

Standing Committee on the Law of Patents

Eighteenth session
Geneva, May 21 to 25, 2012

**OPPOSITION SYSTEMS AND OTHER ADMINISTRATIVE REVOCATION
AND INVALIDATION MECHANISMS**

Document prepared by the Secretariat

Table of Contents

EXECUTIVE SUMMARY	3
I. INTRODUCTION	5
II. OVERVIEW OF OPPOSITION SYSTEMS AND RELATED MECHANISMS	6
III. RATIONALE AND OBJECTIVES	10
IV. INTERNATIONAL LEGAL FRAMEWORK.....	16
V. EXAMPLES OF OPPOSITION PROCEDURES.....	17
VI. RELATED MECHANISMS	35
A. Re-examination Systems	35
(i) Ex parte Re -examination under 35 U.S.C. § 302 to § 307	38
(ii) <i>Inter partes</i> re-examination	39
(iii) A substantial new question of patentability	41
(iv) Inter partes review	41
B. Submission of Information by Third Parties	42
(i) Rationale and objectives	42
(ii) National/Regional laws	44
C. Administrative Revocation and Invalidation Mechanisms	51
(i) Rationale and objectives	51
(ii) National/Regional laws	52
VII. INTERFACE BETWEEN THE DIFFERENT MECHANISMS	56
A. Recent Reforms of National Systems	56
B. Combination of Various Mechanisms	60

ANNEXES:

ANNEX I: Statistics ~~on Opposition~~[ANNEX II: Compilation of Different Opposition Systems and Related Mechanisms](#)

EXECUTIVE SUMMARY

1. Pursuant to the decision of the Standing Committee on the Law of Patents (SCP) at its thirteenth session, held from March 23 to 27, 2009, in Geneva, a preliminary study on patent opposition systems (document SCP/14/5) was prepared by the Secretariat. That document contextualized various aspects relating to existing opposition systems in a comprehensive manner, and contained no conclusions.
2. ~~At In accordance with the decision of the SCP at~~ its sixteenth session, held from May 16 to 20, 2011, in Geneva, the ~~SCP requested the~~ Secretariat ~~to revise~~ revised document SCP/14/5, ~~taking into account the comments made, and any additional information to be submitted, by Member States. The present document implements the above request and revises the document on in respect of~~ issues which were raised by Member States at the fourteenth, fifteenth and ~~sixteenth~~ sessions of the SCP, taking into account additional information submitted by Member States regarding their opposition systems— and prepared document SCP/17/9.
3. At its seventeenth session, held from December 5 to 9, 2011, the SCP requested the Secretariat to further revise document SCP/17/9 (Opposition Systems), taking into account the comments made, and any additional information to be submitted, by Member States, in particular, information on administrative revocation and invalidation mechanisms, and other similar procedures not addressed in the above document. The present document implementing the above request is thus submitted to the eighteenth session of the SCP, to be held from May 21 to 25, 2012.
4. Following a general introduction, Chapter II provides an overview of opposition systems and other related administrative revocation and invalidation mechanisms 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.
5. Chapter III describes the objectives of opposition systems and their role in the proper functioning of the patent system. Costs and benefits are mainly described from the viewpoint of quality and validity of patents, as well as of efficiency and effectiveness of patent procedures so that opposition systems support the public policy objectives of each country.
6. 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.
7. Chapter V describes the national/regional laws and practices of Australia, Brazil, Costa Rica, Denmark, Egypt, Finland, Germany, Honduras, India, Norway, Pakistan, Portugal, the Republic of Moldova, Spain, Sweden, the ~~European Patent Office (EPO) and the United States of America, the~~ Eurasian Patent Office (EAPO) and the European Patent Office (EPO) as concrete examples of different opposition systems.
8. Chapter VI ~~finally~~ provides some other mechanisms that are related to opposition systems, namely, re-examination systems applied in Australia, Denmark, Norway and the United States of America—~~and~~ third party observations mechanisms available in Australia, China, Denmark, ~~China~~, Finland, Japan, Mexico, Norway, Pakistan, the Philippines, the Republic of Korea, ~~Slovak Republic~~ the Russian Federation, Slovakia, Spain, the United Kingdom, the United States of America and the EPO, as well as other administrative revocation and invalidation mechanisms provided by China, Costa Rica, Japan, Mexico, the Philippines, the Republic of Korea, the Russian Federation, Slovakia and the United States of America. ~~Kingdom~~. 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.~~

9. Finally, Chapter VII provides a comparative analysis of the different opposition systems and related mechanisms. It aims at summarizing the interrelationship between the opposition systems and related mechanisms, in particular with a view to recent national reforms of the opposition systems, without drawing any specific conclusions. Accordingly, Annex II to this document contains a comparative table of the different mechanisms.

I. INTRODUCTION

10. 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.

11. It was understood by the Committee that those issues were 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.).

12. Accordingly, document SCP/14/5 was prepared by the Secretariat as a preliminary study on the issue of opposition systems for the fourteenth session of the SCP, held from January 25 to 29, 2010.

13. At its sixteenth session, held from May 16 to 20, 2011, in Geneva, the SCP requested the Secretariat to revise ~~the preliminary study on opposition systems (document SCP/14/5), taking into account the comments made, and any additional information to be submitted, by Member States. The present document implements the above request and revises the document~~ on issues which were raised by Member States at the fourteenth, fifteenth and sixteenth sessions of the SCP, taking into account information submitted by Member States regarding their opposition systems.¹

14. ~~The present~~Therefore, document [SCP/17/9 submitted to the seventeenth session of the SCP, held from December 5 to 11, 2011](#), primarily addresseds opposition systems, which are understood as time-bound *inter partes* procedures before a patent office, 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 described in Chapter VI.~~

15.— ~~It is probable, however, that~~and considering the high probability that the term “opposition system” may have different meanings under various national laws or in different languages. ~~Thus, in addition to the information on opposition systems in the above sense,~~ Member States ~~have had~~ submitted information on various procedures available under the national laws including, for example, on invalidation or revocation procedures conducted before the patent offices/quasi-judicial bodies and/or courts and procedures related to the limitation of granted patents which may be initiated solely by the patentee.² Although those procedures also aim at improving the quality of granted patents, they were not included in ~~this~~ document [SCP/17/9](#), since the purpose of the ~~preliminary~~ study ~~is~~ ~~was~~ to focus on time-bound *inter partes* opposition systems generally filed by third parties and related mechanisms, such as re-examination procedures, and third party observation mechanisms conducted before the patent offices. ~~However~~

¹ In response to Circular 7992 dated June 10, 2011, the information has been received from Australia, Denmark, Finland, Georgia, Germany, Honduras, Mexico, Pakistan, Portugal, Republic of Korea, Republic of Moldova, Slovak Republic, Spain, Sweden, Ukraine, the United States of America and the European Patent Office (EPO).

² Information on those other procedures was received from Costa Rica, Mexico, the Republic of Korea and the Slovak ~~Republic~~ Republic.

15. At its seventeenth session, the SCP requested the Secretariat to revise document SCP/17/9, taking into account the comments made, and any additional information to be submitted, by Member States, in particular, information on administrative revocation and invalidation mechanisms, and other similar procedures not addressed in the above document.

16. Pursuant to that request, the present document contains additional information on administrative revocation and invalidation mechanisms conducted before the patent offices and/or quasi-judicial bodies. Those mechanisms are similar to opposition systems, as they are *inter partes* proceedings to challenge the patentability of inventions, but they are in general not time-bound. With a view to summarizing the different mechanisms available, the present document provides a non-conclusive comparative analysis in Chapter VII and information on recent reforms in patent laws. Annex I contains statistics submitted by some Member States. Annex II provides a comparative table on the different mechanisms available at the national, regional and international levels.

17. In addition, all submissions by members and observers of the SCP concerning the various mechanisms ~~containing those other procedures~~ are available on the website of the SCP electronic forum, in view of their valuable contribution to the better understanding of national systems.

18. 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 AND RELATED MECHANISMS

19. Many countries provide opposition mechanisms in their patent systems. Opposition systems *stricto sensu* offer third parties an 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). In some countries, an opposition may be filed pre-grant, within a certain time period immediately after the publication of the application for a patent and before the examination phase, in which case the procedure resembles, to a certain extent, the so-called third party observation system. It is possible to combine pre-grant and post-grant opposition systems. 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 *inter partes* procedures conducted before the patent office, not a court.

20. 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.

21. In some countries, the pre-grant opposition system is designed in such a way that it starts after the publication of the patent application and before substantive examination. Once the patent application is published, an opposition may be filed within a certain time period prescribed under the applicable law. The opponent shall state the grounds for opposition and submit any evidence. If no opposition is filed during that period, the substantive examination will be carried out. If an opposition is filed, the applicant will be notified, and given an opportunity to make observations and/or amend the application within the prescribed time period. The conclusion of the opposition will be notified to both the applicant and the opponent.

22. 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, amended or revoked.

23. Since one of the objectives of the opposition system is to provide a simple mechanism to ensure the quality and validity of granted patents, procedural and substantive requirements provided by the applicable laws regarding opposition systems have certain common aspects. However, there are differences in the details. Some of these differences are the following:

(i) the timeframe during which an opposition may be filed: the opposition period may start immediately after the publication of the patent application, after the completion of the substantive examination with a positive result and/or after the grant of the patent;

(ii) entitlement to file an opposition: 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;

(iii) the threshold for opposition: in many countries the opponent has to provide full evidence of the grounds on which the opposition is based. In one country, an opposition may be instituted if it is "more likely than not" that the patent is invalid; with respect to admissibility, in some countries, the request has to be sufficiently substantiated, provide written documents and other evidence, while in other countries, the criteria of admissibility are not defined in the patent laws;

(iv) the disclosure of the identity of the requester: in some countries, it is possible for the opponent, the true party in interest, not to disclose his identity,³ which may be in support of a continued good business relationship between the opponent and the patent applicant or patentee;

³ In 1999, the Enlarged Board of Appeal of the European Patent Office held that the use of a straw man did not render the opposition inadmissible unless "the involvement of the opponent is to be regarded as circumventing the law by abuse of process." <http://www.epo.org/law-practice/case-law-appeals/recent/g970003ep1.html>

(v) the length of the opposition period: the length of the opposition period varies from country to country. Among the countries listed in Chapter V, the duration varies from two to six months for pre-grant opposition and from six to 12 months for post-grant opposition;

(vi) the grounds for an opposition: in many countries, the requirements regarding novelty, inventive step, industrial applicability, sufficiency of disclosure and addition of new matter going beyond the original disclosure are grounds for an opposition.

Non-compliance with the requirements concerning the exclusions from patentable subject matter also forms part of the grounds for an opposition in many countries. Some countries accept an opposition on the grounds that an applicant/patentee is not entitled to the right to a patent, or on other grounds covering all requirements that should be fulfilled to obtain a patent. They include, for example, the fact that information regarding corresponding foreign applications was not submitted, the source or geographical origin of biological material used in the invention was not disclosed, or the essential formalities were not complied with;

(vii) reviewing officers: the opposition may be conducted by an examination division or the proceedings may be held before a special opposition board; the board may include technical and legal examiners or judges;

(viii) *inter partes* procedural requirements: formal and procedural requirements relating to, for example, a request, notification to parties, arguments, evidence, oral hearing and final decision depends on the applicable law, most likely based on the general civil procedural law of each country;

(ix) opposition fee: in many countries, the payment of an opposition fee is required to file an opposition;

(x) the effect of the opposition on civil actions: in some countries the opposition has an estoppel effect or the effect that civil proceedings are stayed. In other countries, both administrative and civil proceedings can be pursued independently and in parallel; and

(xi) the timeframe for filing an opposition: in one country the final determination has to be issued within one year, extendable up to six months; in many countries, no time limits for a final administrative decision is specified.

24. 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, final administrative decisions in procedures concerning the acquisition and maintenance of intellectual property rights as well as the administrative revocation and *inter partes* procedures shall be subject to review by a judicial or quasi-judicial authority.

