that directly or indirectly cite the claim whose statement is corrected in the citation relation before the correction. As such dependent form claims (dependent claims) in general include the correction items of the claim whose statement is corrected, they shall be handled as those corrected in conjunction with the claim whose statement is corrected, irrespective of whether statements of the dependent form claims (dependent claims) are corrected.

Example: Assuming the scope of claims consists of Claim 1 and Claim 2 that cites Claim 1 and the statement "A" in Claim 1 is corrected to "A'." In such case, Claim 2 is also corrected in conjunction with the correction item that corrects the statement of Claim 1. Therefore, Claims 1 and 2 constitute a "group of claims" (Figure 1).

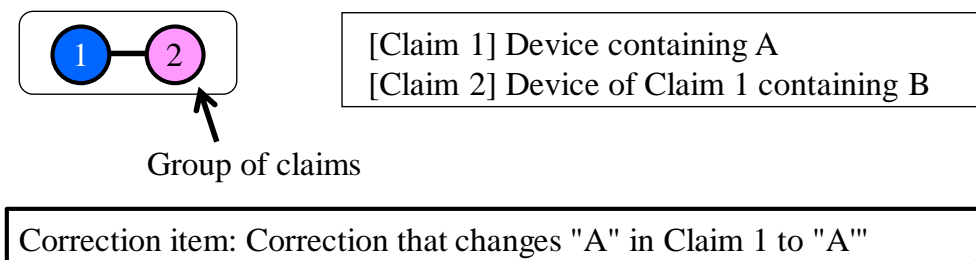


Figure 1 Basic idea of a "group of claims"

A "group of claims" is identified based on the citation relation before a correction, and it consists of a group of claims that are corrected in conjunction with a correction item. Therefore, it should be noted that even if claims have the citation relation before a correction, they do not constitute a "group of claims" unless they are subject to a correction item.

Example: Assuming the scope of claims consists of Claim 1, Claim 2 that cites Claim 1, and Claim 3 that cites Claim 2 and the statement "B" in Claim 2 is corrected to "B'." In such case, Claim 3 is corrected in conjunction with the correction item that corrects the statement of Claim 2. Therefore, Claims 2 and 3 constitute a "group of claims." However, Claim 1 that is not subject to the correction item does not constitute a "group of claims" because it is not corrected in conjunction with the correction item that corrects the statement of Claim 2 even though it has the citation relation with Claim 2 before the correction (Figure 2).

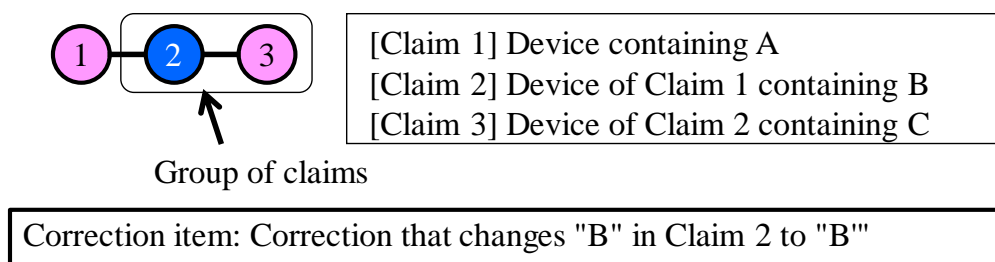


Figure 2 Example where there is a claim that does not constitute a "group of claims"

Where there are multiple "groups of claims" that are identified as above and there are two or more "groups of claims" that include a claim in common (the scope is partially redundant), these "groups of claims" are combined to form one "group of claims" (Regulations under the Patent Act Article 45-4).

Example: Assuming the scope of claims consists of Claim 1, Claim 2, and Claim 3 that cites Claim 1 or 2, and corrections are made with regard to Correction Item 1 that corrects the statement "A" in Claim 1 to "A'" and Correction Item 2 that corrects the statement "B" in Claim 2 to "B'." In such case, as explained above, Claims 1 and 3 constitute a "group of claims" and Claims 2 and 3 also constitute a "group of claims." In this case, these groups of claims that include Claim 3 in common are combined, and Claims 1 to 3

form one "group of claims" (Figure 3).

