

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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Jorma Hanski  
Chairperson of the BOAC  
Carl Josefsson  
President of the Boards of Appeal  
European Patent Office  
Richard-Reitzner-Allee 8 | 85540 Haar | Germany

Re: JIPA Comments on the proposed amendments to the Rules of Procedure of the Boards of Appeal to further enhance the timeliness of appeal proceedings

Dear Chairperson Jorma Hanski and President Carl Josefsson,

We, the Japan Intellectual Property Association “JIPA”, are a private user organization with about 990 major Japanese companies as members. When appropriate opportunities arise, we offer our opinions on the intellectual property system of other countries and make recommendations for more effective implementation of the systems. Having learned a consultation, the proposed amendments to the Rules of Procedure of the Boards of Appeal to further enhance the timeliness of appeal proceedings, we would like to offer our opinions as follows.

Your consideration on our opinions would be greatly appreciated.

Sincerely yours,



Akitoshi YAMANAKA  
Vice President  
Japan Intellectual Property Association

## **JIPA's comments on the draft proposed amendments to the Rules of Procedure of the Boards of Appeal**

We, as applicants, feel that the EPO's objectives of "reducing the number of pending cases to below 7,000 and settling 90% of cases within 30 months by 2023" is beneficial. We welcome the intention of the Boards of Appeal to pursue more ambitious and timeliness objectives in the future.

With respect to the draft amendments, currently proposed, to the Rules of Procedure of the Boards of Appeal, we have requests described below.

We are against the amendment to Article 12(1)(c). Reasons are shown below.

The first reason is that two months is too short as a period to prepare a written reply of "the other party." Our understanding is that in an appeal, a new assertion or discussion in the middle of the appeal after submission of a written reply is not permitted as a general rule. Thus, contents of the written reply are the most important to "the other party", and the step to study the contents of a previous decision and the contents of an assertion, and prepare the written reply requires a lot of time.

Further, even though there exists such a general rule, if a new assertion or evidence is actually submitted for the grounds of appeal, "the other party" will have to study contents thereof or the validity of submission thereof at the stage of the appeal during the preparation of the written reply.

Furthermore, for applicants residing in states outside the EPC, they spend a lot of time for discussion with local agents due to differences from a patent system of a state of residence, and they need a time for translation or the like if they are in the non-English-speaking world (for example, if an appeal is filed in German, it is believed that many of Japanese companies have to prepare documents translated in both English and Japanese).

The second reason is that an imbalance of fairness between "appellant" and "the other party" will occur. According to Article 108 of the EPC, a period of four months of notification of the decision of the Opposition Division is ensured for the appellant to study contents of assertion for the grounds of appeal. Meanwhile, according to the existing Article 12(1)(c), the same period of four months as above for the appellant is ensured for "the other party" as a counterpart to study contents of argument against the grounds of appeal. We consider that the fairness is maintained. However, if a period for "the other party" to prepare a written reply is shortened from four months to two months as currently proposed in the draft proposed amendment of this time, we have an impression that an imbalance would occur toward a disadvantageous state to "the other party."

Before the currently proposed amendment, Article 12(7) has stipulated that the period for "the other party" to prepare a written reply may be extended up to a maximum of six months. However, this extension is exceptional and it is at the Board's discretion. It is believed that the fairness is not guaranteed unless a decision by such discretion is based on the uniform criteria. Thus, we, as users, feel reluctant to positively utilize this provision for extension and we hope

to maintain the existing provision of Article 12(1)(c), which stipulates that the period to prepare a written reply is four months.

END