25. The number of patent applications/patents in respect of which oppositions are filed is not very high.⁴ For example, the opposition rate at the European Patent Office (EPO) in 2008, 2009 and 2010 was 5.32%, 4.7% and 5.2%, respectively. Information on other countries' statistical data on oppositions is available in ~~the~~ Annex I to this document.

26. In a larger sense, the opposition system is complemented by related mechanisms which allow third parties to intervene in the patent examination process before the grant of a patent or to challenge the grant of a patent after its grant. Those mechanisms are similar to an opposition

⁴

However, according to the statistics received from some Member States, there was a case where the share of the applications/patents ~~on~~ in respect of which oppositions were lodged was high (see the information received from Pakistan in the Annex to this document).

system, but may differ in some aspects from opposition systems *stricto sensu*. Three types of related mechanisms can be distinguished:

(i) third party observations: many patent systems provide the opportunity for third parties to submit prior art documents or other related information, including comments and observations during the patent examination process. Those pre-issuance submissions by third parties are considered to contribute to a higher quality of patents as they assist the patent examination by submitting information on prior art, for example, published patent applications and other printed publications of potential relevance. Third-party observations do not trigger a specific review process, but are in most countries made available to the public and included in the file. In some countries, additional mechanisms are provided beyond third party observations. Third party observations are distinct from opposition system as they do not trigger a review process, they are generally restricted to prior art documents, and the submitting third party does not become a party to the process (*ex parte*).

(ii) re-examination: in some countries, procedures exist to provide the post-grant opportunity for third parties to request a re-examination of the patent in the context of new pieces of prior art. In general, the main difference between re-examination and a post-grant opposition system consists in the fact that post-grant opposition can be raised within a certain time period, while a re-examination may be requested during the lifetime of the patent. Re-examination can be conducted *ex parte*, (largely without the participation of the requester in the conduct of the re-examination) or *inter partes*, with greater participation of the respective parties. *Ex parte* re-examination often has the characteristic of re-conducting substantive examination at the administration level on the basis of the prior art submitted by the requester of the re-examination. *Inter partes* re-examination in certain countries is similar to administrative revocation or invalidation mechanisms in some other countries in the sense that both provide for a wide range of substantive grounds and *inter partes* proceedings allowing third parties to challenge a patent before an administrative body. However, the proceedings of *inter partes* re-examination are generally conducted as a second examination by the patent office itself rather than as a full *inter partes* administrative review by a specialized board. Further, in one country, *inter partes* re-examination is also limited to the grounds of novelty and inventive step. In some countries, *inter partes* re-examination mechanisms complement the opposition system after the opposition period has expired.

(iii) administrative revocation and invalidation: some countries provide for administrative revocation and invalidation mechanisms available after the grant of the patent without a time limit, in some countries even after expiry of the patent. Those mechanisms provide for similar *inter partes* opportunities for third parties to challenge a patent on administrative, non-judicial grounds. For example, Japan provides for the possibility of an administrative appeal for revocation called “trial for invalidity”. Administrative review mechanisms might complement a system of third party observations or pre-grant opposition system, such as in some countries in Asia, for example, China, Japan, the Philippines and the Republic of Korea, or in Costa Rica. In general, the administrative review is conducted by a specialized board which reviews certain grounds for invalidity. Therefore, those mechanisms are sometime called “administrative appeal for revocation”. In addition, in most countries, an appeal of the administrative review decision is possible, generally to a court, which may be a specialized patents court in some countries.

III. RATIONALE AND OBJECTIVES

27. The patent system intends to promote innovation, dissemination and transfer of technology 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.

28. 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, [since the patent examination process is conducted primarily ex parte](#), 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 in a given country, since the piece of prior art could be published in an exotic language or in an isolated publication. Further, in some countries, only formality examination is conducted. 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,⁵ 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 is also beneficial for a patentee, since the patentee can have more trust in the validity of his patent. Thus, a patent granted on an invention that has gone through opposition proceedings would be considered as having a higher credibility in terms of its compliance with novelty, inventive step and other requirements of patent law.

29. Compared to the review process before a court, the opposition system [has and related administrative mechanisms have](#) various advantages. They include:

- (i) the opposition procedure, which is an administrative process, is generally simpler, quicker⁶ 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

⁵ The third parties could be, *inter alia*, competitors of the applicant or patentee having a good knowledge of the technological area concerned and who have their business interest in eliminating deficient patents.

⁶ In a study related to the EPO, it was reported that the duration of the opposition procedure, from filing the notice of opposition till the delivery of the decision by the Opposition Division, was about 1.9 year on average (See D. Harhoff, K. Hoisl, B. Reichl, and B. Van Pottelsberghe, Patent Validation at the Country Level – The Role of Fees and Translation Costs, Research Policy, Elsevier, 2009, v. 38(9)). However, it was reported that in some technical fields the median duration of the opposition and appeal at the EPO can be estimated in average at about 3.07 years. (See S.J.Graham et.al. Patent Control: A Comparison of U.S. Patent Re-examination and the European Patent Oppositions, August 2002).

the wider knowledge of the general public; in addition, in, some countries, the reviewing body may also consider evidence not presented by the parties;

(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 concerned⁷;

(iv) differently from litigation in court in some countries, the patent applicant or patentee is given, by the administrative body conducting the opposition, an opportunity to narrow or amend the claims, in order to avoid the refusal or revocation of the patent application or patent;

(v) the proceedings before an opposition board is considered to put less strain than revocation litigation on the relationship of parties, which might be partners in other research and development projects. For example, in some countries, the third party might oppose anonymously a patent, and the procedure of submitting third party observations is largely documentary or conducted *ex officio*.

30. 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.⁷ 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.

31. Viewed from the angle of innovation policy, the positive effect of the patent system on innovation can only be achieved by valid patents complying with all the requirements of the applicable law. Patent opposition procedures, along with other revocation procedures available under the national law, can be considered as one of the possible tools available in the patent system which support the grant of valid patents. It is in keeping with the broad policy objectives of the patent system and in the interest of various stakeholders, such as government, industry, academia, the patentees and third parties, that patents are granted only to genuine inventions that meet all the requirements under the applicable law. While the grounds for opposition may differ from country to country, the most common grounds provided under national laws, such as the lack of novelty, inventive step or industrial applicability and non-compliance with the requirement of sufficient disclosure, are grounds that are often invoked by patent examiners to reject patent applications. By ensuring a high credibility and validity of granted patents, the opposition mechanisms, along with other revocation procedures, mitigate the problem of cost that patents of unsatisfactory quality may create.⁸ Patents that meet all the requirements imposed by patent laws may be reliably enforced in court and licensed to others. At the same time, such patents also provide the greatest value to the public and clarify the extent to which others may approach the protected invention without infringing it.

32. In order to set up an opposition procedure, the administration (the patent office) needs to have relevant resources, such as technically qualified examiners or other officers who will conduct the opposition proceedings.⁹ This could be relevant particularly for offices in

⁷ Recommendations 16 and 20 of the WIPO Development Agenda touch upon the public domain issues.

⁸ In addition to high social cost, invalid patents create cost for patentees of such patents if the patentees need to spend resources in fighting off litigation involving patents with questionable validity.

⁹ As an alternative, a patent Office which does not have resources to conduct substantive review may conclude cooperation agreement with other offices. For example, while the Intellectual Property Office of Singapore does not provide the opposition procedure, upon cooperation

developing countries which may have more difficulty in hiring technically qualified staff and have perhaps a more limited access to technological material on prior art to carry out substantive examination.¹⁰ In this context, it is recalled that the opposition procedures are closely related to the patent granting procedures. Since high quality substantive examination requires human and financial resources, it seems that opposition systems are utilized in the national/regional patent granting procedures either as a supplementary mechanism to the substantive examination by examiners or as a complementary mechanism to substantive examination. Taking the former approach, patent examiners are primarily tasked to conduct substantive examination, and only where they made affirmative decisions, the general public has the opportunity to supplement the examination shortly before or after the patent grant. On the other hand, according to the second approach, the general public plays a complementary role in examining patent applications, thus “examining” published patent applications which have not been reviewed by patent examiners yet. In the latter case, one researcher stated that such procedures allow the opposition to a patent at a wrong time, as the only information available for third parties at that early stage would be the patent specification as filed.¹¹ Nevertheless, different approaches are possible depending on the resources available in the patent office examination sector and in the general public, as well as on the allocation of tasks among different “agents” in order to provide an optimal examination/review mechanism. [It has been recommended that countries without substantive examination should inform the public about observations by third parties in the absence of opposition proceedings.](#)¹² Therefore, it is considered important that the patent law of each country explore various mechanisms which would allow detecting and challenging the grant of invalid patents at an early stage of the patent granting procedure, taking into account the available resources.

33. The opposition is subject to the payment of fee in most countries. However, in general, such fee is not significant compared to patent litigation costs.¹³ Opposition fees are set by the national patent offices reflecting, in general, the marginal costs for the patent offices to review the applications or patents under opposition, and countries are free to make such procedures free of charge or to provide various flexibilities to various opponents, for example to natural persons or small and medium sized enterprises, if they wish to do so. While, at the national level, various fee-related policies can be adopted by the patent offices, it is most likely that opponents should bear the cost of hiring professional advisors to assist them in preparing and filing the opposition case. The fee related to hiring professional advisors is particularly relevant when the opponent is a national or resident of another country and, therefore, according to the national law, may be obliged to hire a local advisor to file an opposition.¹⁴

[Footnote continued from previous page]

agreements concluded with other patent offices, such as the Austrian Patent Office, IP Australia, the Danish Patent and the Trademark Office and the Hungarian Patent Office, it outsources search and examination work in relation to patent applications, as well as the re-examination of the granted patent(s) initiated by the Registrar or any person to revoke a patent.

¹⁰ There are various projects undertaken by WIPO to improve access of developing countries to prior art databases. These initiatives are described in documents SCP/13/5 and SCP/14/3.

¹¹ Jakkrit Kuanpoth, Appropriate Patent Rules in the Developing Country – Some Deliberations Based on Thai Legislation, *Journal of Intellectual Property Rights*, Vol. 13, Sept 2001, 447-455.

¹² [AIPPI, Yearbook 1991/I, pages 291-294.](#)

¹³ For example, it was estimated that the patent litigation cost in Germany could be around EUR 50.000 (cost of 1st instance) and EUR 90.000 (cost of second instance) (See Communication from the Commission to the European Parliament and the Council, Enhancing the Patent System in Europe, Brussels, 3.4.2007, COM(2007)). The fee for filing an opposition in Germany with DPMA is EUR 200.

¹⁴ Article 2(3) of the Paris Convention (and Article 3(2) of the TRIPS Agreement by reference to the Paris Convention), allows certain discrimination against nationals of other countries including in relation to the requirement that foreigners should appoint a local agent.

34. One of the major challenges in designing an opposition procedure¹⁵ is that it could 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.¹⁵ 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. However, the pre-grant opposition introduces an additional period during which all the applications are pending before the patent office prior to the grant of the patents. In practice, only a small number of applications are opposed.¹⁶ Consequently, although it is a matter of several months, in general, there is an inevitable delay across the board in granting patents, including for applications which were not subject to opposition, for the period during which an opposition could be filed. In a post-grant opposition system, the delay will only be applicable, in principle, to those affected by oppositions and this does not have an impact on those patents not subject to any opposition. However, 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 opposed patent could be uncertain.¹⁷ Another effect of the post-grant opposition could be that such patents may not be considered of a high commercial value, since potential licensees may hesitate to enter into licensing agreement due to the uncertainty over the validity of the patent during the opposition period.¹⁸ 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 delay the granting process and introduce a period of uncertainty as regards the enforceability of opposed patents and hold up licensing deals. [In comparison, some researchers found that, in Australia, the processing period for a pre-grant opposition often amounts to more than one year, similar to the periods for the processing of post-grant oppositions.](#)¹⁹

35. The publication of relevant information, [such as the publication of the patent application after 18 months from the filing date \(or priority date\) and/or the publication of the granted patent,](#) is a prerequisite for pre-grant and post-grant opposition. However, the scope of published information, for the purposes of opposition, may vary from one country to another,²⁰ from the publication of all information contained in patent applications, including the detailed description

¹⁵ 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).

