Japan
New examination practice: changes under the new Patent Law

The new examination practice under the Patent Law, which came into force on April 1 2007, has already had a significant impact on procedures such as claim drafting, preparation of amendments and filing of divisional applications. This chapter reviews the new examination practice and considers the restrictions on amendments imposed by the amended Patent Law.

Restrictions on claim amendments under the Patent Law
The restrictions on amendments to claims imposed by the revised Patent Law can be summarised as follows.

The restrictions imposed by the new law apply only to those amendments submitted in response to a first office action (and therefore not to voluntary amendments submitted before such an action). Claims altered by amendments submitted in response to a first office action must share unity of invention with the claims already examined in the first office action (Article 17bis(4) of the Patent Law). If some claims have been examined and rejected, and others were unexamined in the first office action as lacking unity of invention, the amendments submitted in response to the first office action are limited to the examined claims.

Unity of invention is achieved when two or more claims have a common patentable technical feature (Article 25-8). Therefore, if an independent claim is deemed to be patentable, all the claims dependent on that independent claim will satisfy the unity of invention criterion. However, if an independent claim does not have a patentable feature and is therefore rejected, the claims dependent on that independent claim will lack unity of invention. Unity of invention is satisfied by inventions belonging to different categories if they satisfy certain relationships (e.g., a product and a method suitable for making the product, or a product and an apparatus suitable for making the product). Whether more than one claim has unity of invention is determined according to the following procedure:

- If Claim 1 is patentable:
  - other independent claims having the same patentable technical features as Claim 1 are deemed to have unity of invention; and
  - claims dependent on Claim 1 or other independent claims having unity of invention with Claim 1 are considered, in general, to have unity of invention.

- If Claim 1 is not patentable:
  - other independent claims do not have unity of invention since there is no patentable technical feature; and
  - claims dependent on Claim 1 or other independent claims do not have unity of invention since there is no patentable technical feature.

Claims examined in first office action
The examination standards provide that the examiner shall examine Claim 1 and other claims with unity of invention (having a common patentable feature) together with Claim 1, and shall not examine claims with no unity of invention. However, as an exception, even if Claim 1 is to be rejected, the claim with the lowest reference number among the claims directly dependent on Claim 1 shall be examined, and even if the dependent claim is also to be rejected, the claim with the lowest reference number among the claims dependent thereon shall be examined, and so on. Claims to be examined in the first office action are determined according to the following procedure:

- If Claim 1 is patentable, all claims with unity of invention are examined.
- If Claim 1 is unpatentable:
  - Claim M (M being the lowest reference number among those dependent on Claim 1), belonging to the same category and having a new feature (either an additional feature or a feature which
narrowed the cited feature) in addition to all features recited in Claim 1, is examined;
• if Claim M is patentable, all claims having the same patentable technical feature are examined; and
• if Claim M is unpatentable, Claim N (N being the lowest reference number among those dependent on Claim M), belonging to the same category and having a new feature (either an additional feature or a feature which narrows the cited feature) in addition to all the features recited in Claim M, is examined.

This procedure is repeated until a patentable claim is found or a dependent claim on which no other claim is dependent is examined.

This examination procedure is illustrated by Figure 1 below.

Claim 1 is examined first. If Claim 1 lacks a patentable technical feature, Claim 2, having additional features to those cited in Claim 1, is examined. Claim 6 is not examined, even though it also has additional features to those cited in Claim 1, because Claim 6 does not have the lowest reference number among those dependent on Claim 1 (Claim 2 has the lowest reference number). If Claim 2 lacks a patentable technical feature, Claim 3 is examined, while Claims 4 and 5 remain unexamined. If Claim 3 is found to have a patentable technical feature, all claims dependent on Claim 3 (i.e., Claims 7, 8 and 9) are examined, since they have the same patentable technical feature as Claim 3. Furthermore, the claims with the same patentable technical feature as Claims 3, 7, 8 and 9, but belonging to different categories, are examined.

If there are independent claims in the same category as Claim 1, they will be examined only if Claim 1 and the other independent claims have a common patentable technical feature. If there are independent claims in categories other than Claim 1, the independent claims will be examined only if Claim 1 is patentable and the independent claims have a relationship specified in the examination standards (e.g., a product and a method suitable for making the product). If there are dependent claims depending on the independent claim belonging to a different category, the dependent claims are examined even if the independent claims are not, as long as their counterpart dependent claims stemming from Claim 1 are found to have a patentable technical feature.

