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## **STANDING COMMITTEE ON THE LAW OF PATENTS**

**Fourteenth Session**

**Geneva, January 25 to 29, 2010**

**OPPOSITION SYSTEMS\***

*Document prepared by the Secretariat*

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\* Comments received from Members and Observers of the SCP on this document are available at:  
[http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=154137](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=154137)

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## EXECUTIVE SUMMARY

1. The present document is a preliminary study which addresses patent opposition systems. It contextualizes various aspects relating to existing opposition systems in a comprehensive manner, and contains no conclusions.
2. Following a general introduction, Chapter II provides an overview of opposition systems as they exist in many countries. While illustrating that national opposition systems vary from one country to the other, it describes general characteristics of the opposition systems in patent proceedings.
3. Chapter III describes the objectives of opposition systems and their role in the proper functioning of the patent system. Costs and benefits are described from the view point of quality and validity of patents, as well as of efficiency and effectiveness of patent procedures.
4. Chapter IV looks specifically into international agreements. While no international treaty regulates patent opposition systems *per se*, some provisions relating to procedural aspects in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) and the Patent Law Treaty (PLT) may also be applicable to opposition procedures.
5. Chapter V describes the national/regional laws and practices of Brazil, Egypt, India, the European Patent Office (EPO) and the Eurasian Patent Office (EAPO) as concrete examples of different opposition systems.
6. Chapter VI finally provides some other mechanisms that are related to opposition systems, namely, re-examination systems applied in some countries and third party observations mechanisms. They are not opposition systems *stricto sensu*. However, with respect to the shared objective of increasing the quality of granted patents by taking into account the wider knowledge of the general public, they are included in this document with a view to providing supplementary information.

## I. INTRODUCTION

7. At its thirteenth session which was held from March 23 to 27, 2009, in Geneva, the Standing Committee on the Law of Patents (SCP) asked the WIPO Secretariat to establish, for the next session of the SCP, preliminary studies on two additional issues, namely, transfer of technology and opposition systems.

8. It is understood by the Committee that these issues are not to be considered prioritized over other issues contained on the list which was established during the twelfth and thirteenth sessions of the SCP and was contained in the Annex to document SCP/13/7 (see paragraph 8(c) of document SCP/12/4 Rev.).

9. Accordingly, this document has been prepared by the Secretariat as a preliminary study on the issue of opposition systems for the fourteenth session of the SCP, to be held from January 25 to 29, 2010.

10. The present document primarily addresses traditional opposition systems, which are *inter partes* procedures, under which an opponent challenges the patentability of inventions and the applicant (or the patentee) is given an opportunity for rebuttal. However, with respect to the shared objective of increasing the quality of granted patents by taking into account the wider knowledge of the general public, related mechanisms, such as re-examination systems and mechanisms that allow third parties to submit prior art information to a patent office, are also briefly described in Chapter VI.

11. At the twelfth session of the SCP, it was clarified that the *modus operandi* of the Committee, namely, to move forward along a number of tracks, including the preparation of preliminary studies, was agreed upon for the purpose of developing a work program of the SCP (see paragraph 123 of document SCP/12/5 Prov.). In view of this specific background, this preliminary study contextualizes various issues relating to opposition systems in a holistic manner, and contains no conclusions.

## II. OVERVIEW OF OPPOSITION SYSTEMS

12. Many countries provide opposition mechanisms in their patent systems. Opposition systems offer third parties the opportunity to oppose the grant of a patent within a certain period of time provided by the applicable law. An opponent must allege at least one of the grounds for opposition among those that are prescribed in the applicable law. Opposition procedures are closely related to the patent granting procedure. An opposition may be requested soon before the grant of a patent (pre-grant opposition) or after the grant of a patent (post-grant opposition). India, for example, provides both a pre-grant and a post-grant opposition system. One of the main objectives of the opposition system is to provide a simple, quick and inexpensive mechanism that ensures the quality and validity of granted patents by allowing an early rectification of invalid patents. In general, opposition proceedings are conducted before the patent office, not a court. In some patent offices, they are held before a special opposition board.

13. Pre-grant opposition often starts once the examination of a patent application has been completed by a positive result. The Office publishes its intention to grant the patent on the claimed invention contained in the application, and provides a certain time period during which an opposition can be filed. The opponent shall state the grounds for opposition and

submit any evidence. If no opposition is filed during that period, the patent will be granted. If an opposition is filed, the applicant will be notified of that fact, together with the grounds for opposition and the evidence (for example, prior art documents that demonstrate lack of inventive step). The applicant will be given the opportunity to comply with the requirements under the applicable law, and to make observations, within the prescribed time limit. In accordance with the applicable law, the opponent has the possibility to respond to the observations made by the applicant. Based on the submissions by the opponent and the applicant, an examiner or any other person entrusted to decide on opposition cases under the applicable law will make a decision as to whether the patent shall be granted or not.

14. Post-grant opposition starts once the patent is granted. Once the fact that a patent has been granted is published, an opposition may be filed with evidence within a certain time period prescribed in the applicable law. Similar to the pre-grant opposition, the patentee will be notified about that fact, and be given the opportunity to comply with the requirements under the applicable law, and to make observations, within the prescribed time limit. In accordance with the applicable law, the opponent has the possibility to respond to the observations made by the patentee. Based on the submissions by the opponent and the applicant, whoever is entrusted to decide on opposition cases under the applicable law will make a decision as to whether the patent shall be maintained or revoked.

15. Since one of the objectives of the opposition system is to provide a simple mechanism to ensure the quality and validity of granted patents, in many national laws, any party, including the applicant or the patentee, may file an opposition. However, some laws provide that any third party (excluding the applicant or the patentee) may file an opposition. In many countries, the payment of an opposition fee is required to file an opposition.

16. An appeal against the final decision of the opposition body is generally possible, often to a court. It should be noted that, according to Article 62.5 of the TRIPS Agreement, administrative decisions shall be subject to review by a judicial or quasi-judicial authority. The number of patent applications/patents with respect to which oppositions are filed is not very high. The opposition rates at the European Patent Office (EPO), the German Patent Office and the Korean Intellectual Property Office are 6.0%, 4.6% and 1.3%, respectively, in 2007.<sup>1</sup>

### III. RATIONALE AND OBJECTIVES

17. The patent system intends to promote innovation by granting a limited exclusive right to prevent others from using a patented invention without the consent of the patent owner and, at the same time, requiring the patent owner to fully disclose the invention to the public. In order to meet this objective, the patent law lays down strict requirements, both procedural and substantive, to obtain patent protection. Those requirements are fundamental to a functioning patent system, as they were created in order to ensure that only those inventions that are “worth” protecting for the purposes of facilitating innovation and meeting the broad public interest would obtain patent protection.

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<sup>1</sup> WIPO Statistics Database. The opposition rate is calculated based on the number of opposition filed and the number of patents granted in 2007.

18. However, in reality, it may nevertheless happen that an invention that does not fully meet the requirements under the applicable law obtains a patent. For example, a substantive examiner may overlook a piece of prior art and inadvertently reach a positive decision regarding the patentability of the claimed invention. Such a situation should not be necessarily considered as low quality examination, since the piece of prior art could be published in an exotic language or in an isolated publication. In order to rectify the grant of a deficient patent, in general, a patent revocation procedure is provided either before a competent court or before an administrative/quasi-judicial body the decision of which can be reviewed by a judicial body. The opposition system provides an additional administrative layer of review that prevents the grant of invalid patents through the participation of third parties to the review process. The idea is that the participation of third parties, who may be well informed about the technology concerned, would complement the resources available to the patent office, and would increase the credibility of granted patents. Since the opposition procedure is provided just before or after the grant of the patent, it allows an early rectification of invalid patents. The possibility to rectify invalid patents at an early stage may be also beneficial for a patentee, since the patentee can have more trust in the validity of his patent.