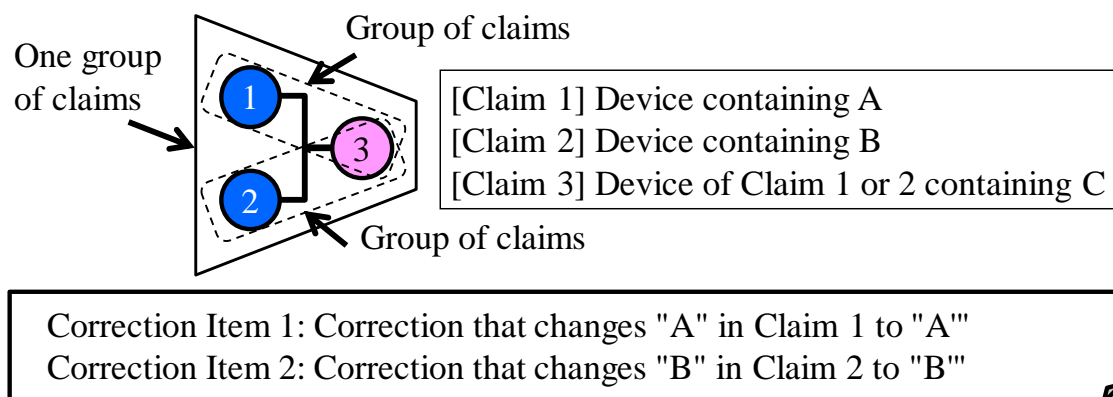


Figure 3 Example where two or more "groups of claims" are combined

2. Request that a Claim Be a Different Unit of Correction

If a correction that dissolves the citation relation between claims (correction that rewrites a claim that cites the statement of another claim to a claim that does not cite that the said statement of another claim), a correction that deletes a dependent form claim (dependent claim), a correction that reduces the number of cited claims in relation to a claim that cites multiple claims, etc. is made, the citation relation between the claims may be dissolved after the correction in some cases.

Based on the purport of introduction of correction intended for rewriting a claim that cites the statement of another claim to a claim that does not cite the said statement of another claim (Patent Act Article 120-5 (2) (iv), Article 126 (1) (iv), Article 134-2 (1) (iv)) through legal revision of 2011, in a case where a correction that dissolves the citation relation, etc. is made for a specific claim that constitutes a "group of claims" in the citation relation before the correction, the correction item concerning the said specific claim shall be handled as a different unit of correction from the "group of claims" if the prescribed request is made.

Such request shall be called a "request that a claim be a different unit of correction."

If a "request that a claim be a different unit of correction" is made for a correction item concerning a specific claim, the correction item concerning the said specific claim can be independently allowed without being affected by determination of whether or not

to allow other corrections concerning the "group of claims." In this manner, the said specific claim for which a "request that a claim be a different unit of correction" was made is handled as a different unit of correction from other corrections concerning the "group of claims." Therefore, a trial decision, etc. shall become final and binding for the said specific claim without being affected by the "group of claims."

Example: Assuming the scope of claims consists of Claim 1 and Claim 2 that cites Claim 1, and corrections are made with regard to Correction Item 1 that corrects the statement "A" in Claim 1 to "A'," Correction Item 2 that corrects Claim 2 that cites Claim 1 to an independent form claims (independent claims) (correction that dissolves the citation relation), and Correction Item 3 that corrects the statement "B" in Claim 2 to "B" (Correction Items 2 and 3 are considered as one correction item without being separated in some cases), and Correction Item 1 falls under an addition of a new matter, etc. and violates the requirements for correction (Figure 4).

In case where a "request that a claim be a different unit of correction" is not filed for Correction Items 2 and 3 concerning Claim 2, Claims 1 and 2 constitute a group of claims. Therefore, Correction Items 2 and 3 are also handed as correction items that are integral with Correction Item 1. Consequently, the corrections shall not be allowed, and a trial decision, etc. shall become final and binding in an integral manner for Claims 1 and 2 that constitute a group of claims. On the other hand, where a "request that a claim be a different unit of correction" is filed, the correction items concerning Claim 2 are handled based on a different unit of correction from other claims constituting the "group of claims" if Correction Items 2 and 3 fulfill the requirements for correction. Therefore, Correction Items 2 and 3 shall be allowed independently of a determination concerning Correction Item 1, and a trial decision, etc. shall become final and binding independently of Claim 1.