¹⁶ The statistical data submitted by the Member States appears to support this conclusion. See Annex to this document.

¹⁷ In addition, some patent laws allow the alleged infringer to intervene in the opposition proceeding in response to the request of the patentee, whose patent is being opposed, to cease alleged infringement.

¹⁸ This particularly could be the case for inventions in some technological areas which have higher probability of being opposed than patents in other areas. In addition, the possibility of the patents to be objected by third parties, if such mechanism exists under the applicable law, would probably also be taken into account by the potential licensees in the decision making process.

¹⁹ See K. Weatherall, F. Rotstein, Ch. Dent, and A. Christie, Patent Oppositions in Australia: The Facts, UNSW Law Journal, Volume 34(1), 2011, p. 106 (with reference to Australia mean number of delay 2.4 years, median number 1.8 years).

²⁰ According to Article 12 of the Paris Convention, while each country of the Union has to establish a special industrial property service for the communication to the public of, *inter alia*, patents through its publication, the publication is only mandatory in relation to essential data such as, the names of the proprietors of patents granted, with a brief designation of the inventions patented. Thus, the Paris Convention does not specify how patents should be “communicated to the public”.

of inventions, in some countries, to only the bibliographic data²¹ in other countries. However, it is to be noted that even in those countries where only the bibliographic data is published, the patent offices make available to the public the full contents of patent applications or patents for inspection, and allowing third parties to access the entire applications or patents in the pre-grant or post-grant opposition context.²² In addition, easier access to prior art information by third parties will make it more easy for them to substantiate their opposition claim.

36. Even if a third party, often a competitor, has access to relevant information and has evidence that could be sufficient to file an opposition to prevent a patent to be granted or to revoke a granted patent, he may not necessarily launch the opposition in view of his overall business interest. For example, a patent may be so trivial that it can easily be designed around. Further, not every granted patent will be successfully commercialized and therefore might not be opposed by competitors. An opposition system is only one of the various mechanisms that support the patent administration in fulfilling the public policy objectives, and an effective opposition system can be designed only in connection with the patent-granting procedures and other revocation mechanisms in a given country.

~~30.—The changes made in the Japanese opposition system during the past 15 years are interesting from the policy perspective. Prior to 1996, 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,²³ and in 1996, 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 publication of the gazette containing the patent. However, the opponent cannot fully participate in the review process, which is conducted between the patent office and the patentee.²⁴ 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 capable of reviewing the validity of patents regardless of the status and outcome of the administrative appeal proceedings at the Japan Patent Office.²⁵~~

²¹ Such as the name and address of the applicant, inventor and patent agent; the title of the invention; the date of the filing of the application; and the date, place and serial number of the earlier application the priority of which is claimed.

²² Within the Program on Modernization of IP Institutions, WIPO have assisted national IP Offices in making their databases available to public through digitations of paper documentation.

~~²³ —In connection with the Structural Impediments Initiative (SII) negotiated between the United States of America and Japan in late 1980s, the former argued that a great number of pre-grant oppositions filed by Japanese firms on the patent applications filed by US firms purposely delayed the grant of patents on US inventions, and thus unfairly benefitted the Japanese industry. Japan responded that its opposition system had not delayed the patent granting process, since among a small number of opposition cases, it was only in very exceptional cases where a great number of opposition requests had been filed on one application.~~

~~²⁴ —Goto A, Motohashi K. Construction of a Japanese Patent Database and a First Look at Japanese Patenting Activities. Research Policy 2007; 36:1431-42. The authors concludes that the change to the post-grant opposition system from the pre-grant opposition system resulted in the Japan Patent Office accelerated the granting of patents, and all pending patents under the old pre-grant opposition period prior to 1996 were processed in that year.~~

~~²⁵ —Fujitsu v. Texas Instruments, 1998(O)No. 364, Supreme Court, April 11, 2000.~~

~~31.— 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.²⁶~~

~~32.— 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 over-burdened the State Intellectual Property Office (SIPO). At present, the patent invalidation procedure is the only mechanism available for challenging the validity of a patent.²⁷~~

~~33.— Although it may still be too early to draw any conclusions from the changes that took place in Japan and China which were made in the specific contexts of these countries, 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.~~

37. While national/regional opposition systems are different, in view of the above paragraphs, non-exhaustive factors that may contribute to an enabling environment for an effective opposition system may include:

- (i) easy access to patent applications and patents that are laid open for opposition;
- (ii) easy access to prior art information;
- (iii) availability of human resources capable to conduct opposition procedures;
- (iv) reasonable opposition timeframe which balances the interests of applicants/patentees and third parties;
- (v) reasonable formalities and procedures that allow effective conduct of opposition procedures, such as:

²⁶ — ~~While, at present, the academic research providing conclusive evidence on the role of the opposition systems in enhancing innovation in Japan is scarce, one paper focusing on the topic of patents and incentive to innovate in Japan and the United States of America suggests that the Japanese first-to-file system as compared to the (soon-to-be-replaced) first-to-invent in the United States of America places more information in the public domain sooner, induces the filing of a patent application sooner in the innovation process; and that the opportunity for pre-grant opposition strengthens the incentives to monitor competitors' patent filings early on. (See Wesley Cohen et al., R&D and Spillover, Patents and the Incentives to Innovate in Japan and the United States, Research Policy, 31 (2002)).~~

²⁷ — ~~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.~~

- conduct of *inter partes* procedures that include adequate documentary and/or oral proceedings;~~and~~

- rules for the provision of supporting evidence and arguments;

- composition of the opposition body that takes into account the policy objectives pursued by the opposition system;

(vi) grounds for opposition that balance the interest in the quality of the patent system and legal certainty;

(vii) ~~appropriate~~ fee mechanisms; and

(viii) rules on the interrelationship between opposition procedures and litigation.

IV. INTERNATIONAL LEGAL FRAMEWORK

38. 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.

AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS (TRIPS AGREEMENT)

39. 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."

40. 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.

41. 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)

42. 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.

43. 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.

44. 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.

45. 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

46. 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) [disclosure of the identity of the requester](#); (iv) period for filing an opposition; (v) grounds for an opposition; (vi) *inter partes* procedural requirements, such as a request, notification to parties, arguments, evidence, oral hearing, final decision etc.; and (vii) 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. [In some countries, opposition systems are named differently, for example, Brazil's administrative nullity proceedings. However, in this document, time bound and *inter partes* procedures for challenging patents are referred to as "opposition systems".](#)

AUSTRALIA

47. Australia operates a pre-grant opposition system for standard patent applications,²⁸ where any person may oppose the granting of a patent within three months of acceptance of the application²⁹ being advertised in the Official Journal of Patents.

48. According to Section 59 of the Patents Act, the Minister or any other person may, in accordance with the Regulations, oppose the grant of a standard patent on one or more of the following grounds, but on no other ground:

- (i) that the nominated person is either (a) not entitled to the grant of a patent for the invention; or (b) entitled to the grant of a patent for the invention, but only in conjunction with some other person;
- (ii) that the invention is not a patentable invention;
- (iii) that the specification filed in respect of the complete application does not comply with subsection 40(2) or (3).³⁰

49. As provided in Section 60 of the Patents Act, the opposition is heard by the Commissioner which must decide the case in accordance with the Regulations. The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding the case. The Commissioner may, in deciding the case, take into account any ground on which the grant of a standard patent may be opposed, whether relied upon by the opponent or not. The applicant, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this Section. Oppositions can also arise with regard to procedural matters including:

- (i) amendments: under Section 104(4) of the Patents Act, any person may oppose the allowance of an amendment. Section 102 of the Patents Act provides that amendment of complete specification are not allowable if amended specification would claim matter not in substance disclosed in the filed specification;
- (ii) extensions of time: under Section 223(6) of the Patents Act, any person may oppose the granting of an extension of time;
- (iii) extension of term for a pharmaceutical patent; under Section 70 of the Patents Act, any person may oppose the grant of an extension of term under Section 75 but only on the grounds that Section 70 (defines what subject matter is available for extension of term) or Section 71 (relating to the form and timing of an application) is not met;

²⁸ There are two types of patents in Australia, the “standard” patent and the “innovation” patent (similar to utility model). Oppositions to innovation patents can only be initiated after the patent has been granted and then certified. For further information on innovation patents, see the submission of Australia available on the SCP electronic forum website at: http://www.wipo.int/export/sites/www/scp/en/meetings/session_17/opposition/australia.pdf.

²⁹ Section 49 (1) of the Patents Act provides that, subject to Section 50, the Commissioner must accept a patent request and complete specification relating to an application for a standard patent, if: (a) the Commissioner is satisfied that the invention satisfies the criteria mentioned in paragraph 18(1)(b), i.e., novelty and inventive step; and (b) the Commissioner considers that: (i) there is no lawful ground of objection (other than a ground in respect of paragraph 18(1)(b)) to the request and specification; or (ii) any such ground of objection has been removed.

³⁰ Subsection 40(2) of the Patents Act provides that a complete specification must (i) describe the invention fully, including the best methods known to the applicant of performing the invention, and (ii) end with a claim or claims defining the invention. Article 40(3) states that the claims or claim must be clear and succinct and fairly based on the matter described in the specification.

(iv) amendment of the Register or a patent: under Regulation 10.7(4) of the Patents Regulations 1991, any person may oppose the making of an amendment of the Register;

(v) grant of a licence to exploit an invention: under Regulation 22.21(4) of the Patents Regulations 1991, a person who receives a copy of an application for a licence can oppose the granting of that licence.

50. According to the data submitted by the Australian Patent Office, there were 130 oppositions over 27,594 applications filed³¹ in 2006/2007 reporting period, compared to 109 over 27,979 applications filed in 2007/2008, 167 over 26,259 applications filed in 2008/2009, 120 over 25,443 applications filed in 2009/2010 and 143 over 26,473 applications filed in 2010/2011.

BRAZIL

51. The Industrial Property Law of Brazil³² 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.³³

52. The administrative nullity proceedings can be instituted on any of the following grounds:³⁴

(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.

53. 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.³⁵

54. 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 at the administrative level³⁶ and could be appealed in court. Nullity of a patent shall produce effects from the filing date of the application.³⁷

³¹ The applications filed number does not include provisional filings, but does include both innovation and standard patent applications.

³² The Industrial Property Law No.9.279 of May 14, 1996.

³³ Article 51 of the Industrial Property Law.

³⁴ Article 50 of the Industrial Property Law.

³⁵ Article 53 of the Industrial Property Law.

³⁶ Article 54 of the Industrial Property Law.

³⁷ Article 48 of the Industrial Property Law.

COSTA RICA

55. In the case of Costa Rica, Article 12 of the Law on Patents, Industrial Designs and Utility Models,³⁸ states that any person may oppose a patent within three months, beginning from the third publication of the application in the Official Journal (*La Gaceta*), on the grounds that the substantive requirements prescribed by the law are not fulfilled. 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 thereof shall be presented within two months following the opposition, subject to inadmissibility.³⁹ Similarly, Section 18 of the Regulations under the above Law⁴⁰ states that the opposition shall contain *inter alia* the basic grounds for and right of the opposition, the proof that it is relevant in support of the grounds for opposition, and the proof of payment of the opposition fee. 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 substantive examination provided for in Article 13 of the Patent Law shall be conducted. Once the pre-grant opposition period has lapsed without any form of opposition, the substantive examination provided for in Article 13 shall be conducted.

56. Following the preparation of the examination report, a reasoned decision as to whether to grant a patent or not is made, and the decision is 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.

DENMARK

57. The Consolidated Patents Act⁴¹ provides a post-grant opposition. Granted Danish patents may be opposed by any person within nine month of the date of the publication of the grant of a Danish patent in the Danish Patent Bulletin.⁴²

58. The notice of opposition must be filed in writing and contain, *inter alia*, a statement of the extent to which the Danish patent is opposed and of the grounds on which the opposition is based, as well as the facts and evidence in support of the grounds.