19. Compared with a review process before a court, the opposition system has various advantages. They include:

- (i) the opposition procedure, which is an administrative process, is generally simpler, quicker and less expensive;
- (ii) an opposition may be filed by any person (or any third party), while a patent revocation procedure may, in some countries, be initiated only by a party who fulfills certain conditions, for example, being an interested party or being adversely affected by the decision subject to the appeal. Therefore, the opposition system takes into account the wider knowledge of the general public;
- (iii) the decision of an opposition board is made by examiners and other officers with technical expertise, while a judge may not always be familiar with the technology concerned.

20. While the primary purpose of opposition systems is to ensure that patents are not granted to creations which do not meet the patentability requirements, they also target another important objective, which is to safeguard the scope of information in the public domain.<sup>2</sup> Although revocation proceedings are available, the grant of patents of unsatisfactory quality may have a limiting effect on the public domain. In other words, once a patent is erroneously granted, the claimed invention, which otherwise would remain in the public domain, can be used by others only with the authorization of the patentee.

21. On the other hand, the opposition system also incurs costs, and is not always free from criticism. First, in order to set up an opposition procedure, the administration

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<sup>2</sup> Recommendations 16 and 20 of the WIPO Development Agenda touch upon the public domain issues.

(the patent office) needs to have relevant resources, such as technically qualified examiners who are capable of reviewing the initial decision.<sup>3</sup>

22. The major challenge in designing an opposition procedure, however, is that it could substantially delay the whole process of finalizing the grant of a patent. Where a number of oppositions based on different items of prior art and on different grounds are filed, the applicant (or the patentee) shall argue against each opponent, and shall defend his invention. Since anyone can file an opposition, a great number of oppositions could be filed in complex cases.<sup>4</sup> On the one hand, a pre-grant opposition system supports legal certainty by allowing a pre-review of the patentability of an invention by third parties before granting the patent. In other words, it increases the validity of granted patents. On the other hand, the pre-grant opposition period holds all other applications pending before the office, which will never be opposed. In practice, only a small number of applications are opposed. Consequently, there is an inevitable delay in granting patents. While the post-grant opposition system does not extend the period between the filing of the application and the grant of the patent, during the opposition period, the enforceability of the granted patent is uncertain. In short, policy makers need to consider two elements: on the one hand, an additional review process may have a positive effect on the promotion of innovation by increasing the quality and the validity of granted patents. On the other hand, such an additional process may have a negative effect on the promotion of innovation by delaying the granting process.

23. The changes made in the Japanese opposition system during the past 15 years are interesting from the above policy perspective. Prior to 1994, the Japan Patent Law provided a pre-grant opposition system which allowed the public to complement the examination by substantive examiners. However, concerns over the delay in granting a patent became stronger, and in 1994, the pre-grant opposition system was replaced by a post-grant opposition system. Consequently, two mechanisms to challenge the validity of granted patents coexist in Japan, i.e., a post-grant opposition system and an administrative appeal for revocation of a patent. The post-grant opposition can be filed by anyone within six months from the date of patent registration. However, the opponent can not fully participate in the review process, which is conducted between the patent office and the patentee. The system was designed so that the patent office reviews its prior decision based on the evidence provided by the opponent and the counter-argument, if any, submitted by the patentee. On the other hand, the appeal for revocation of a patent, which is an *inter partes* procedure, can be filed by an interested party any time after the registration. Such a dual system was later found problematic, since the same patent could be subject to both post-grant opposition and appeal for revocation in two separate cases. The situation became even more complicated after the Supreme Court's decision in April 2000, in which the Court held that judicial courts were

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<sup>3</sup> As an alternative, a patent Office which does not have resources to conduct substantive review may conclude cooperation agreement with other offices.

<sup>4</sup> For example, the Oncomouse case (EP 0169672) received 17 oppositions, and Edinburgh/stem cells case (EP 0695351) received 14 oppositions. A study shows that the likelihood of opposition increases with patent value, and that opposition is particularly frequent in areas with strong patenting activities and with high technical or market uncertainty. (Dietman Harhoff, Markus Reitzig "Determinant of opposition against EPO patent grants - the case of biotechnology and pharmaceuticals", International Journal of Industrial Organization, 22 (2004), 443-480)

capable of reviewing the validity of patents regardless of the status and outcome of the administrative appeal proceedings at the Japan Patent Office.<sup>5</sup>

24. In order to streamline the post-grant review procedures, the post-grant opposition system was abolished in 2004, and the mechanism to challenge a granted patent was streamlined into a single procedure, namely the administrative appeal for revocation of a patent. The revised appeal for revocation of a patent allows, in principle, anyone to file an appeal. In order to maintain a simpler and cheaper option to assist invalidating patents that have been inadvertently granted, the Office has created a mechanism that allows third parties to submit, free of charge, any information which may be relevant to various patentability requirements even after the grant of a patent.

25. The experience of China with designing an opposition procedure is also worth considering. China had a pre-grant opposition procedure prior to 1992, which was changed to a post-grant opposition system due to delays associated with the grant of a patent. Prior to 2000, both systems existed: a post-grant opposition procedure as well as a post-grant invalidation procedure. The two systems differed in the grounds for invalidation and time period allowed for bringing an action. Particularly, the invalidation procedure could not be initiated until an opposition procedure involving the same patent was concluded. In 2000, the patent law was amended to abolish the post-grant opposition system. The amendment was required by the fact that the patentee could be subject to multiple attacks and because it overburdened the State Intellectual Property Office (SIPO). At present, the patent invalidation procedure is the only mechanism available for challenging the validity of a patent.<sup>6</sup>

26. Although it may be still too early to draw any conclusions from the changes that took place in Japan and China, it appears that designing a national opposition system is linked to the availability of other possibilities of reviewing the validity of patents. It seems that if more than one review mechanism exists in the national patent system, an additional mechanism should have additional benefits and should not just be a duplication of another review process. This could complicate the procedures, delay the whole process of delivering the final administrative decision and increase legal uncertainty.

#### IV. INTERNATIONAL LEGAL FRAMEWORK

27. No international treaty regulates opposition systems as such. Countries are free to provide, or not to provide, an opposition mechanism in their national laws. While substantive requirements with respect to opposition proceedings are not dealt with in existing treaties, some general procedural requirements prescribed in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) and the Patent Law Treaty (PLT) may also be applicable to opposition procedures.

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<sup>5</sup> Fujitsu v. Texas Instruments, 1998(O)No. 364, Supreme Court, April 11, 2000

<sup>6</sup> Haitao Sun, Post-Grant Patent Invalidation in China and in the United States, Europe, Japan: A Comparative Study, 15 Fordham Intellectual Property, Media & Entertainment Law Journal, 2004



*Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement)*

28. Article 62.4 of the TRIPS Agreement provides that, where a Member's law provides administrative revocation and *inter partes* procedures such as opposition, revocation and cancellation, they shall be governed by the general principles set out in Article 41.2 and 3. Article 41.2 and 3 reads:

“2. Procedures concerning the enforcement of intellectual property rights shall be fair and equitable. They shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

“3. Decisions on the merits of a case shall preferably be in writing and reasoned. They shall be made available at least to the parties to the proceeding without undue delay. Decisions on the merits of a case shall be based only on evidence in respect of which parties were offered the opportunity to be heard.”