However, even where Correction Item 1 itself is allowed, if Correction Item 3 concerning Claim 2 is not allowed, Correction Item 2 concerning Claim 2 will not be allowed as well in an integral manner. This will also cause a "request that a claim be a different unit of correction" for Claim 2 not to be allowed. Furthermore, since a "request that a claim be a different unit of correction" is not allowed, Correction Item 1 concerning Claim 1 that constitutes a "group of claims" together with Claim 2 will not be allowed as

well in an integral manner.

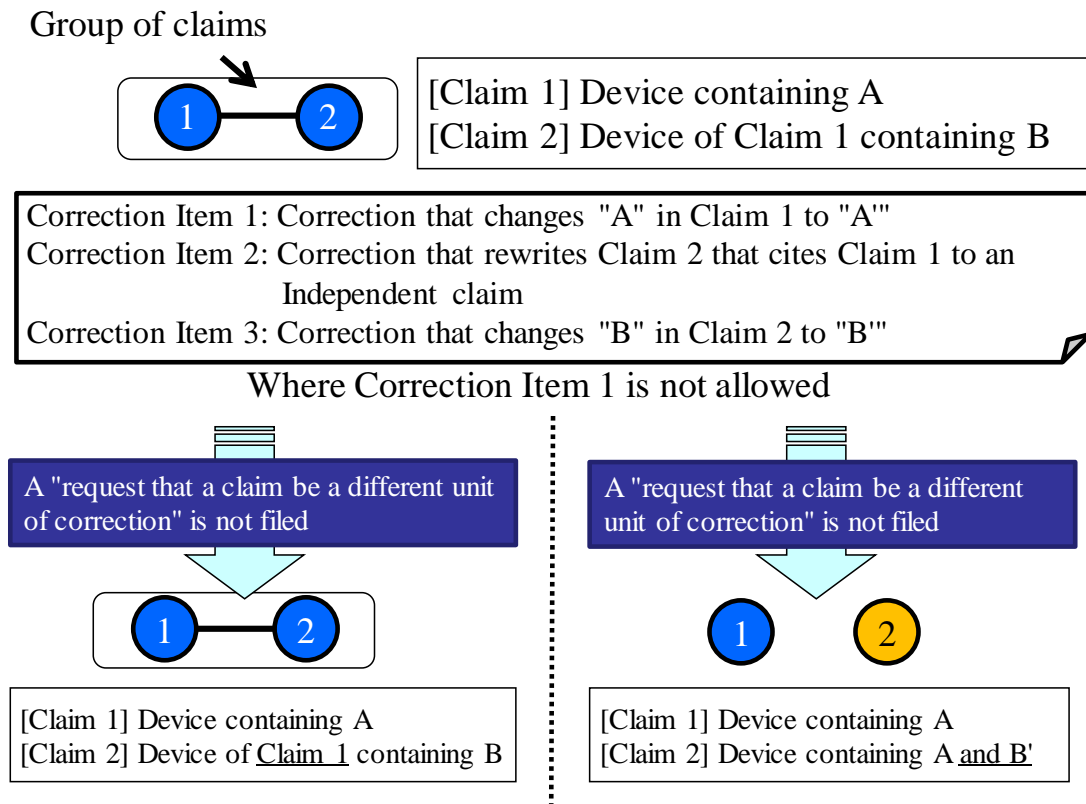


Figure 4 Effect of a "request that a claim be a different unit of correction"

As this "request that a claim be a different unit of correction" is allowed as an exception to a "group of claims" upon request of the patentee, it must be clearly stated in a written request for a trial for correction or written request for correction in a trial for invalidation, etc. That is, it is considered that an integral determination of whether or not to allow a correction is desired as a "group of claims" if a "request that a claim be a different unit of correction" is not filed even where a correction that dissolves the citation relation, etc. is made.

3. Remark for Procedures

A "request that a claim be a different unit of correction" shall be stated in the "Reasons for the request" column in a written request for a trial for correction or written request for correction (→ 38-04, 2.(3)C.).

Where there are any deficiencies in a request that a claim be a different unit of

correction, the chief administrative judge shall order the patentee to make an amendment within a reasonable time limit (normally 30 days → 25-01.5).

(Revised Sep. 2018)