59. As provided by Section 21 of the Consolidated Patents Act, the opposition can only be based on the following grounds: the subject matter does not fulfill the patentability criteria (industrial applicability, novelty, inventive step), the invention is not sufficiently disclosed to allow a person skilled in the art to carry it out; and the content of the patent extends beyond the content of the application as filed.

60. After a hearing phase with the parties of the opposition case, the Opposition Division renders a decision. The result can be to reject the opposition, to revoke the patent or maintain the patent in amended form.

61. A notice of appeal must be filed to the Danish Board of Appeal within two months of notification of the opposition decision, and the fee for appeal must be paid.

³⁸ [The Law on Patents, Industrial Designs and Utility Models, No. 6867.](#)

³⁹ [Paragraph 1 of this Article has been reformed through Law No. 8632 of March 28, 2008. *La Gaceta* No. 80 of April 25, 2008.](#)

⁴⁰ [Executive Decree No. 15222 MIEM J.](#)

⁴¹ The Consolidated Patents Act No. 91 of 28 January 2009.

⁴² Section 21 of the Patents Act.

EGYPT

62. 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 Rights⁴³ 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.

63. 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.⁴⁴

64. 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.⁴⁵

65. 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.⁴⁶ The Committee delivers the decision within 60 days from the date of the filing of the opposition notice.⁴⁷ 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.⁴⁸

66. 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.

FINLAND

67. According to the Patents Act of Finland,⁴⁹ any person, including the proprietor of the patent, can file an opposition against a granted patent. The opposition must be filed in writing within nine months from the date of the grant of the patent and it must specify the grounds on which it is made. The proprietor of the patent will be notified thereof and he will be given an opportunity to make observations on the opposition. According to Section 25 of the Patents Act, a patent shall be revoked on the following grounds:

- (i) the invention lacks novelty, inventive step or industrial applicability;

⁴³ Law on the Protection of Intellectual Property Right 82 of 2002.

⁴⁴ Article 17 of the Law on the Protection of Intellectual Property Right 82 of 2002.

⁴⁵ Rule 24 of the Regulations of Law 82 of 2002.

⁴⁶ Rule 27 and 28 of the Regulations of Law 82 of 2002.

⁴⁷ Article 36 of the Law on the Protection of Intellectual Property Right 82 of 2002.

⁴⁸ Rule 29 of the Regulations of Law 82 of 2002.

⁴⁹ Patents Act 15.12.1967/550.

- (ii) the patent relates to an invention the description of which is not sufficiently clear to enable a person skilled in the art to carry out the invention;
- (iii) the patent contains subject matter not included in the application as filed.

68. At the moment, there is no opposition fee. However, an opposition fee must be paid when the opposition is filed against a patent which will be granted on or after November 1, 2011.

69. According to the National Board of Patents and Registration of Finland, the number of oppositions filed was 21 in 2008, 26 in 2009 and 23 in 2010.⁵⁰

GERMANY

70. Under the Patents Act of Germany, a notice of opposition against a granted patent can be filed at the German Patent and Trade Mark Office (DPMA). The opposition must be filed at the DPMA within three months from the publication of the patent grant.⁵¹ The time limit is observed only if all admissibility requirements are met within the specified period. In particular, the notice of opposition must be sufficiently substantiated. Reestablishment of rights is not available if the time limit for filing an opposition has not been observed. Under the Patent Costs Act⁵² the filing of an opposition is subject to a fee of 200 EUR, to be paid to the DPMA within the opposition period.

71. Anyone can oppose a patent, except the patent owner himself.⁵³ In case of usurpation,⁵⁴ only the injured party can file an opposition against the patent.

72. The notice of opposition must be filed with the DPMA in writing, bear a hand-written signature, and comply with all other requirements for admissibility. These include, for example, the requirement that the notice of opposition must not leave any doubt as to the opponent's identity. In the reasoning, the opponent must specify the facts supposed to lead to the conclusion that the patent has to be revoked in full or in part. The relevant actual facts must be explained in detail in such a way that the DPMA and the patent owner need not further investigate the matter in order to examine whether or not there is a ground for revocation.

73. Section 21(1) of the Patents Act sets out the grounds for revocation on which an opposition can be based. According to this provision, a patent will be revoked if:

- (i) the subject matter of the patent is not patentable under Sections 1 to 5 of Patents Act;
- (ii) the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (iii) the essential elements of the patent have been taken from the descriptions, drawings, models, appliances or equipment of another person, or from a process used by another person, without his consent, and

⁵⁰ Further statistical data on opposition in Finland is available in the Annex to this document.

⁵¹ Section 59(1) of the Patents Act [Patentgesetz].

⁵² [Patentkostengesetz].

⁵³ The patent owner, however, can abandon his patent or request a limitation of his patent before the DPMA.

⁵⁴ Section 21(3) of the Patents Act [Patentgesetz] states that: "3. the essential contents of the patent have been taken from the descriptions, drawings, models, appliances or equipment of another, or from a process used by another, without the consent of said person (usurpation);".

(iv) the subject matter of the patent extends beyond the content of the application as originally filed with the competent authorities.

74. The opposition proceedings are conducted by the Patent Division of the DPMA, which decides whether a patent shall be revoked or maintained.⁵⁵ As a rule, the decision is taken by a panel of three technical members of the Patent Division. If the case involves special legal difficulties, a legal member of the Patent Division joins the panel.⁵⁶

75. According to the DPMA, 665 oppositions were filed in 2010. Opposition proceedings conducted in 2010 were as follows: 75 cases by the abandonment of the patent by the patent owner, 87 cases by non-payment of the annual fee, 278 cases by revocation of the patent by the DPMA and 538 cases by a decision of the DPMA to maintain the patent in full or in part. In 61 cases, the patent owner lodged an appeal against the revocation of the patent. In 123 cases, an appeal was lodged against the decision of the DPMA to maintain the patent in full or in part.

HONDURAS

76. According to Article 55 of the Industrial Property Law of Honduras, once the application is in order, or any deficiency of form has been corrected, an individual substantive examination of the application is conducted in which it is verified whether the general conditions of novelty, inventive step and industrial applicability are satisfied, and the publication of a relevant notice (notice of publication) is ordered in the Official Journal, *La Gaceta*, on three consecutive occasions, each 30 days apart. This publication will provide details of the applicant's name and a summary of the invention.

77. Any interested person may, during the period in which the publications in question are made, raise an opposition in the form of observations and the presentation of information or documents relating to the patentability of the invention. In the case of patents, the opposition may be based on a previous patent, on a patent application already published or on any other form of proof which includes information on the invention that has been made available to the public prior to the application.

78. Once the period of publication has elapsed without any opposition being raised, or if the opposition has been considered unfounded, the decision to grant a patent is published and subsequently the patent registration certificate is issued. Should the opposition be proven, a new substantive examination of the application is carried out in order to establish whether the conditions of patentability are satisfied.

INDIA

79. 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.⁵⁷ 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;

⁵⁵ Section 61(1) of Patents Act.

⁵⁶ Section 27(3) of Patents Act.

⁵⁷ Section 25(1) of the Patent Act 1970.

- (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 as contained in Chapter VI;
- (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;
- (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 of convention application is claimed, the application was not filed within 12 months from the priority date of first application;
- (x) the complete specification does not disclose or wrongly mentions the source or 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.

80. 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.

81. Once a patent is granted, third parties have another opportunity to file an opposition.⁵⁸ 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 7679. The Controller shall notify the patentee where such notice of opposition was

⁵⁸ Section 25(2) of the Patents Act 1970.

submitted.⁵⁹ 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.⁶⁰ 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.⁶¹ 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.⁶²

82. 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 maintain or to amend or to revoke the patent.⁶³ 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 [7679](#).

83. 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 [7679](#) 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.

84. The decision of the Controller regarding post-grant opposition may be appealed to the Intellectual Property Appellate Board within three months from the date of the decision, unless the Appellate Board allows another timeframe in accordance with its rules. However, in case where a patent is granted by the Controller after refusing pre-grant opposition, in such circumstances, the decision of the Controller is not appealable before Intellectual Property Appellate Board but a writ petition can be filed in the High Court against such decision.

NORWAY

85. According to Section 24 of the Norwegian Patent Act, Norway provides for a post-grant opposition system, under which any person can oppose a patent within nine months from the publication of the grant. If the opposition is based on the argument that the granting of the patent should have been refused on the basis that commercial exploitation of the invention would be contrary to *ordre public* or morality, the opposition period is three years. Any person may file such an opposition with the Norwegian Industrial Property Office.

86. The Patent Office shall notify the patent holder of the opposition and give him an opportunity to file observations on them. The patent will be revoked if, (i) the patentability criteria in Articles 1 and 2 of the Patent Act are not fulfilled, (ii) the invention is not sufficiently disclosed, and/or (iii) the subject matter extends beyond the content of the application as filed. The patent holder is given the possibility to amend the patent in order to maintain the patent. A

⁵⁹ Section 25(3) of the Patents Act 1970.

⁶⁰ Rule 57 of the Patents Rules 2003.

⁶¹ Rule 58(2) of the Patents Rules 2003.

⁶² Rule 59 of the Patents Rules 2003.

⁶³ Section 25(4) of the Patents Act 1970.

[decision from the patent office regarding an opposition can be appealed to the Board of Appeals. A further appeal to courts is available.](#)⁶⁴

PAKISTAN

87. The Patent law of Pakistan provides pre-grant opposition and post-grant revocation mechanisms, both conducted before the patent office. Under Section 23 of the Patents Ordinance 2000⁶⁵, at any time within four months from the date of advertisement of the acceptance of a complete specification, any person may give a notice of opposition to the Controller to the grant of a patent on any of the following grounds:

- (i) the applicant for the patent obtained the invention or any part thereof from him or from the person of whom the opponent is the legal representative, assignee, agent or attorney;
- (ii) the invention is not a patentable invention within the meaning of the Patent Ordinance;
- (iii) the specification does not disclose the invention in a manner clear and complete enough for it to be carried out by a person skilled in the art;
- (iv) the claims are not clear or extend beyond the scope of the disclosure in the complete specification as originally filed;
- (v) the complete specification describes or claims an invention other than that described in the provisional specification and such other invention either forms the subject of an application made by the opponent for a patent, which, if granted, would bear a date in the interval between the date of the application and the leaving of the complete specification, or has been made available to the public by publication in any document in that interval.

88. Upon receiving a notice of opposition from the interested person, the Controller shall send the notice of the opposition to the applicant, and shall, before deciding the case, give the applicant and the opponent an opportunity of being heard. In concluding the argument of both parties, the opposition is decided by the Controller of Patents.

89. According to Section 50 of the Patents Ordinance 2000, the Controller of Patents exercises powers of Civil Court in opposition proceedings. An appeal can be filed against the decisions of the Controller of Patents with the High Court under Section 69 of the Patent Ordinance 2000, to be filed within 90 days. If no appeal is filed with the High Court within 90 days, the patent is sealed and granted upon the final determination of the opposition proceedings.

90. In addition to the pre-grant opposition mechanism, a system of revocation of patents by the Controller is provided for under Section 47 of the Patents Ordinance 2000, according to which at any time within twelve months after the sealing of a patent, any interested person who did not oppose the grant of the patent may apply to the Controller for an order revoking the patent on any one or more of the grounds upon which the grant of the patent could have been opposed, provided that when an action for infringement, or proceedings for the revocation, of a patent are pending in any court, an application to the Controller under this section shall not be made except with the leave of the court.

⁶⁴ [Section 24 and 25 of the Norwegian Patent Act, as entered into force January 1, 2008.](#)

⁶⁵ Patents Ordinance 2000, as amended by Patents Ordinance 2002.