29. Further, Article 62.5 states that final administrative decisions in the above procedures referred to under Article 62.4, including administrative revocation and *inter partes* opposition procedures, shall be subject to review by a judicial or quasi-judicial authority. However, there shall be no obligation to provide an opportunity for such review of decisions in cases of unsuccessful opposition or administrative revocation, provided that the grounds for such procedures can be the subject of invalidation procedures.

30. In addition, as a general rule, according to Article 62.2, Members shall ensure that the procedures for grant, subject to compliance with the substantive conditions for acquisition of the right, permit the granting of the right within a reasonable period of time so as to avoid unwarranted curtailment of the period of protection.

*Patent Law Treaty (PLT)*

31. According to PLT Article 10(1), non-compliance with certain formal requirements with respect to an application may not be a ground for revocation or invalidation of a patent, either totally or in part, except where the non-compliance with the formal requirement occurred as a result of a fraudulent intention. Those formal requirements are: (i) form or contents of application (PLT Article 6(1)); (ii) formal requirements relating to request form, fees and priority document (PLT Article 6(2), (4) and (5)); (iii) form and means of transmittal of communications (PLT Article 8(1) and (3)); and (iv) language and signature of communications (PLT Article 8(2) and (4)). In other words, once a patent is granted, it shall not be revoked or invalidated on the grounds of non-compliance with the above formal requirements.

32. In addition, PLT Article 10(2) provides that a patent may not be revoked or invalidated, either totally or in part, without the owner being given the opportunity to make observations on the intended revocation or invalidation, and to make amendments and corrections where permitted under the applicable law, within a reasonable time limit.

33. Further, PLT Article 11 provides the extension of a time limit for an applicant's action before the patent office under certain conditions, and PLT Article 12 requires Contracting Parties to provide reinstatement of rights where an applicant lost his rights because of the failure to observe a time limit, if the failure occurred in spite of due care required by the circumstances or was unintentional. However, in accordance with PLT Rules 12(5)(vi)

and 13(iv), no Contracting parties shall be required to grant a relief under PLT Article 11 or reinstatement of rights under Article 12 in respect of a time limit for an action in *inter partes* proceedings. In other words, a Contracting party is free to provide, or not to provide, the extension of a time limit and/or the reinstatement of rights regarding a time limit for an action in *inter partes* opposition proceedings.

34. However, when adopting these Rules, the Diplomatic Conference adopted Agreed Statement No. 5, stating that while it was appropriate to exclude actions in relation to *inter partes* proceedings from the relief provided by Articles 11 and 12, it was desirable that the applicable laws of the Contracting Parties provide appropriate relief in those circumstances which takes into account the competing interests of third parties, as well as the interests of others who are not parties to the proceedings.

## V. EXAMPLES OF OPPOSITION PROCEDURES

35. As mentioned earlier, each country may have its own reasons to introduce opposition procedures, or not to introduce such procedures, under its national law. Among the countries that have an opposition system, procedural and substantive requirements have some common aspects, but are different in details, reflecting the various needs. Such differences may include: (i) pre-grant or post-grant opposition; (ii) entitlement to file an opposition; (iii) period for filing an opposition; (iv) grounds for an opposition; (v) *inter partes* procedural requirements, such as a request, notification to parties, arguments, evidence, oral hearing, final decision etc.; and (vi) an appeal against the final decision (competent authority, time limit to file an appeal etc.). The following paragraphs illustrate existing opposition systems in a number of countries/regions.

### *Brazil*

36. The Industrial Property Law of Brazil<sup>7</sup> provides administrative nullity procedures which can be instituted either *ex officio* or at the request of any person having a legitimate interest, within a period of six months from the date of the grant of the patent.<sup>8</sup>

37. The administrative nullity proceedings can be instituted on any of the following grounds:<sup>9</sup>

- (i) the legal requirements on patentability were not satisfied;
- (ii) the specifications and claims did not comply with requirements of sufficient disclosure and enablement;
- (iii) the object of the patent extends beyond the contents of the application filed originally;
- (iv) any of the essential formalities that are indispensable to granting has been omitted during the processing thereof.

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<sup>7</sup> The Industrial Property Law No.9.279 of May 14, 1996

<sup>8</sup> Article 51 of the Industrial Property Law

<sup>9</sup> Article 50 of the Industrial Property Law

38. After acceptance of the nullity request, the patent holder is notified to that effect and requested to submit comments in relation to the request within a period of 60 days from the date of receipt of such notification. After the expiration of those 60 days, whether or not comments were submitted, the National Institute of Industrial Property (INPI) will issue an opinion and request the patent holder and the person who filed the nullity request to submit their comments within an additional period of 60 days.<sup>10</sup>

39. After the time limit of 60 days has elapsed, even if no comments have been submitted, the case is decided by the President of INPI upon the results of technical and legal reports submitted to the President by the relevant departments of INPI which have examined the case. The decision of the President is final and can not be appealed.<sup>11</sup> Nullity of a patent shall produce effects from the filing date of the application.<sup>12</sup>

### *Egypt*

40. A pre-grant opposition procedure before the Egyptian Patent Office is provided in Egypt. Article 16 of the Law on the Protection of Intellectual Property Rights<sup>13</sup> provides that any party may submit to the Patent Office a written notice opposing the grant of a patent and stating the reasons thereof within 60 days from the publication of the application acceptance in the Patent Gazette. Such an opposition is the subject to the payment of a fee which will be reimbursed in case the opposition is accepted.

41. In cases where the application relates to defense, military production, security or has health significance, the relevant Ministry may oppose the grant of the patent within 90 days from the date of publication of the application.<sup>14</sup>

42. After the acceptance of the opposition request, the Office will notify the applicant by transmitting a copy of the opposition request within 7 days from the date of its receipt by the Office. The applicant may respond to the arguments contained in the opposition request within 15 days from the day he was notified about it. The Office then transmits to the opposing party a copy of the response of the applicant within 7 days from the date of its receipt by the Office.<sup>15</sup>

43. The opposition is examined by a Committee which is composed of a chairman who is a judge from the appeal courts, or a person of the same rank from the members of the judicial system, an associate judge from the State Council (administrative tribunal) as well as three other members who have relevant expertise. The Law does not provide for the mandatory representation of the Patent Office in the work of the Committee. In certain cases, the Committee may decide to seek an advice of an expert who can be an official of the government or any other external expert.<sup>16</sup> The Committee delivers the decision within

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<sup>10</sup> Article 53 of the Industrial Property Law

<sup>11</sup> Article 54 of the Industrial Property Law

<sup>12</sup> Article 48 of the Industrial Property Law

<sup>13</sup> Law on the Protection of Intellectual Property Right 82 of 2002

<sup>14</sup> Article 17 of the Law on the Protection of Intellectual Property Right 82 of 2002

<sup>15</sup> Rule 24 of the Regulations of Law 82 of 2002

<sup>16</sup> Rule 27 and 28 of the Regulations of Law 82 of 2002

60 days from the date of the filing of the opposition notice.<sup>17</sup> The Office will then notify the parties about the decision taken on the opposition, stating the reasons of the decision within 10 days from the date of its issuance.<sup>18</sup>

44. The decision of the Committee may be appealed either by the Patent Office or any interested party to the Administrative Tribunal within 60 days from the date of notification of the decision.

