



JAPAN PATENT ATTORNEYS ASSOCIATION

3-4-2, Kasumigaseki Chiyoda-ku, Tokyo 100-0013, JAPAN
Telephone: + 81-3-3581-1211 / Facsimile: +81-3-3581-9188
<http://www.jpaa.or.jp>

European Patent Office

March 28, 2013

Re: JPAA's Comments regarding divisional applications (Rule 36 EPC)

Dear Sirs:

The Japan Patent Attorneys Association (JPAA) is a professional association of more than 9,600 patent attorneys practicing intellectual property law in Japan. Its members practice in all areas of intellectual property law including copyright and unfair competition as well as patent, trademark, and design laws; many of whom are capable of representing clients in infringement lawsuits.

The JPAA would like to offer some comments regarding divisional applications (Rule 36 EPC), since your organization is currently soliciting public comments on your website. The JPAA appreciates this opportunity to present our opinions.

We support the opinions expressed in the document entitled "epi Position on Rule 36 EPC" prepared by the Council of epi.

It is understood that ultimately, the objective of Rule 36 EPC is to "achieve an optimum balance between the legitimate interest of applicants in obtaining full protection for their inventions and the need to establish a clear cut-off point providing third parties with necessary legal certainty." The introduction of 24-month time limits for filing divisional applications, however, resulted in an increase of the overall number of divisional applications, causing remarkable growth in first-generation divisional applications. Such remarkable growth in first-generation divisional applications is an indication of legitimate interest of applicants in obtaining full protection for their inventions. However, the effect of the amendment on avoiding divisionals as a tool to prolong the pendency of the subject-matter before the EPO is uncertain. We suspect that the intended objective of the EPO has not been achieved, and, more importantly, we have a concern about a negative impact on legitimate interests of applicants to obtain full protection for all inventions contained in the originally filed application. Moreover, Rule 36 EPC does not work for third parties or the EPO, as pointed out in the document

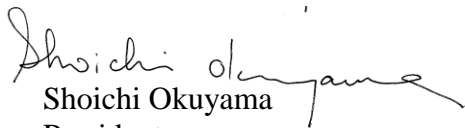


prepared by the Council of epi.

We, therefore, believe that the Rule 36 EPC should be amended to revert it to its previous wording, i.e. allowing divisional applications to be filed while the parent European patent application is still pending.

Further, some members of JPAA have additional opinions as follows: In order to avoid an unnecessary increase in divisional applications that unity of the invention requirements should be considered, as well as simplification of Rule 43(2) EPC for the applicant. Since only one independent claim is permitted in each category because of Rule 43(2) EPC, for example, when a patent application includes two independent claims that belong to the same category, an applicant is invited to select one of these independent claims for search even though the applicant may argue that the application complies with the rule. The present examination practice is so strict that his or her argument is rarely accepted. This represents an excessive burden on applicants who do not have enough funds, such as SMEs, individuals, and venture companies. On the contrary, in the U.S., for example, an applicant is not required to select one of independent claims, each of which belongs to the same category in a patent application, to restrict his/her subject matter unless the independent claims are classified to the same patent classification.

Very truly yours,


Shoichi Okuyama
President
Japan Patent Attorneys Association