

JIPA Comments on EPO's online consultation on how Rule 36 ought to be amended.

- 1. How has the introduction of the time limits for filing divisional applications affected you? (It would be useful to learn about your background and / or your professional activity, as well as to get some insights into the extent to which your comments are the result of direct experience)**

Dear Sirs,

We, the Japan Intellectual Property Association, are a private user organization established in Japan in 1938 for the purpose of promoting intellectual property protection, with about 900 major Japanese companies as members. When appropriate opportunities arise, we offer our opinions on the intellectual property systems of other countries and make recommendations for more effective implementation of the systems. We would like to offer our comments as follows. Your consideration of them would be greatly appreciated.

Sincerely yours

Takeshi Ueno

President

Japan Intellectual Property Association

There are some cases where we have to file a divisional application as a precautionary filing, when the parent application is still pending. This has resulted in an increase of cost and workload for due date management for the applicants as well as an increase of workload for monitoring divisional applications for third parties.

- 2. What is your overall assessment of current Rule 36 EPC?**

We think that it will not bring any benefits to either applicants or third parties. Furthermore, it is not user-friendly, because there are many base dates that must be reckoned.

- 3. What are, in your opinion, the most positive aspects of the current regime? Would it be possible to reinforce them? How?**

We don't foresee any positive aspects.

- 4. Are there aspects of the Rule you think should be reconsidered? For example, should the time limits be extended from 24 to 48 or 60 months?**

Because the consideration for divisional applications is influenced by the term of the examination for the parent application or the status of the parent application which are variable and unpredictable, discussion at the total term is not useful. The extension of the term does not seem to address the above problems.

We think that Rule 36 should be returned to the former rule. That is to say, the term should be based on the

pending term of the parent application. From the view of harmonization, the EPO should refer to the rule in other countries regarding the term for divisional applications.

5. Do you think that further amendment of the Rule would help to optimise it? If so, could you please outline your preferred option?

No, we don't. It is difficult for the users to understand even the current rule.

6. What kind of action other than legal measures (e.g. administrative or financial ones) do you think the EPO could take that would effectively address the issue of divisionals filed merely in order to prolong pendency?

We think that the EPO should shorten the term of examination.