#### *India*

45. The Indian Patent Act provides both pre-grant and post-grant opposition. Where an application for a patent has been published but a patent has not been granted, any person may, in writing, lodge an opposition with the Controller against the grant of a patent.<sup>19</sup> The opposition may be filed on the following grounds together with supporting evidence and a request for hearing, if so desired:

(i) the applicant or the person under or through whom he claims wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(ii) the claimed invention has been published before the filing date (priority date) in a specification of an application filed in India on or after January 1, 1912, or in any other documents in India or elsewhere, provided that the disclosure does not fall under the grace period exception;

(iii) the claimed invention is claimed in a claim of a complete specification published on or after the filing date (priority date) of the applicant's claim and filed in pursuance of an application for a patent in India before the filing date (priority date) of the applicant's claim;

(iv) the claimed invention is publicly known or publicly used in India before the filing date (priority date). Where a claimed invention is a process invention, it shall be deemed to be publicly known or publicly used in India before the filing date (priority date) of the claim if a product made by that process had already been imported in India before that date, except where such importation has been for the purpose of reasonable trial or experiment only;

(v) the claimed invention is obvious and clearly does not involve any inventive step, having regard to the published matters referred to in (ii) or having regard to what was used in India before the filing date (priority date);

(vi) the subject of the claimed invention is neither an invention within the meaning of the Act nor patentable under the Act;

(vii) the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

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<sup>17</sup> Article 36 of the Law on the Protection of Intellectual Property Right 82 of 2002

<sup>18</sup> Rule 29 of the Regulations of Law 82 of 2002

<sup>19</sup> Section 25(1) of the Patent Act 1970

(viii) the applicant has failed to disclose the information required by Section 8 of the Act (information regarding corresponding foreign applications) or has furnished false information;

(ix) where priority is claimed, the application was not filed within 12 months from the priority date;

(x) the complete specification does not disclose or wrongly mentions the source of geographical origin of biological material used for the invention;

(xi) the claimed invention in the complete specification is anticipated having regard to the knowledge, oral, or otherwise, available within any local or indigenous community in India or elsewhere.

46. According to Rule 55(1A), no patents shall be granted before the expiry of a period of six months from the date of publication of the application. In other words, third parties have at least six months from the publication date of the application to file a pre-grant opposition. If the Controller is of the opinion that the application should be refused or be amended, he shall notify that effect to the applicant together with a copy of the opponent's documents. In response, the applicant may file his statement and evidence in support of his application within three months from the date of the above notice from the Controller. On consideration of the statement and evidence from both parties, the Controller would decide whether a patent should be granted or not.

47. Once a patent is granted, third parties have another opportunity to file an opposition.<sup>20</sup> Such opposition can be filed by any interested person before the expiry of a period of one year from the date of publication of grant of a patent based on the same grounds as described in paragraph 46. The Controller shall notify the patentee where such notice of opposition was submitted.<sup>21</sup> The opponent shall send a written statement setting out the nature of the opponent's interest, the facts upon which he bases his case and relief which he seeks and evidence, if any, along with notice of opposition and shall deliver to the patentee a copy of the statement and evidence, if any.<sup>22</sup> The patentee is given an opportunity to respond to the opponent's claim and to submit any evidence supporting the patent within two months from the date of receipt of the copy of the opponent's statement and evidence. The patentee shall also send a copy of his response to the opponent. If the patentee does not contest within the above two months period, the patent shall be deemed to have been revoked.<sup>23</sup> Once the opponent received a copy of the response made by the patentee, he may, within one month, submit evidence strictly confined to matters in the patentee's evidence, and shall deliver to the patentee a copy of such evidence.<sup>24</sup>

48. The post-grant opposition is examined by an Opposition Board consisting of three members. It examines all documents and evidence submitted, and submits its recommendations to the Controller. On receipt of the recommendation and after giving the patentee and the opponent an opportunity to be heard, the Controller shall order either to

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<sup>20</sup> Section 25(2) of the Patents Act 1970

<sup>21</sup> Section 25(3) of the Patents Act 1970

<sup>22</sup> Rule 57 of the Patents Rules 2003

<sup>23</sup> Rule 58(2) of the Patents Rules 2003

<sup>24</sup> Rule 59 of the Patents Rules 2003

maintain or to amend or to revoke the patent.<sup>25</sup> The controller shall not take into account any personal document or secret trial or secret use when determining the compliance with (iv) and (v) in paragraph 46.

49. Section 26 of the Patents Act provides specific rules for the case where the opposition was successful on the grounds that the claimed invention was wrongly obtained from the opponent (see item (i) in paragraph 46 above). In such a case, the Controller may decide that the patent should be amended in the name of the opponent. Similarly, where a part of the invention described in the specification is wrongly obtained from the opponent, the Controller may decide that the specification be amended by the exclusion of that part of the invention.

50. The decision of the Controller regarding pre-grant opposition and post-grant opposition may be appealed to the Appellate Board within three months from the date of the decision, unless the Appellate Board allows another timeframe in accordance with its rules.

### *Eurasian Patent Office*

51. The Eurasian Patent Convention provides post-grant revocation rules in relation to Eurasian patents. A Eurasian patent can be revoked by any person, other than the patent owner, by filing a notice of opposition within six months of the date of publication of information concerning the grant of a Eurasian patent.<sup>26</sup> The time period for filing a notice of opposition may not be prolonged.<sup>27</sup> A right to file a notice of opposition, lost due to lapse of time for filing, may not be restored.<sup>28</sup>

52. The notice of opposition shall be filed in writing, contain a statement of the reasons thereof, and be supported by the payment of the prescribed fee.<sup>29</sup> The consideration of the opposition proceeding shall be within six months of the date of its receipt by the Eurasian Patent Office (hereinafter referred to as “the Eurasian Office”).

53. The notice of opposition can state the following grounds for revocation of a Eurasian patent:<sup>30</sup>

- (i) failure to satisfy the patentability conditions, because the invention:
  - is not novel;
  - does not involve an inventive step;
  - is not industrially applicable;
  - is not recognized as an invention *per se*;
  - belongs to solutions for which Eurasian patents shall not be granted.

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<sup>25</sup> Section 25(4) of the Patents Act 1970

<sup>26</sup> Rule 53(1) of the Patent Regulations under the Eurasian Patent Convention, and Rule 1.1 of the Rules for Filing and Examining Opposition Against the Grant of a Eurasian Patent on the Basis of Administrative Revocation of a Eurasian Patent (hereinafter “Rules of Opposition Filing and Examination”)

<sup>27</sup> Rule 37(4) of the Patent Regulations

<sup>28</sup> Rule 39(3) of the Patent Regulations

<sup>29</sup> Rule 53(5) of the Patent Regulations

<sup>30</sup> Rule 53(2) of the Patent Regulations and Rule 1.8 of the Rules of Opposition Filing and Examination

(ii) the claims include features that did not appear in the Eurasian application as originally filed.