91. Where a request for revocation is made under Section 47, the Controller shall give notice to the patentee and shall give to the person requesting such revocation and the patentee an opportunity of being heard before deciding the case. If the Controller is satisfied that any of the grounds are established, he may order that the patent shall be revoked either unconditionally or unless within such time as may be specified in the order the complete specification is amended to his satisfaction.⁶⁶

92. According to the Intellectual Property Organisation of Pakistan, the number of oppositions received in 2007 was 33, in 2008 - 199, in 2009 - 246 and 2010 - 129.⁶⁷

PORTUGAL

93. Portuguese law provides for a pre-grant opposition procedure. As provided by Article 17 of the Industrial Property Code of Portugal⁶⁸, the time limit for submitting oppositions is two months from the publication of the application in the Industrial Property Bulletin.⁶⁹ The patent applicant may reply to the opposition within two months from the notification. During the time limits established above and on justified request by the interested party, the Institute of Industrial Property of Portugal (INPI) may grant a single extension of one month for the submission of the opposition and the reply. In the latter case, the opposing party shall be notified.

94. The opposition must be filed in writing and shall include a reference as to which patent application is opposed and the reasons on which the opposition is based. If the INPI receives such opposition, the patent applicant has the opportunity to submit comments on that opposition.

95. To file an opposition, the opponent has to pay the opposition fee and if the patent applicant wishes to reply to an opposition, it is also necessary to pay a fee (50,70 €, if submitted through online services, or 101,40 € when submitted in paper form, in both cases).

96. The substantive examination phase starts after the opposition phase. If an opposition was submitted, it will be considered by the examiner in the analysis of the patentability criteria (novelty, inventive step and industrial applicability). The conclusion of the examination process is the notification of grant, refusal, or partial grant, issued accordingly, and is communicated both to the patent applicant and the opponent. These decisions are subject to appeal at the Lisbon Commercial Court, within two months that follow the publication of the decision in the Industrial Property Bulletin. The total number of oppositions filed from 2005 to 2011 is 29.⁷⁰

REPUBLIC OF MOLDOVA

97. A post-grant opposition procedure before the State Agency on Intellectual Property (AGEPI) is provided in the Republic of Moldova. According to Article 57 of the National Law on the Protection of Inventions,⁷¹ within six months from the publication of the mention of the grant of the patent, any person may give a notice of opposition to the AGEPI to the patent in question, specifying, *inter alia*, the grounds on which the opposition is based, as well as an indication of the evidence and arguments presented in support of those grounds. A notice of opposition shall

⁶⁶ Section 47 of the Patents Ordinance 2000.

⁶⁷ Further statistical data on opposition in Pakistan is available in the Annex to this document.

⁶⁸ Industrial Property Code approved by Decree-Law 36/2003 of March 5, 2003 and last amended by Law 16/2008 of April 1, 2008.

⁶⁹ The publication of the application is made 18 months after the date of its submission to the National Institute of Industrial Property (Article 66 of the Industrial Property Code).

⁷⁰ The number of oppositions covers patent and utility model applications. The statistical data is available in the Annex to this document.

⁷¹ No. 50-XVI of 07.03.2008, in force from October 4, 2008.

be examined within three months by the AGEPI division which took the decision to grant the patent.

98. An opposition shall only be filed in writing and on the following grounds:

- (i) the subject matter of the patent is not patentable within the meaning of Articles 6 to 11;⁷²
- (ii) the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (iii) the subject matter 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 by non-entitled persons, beyond the content of the earlier application as filed.

99. The opposition filed shall have suspensive effect. It shall not be deemed to have been filed until the opposition fee has been paid.

100. If it is found that the opposition is admissible, the division of AGEPI which issued the decision shall examine, in accordance with the provisions of Article 57 of the Law, whether at least one ground for opposition under Article 57, paragraph (2), of the Law, prejudices the grant of the patent. If the opposition is admissible, the patent applicant shall be notified of the opposition filed and shall be invited to file his observations and to amend, where appropriate, the description, claims and drawings within a period of two months. Any observation and amendments filed by the applicant shall be communicated to the opponent who shall reply within a period of two months.⁷³

101. The examiner may require from the opponent or patent applicant additional information necessary for examination. Any notification made during the examination of the opposition and all replies thereto shall be communicated to all parties.

102. Where appropriate, during the opposition procedure, AGEPI shall carry out an additional documentary search and shall draw up a search report on a form approved by AGEPI. A re-examination report shall be drawn up on the basis of the opposition examination results which shall be sent to all parties.

103. Where it is revealed that the maintenance of the decision to grant the patent is possible by way of amendments, the patent applicant shall be invited to make any amendments or to submit his own amended version of the description and claims, without extending beyond the content of the original application.

104. If the AGEPI division which took the decision to grant the patent is of the opinion that at least one of the grounds for opposition referred to above prejudices the maintenance of the patent, it shall revoke the respective decision. Otherwise, it shall reject the opposition. If AGEPI is of the opinion that, taking into consideration the amendments made by the applicant during the opposition proceedings, the patent and the invention to which it relates meet the requirements of the law, it shall decide to maintain the decision to grant the patent as amended.⁷⁴

⁷² Article 6 - patentable inventions, Article 7- exceptions to patentability, Article 8 – novelty, Article 9- non-prejudicial disclosure, Article 10- inventive step, Article 11- industrial application.

⁷³ Rule 332 of the Regulations on the Procedure of Filing and Examination of a Patent Application and of Grant of a Patent, approved by Government Decision of the Republic of Moldova No. 528 of 01.09.2009.

⁷⁴ Article 57 of the National Law on the Protection of Inventions.

105. If a patent is amended, the AGEPI shall, after the payment of the prescribed fee, publish a new specification of the patent containing the description, the claims and, as the case may be, any drawings, in the amended form.

106. Any person adversely affected by a decision taken by the respective division of the AGEPI may appeal with the Appeals Board of the AGEPI within 2 months after the date of notification of the decision and shall contain the grounds for appeal.

107. Since the national Law No. 50-XVI of 07.03.2008 on the Protection of Inventions entered into force (see footnote 63), only one opposition has been filed.

SPAIN

108. The Spanish Law on Patents⁷⁵ provides for opposition procedures for utility models and patents filed in accordance with the grant procedure subject to preliminary examination. As regards the opposition procedure for patents, within three months following the publication of the prior art search report, the applicant may request an examination as to sufficient description, novelty and inventive step of the subject matter of the patent application. During the two months following the publication of the request for preliminary examination in the *Official Industrial Property Gazette*, any interested party may oppose the grant of the patent, citing the fact that any of the requirements for such grant are not satisfied. The written opposition submission must be accompanied by appropriate supporting documents. However, the lack of the applicant's right to file the patent, which should be claimed before the common courts, may not be claimed.

109. The Spanish Patent and Trademark Office will notify the outcome of the examination and forward the oppositions submitted to the applicant. Where no opposition has been submitted and the examination has found that none of the requirements is lacking, the Spanish Patent and Trademark Office will grant the patent.

110. Conversely, in cases where oppositions have been submitted, or where the preliminary examination carried out by the Spanish Patent and Trademark Office has found that one of the requirements for the grant of the patent is not satisfied, the applicant may remedy the formal defects claimed in the application, amend the claims, if the applicant so wishes, and respond by submitting allegations he considers appropriate, within two months.

111. Where the applicant fails to respond to the objections raised by the Spanish Patent and Trademark Office or by third parties, the patent should be totally or partially refused. In other cases, the Spanish Patent and Trademark Office, by means of a substantiated decision, will decide as to the total or partial grant, once it has received the applicant's response. Where the decision finds that one of the formal requirements is not satisfied or that the invention is not patentable, the Spanish Patent and Trademark Office will grant the applicant a further period of one month to remedy the defect or make observations which he considers appropriate, and will issue a final decision on the grant of the patent.

112. The number of oppositions submitted in relation to patents filed according to the general grant procedure subject to preliminary examination is less than those filed as utility models (i.e., less than ten per cent).

⁷⁵ Law No. 11/1986, of March 20, on Patents and its Implementing Regulations, approved by Royal Decree No. 2245/1986, of October 10.

SWEDEN

113. The Swedish Patents Act provides for a post-grant opposition system. Sections 24 and 25 of the Swedish Patents Act state that anyone except the patent owner can file an opposition regarding a patent in Sweden within nine months from the day the patent was granted. If the Swedish Patent and Registration Office receives such an opposition, the patent owner will have the possibility to comment on that opposition. If the opposition is withdrawn, the Swedish Patent and Registration Office can examine the opposition anyway, if justified.⁷⁶

114. If the Swedish Patent and Registration Office finds that the patent has been granted despite the fact that the invention lacked novelty or lacked inventive step, or the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, or the subject-matter of the patent extends beyond the content of the application as filed, the patent will be revoked. If the patent owner during the opposition procedure makes amendments so that there is no hindrance against the grant of a patent, the patent is maintained as amended.

115. The total number of oppositions filed with the Swedish Patent and Registration Office from 2005 to 2010 is 219. Of the total number, 82 decisions revoked the patents, and 60 decisions maintained the patents as amended.⁷⁷

UNITED STATES OF AMERICA

116. Until 2011, there was no opposition system *stricto sensu* in the patent system of the United States of America. However, the Leahy-Smith America Invents Act (AIA) of September 16, 2011,⁷⁸ provides for additional options for challenging patent validity which will enter into force on September 16, 2012.⁷⁹ A new post-grant review, which is a time-bound *inter partes* review mechanism, has been introduced, and the former *inter partes* re-examination procedure has been renamed to *inter partes* review.⁸⁰

117. The new post-grant review provides a time limit of nine months after the grant of the patent to file a petition and, therefore, is similar to post-grant opposition mechanisms. Generally speaking, the recent amendments establish a post-grant opposition system in the United States of America, besides the existing *ex parte* and *inter partes* re-examination procedure. The objective has been to provide additional post-grant possibilities to check the quality of patents.⁸¹ The different mechanisms provide for a unique and complex system for challenging the grant of patents in the United States of America.

⁷⁶ Section 24 of the Swedish Patents Act.

⁷⁷ Further statistical data from the Swedish Patent and Registration Office is available in the Annex to this document.

⁷⁸ Leahy-Smith America Invents Act, enacted September 16, 2011. The Leahy-Smith "America Invents Act", which was formerly titled the "Patent Reform Act of 2011", amends title 35, United States Code to provide for patent reform.

⁷⁹ Date of entry into force: The various provisions contained in the Act's 37 sections take effect on different dates.

⁸⁰ Section 35 U.S.C. §§ 311 ff. and §§ 321 ff.

⁸¹ See Compare in this respect, Graham, D. Harhoff, Can Post-Grant Reviews Improve Patent System Design? A Twin Study of US and European Patents, 2006, and Hall/Harhoff: Post-Grant Reviews in the U.S. Patent System-Design Choices and expected impact, Berkley Technology Law Journal, Vol 19:1, (2004) 1.

Post-grant review

118. The post-grant review is a new trial proceeding conducted at the Patent Trial and Appeal Board to review the patentability of one or more claims in a patent on any ground that could be raised under 35 U.S.C. § 282(b)(2) or (3). The Patent Trial and Appeal Board is composed, in case of a post-grant review, of at least three administrative patent judges, having legal knowledge and scientific ability, as designated by the Director.⁸²

119. According to 35 U.S.C. § 321, the post-grant review process begins with a third party filing a petition on or prior to the date that is nine months after the grant of the patent or issuance of a reissue patent.⁸³ The petition has to contain the payment of a fee, provide for the grounds including evidence of those grounds. The petition is made available to the public.⁸⁴ The patent owner may provide a preliminary response to the petition within a time period set by the Director. The institution of the post-grant review is conditioned by a threshold according to 35 U.S.C. § 324, that it is more likely than not that at least one claim challenged is unpatentable. An additional ground may also be that the petition raises a novel or unsettled legal question that is important to other patents or patent applications. It is not possible to appeal the determination of whether to institute a post-grant review.

120. If the proceeding is instituted and not dismissed, a final determination by the Board will be issued within one year, extendable up to six months.⁸⁵ The procedure for conducting post-grant review will take effect on September 16, 2012, and generally applies to patents issuing from applications subject to first-inventor-to-file provisions of the AIA. The post-grant review will have an estoppel effect for civil action on any ground the requester raised or reasonably could have raised during the post-grant review.⁸⁶ It will not be possible to request a post-grant review after a civil action has been started, and in case of a later civil action, it will have to be stayed under the conditions set by 35 U.S.C. § 325.