**Exception to restrictions on amendments**

No amendments will be allowed under the restrictions if all claims examined in the first office action lack a patentable technical feature. Even further narrowing of the narrowest examined claim is impossible, because there can be no common patentable technical feature as the narrowest examined claim has no patentable technical feature. In order to avoid this deadlock, the examination standards indicate that claims submitted in response to the first office action will be examined as if they had been submitted before the first office action—that is, claims which, if submitted earlier, would have been examined in the first office action may be submitted as amendments. In other words, the amendments in response to the first office action are limited to further narrowing of the narrowest examined claims.

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**Figure 1: Claim construction and object of examination**

Solid lines connecting the claims indicate the dependency of the claims.
- - - - - Indicates the claims that are examined as to whether they have a patentable technical feature after Claim 1 is found to be unpatentable.
--- --- Indicates the claims whose substantive patentability is examined.
Violation of restrictions on amendments

In the scenario described in Figure 1, if Claim 4, 5 or 6 is submitted in response to the first office action as an amendment, the amendment violates the requirements of Article 17bis(4) and is therefore rejected. Furthermore, the office action rejecting the amendments will automatically be a decision to reject even if patentable claims are included in the amended claim set, because the amendments will be rejected as a whole; as a result, the reasons for rejection communicated by the first office action still stand.

Influence on divisional applications

In the scenario described in Figure 1, the only way to have Claims 4 to 6 examined is to file a divisional application. However, if the reason for rejection already communicated in the office action issued on the parent application is maintained in the divisional application, the first office action issued on the divisional application will be a final office action, thus limiting the amendments to the following actions:

- cancellation of the claim or claims referred to in Section 36(5);
- amendments to ensure that all or some of the matters necessary to define the invention claimed in the claim or claims under Section 36(5), as well as the industrial applicability of and the problem to be solved by the invention claimed in the amended claim or claims, are the same as those of the invention claimed in the claim or claims prior to the amendment;
- the correction of errors in the description; and
- the clarification of an ambiguous description.

Dealing with restrictions

In view of the narrower interpretation of unity of invention and the restrictions on amendments, claims and responses should be formulated more carefully.

Claim structure

Claim 1 may be broad enough that an inventive step is not guaranteed as long as the dependent claims are in an appropriate sequence. As set out by the examination procedure shown in Figure 1, all dependent claims sequentially dependent on Claim 1 are examined in all cases.

When submitting more than one independent claim, the claim on which the largest number of claims depend should be Claim 1. Even if Claim 1 is unpatentable, if one or more of the claims dependent on Claim 1 is patentable, the claims dependent on other independent claims with the same patentable technical feature are also examined. If, however, Claim 1 does not have dependent claims and Claim 1 is unpatentable, no other claims will be examined.

When two or more dependent claims separately depend on a preceding claim (ie, dependent claims such as Claims 2 and 6, Claims 3 and 4 or Claims 7 and 8 in Figure 1), the dependent claim having most claims dependent thereon should have the smaller reference number. Dependent claims with larger reference numbers are examined only if the preceding claim on which the dependent claims are dependent has a patentable technical feature.

More detailed technical features should be described in the specification for the narrowest claim in sequence from Claim 1. If all the claims are rejected, amendments can add technical features only to the narrowest claim in sequence from Claim 1. In such cases, features cannot be added to the unexamined claims or the claims other than the narrowest claim in sequence from Claim 1.

Response to first office action

Unexamined claims dependent on claims that have been examined and rejected in the first office action cannot be submitted in the amendments. In the example shown in Figure 1, Claim 6 does not have unity of invention because Claims 1 and 6 cannot have a patentable technical feature as long as the patentable technical feature of Claim 1 is denied. The situation is the same for Claims 4 and 5. There is no way to submit claims dependent on a rejected claim, unless the rejection of the claim is overcome by the remarks. The exceptions to restrictions on amendments described above do not apply to these claims because they are not dependent on the narrowest examined claim.

If all the claims are rejected, only claims further narrowing the narrowest examined claim are allowed. Claims adding features to claims other than the narrowest examined claim would not have been examined in the first office action even if such claims had existed in the original application. Therefore, amendments that add features to claims other than the narrowest examined claim will be rejected as violating the restrictions on amendments.

A divisional application must be filed in order to have the unexamined claims examined. Filing a divisional application is the only procedure by which to have unexamined claims examined, unless the lack of patentability of the preceding claim on which an unexamined claim is dependent is overruled by the decision.

Voluntary amendments should be filed, where necessary, before receipt of the first office action based on the examination in other countries. The restrictions on
Yoshitaka Sonoda has a technical background in physics and electronics and received his PhD from the University of Tokyo for his studies on transient vibration of non-linear systems. He is fluent in both English and French, skills that were acquired through his experience as a researcher at the Saclay Nuclear Research Center of the French Atomic Energy Commission and his frequent visits abroad. Mr Sonoda entered the IP field in 1987.

Examination in other countries, it is advisable to revise the Japanese claims so as to ease the subsequent examination procedure.