54. Each of the above conditions is a separate ground for revocation of a Eurasian patent. However, (i) incorrect indication of the patent owner or inventor in the Eurasian patent; (ii) non-compliance of the subject matter of the specification or drawings with established requirements; and (iii) failure to comply with the requirement of unity of invention are not grounds for administrative revocation of a Eurasian patent.<sup>31</sup>

55. If the notice of opposition is filed in compliance with the prescribed requirements,<sup>32</sup> the Eurasian Office accepts such notice and notifies the opponent that the notice of opposition has been accepted for examination and invites the patent owner to respond to the notice of opposition within a time limit prescribed by the Eurasian Office.<sup>33</sup>

56. The patent owner submits to the Eurasian Office his response to the notice of opposition, presenting his arguments against the opponent's claims and may make changes and amendments to the patent.<sup>34</sup>

57. The Eurasian Office subsequently sends the response and the changes and amendments submitted by the patent owner to the opponent or, if several notices of opposition were filed, to all opponents. The Eurasian Office can, if it considers necessary, invite the opponent to present his considerations in respect of the response by the patent owner within a time period stated in the communication.<sup>35</sup>

58. The examination of the notice of opposition as to substance and a decision on it on behalf of the Eurasian Office shall be performed by a board consisting of at least three examiners, employees of the Eurasian Office, at least two of whom were not involved in the decision to grant the opposed Eurasian patent. When necessary, a legal expert of the Eurasian Office may be included in the board. The chairman of this board shall be appointed from among those examiners who were not involved in the decision to grant the opposed Eurasian patent.

59. The board examines the notice of opposition in respect of those grounds for revocation which are supported in the notice. The board is not obliged, but may examine the validity of the patent grant based on other grounds not presented in the notice.<sup>36</sup>

60. The examination of the notice of opposition as to substance shall be concluded by passing a decision without convening an oral hearing, unless the parties request to hold such a meeting or the Eurasian Office considers such a meeting expedient.

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<sup>31</sup> Rule 1.8 of the Rules of Opposition Filing and Examination

<sup>32</sup> The notice of opposition shall comply with the conditions specified in paragraphs (1), (5) and (6) of Rule 53 of the Patent Regulations, and Section 1 of the Rules of Opposition Filing and Examination

<sup>33</sup> Rule 3.2 of the Rules of Opposition Filing and Examination

<sup>34</sup> Rule 3.5 of the Rules of Opposition Filing and Examination

<sup>35</sup> Rule 3.8 of the Rules of Opposition Filing and Examination

<sup>36</sup> Rule 4.4 of the Rules of Opposition Filing and Examination

61. The administrative revocation procedure may result in a decision by the Eurasian Office to revoke the Eurasian patent, to reject the notice of opposition, or to correct or amend the patent. The Eurasian patent recognized as invalid as the result of a revocation procedure, either entirely or in part, is considered void in all Contracting States as from the date of filing of the Eurasian application.<sup>37</sup>

62. The decision on the opposition to the grant of a Eurasian patent is published in the Gazette of the Eurasian Office. In case the opposition resulted in the amendment of a patent, the Eurasian Office publishes the new specification of the Eurasian patent containing the description as such, the claims and the drawings as amended. In the event of an appeal being filed, no acts related to the implementation of the decision on the opposition, including the entry of changes into the Register of Eurasian patents, publication of information on the decision on the opposition in the Eurasian Office Bulletin, shall be performed until a decision is passed on the appeal.

63. An appeal against the decision in question may be lodged by any party in the opposition examination with the President of the Eurasian Office within four months of the date of dispatch of the decision. The President of the Eurasian Office examines the appeal and either orders a renewed hearing of the opposition by the board or takes a final decision on the opposition.<sup>38</sup>

#### *European Patent Office (EPO)*

64. The European Patent Convention (EPC) provides a post-grant opposition. European patents granted by the EPO may be opposed by any person within nine months of the publication of the grant of the European patent in the European Patent Bulletin and upon the payment of the opposition fee.<sup>39</sup> The proprietor of the patent is not entitled to file an opposition,<sup>40</sup> although he may request limitation of his patent under EPC Article 105a.

65. The notice of opposition must be filed in writing and contain, *inter alia*, a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based, as well as an indication of the facts and evidence in support of these grounds.<sup>41</sup>

66. The Opposition Division of the EPO is responsible for the examination of the opposition against any European Patent. It consists of three technically qualified examiners, and in some cases where the nature of the decision so requires, it may be enlarged by the addition of a legally qualified examiner.<sup>42</sup>

67. As provided by Article 100 of the EPC, the opposition can only be based on the following grounds: the subject-matter of the patent is not patentable under Articles 52 to 57 (patentable inventions, exceptions to patentability, novelty, non-prejudicial disclosures, inventive step, industrial application); the invention is not sufficiently disclosed to allow a

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<sup>37</sup> Rule 53(4) of the Patent Regulations

<sup>38</sup> Rule 53(8) of the Patent Regulations

<sup>39</sup> Article 99 EPC

<sup>40</sup> G 9/93 (OJ 12/1994,891)

<sup>41</sup> Rule 76 of the Implementing Regulation to the EPC

<sup>42</sup> Article 19 EPC



person skilled in the art to carry it out; and the content of the patent extends beyond the content of the application as filed or, if the patent was granted on a divisional application or on a new application filed under Article 61, beyond the content of the earlier application as filed.

68. According to Article 101 of the EPC, if the opposition is admissible,<sup>43</sup> the Opposition Division shall examine whether at least one ground for opposition under Article 100 prejudices the maintenance of the European patent. During the examination, the Opposition Division invites the parties to file observations on communications from another party or issued by itself. In particular, after the notice of opposition is granted, it is forwarded to the proprietor of the patent, who may reply with observations or amendments to the description, claims and drawings within a time frame set by the Opposition Division. The observations and amendments filed by the proprietor of the patent are then forwarded by the EPO to other parties to the opposition proceeding, and the opponents are given the opportunity to respond within a specified period.<sup>44</sup>

69. During the opposition, oral proceedings may take place at the request of the EPO or at the request of any party to the proceedings.<sup>45</sup> The oral proceedings are held before the Opposition Division itself.<sup>46</sup> They are generally public unless the Opposition Division decides otherwise in particular cases.<sup>47</sup>

70. Based on all the evidence, the Opposition Division renders a decision. In the event of parity of votes, the vote of the Chairman of the Opposition Division is decisive.<sup>48</sup> If the Opposition Division finds that at least one ground for opposition prejudices the maintenance of the European patent, it revokes the patent. Otherwise, it rejects the opposition. If the Opposition Division concludes that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent (and the invention to which it relates) meets the requirements of the EPC, it decides to maintain the patent as amended. If the patent after such amendments do not meet the requirements of the EPC, the Opposition Division revokes the patent.<sup>49</sup>

71. The opposition shall apply to the European patent in all the Contracting States in which that patent has effect. Decisions by Opposition Divisions are appealable by any party to proceedings adversely affected by the decision before the Board of Appeal of the EPO.<sup>50</sup>

72. A notice of appeal must be filed at the EPO within two months of notification of the contested decision, and the fee for appeal must be paid. In addition, within four months of notification of the decision, a statement setting out the grounds of appeal must be filed.<sup>51</sup>

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<sup>43</sup> Rule 77 of the Implementing Regulation to the EPC provides grounds for a rejection of the opposition as inadmissible

<sup>44</sup> Rule 79 of the Implementing Regulation to Part V of the EPC

<sup>45</sup> Article 116(1) EPC

<sup>46</sup> Article 19 EPC

<sup>47</sup> These are the cases where “admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings” (Article 166 EPC)

<sup>48</sup> Article 19 EPC

<sup>49</sup> Article 101 EPC

<sup>50</sup> Article 106 EPC

<sup>51</sup> Article 108 EPC

73. A petition for review by the Enlarged Board of Appeal of a decision of a Board of Appeal may only be filed on the grounds specified by Article 112a(2) of the EPC.