121. The post-grant review conducted by the Patent Trial and Appeal Board provides *inter partes* proceedings, including either party's rights to an oral hearing as part of the proceedings. In the post-grant review, the petitioner shall have the burden of providing a proposition of unpatentability by a preponderance of the evidence according to 35 U.S.C. § 326. Either party may appeal the final decision of the Patent Trial and Appeal Board to the Court of Appeals for the Federal Circuit.

122. With respect to the review of the validity of business method patents,⁸⁷ Section 18 of the AIA provides a special transitional program. For example, the nine-month time period for requesting a review does not apply to such a transitional post-grant review proceeding.

EURASIAN PATENT OFFICE

123. 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.⁸⁸ The time period for filing a notice of opposition may

⁸² [35 U.S.C. § 6 \(a\)\(c\).](#)

⁸³ [35 U.S.C. § 321 \(c\).](#)

⁸⁴ [35 U.S.C. § 322.](#)

⁸⁵ [35 U.S.C. § 326 \(11\).](#)

⁸⁶ [35 U.S.C. § 325 \(e\).](#)

⁸⁷ [The definition is found in AIA Sec. 18\(d\).](#)

⁸⁸ 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

[Footnote continued on next page]

not be prolonged.⁸⁹ A right to file a notice of opposition, lost due to lapse of time for filing, may not be restored.⁹⁰

124. 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.⁹¹ 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”).

125. The notice of opposition can state the following grounds for revocation of a Eurasian patent.⁹²

- (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.

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

126. 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.⁹³

127. If the notice of opposition is filed in compliance with the prescribed requirements,⁹⁴ 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.⁹⁵

128. 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.⁹⁶

129. 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

[Footnote continued from previous page]

- Administrative Revocation of a Eurasian Patent (hereinafter “Rules of Opposition Filing and Examination”).
- ⁸⁹ Rule 37(4) of the Patent Regulations.
- ⁹⁰ Rule 39(3) of the Patent Regulations.
- ⁹¹ Rule 53(5) of the Patent Regulations.
- ⁹² Rule 53(2) of the Patent Regulations and Rule 1.8 of the Rules of Opposition Filing and Examination.
- ⁹³ Rule 1.8 of the Rules of Opposition Filing and Examination.
- ⁹⁴ 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.
- ⁹⁵ Rule 3.2 of the Rules of Opposition Filing and Examination.
- ⁹⁶ Rule 3.5 of the Rules of Opposition Filing and Examination.

his considerations in respect of the response by the patent owner within a time period stated in the communication.⁹⁷

130. 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.

131. 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.⁹⁸

132. 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.

133. 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.⁹⁹

134. 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.

135. 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.¹⁰⁰

EUROPEAN PATENT OFFICE (EPO)

136. 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 mention of the grant of the European patent in the European Patent Bulletin and upon the payment of the opposition fee.¹⁰¹ The proprietor of the patent is not entitled to file an opposition,¹⁰² although he may request limitation of his patent under EPC Article 105a.

137. Under certain conditions, any third party who proves that proceedings for infringement of the opposed patent have been instituted against him or that the proprietor of the patent has

⁹⁷ Rule 3.8 of the Rules of Opposition Filing and Examination.

⁹⁸ Rule 4.4 of the Rules of Opposition Filing and Examination.

⁹⁹ Rule 53(4) of the Patent Regulations.

¹⁰⁰ Rule 53(8) of the Patent Regulations.

¹⁰¹ Article 99 EPC.

¹⁰² G 9/93 (OJ 12/1994,891).

requested him to cease alleged infringement of the patent and that he has instituted proceedings for a court ruling that he is not infringing the patent may, after the opposition period has expired, intervene in the opposition proceedings.¹⁰³ Once the notice of intervention has been filed in good time and in due form, the intervention is to be treated as an opposition.

138. 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.¹⁰⁴

139. 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.¹⁰⁵

140. 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 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.

141. According to Article 101 of the EPC, if the opposition is admissible,¹⁰⁶ 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, the notice of opposition 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 the opponent(s) who are given the opportunity to respond within a specified period.¹⁰⁷

142. During the opposition, oral proceedings may take place at the instance of the EPO or at the request of any party to the proceedings.¹⁰⁸ The oral proceedings are held before the Opposition Division itself.¹⁰⁹ They are generally public unless the Opposition Division decides otherwise in particular cases.¹¹⁰

143. 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.¹¹¹ 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

¹⁰³ Article 105 EPC.

¹⁰⁴ Rule 76 of the Implementing Regulation to the EPC.

¹⁰⁵ Article 19 EPC.

¹⁰⁶ Rule 77 of the Implementing Regulation to the EPC provides grounds for a rejection of the opposition as inadmissible.

¹⁰⁷ Rule 79 of the Implementing Regulation to Part V of the EPC.

¹⁰⁸ Article 116(1) EPC.

¹⁰⁹ Article 19 EPC.

¹¹⁰ 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).

¹¹¹ Article 19 EPC.

which it relates) meets the requirements of the EPC, it decides to maintain the patent as amended after certain formal requirements have been fulfilled. If the patent after such amendments do not meet the requirements of the EPC, the Opposition Division revokes the patent.¹¹²

144. 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.¹¹³

145. 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.¹¹⁴

146. 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.

147. In 2010, the number of oppositions filed with the EPO against granted patents was 2,770, compared to 2,700 in 2009 and 2,800 in 2008. The opposition rate was 5,2% in 2010, 4,7% in 2009 and 5,32% in 2008. In 2010, 29% of the opposition cases were rejected, 33% led to revocation of patents and 38% to maintenance in amended form.

VI. RELATED MECHANISMS

A. RE-EXAMINATION SYSTEMS

148. In some countries, a re-examination system is provided as an alternative [or complement](#) to the opposition system. 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. For example, [in one country, re-examination may be initiated only where “a substantial new question of patentability” is raised. However, in some countries, the re-examination is not limited to the grounds based on new prior art and provides for other substantive grounds, similar to the process of other types of administrative review. In Norway, the re-examination by the Norwegian Patent Office is called administrative review.](#)

[149. In comparison to the opposition system,](#) in general, the re-examination is not time-bound. [In some cases the re-examination is conducted by a single examiner or the](#) division of the [patent office which has granted the patent in the first place, in comparison to a full opposition board in the cases of post-grant oppositions.](#) Further, the re-examination procedures is [ex parte](#) in some countries and [inter partes](#) in some other countries. The *ex-parte* re-examination may be characterized as a system that [provides for quality check through a second patent examination of the patent by the patent office.](#) In general, the re-examination may be requested mainly on the basis of documentary evidence, and an opportunity to appeal against the re-examination decision is provided.

[150. The re-examination system often includes estoppel-type mechanisms, as the requester of re-examination is, in most countries, estopped from basing a judicial review on the same grounds as the re-examination.](#)

¹¹² Article 101 EPC.

¹¹³ Article 106 EPC.

¹¹⁴ Article 108 EPC.

151. Depending on the expected role of the re-examination system in the entire review mechanisms placed in the national patent system, procedural as well as substantive requirements regarding the re-examination are different from one country to another. For example, in countries where a post-grant opposition and a re-examination co-exist, the re-examination complements the post-grant opposition system, thus can be initiated only after the expiration of the post-grant opposition period or the final decision by the opposition board. In countries where the re-examination has the role of a “second examination”, it is conducted, understandably, *ex parte*. [The re-examination procedure varies with respect to: \(i\) the entitlement to request re-examination; \(ii\) the *ex parte* or *inter partes* nature of re-examination; \(iii\) the disclosure of the identity of the requester; \(iv\) the grounds for re-examination; and \(v\) the re-examination fee.](#)

[152.](#) The following paragraphs describe the re-examination systems in Australia, Denmark, Norway and the United States of America.

Australia

153. Chapter 9 of the Australian Patents Act¹¹⁵ provides for re-examination of applications for standard patents and granted standard patents under certain circumstances. Re-examination of innovation patents is also provided for under section 101G.

154. The re-examination is instigated at the Commissioner's discretion, upon request by the patentee or any interested person or by the direction of a prescribed court before which the validity of the patent in question is in dispute. [The grounds for re-examinations are limited to lack of novelty and inventive step when compared with the prior art base. There are no other grounds for the revocation of a patent, according to Section 98.](#) The procedure is *ex parte*, i.e. the person who requests re-examination has limited opportunity to submit evidence and be heard in the process. The Commissioner will instigate re-examination voluntarily only if an adverse re-examination report will be issued. In contrast, the Commissioner must re-examine where the patentee or third party requests re-examination. [The applicant or patentee may appeal to the Federal Court against a decision of the Commissioner, according to Sections 100A\(3\) and 101\(4\), respectively.](#)

Denmark

155. Section 53b of the Consolidate Patents Act¹¹⁶ provides an administrative re-examination system. A request for re-examination of a Danish patent (national granted patent or validated European patent) may be filed by any person, including the patent holder, after the expiry of the nine month opposition period.

156. If the request for re-examination is filed by a third party, the request must be filed in writing and contain, *inter alia*, a statement of the extent to which the Danish patent is opposed and the grounds on which the request for re-examination is based, as well as the facts and evidence in support of the grounds.

157. According to Section 52 of the Consolidate Patents Act, the re-examination can only be based on the following grounds: the subject matter does not fulfil the patentability criteria (industrial applicability, novelty, inventive step), the invention is not sufficiently disclosed to allow a person skilled in the art to carry it out, the content of the patent extends beyond the content of the application as filed or the scope of protection has been expanded after the grant of the patent.

¹¹⁵ Australian Patents Act 1990.

¹¹⁶ The Consolidate Patents Act No.91 of January 28, 2009.

158. After a hearing phase of the re-examination procedure, the Opposition Division renders a decision. The result can be to reject the re-examination, to revoke the patent or maintain the patent in amended form.

159. If the request for re-examination is filed by the patent holder, it is only necessary that the request explain the desired limitation of patent claims. No statement of grounds or evidence is mandatory. In this case the Danish Patent Office will examine whether the requested limitation is allowable.

160. A notice of appeal must be filed to the Danish Board of Appeal within two months of notification of the re-examination decision, and the fee for appeal must be paid.

Norway

161. Norway provides for an additional administrative review. According to Section 52b of the Norwegian Patent Act,¹¹⁷ anyone may file a request with the Norwegian Industrial Property Office that a patent shall be declared invalid in full or in part. After a written request containing the necessary documents and based on the grounds for invalidation, the patent office shall notify the patent holder and grant a reasonable time limit in which to submit observations and, if possible, correct the deficiencies. If the deficiencies are not corrected by the patent holder before the expiration of the time limit, the request must be rejected. The Norwegian Industrial Property Office may consider a request for an administrative review even if the patent has no longer been in force, if the party requesting an administrative review has a legal interest in having this matter reviewed.

162. A request for an administrative review cannot be filed before the time limit for oppositions has expired or while an opposition procedure or patent limitation proceedings requested by a patent holder are pending. The same shall apply for as long as legal proceedings regarding the patent are pending before the courts. If legal proceedings regarding the patent are brought before the courts before a final decision has been made on a request for an administrative review, the Norwegian Industrial Property Office shall suspend its handling of the administrative review until the legal proceedings have been finally decided if the administrative review has been requested by other parties than the patent holder. The party requesting an administrative review cannot institute legal proceedings regarding the patent while administrative review proceedings are pending before the Norwegian Industrial Property Office.

163. According to Section 52d of the Norwegian Patent Act, a request for an administrative review may only be filed on the grounds of non-fulfillment of the patentability criteria. If the Norwegian Industrial Property Office finds that the patent has been granted in contravention of sections 1 and 2, i.e., the patentability criteria, it shall be declared invalid if the grounds for such invalidity cannot be remedied through an amendment of the patent. The patent may only be maintained in amended form if the patent holder agrees with the amendments that the Norwegian Industrial Property Office intends to make. A decision to declare a patent fully or partly invalid shall take effect from the date on which the patent application was filed.

