

Standing Committee on the Law of Patents

**Seventeenth Session
Geneva, December 5 to 9, 2011**

ADDENDUM TO OPPOSITION SYSTEMS

Document prepared by the Secretariat

1. In a communication dated October 24, 2011, the International Bureau received additional information from the Delegation of Costa Rica regarding opposition procedures, which should be included in the Annex of document SCP/17/9.
2. The said information is contained in the Annex to the present document.

[Annex follows]

ADDITIONAL INFORMATION CONCERNING DOCUMENT SCP/14/5 OPPOSITION PROCEDURES

1. In the case of Costa Rica, Article 12 of the Law on Patents, Industrial Designs and Utility Models, No. 6867, states:

“Article 12.- Opposition and observations. (*)

1. Any person who considers that the grant of a patent should be refused, since the application does not satisfy the substantive requirements prescribed in this Law, may raise an opposition within three months, beginning from the third publication of the application in the Official Journal (*La Gaceta*). The opposition shall be duly substantiated, and accompanied by the relevant proof or the offer thereof, and proof of payment of the opposition fee. The proof or means for better provision shall be presented within the two months following submission of the opposition, subject to the opposition being declared irreceivable (*)

2. In the case of opposition, the Industrial Property Registry shall communicate details thereof to the applicant and shall advise him to submit a response within the following month. Once this period is complete, the examination provided for in Article 13 shall be conducted.

3. Once the period is complete without any form of opposition being raised, the examination provided for in Article 13 shall be conducted.”

(*) (1) of this Article has been reformed through Law No. 8632 of March 28, 2008. *La Gaceta* No. 80 of April 25, 2008.

2. Similarly, Section 18 of the Regulations under the above Law, i.e. Executive Decree No. 15222-MIEM-J, states:

“Article 18.- Opposition to the grant of a patent
An opposition raised against the grant of a patent shall contain:

- (a) the name, domicile and address of the person raising the opposition.
 - (b) the name and address of the agent, where appropriate.
 - (c) the number and date of filing of the application subject to the opposition and the title of the invention which is the subject of said application.
 - (d) the basic grounds and right of opposition.
 - (e) details of the residence or office within the national territory where notifications are to be heard.
 - (f) the signature of the person raising the opposition, duly authenticated by a lawyer as appropriate.
 - (g) the proof that it is relevant in support of the grounds for opposition; and
 - (h) proof of payment of the opposition fee.
- (...)”

3. In practice, once the opposition(s) is (are) received, it shall be notified to the applicant and the period of one month granted for the applicant to challenge the opposition. Once this period is complete, or if there is no opposition, the application is prepared for the conduct of the corresponding substantive study.

4. Once the report has been produced by the examiner, a reasoned decision is issued in which the requested patent is granted or refused, and the decision notified both to the applicant and the person raising the opposition, who may present grounds for revocation and/or appeal within the period of three and five days respectively. The appeal shall be heard by the Administrative Registration Tribunal.

5. In addition, Article 21 of the Costa Rican law states the possibility of requesting the nullity of a patent already granted:

“Article 21.- Nullity (*)

1. At the request of any interested person or *ex officio*, and subject to hearing the patent owner, the Industrial Property Registry shall declare the nullity of said patent, where it is demonstrated that the patent was granted in contravention of any of the provisions of Articles 1 and 2 of this Law. Any person requesting the nullity of a patent may provide all proof that he considers relevant. (*)

2. The licensor of the revoked patent shall, where appropriate, have the right to return of the payments already made in relation to the patent, provided that he has not benefited from the license.

3. Invalidity may be declared at any time prior to expiry of the patent.”

(*) Paragraph (1) of this Article has been reformed through Law No. 8632 of March 28, 2008. *La Gaceta* No. 80 of April 25, 2008.

6. Once the application for nullity has been received, the patent owner shall be notified to the effect that within one month he should take action in that regard. Once the owner’s arguments have been received, a new substantive examination shall be carried out. Once the respective technical report is received, the decision in which the patent is cancelled or registration thereof is maintained shall be issued. Equally, there remains the possibility of raising grounds for revocation and/or appeal within the period of three and five days respectively. The appeal shall be heard by the Administrative Registration Tribunal.

Statistics

Year	Number of applications	Number of oppositions
2005	580	28
2006	739	112
2007	829	135
2008	886	243
2009	635	203
2010	692	173

(*) Includes applications for patents, utility models and industrial designs.

[End of Annex and of document]