74. In 2008, oppositions were filed against 2,800 European patents granted by the EPO (in 2007, against 3,300 patents), and 1,980 decisions in opposition cases took effect (in 2007, 2,100 decisions).<sup>52</sup> Overall, about 6% of European patents granted are opposed. Of those, about 1/3 are revoked, 1/3 are maintained in amended form, and 1/3 are maintained as originally granted (the opposition is rejected). The opposition rate before the EPO is consistently higher in the closest available proxy for the pharmaceutical sector than it is in organic chemistry and in all sectors (overall EPO average).<sup>53</sup>

## VI. RELATED MECHANISMS

### (a) Re-examination Systems

75. In some countries, a re-examination system is provided as an alternative to the opposition system. For example, the patent law of the United States of America provides two types of re-examination mechanisms. The primary objective of the re-examination is to provide a forum, other than the courts, for challenging the validity of an issued patent. It allows to re-examine a patent in view of new prior art, and to correct a patent which was inadvertently issued. The following paragraphs describe the re-examination system in the United States of America.

#### (i) Re-examination under 35 U.S.C. §302 to §307

76. The re-examination procedure is codified in 35 U.S.C. §§ 302-307 (often called “*ex parte* re-examination”). These provisions were enacted in 1980 in order to resolve patent validity disputes more quickly and less expensively than litigation, permitting courts to defer issues of patent validity to the expertise of the United States Patent and Trademark Office (USPTO).<sup>54</sup> The re-examination proceedings allows anyone, including the patent owner, to file a request for re-examination of any claim of a patent by providing the USPTO with a written request for re-examination accompanied by the fee, the pertinent prior art, and the manner of applying the prior art to the claim(s) at issue. The identity of the real party in interest may be kept confidential, as an attorney representing the real party in interest may file the request.<sup>55</sup> The prior art cited to the USPTO by the requester must consist of patents or printed publications.<sup>56</sup> Unless the person requesting re-examination is the patent owner, he will then be notified by the USPTO of the request for re-examination.

77. The USPTO will determine within three months whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, and if so, a re-examination proceeding will be initiated. The USPTO, in making its determination, is not

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<sup>52</sup> EPO Annual Report 2008

<sup>53</sup> Pharmaceutical Sector Enquiry, Preliminary Report (DG Competition Staff Working Paper), 28 November, 2008

<sup>54</sup> See 145 Cong. Rec. H6929, H6944 (daily ed. Aug. 3, 1999)

<sup>55</sup> *Syntex Inc. v. United States Patent and Trademark Office*, 882 F.2d 1570, 1573 (Fed. Cir. 1989).

<sup>56</sup> 35 U.S.C. § 302

limited to the prior art submitted by the requester, but may also consider other patents and printed publications.<sup>57</sup> For example, any relevant prior art patents or printed publications submitted by a third party that have been included in the official file under 35 U.S.C. §301 (see Chapter VI(2)) may be considered in the re-examination process. The determination that no substantial new question of patentability has been raised is final and non-appealable by both parties.<sup>58</sup>

78. Where the USPTO issues an order for re-examination of the patent, the patent owner will be given a period not less than two months from the date the copy of the determination is given to him, within which he may file a statement including any amendments he may wish to propose. Where a patent owner files such a statement, its copy is communicated to the requester. The requester may submit a response to the statement made by the patent owner.<sup>59</sup> If the patent owner decides not to file a statement, the requester may not file any further communications in the proceeding.

79. After the time limits for filing the statement by the patent owner and reply by the third party requester have expired, the re-examination procedure will be conducted in a manner similar to that of the initial examination process. In any re-examination proceeding, the patent owner is permitted to propose any amendment to his patent and a new claim to distinguish his patent from the prior art cited, although the scope of the claims may not be enlarged.<sup>60</sup>

80. Once the USPTO renders a decision, the patent owner may appeal an adverse determination to the Board of Patent Appeals and Interferences (BPAI). A further appeal can be made to the Court of Appeals for the Federal Circuit or to the District Court (for the District of Columbia).<sup>61</sup>

81. In 2008, 680 requests for *ex parte* re-examination were filed with USPTO (in 2007, 643 requests). The number corresponds to about 0.43% of the number of patents issued in a given year. The highest number of re-examination requests, in 2008, concerned patents in the electrical field (305 requests), followed by the mechanical field (237 requests). Of the total number of requests filed in 2008, 626 requests were granted and 40 requests were denied.<sup>62</sup>

(ii) *Inter Partes* Re-examination

82. Optional *inter partes* re-examination is codified in 35 U.S.C. §§ 311-318.<sup>63</sup> The primary objective of the *inter partes* re-examination procedure is to reduce costly patent litigation in US district courts by providing an expanded means for third parties to challenge the validity of a patent.<sup>64</sup> Compared with the *ex parte* re-examination procedure above, the following major differences are found in the *inter partes* re-examination procedure. First, *inter partes* re-examination may only be filed by a third party, but not by the patent owner.

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<sup>57</sup> 35 U.S.C. § 303(a)

<sup>58</sup> 35 U.S.C. § 303(c)

<sup>59</sup> 35 U.S.C. § 304

<sup>60</sup> 35 U.S.C. § 305

<sup>61</sup> 35 U.S.C. § 306

<sup>62</sup> USPTO Performance and Accountability Report, Fiscal Year 2008

<sup>63</sup> 35 U.S.C. §§ 311-318

<sup>64</sup> 145 Cong. Rec. E1788, at E1789-90

Second, the *inter partes* procedure allows the third party requester to fully participate in the proceedings. He receives any document filed by the patent owner and a copy of all communications sent from the Office to the patent owner in relation to the *inter partes* re-examination, and has an opportunity to file comments on the issues raised by the patent owner or the Office. In the *ex parte* re-examination procedure, an opportunity for the third party re-examination requester to submit a comment is given only during a limited period and under certain conditions.

83. *Inter partes* re-examination may be initiated by any third party requester at any time on the basis of prior art consisting of patents and printed publications.<sup>65</sup> Such a request shall include the identification of the real party in interest standing behind the request, payment of the established fee, the cited prior art, and a statement regarding the manner in which the prior art should be applied to the claims of the patent.<sup>66</sup>

84. Within three months after the filing of the request, the USPTO will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.<sup>67</sup> The determination that no substantial new question of patentability has been raised is final and non-appealable.<sup>68</sup>

85. If it is found that a substantial new question of patentability affecting any claim of the patent is raised, the USPTO issues an order for *inter partes* re-examination of the patent. *Inter partes* re-examination is conducted according to the procedures established for initial examination in that the patent owner is permitted to propose any amendment to his patent and a new claim to distinguish his patent from the prior art cited, although the scope of the claims may not be broadened.<sup>69</sup> Any document filed by either the patent owner or the third party requester shall be communicated to the other party. The third party requester will be copied by the USPTO on each communication sent by the USPTO to the patent owner in the proceeding.