164. According to Section 52e of the Patent Act, a decision on a request for an administrative review by the Norwegian Industrial Property Office may be appealed to the Board of Appeals.

¹¹⁷ Norwegian Patent Act, as entered into force January 1, 2008..

United States of America⁴¹⁸

165. The patent law of the United States of America, currently in force, provides two types of re-examination mechanisms: the (ex parte) re-examination under 35 U.S.C. § 302 to § 307 and the inter partes re-examination. With the entering into force of the AIA in 2011, the inter partes re-examination will be replaced by the inter partes review from September 16, 2012.

166. As the current inter partes re-examination system is still in force, both the current and the new inter partes procedures are described below.

(i) Ex parte Rre-examination under 35 U.S.C. § 302 to § 307

167. 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).¹¹⁹ 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.¹²⁰ The prior art cited to the USPTO by the requester must consist of patents or printed publications.¹²¹ Unless the person requesting re-examination is the patent owner, he will then be notified by the USPTO of the request for re-examination.

168. 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 limited to the prior art submitted by the requester, but may also consider other patents and printed publications.¹²² 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.¹²³

169. 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.¹²⁴ If the patent owner decides not to file a statement, the requester may not file any further communications in the proceeding.

⁴¹⁸ ~~The revision to this chapter was made according to the submission of the USPTO dated August 15, 2011. It does not include information regarding the recent amendments introduced by the America Invents Act.~~

¹¹⁹ See 145 Cong. Rec. H6929, H6944 (daily ed. Aug. 3, 1999).

¹²⁰ Syntex Inc. v. United States Patent and Trademark Office, 882 F.2d 1570, 1573 (Fed. Cir. 1989).

¹²¹ 35 U.S.C. § 302.

¹²² 35 U.S.C. § 303(a).

¹²³ 35 U.S.C. § 303(c).

¹²⁴ 35 U.S.C. § 304.

170. 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.¹²⁵

171. 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).¹²⁶ The *ex-parte* re-examination requester, other than the patent owner, has no right to participate in either appeal.

172. According to the latest data provided by the USPTO, there have been 11,604 *ex parte* examinations applications filed with the USPTO since the start of *ex parte* re-examination in January 1981 up to June 30, 2011. Of those, 33 % were filed by the patent owner, 66% by other member of public and 1% by order of the Commissioner. The highest number of re-examination requests concerned patents in electrical operation (37%), mechanical operation (34%) and chemical operation (27%). 92% of those requests were granted and 8% were denied.¹²⁷

(ii) *Inter Partes* Re-examination

173. Optional *inter partes* re-examination is codified in 35 U.S.C. §§ 311-318.^{128 129} 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.¹³⁰ 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. 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.

174. *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.¹³¹ 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.¹³²

¹²⁵ 35 U.S.C. § 305.

¹²⁶ 35 U.S.C. § 306.

¹²⁷ Other statistical data submitted by the USPTO on *ex parte* re-examination filing is available in the Annex to this document.

¹²⁸ 35 U.S.C. §§ 311-318.

¹²⁹ Both, the *ex parte* re-examination and the *inter partes* re-examination, are available for patents issued from applications filed on or after November 29, 1999. For patents issued from an application filed prior to November 29, 1999, the statutory *inter partes* re-examination option is not available, and only the *ex parte* re-examination is available.

¹³⁰ 145 Cong. Rec. E1788, at E1789-90.

¹³¹ 35 U.S.C. § 311(a).

¹³² 35 U.S.C. § 311(b).

175. 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.¹³³ The determination that no substantial new question of patentability has been raised is final and non-appealable.¹³⁴

176. 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.¹³⁵ 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.

177. 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.¹³⁶

178. 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*.¹³⁷ 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 the USPTO.¹³⁸ 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.¹³⁹ 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.¹⁴⁰

179. The total number of requests filed since the start of *inter partes* re-examination in November 1999 till June 30, 2011 was 1286. The highest number of re-examination requests concerned electrical operation (53%) and mechanical operation (29%). Among the total *inter-partes* re-examination requests, 95% were granted and 5% were denied.¹⁴¹

¹³³ 35 U.S.C. § 312(a).

¹³⁴ 35 U.S.C. § 312(c).

¹³⁵ 35 U.S.C. § 314.

¹³⁶ 35 U.S.C. § 314(b)(2).

¹³⁷ 35 U.S.C. § 315.

¹³⁸ 35 U.S.C. § 318.

¹³⁹ These provisions are aimed at preventing *inter partes* re-examination proceedings from being used to harass patent owners (see the submission of the USPTO on the SCP electronic forum website).

¹⁴⁰ 35 U.S.C. § 315(c).

¹⁴¹ Other statistical data submitted by the USPTO on *inter partes* re-examination filing is available in the Annex to this document.

(iii) A Substantial New Question of Patentability

180. Both *ex parte* and *inter partes* re-examination procedures are ordered only when there is "a substantial new question of patentability" in at least one claim of the patent. If there is no such "question", no re-examination can be initiated. The meaning and scope of the "substantial new question of patentability" is developed through case law.

181. A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications are considered important, then the examiner should find that "a substantial new question of patentability" exists.

182. However, if the same substantial question of patentability has already been decided previously, re-examination will not be proper. For example, if the examiner finds that the additional prior art patents or printed publications are merely cumulative to similar prior art already fully considered in a previous examination of the claim, there is no "substantial new question of patentability".

183. Accordingly, for "a substantial new question of patentability" to exist, it is necessary that:

- (i) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim. This means that the teaching of the prior art is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and
- (ii) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending re-examination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

It is not necessary for the submitted prior art to form a "prima facie" case of unpatentability. A "substantial new question of patentability" as to a patent claim may exist even if the examiner would not necessarily reject the claim as either anticipated by, or obvious in view of, those prior art patents or printed publications.

(iv) Inter partes review

184. Inter partes review is a new trial proceeding conducted by the Patent Trial and Appeal Board to review the patentability of one or more claims in a patent only on a ground that could be raised under 35 U.S.C. §§ 102 or 103, i.e., novelty and non-obviousness, and only on the basis of prior art consisting of patents or printed publications.¹⁴² The *inter partes* review process begins with a third party filing a petition after the later of either: (1) nine months after the grant of the patent or issuance of a reissue patent; or, (2) if a post-grant review is instituted, the termination of the post-grant review. However, there are certain circumstances where an *inter partes* review may not be instituted. They include the cases where a petitioner filed a civil action challenging the validity of a claim before filing a petition for *inter partes* review. Similarly, an *inter partes* review may not be instituted if the petition is filed more than one year after the date on which the petitioner is served with a complaint alleging infringement of the patent.

185. The petition has to be based on copies of patents and printed publications, affidavits or declarations of supporting evidence or any other document. It will be made available to the public. For the institution of an *inter partes* review, it will be necessary to show that there is a

¹⁴² 35 U.S.C. § 311.

reasonable likelihood that the petitioner would prevail with respect to at least one claim.¹⁴³ This is one of the major differences with the *inter partes* re-examination which can be initiated only where a substantial new question of patentability affecting a claim has been raised. Similar to the post-grant review, there is no possibility to appeal from the determination of the threshold by the Director.

186. If the proceeding is instituted and not dismissed, a final determination by the Board will be issued within one year, extendable up to six months. The rules for estoppel and the stay of civil litigation are similar to those of the post-grant review.¹⁴⁴ The conduct of the *inter partes* review is similar to that of the post-grant review and may include oral hearings.¹⁴⁵ It is possible to appeal against the final decision of the Board to the Court of Appeals for the Federal Circuit.

B. SUBMISSION OF INFORMATION BY THIRD PARTIES

(i) Rationale and objectives

187. 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.

188. 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 an *ex parte* procedure under which the third party who submitted the information cannot participate in the subsequent ~~review~~ examination or 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. In general, the submission of third party observations is not subject to the payment of fees. In some countries, fees are required if the observations are voluminous.

189. 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 post-grant phase. The submitted information will be included in the official file (dossier) which is accessible to the public. In some countries, it is possible to submit, in addition to the prior art documents or the reference thereof, a comment on the relevance of each document submitted. In other countries, it is possible to file a protest.

¹⁴³ 35 U.S.C. § 314 (a).

¹⁴⁴ 35 U.S.C. § 314

¹⁴⁵ 35 U.S.C. § 316.

190. 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. In contrast to a pre-grant opposition after the positive determination by the examiner, the submission of observations does not provide a period during which the processing of the patent application has to be stayed. On the other hand, due to its informal and ex parte 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 the examiner who conducts the substantive examination and on the party requesting the opposition/revocation of the patent concerned. In most countries, the third party submitting the information does not receive any feedback as to how the material is used in the examination process.

191. 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 suggested that a system that allowed third party observations on novelty and inventive step which would 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).

192. Meanwhile, work has begun on the implementation of a third party observation system, broadly in line with the proposals set out in the Annex to Circular C. PCT 1288 and taking into account the comments received in response to that Circular. While the fourth session of the PCT Working Group, held from June 6 to 10, 2011, supported the introduction of the system, it noted a number of concerns with regard to specific features of the system which the International Bureau would further consider in the implementation of the system. The pilot will be closely monitored, in particular with regard to possible abuses. ~~The service is expected to start in early 2012.~~

193. As the work is almost complete in respect of the technical systems allowing third parties to make observations on international applications,¹⁴⁶ the International Bureau of WIPO will provide a demonstration version in the near future. It is currently planned to start the operation of the system from July 1, 2012, permitting observations on any international application for which the time limit of 28 months from the priority date has not expired.

194. The following differences in the design of the third party observation systems exist: (i) period for submitting observations; (ii) conduct of procedure: notification to the applicant, possibility of comments or counter-arguments by the applicant, public disclosure of observations, feedback to requester; (iii) grounds for observations: documents and information to be submitted; and (iv) fees.

¹⁴⁶ See document PCT/WG/4/7 and the comments reported in paragraphs 122 to 142 of document PCT/WG/4/17.

(ii) National/Regional laws

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

Australia

196. Australia allows third party observations under Section 27 of the Patents Act¹⁴⁷ in relation to standard patents.¹⁴⁸ Under this provision, a person may, within the prescribed period after a complete specification becomes open to public inspection, notify the Commissioner, in accordance with the Regulations, that the person asserts, for reasons stated in the notice, that the invention concerned is not a patentable invention because it does not comply with the requirements of novelty, inventive step and usefulness.

197. The Commissioner must inform the applicant for the patent in writing of any matter of which the Commissioner was notified and send the applicant a copy of any document accompanying the notice. The Commissioner must otherwise consider and deal with a notice in accordance with the Regulations. The notice and any document accompanying it are open to public inspection.

China

198. 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.

Denmark

199. Rule 43 of the Order on Patents and Supplementary Protection Certificates states that any person may provide information or observations of relevance for the examination of a patent application. No particular grounds are to be specified. [However, the person who has submitted such information shall, where relevant, be notified of the additional opportunity to file an opposition if and when a patent is granted.](#)

Finland

200. Third parties may file a communication which is of importance for the examination of the application with the Patent Office. There is no fee and no particular grounds are to be specified. The Office shall notify the party that submitted the communication of the possibility of filing an opposition if a patent is granted.¹⁴⁹

Japan

201. 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).

¹⁴⁷ Patents Act 1990.

¹⁴⁸ In addition, Section 28 of the Patents Act allows third party observations in relation to innovation patents.

¹⁴⁹ Section 26a, Patents Decree.

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.

202. 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*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*(3) 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*.

203. 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.

204. 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.¹⁵⁰ 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 July 2008. The pilot project has, in general, produced positive results.¹⁵¹

Mexico

205. Article 52 BIS of the Industrial Property Law (LPI) states that within a period of six months, beginning from the date of publication of the patent application in the Official Gazette, the Institute may receive information from any person relating to the issue of whether the application complies with the provisions of Articles 16 (novelty, inventive step and industrial applicability requirements) and 19 (subject matters not considered inventions) of LPI.