86. In *inter partes* re-examination, the third party requester has an opportunity to file written comments within thirty days after the date of service of the patent owner's response to an action of the Office. Each time when the patent owner files such response, the third party requester has one opportunity to make comments. These comments may address issues raised by the USPTO, as well as issues raised by the patent owner.<sup>70</sup>

87. Either party may appeal an adverse final decision of the USPTO to the BPAI. A further appeal is possible to the Court of Appeals for the Federal Circuit. The patent owner may be a party to any appeal initiated by a third party requester, and *vice versa*.<sup>71</sup> In addition, the patent owner has the option of obtaining a stay of pending litigation involving a question of validity of the same patent after an order for *inter partes* re-examination has been issued by

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<sup>65</sup> 35 U.S.C. § 311(a)

<sup>66</sup> 35 U.S.C. § 311(b)

<sup>67</sup> 35 U.S.C. § 312(a)

<sup>68</sup> 35 U.S.C. § 312(c)

<sup>69</sup> 35 U.S.C. § 314

<sup>70</sup> 35 U.S.C. § 314(b)(2)

<sup>71</sup> 35 U.S.C. § 315

the USPTO.<sup>72</sup> A third-party requester is estopped from asserting at a later time, in any civil action the invalidity of any claim that was determined to be valid and patentable on any ground which the third party requester raised, or could have raised, during the *inter partes* re-examination proceedings. The estoppel provision, however, does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third party requester and the USPTO at the time of the *inter partes* re-examination proceedings.<sup>73</sup>

88. In 2008, 168 requests for *inter partes* re-examinations were filed with the USPTO (in 2007, 126 requests). Of those, 142 requests were granted, and 8 requests were denied. The number corresponds to about 0.10% of the number of patents issued in that year. The highest number of re-examination requests, in 2008, concerned patents in the electrical field (67 requests), followed by the mechanical field (73 requests).<sup>74</sup>

(b) Submission of Information by Third Parties

(i) Rationale and objectives

89. In countries where a patent application is published before the grant of the patent, third parties are in a position to analyze the claimed invention contained in the published patent application before the grant of the patent or the refusal of the patent application. In order to assist a substantive examiner to examine the patentability of the claimed invention, in some countries, third parties may submit prior art information which is relevant to such determination of patentability. In general, the fact that information is submitted by a third party and the content of such information are made available to the public. The objective of such mechanism is, similar to the pre-grant opposition system, to increase the validity of granted patents through contributions from third parties having good knowledge of the prior art technology concerned.

90. The third party observations system, however, is different from the pre-grant opposition system in many aspects, although it varies from one country to the other. It is a procedure under which the third party who submitted the information cannot participate in the subsequent review procedure. The submission of the relevant information does not trigger any specific review process (although an examiner may take into account the submitted information, if appropriate), and the information will be simply included in the file which can be consulted by the public. In many countries, there is no time limit for third parties to submit relevant information. The anonymous submission of information is allowed in certain countries. This could help third parties to submit prior art information even if they have business relationship with the applicant and therefore, are unwilling to disclose their identities. Further, in some countries, the grounds for the submission of information may be limited by certain requirements.

91. Theoretically, it is possible to introduce such a system in a patent office that does not conduct substantive examination. The prior art information submitted by a third party will be made available to the public upon the publication of the patent, and it can be used by any party during the post-grant revocation proceedings. For that reason, in some countries, third parties may also submit prior art information to the patent office anytime during the

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<sup>72</sup> 35 U.S.C. § 318

<sup>73</sup> 35 U.S.C. § 315(c)

<sup>74</sup> USPTO Performance and Accountability Report, Fiscal Year 2008

post-grant phase. The submitted information will be included in the official file (dossier) which is accessible to the public.

92. The submission of information relevant to patentability by third parties is a simple, inexpensive (often free of charge) and informal way to publicly question the validity of a patent. On the other hand, due to its informal nature, the submitter of the information cannot participate in and influence the review process. Whether the information submitted would be fully considered during the review process depends on examiner who conducts the substantive examination and on the party requesting the opposition/revocation of the patent concerned.

93. The possibility of introducing third party observations in the Patent Cooperation Treaty (PCT) system has been explored by the PCT Working Group. The draft PCT Roadmap suggests that a system that allows third party observations on novelty and inventive step which will be made available to the International Preliminary Examining Authority and designated Offices be developed by January 2011 (see document PCT/WG/2/3, Annex I, paragraph 5). At the second session of the PCT Working Group, held from May 4 to 8, 2009, several delegations stated that more discussions were needed on the possible details of such a third party observations system, including whether the applicant should be entitled to comment on any such third party observations and the possible need for translations of such observations. One delegation stated that it wished to reserve its position on the proposal to set up a system allowing for the submission of third party observations, noting the possible impact on the pre-grant opposition system existing under its national law (see document PCT/WG/2/14, paragraph 58).

(ii) National/Regional laws

94. The following paragraphs provide information regarding third party observation mechanisms contained in some national/regional laws.

*China*

95. Rule 48 of the Implementing Regulations of the Patent Law states that any person may, from the date of publication of an application till the date of announcing the grant of a patent, submit his observations on an application which is not in conformity with the provisions of the Patent Law. The observations shall be submitted to the Patent Administration Department with reasons of non-compliance with the provisions.

*Japan*

96. Rules 13*bis* and 13*ter* of the Regulations under the Japanese Patent Law provides that any person may submit information relating to patentability of claimed inventions contained in a patent application or a granted patent to the Commissioner of the Japan Patent Office (JPO). Such information can be submitted anonymously. The content of the submitted information is open to the public inspection. No fee is required for the submission of this information.

97. The information that third parties may submit shall be on the following grounds, which shall be substantiated by written evidence:

- the claimed invention is not patentable subject matter or it does not meet the requirement of novelty, inventive step or industrial applicability;

- double patenting or the claimed invention is contained in an application filed earlier but published later than the filing date of the application/patent concerned (non-compliance with Article 29, 29*bis* or 39(1) to (4) of the Japanese Patent Law);
- the description requirement has not been met (non-compliance with Article 36(4) or (6) (except (6)(iv)) of the Japanese Patent Law);
- the patent application was amended in a manner that new matter going beyond the scope of the disclosure at the time of the filing date has been included (non-compliance with Article 17*bis*(2)(iii) of the Japanese Patent Law);
- the scope of the Japanese translation of an application filed in a foreign language goes beyond the scope of the application as filed;
- the patent was corrected in a manner not in compliance with Article 126(1), *proviso*, (3), (4) or (5), or Article 134*bis*, *proviso*.

98. The submitted information will be notified by the JPO to the applicant concerned (or the patentee concerned). Upon request, it is possible to obtain a feedback as to whether the submitted information has been utilized by an examiner for the purpose of substantive examination or not.

99. In addition to paper submissions, relevant information may be submitted on-line to the JPO. In 2007, 7,487 submissions were made in total, and 76% of them were utilized by examiners.<sup>75</sup> Inspired by the Peer Review Prior Art pilot project conducted by the USPTO (see below), the JPO has started a Community Patent Review pilot since June 2008. The pilot project has, in general, produced positive results.<sup>76</sup>

### *Philippines*

100. Section 47 of the Intellectual Property Code (Republic Act No. 8293) states that, following the publication of an application, any person may present observations in writing concerning the patentability of the invention. Such observations must be filed in writing and must include a statement, in English or Filipino, of the grounds on which they are based.<sup>77</sup> The person who submitted the observations shall not be a part to the proceedings before the Bureau of Patents.<sup>78</sup> No fee is required to submit observations. Since opposition proceedings before the Bureau of Patents are not provided for in the Intellectual Property Code, the third party observation system is considered to be a low-cost way to challenge a potential patent.<sup>79</sup>

101. According to Section 47, the observations shall be communicated to the applicant who may comment on them. The Patent Office shall acknowledge receipt of such observations and comments and put them in the file of the application to which they relate. The Patent

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<sup>75</sup> JPO Annual Report 2008

<sup>76</sup> The report is available at: [http://www.peertopatent.org/CPR\\_Pilot\\_Report.pdf](http://www.peertopatent.org/CPR_Pilot_Report.pdf)

<sup>77</sup> Manual for Substantive Examination Procedure, Chapter VI.11

<sup>78</sup> *Ibid*

<sup>79</sup> *Ibid*

Office will not inform the third party of any further action taken by the Office in response to his observations.<sup>80</sup>

102. If the observations relate to alleged prior art other than a document form, for example, from use, such observations should be taken into account only if the alleged facts are either not disputed by the applicant (or proprietor) or established beyond reasonable doubt. Observations received from third parties after the conclusion of proceedings will not be taken into account and will be simply added to the file.

#### *United Kingdom*

103. Section 21 of the Patents Act 1977 provides that, where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller on the question whether the invention is a patentable invention, stating reasons for the observations. Such other person cannot become a party to any proceedings under the Act before the controller. In other words, apart from the receipt of acknowledgement (see below), he has no right to discuss the matter directly with an examiner or request a notification about the decision taken by the examiner. The observations can be submitted anonymously. No fee is required for the submission of observations.

104. Rule 33 of the Patents Rules 2007 provides detailed procedures regarding third party observations. The controller must send to the applicant a copy of the observations on patentability, unless they disparage any person in a way likely to damage such person or are generally expected to encourage offensive, immoral or anti-social behavior. The controller may, if necessary, send to the applicant a copy of any document referred to in the observations. It is recommended that any observations be filed within three months after the application has been published, as a patent may be granted after that period.<sup>81</sup> The observations must be made in writing, and can be filed on paper or electronically. They shall be supported by evidence wherever possible.

105. The Office will acknowledge receipt of the submitted observations if contact information of the submitter is available. Where observations were made before the grant of the patent, an examiner will take them into account when deciding upon the patentability of the invention concerned. The observations will be added to the official file, which is available to the public, and a copy of the observations will be sent to the applicant. Even if the observations are received after the grant of the patent, they will be placed in the patent file, and a copy of the observations will be sent to the patentee.

#### *United States of America*

106. According to 35 U.S.C. § 301, any person may at any time cite to the USPTO, in writing, prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. It is possible to submit such prior art information anonymously

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<sup>80</sup> *Ibid*

<sup>81</sup> <http://www.ipo.gov.uk/types/patent/p-other/p-object/p-observation/p-observation-making.htm>



(upon request, the identity of the submitter will be excluded from the official file and kept confidential).

107. In accordance with 37 C.F.R. § 1.99, there is the possibility for third parties to submit patents or printed publications relevant to a pending published patent application. The submission must be filed within two months from the date of publication of the application or prior to the mailing of the notice of allowance, whichever is earlier. If the relevant patents or publications are not in English, an English translation of all the necessary and pertinent parts is required. The information submitted will be included in the application file. A fee (USD180.00) shall be paid, and the submission is limited to ten total patents or publications.

108. The submitter of the information shall serve a copy on the applicant. In the absence of a request by the USPTO, the applicant, however, has no duty to, and need not, reply to such submission. The submitter of the information will not receive any communication from the USPTO relating to such submission, except where included a self-addressed postcard with the submission to receive an acknowledgement of receipt by the USPTO. The submission of patents and publications relevant to pending patent applications under 37 C.F.R. Section 1.99 can be made only on paper.

109. In 2007, the USPTO started a pilot project, “Peer Reviewed Prior Art Pilot”, to determine the extent to which the organized submission of documents together with comments by the public will provide useful prior art for examiners.<sup>82</sup> Following a proposal by a group of academic and business professionals, the pilot tests a collaborative, on-line, community process where the public may locate potential prior art information on a dedicated Peer-to-Patent website developed by the Community Patent Review Project of the Institute for Information Law and Policy at New York Law School.<sup>83</sup> The pilot, in particular, analyzes whether such collaborative public review would effectively identify prior art that might not otherwise be found during the ordinary examination process.

110. The community patent review process enables the public to submit prior art information and commentary relevant to the claims of pending patent applications, which have been posted on the Peer-to-Patent website by volunteer applicants. Following the community review process, the top ten references, along with a commentary, are submitted to the USPTO for its consideration. The pilot is limited to the applications in the fields of computer architecture, computer networks, cryptography and security and business methods.

111. The USPTO has lately been evaluating the impact of public input on improving patent quality through the Peer-to-Patent review process. As of October 1, 2009, office actions have been taken with respect to 104 pilot applications. Among those, 21% referred to prior art found by third parties through the Peer-to-Patent review. Among such prior art found by third parties, half of them, however, were also found by examiners independently.<sup>84</sup>

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<sup>82</sup> Information concerning the Peer Reviewed Prior Art Pilot is available at:

[http://www.uspto.gov/patents/init\\_events/peerpriorartpilotindex.jsp](http://www.uspto.gov/patents/init_events/peerpriorartpilotindex.jsp)

<sup>83</sup> <http://www.peertopatent.org/>

<sup>84</sup> <http://www.uspto.gov/web/patents/peerpriorartpilot/p2ppie.pdf>

*European Patent Office (EPO)*

112. In accordance with EPC Article 115, in proceedings before the EPO, any third party may present observations concerning the patentability of the invention to which the application or patent relates, once the publication of the European patent application was made. That person may not be a party to the proceedings before the EPO. No fee is required for the submission of observations.

113. Such observations shall be filed in writing in an official language of the EPO, and state the grounds on which they are based.<sup>85</sup> Documentary evidence and, in particular, publications submitted in support of the arguments may be filed in any language. However, the EPO may request that a translation into one of its official languages be filed; otherwise the evidence will be disregarded.<sup>86</sup>

114. The observations made by a third party will be communicated to the applicant (or the patentee), who may comment on them.<sup>87</sup> If they call into question the patentability of the invention in whole or in part, they must be taken into account in any proceedings pending before a department of the EPO until such proceedings have been terminated, i.e. they must be admitted to the proceedings.<sup>88</sup> If the observations relate to alleged prior art available other than from a document, e.g. from use, this should be taken into account only if the alleged facts either are not disputed by the applicant (or the patentee) or are established beyond reasonable doubt.<sup>89</sup> Observations received after the conclusion of the proceedings will simply be added to the file.<sup>90</sup> Although the third party is sent acknowledgment of the receipt of his observations, the EPO does not inform him of any further action it takes in response to them.<sup>91</sup>

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<sup>85</sup> Rule 114(1) of the Implementing Regulations under the EPC

<sup>86</sup> EPO Examination Guidelines, Part E, VI.3

<sup>87</sup> Rule 114(2) of the Implementing Regulations under the EPC

<sup>88</sup> EPO Examination Guidelines, Part E, VI.3

<sup>89</sup> *Ibid*

<sup>90</sup> *Ibid*

<sup>91</sup> *Ibid*