206. The Institute may treat the said information as technical support documents within the context of the substantive examination of the application, without being obliged to rule on the scope of said information. The Institute shall make the information available to the applicant, in order to allow him, should he consider it necessary, to put forward in written form any arguments that he might deem to be in his interest.

¹⁵⁰ JPO Annual Report 2008.

¹⁵¹ The report is available at: http://www.peertopatent.org/CPR_Pilot_Report.pdf.

207. The submission of information shall not have the effect of suspending the process, nor shall the person submitting the information be attributed the status of interested party, third party or party, and, should the case arise, the actions provided for in Article 78 (nullity) of this Law shall be carried out. To date, no submissions have been made under this provision.¹⁵²

Norway

208. Norway provides for the opportunity of third party observations in the form of a protest. According to Section 35 of Regulations under the Norwegian Patent Act, any person could file a protest against a pending application.¹⁵³ In that case, the patent Office is obliged to consider whether the observation has an impact on patentability. If, before the patent has been granted, the Norwegian Industrial Property Office receives a protest that is of significance to the assessment of the application, the Office shall notify the applicant thereof. If other novelty-destroying elements than obvious use of the invention are claimed in the protest, the Office shall immediately examine whether this means that the applicant should be notified. If the protest contains a claim regarding obvious use of the invention, it will, as a general rule, only be set down for assessment after the expiration of the time limit for the submission of protests and only if the same claim is also made in an opposition. A protest to the grant of a patent will not affect any litigant party rights.¹⁵⁴

Pakistan

209. Under Section 24 of the Patents Ordinance, 2000 and Rule 19 of the Patent Rules, 2003, at any time after the publication of the accepted specification in the Official Gazette, any person can make observations in writing to the Controller on the novelty of the invention giving evidence in support of his observations. The Controller shall consider the observations in the light of the evidence made available to him before the grant of the patent. The person shall not become a party to the proceedings.

Philippines

210. 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.¹⁵⁵ The person who submitted the observations shall not be a part to the proceedings before the Bureau of Patents.¹⁵⁶ 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.¹⁵⁷

211. 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 Office will not inform the third party of any further action taken by the Office in response to his observations.¹⁵⁸

¹⁵² Article 52 BIS is a new provision which entered into force on September 18, 2010.

¹⁵³ Norway Patent Regulations (2007).

¹⁵⁴ [Section 35 of Regulations under the Norwegian Patent Act.](#)

¹⁵⁵ Manual for Substantive Examination Procedure, Chapter VI.11.

¹⁵⁶ *Ibid.*

¹⁵⁷ *Ibid.*

¹⁵⁸ *Ibid.*

212. 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.

Republic of Korea

213. According to Article 63bis of the Korean Patent Act, any person may provide the Commissioner of the Korean Intellectual Property Office (KIPO) with information and evidence of a ground for rejecting the patent application. Since 2006, third party submissions are possible even before the publication of the patent application.¹⁵⁹

Russian Federation

214. In the Russian Federation, there are no formal third party observations. However, any person has the right to provide prior art documents known to him, which might be used in the patent examination process at any stage of the examination process until the grant of the patent.¹⁶⁰ Where an examiner finds that a piece of prior art is relevant for the invention claimed, such prior art is included in the search report.¹⁶¹ Those statements have purely informational value and may be ignored by the examiner.

Slovakia

215. Article 42(1) of the Patent Act¹⁶² provides that any person may file oppositions on patentability of the subject-matter of an application with the Office after publication of the application. If the oppositions are filed, the Office shall take them into consideration during substantive examination of the application.

216. According to Article 42(2) of the Patent Act, persons who have filed oppositions pursuant to paragraph 1 shall not become parties to the application proceedings. However, an applicant shall be notified about oppositions and shall have the right to respond to them.

217. According to the data submitted by the Industrial Property Office of the Slovak Republic, there were 2 oppositions filed over 231 published patent applications in 2006, 3 oppositions over 167 patent applications in 2007, 3 oppositions over 181 patent application in 2008, 4 oppositions over 179 patent applications in 2009 and 5 oppositions over 153 patent applications in 2010.¹⁶³

¹⁵⁹ [See Article 63bis of the Korean Patent Act.](#)

¹⁶⁰ See document SCP/15/6, para. 161; [SCP/17/13 Prov.1, para. 72.](#)

¹⁶¹ [In accordance with the Russian legislation, any person has the right to request the conduct of a prior art search of the patent application of another person upon a payment of fee. The procedure for conducting such a prior art search is regulated by the office rules. A search report is then sent to the person concerned after publication of the application. The results of such a search report are taken into account when examining the patentability of a claimed invention. Where an application contains a search report conducted upon such a request, the level of the fee for conducting an examination on the application is reduced by fifty per cent.](#)

¹⁶² Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and Amendment of Some Acts (The Patent Act).

¹⁶³ The statistical data is available in the Annex to this document.

Spain

218. According to the general grant procedure of Spain, *i.e.*, the procedure which does not involve preliminary (substantive) examination,¹⁶⁴ once the continuation of such procedure has been published in the *Official Industrial Property Gazette*, a period of two months is granted to third parties to raise duly reasoned and documented comments on the prior art report (search report).¹⁶⁵ Once the deadline for third parties to submit comments on the prior art report has passed, the written submissions are forwarded to the applicant to set out comments which he considers appropriate on the prior art report, make the comments which he deems relevant to the comments raised by third parties and, if he so desires, to amend the claims, within two months. Independently of the content of the prior art report and of the comments submitted by third parties, once the deadline for the applicant's comments has passed, the Spanish Patent and Trademark Office will grant the patent, announce this in the *Official Industrial Property Gazette* and provide the public with the documents relating to the patent, together with the report on prior art and all the comments relating to such report. In the case where claims have been amended, the public shall be provided with the amended claims, with an indication of the respective date(s) of the amendment.

United Kingdom

219. 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.

220. 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.¹⁶⁶ The observations must be made in writing, and can be filed on paper or electronically. They shall be supported by evidence wherever possible.

221. 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.

¹⁶⁴ Within three months following the publication of the report on prior art (search report), the applicant may express his desire that an examination as to sufficient description, novelty and inventive step will take place or that the grant procedure will continue without examination. In any case, where no preference has been expressed within those three months, the grant procedure will continue without the preliminary examination.

¹⁶⁵ The share of patent applications filed according to the general grant procedure (without preliminary examination), in which comments are submitted by third parties, is less than ten per cent.

¹⁶⁶ <http://www.ipo.gov.uk/types/patent/p-other/p-object/p-observation/p-observation-making.htm>.

United States of America

(i) Third party submission in published application

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

223. 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 submission shall not include any explanation of the patents or publications provided, or any other information. The USPTO will not enter such explanation or information if it is included in the submission under 37 C.F.R. § 1.99. 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.

224. 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.

225. The AIA amends the third party observation system, with effect on September 16, 2012. According to Section 8 of the AIA which amends 35 U.S.C. §122, the preissuance submission shall include a "concise description of the asserted relevance" of each document submitted and shall be submitted within an extended deadline, which is before the earlier of:

- (a) the mailing of a notice of allowance; or
- (b) the later of
 - (i) six months from the date of publication of the application; or
 - (ii) the date of the first rejection by the examiner.

226. The USPTO plans to permit third-party preissuance submissions to be filed via the Office electronic filing system (EFS) with an immediate electronic acknowledgement. Compliant preissuance submissions would be entered into the electronic image file wrapper (IFW). The USPTO plans to have examiners acknowledge, in the record of the patent application, the examiner's consideration of the document submitted.

227. Providing any preissuance submission at the earliest opportunity would be advantageous for the examiners to have the most relevant prior art before them prior to issuing the first Office action on the merits. The USPTO proposes to provide an exemption from the above mentioned fee where a preissuance submission by a third party lists three or fewer total documents, considering the benefits of such submission in assisting the examination process and the cost of

processing the submission. Another third party is not precluded from also taking advantage of the fee exemption, if those third parties are not in privity to each other.¹⁶⁷

(ii) *Protest under 37 C.F.R §1.291.*

228. In addition to the third party submission in respect of published applications, a protest under 37 C.F.R §1.291 may be filed by a member of the public against a pending application, to challenge the issuance of a patent from the application. In this case, the protester is entitled to provide written comments describing the relevance of publications or other information being submitted as prior art to the claims of the pending application of the patents. However, under 37 C.F.R. 1.291, the protest must be filed before the challenged pending application is published, or if the application is not published, before a Notice of Allowance is issued. Thus, a protest can only take place when the challenger has personal knowledge of the application being filed. The total number of protests filed from 1996 to 2011 is 127.¹⁶⁸

229. 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.¹⁶⁹ 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.¹⁷⁰ 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.

230. 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.

231. 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.¹⁷¹

European Patent Office (EPO)

232. 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 will not be a party to the proceedings before the EPO. No fee is required for the submission of observations.

¹⁶⁷ [USPTO, Federal Register / Vol. 77, No. 3 / Thursday, January 5, 2012 / Proposed Rules. P. 448 ff.](#)

¹⁶⁸ A breakdown of data by year is available in the Annex to this document.

¹⁶⁹ Information concerning the Peer Reviewed Prior Art Pilot is available at:
http://www.uspto.gov/patents/init_events/peerpriorartpilotindex.jsp

¹⁷⁰ <http://www.peertopatent.org/>

¹⁷¹ <http://www.uspto.gov/web/patents/peerpriorartpilot/p2ppie.pdf>

233. Such observations shall be filed in writing in an official language of the EPO, and state the grounds on which they are based.¹⁷² 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.¹⁷³

234. The observations made by a third party will be communicated to the applicant (or the patentee), who may comment on them.¹⁷⁴ 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.¹⁷⁵ 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.¹⁷⁶ Observations received after the conclusion of the proceedings will simply be added to the file.¹⁷⁷ 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.¹⁷⁸

235. In order to facilitate the filing of third party observations, the EPO has launched a pilot project. As of August 1, 2011, such observations can be filed by filling out an online form on the EPO website. The traditional means of filing (e.g. by letter or fax) will continue to be accepted.

C. ADMINISTRATIVE REVOCATION AND INVALIDATION MECHANISMS

(i) Rationale and objectives

236. The administrative revocation and invalidation mechanisms provide for an *inter partes* review of the validity of a patent which is not limited to a certain period after the grant of the patent. Even though the administrative review has quasi-judicial elements in some countries, the procedure is different from a judicial review, which is, in general, initiated only by interested parties, fully adversarial and entirely court-based. In many countries, similar to the opposition proceedings, any person can request an administrative review.

237. The rationale for an administrative review is similar to that of an opposition system. It aims at increasing the quality of patents by providing a simple and inexpensive alternative to litigation. It constitutes a forum outside of court, composed of a panel of experienced examiners and/or administrative judges, for reviewing the validity of the patent. It allows for reviewing the patent on grounds which might render a patent invalid, most importantly, non-compliance with the substantive patentability criteria. Mechanisms for administrative revocation and invalidation are conducted *inter partes*, similar to the opposition, but they are generally not time-bound. In several countries, an administrative review is also initiated and conducted *ex officio*.

238. While post-grant opposition systems provide third parties to challenge patents at the administrative level, since the opposition period is limited, there could be cases where third parties recognize the need to invalidate a patent only after the expiration of the opposition period. It is often the case where the technology surrounding a patented invention is developed and commercialized only some years after the grant of the patent, and at that point, the validity

¹⁷² Rule 114(1) of the Implementing Regulations under the EPC.

¹⁷³ EPO Examination Guidelines, Part E, VI.3.

¹⁷⁴ Rule 114(2) of the Implementing Regulations under the EPC.

¹⁷⁵ EPO Examination Guidelines, Part E, VI.3.

¹⁷⁶ *Ibid.*

¹⁷⁷ *Ibid.*

¹⁷⁸ *Ibid.*

of the patent will be examined by competitors. The administrative review provides for a longer or a second window for challenging patents for anyone. In some countries, the administrative revocation and invalidation is the only *inter partes* mechanism to challenge the validity of patents before an administrative body, such as in China, Japan, the Republic of Korea and the United Kingdom.

239. Among the countries that have an administrative review mechanism, the procedural and substantive requirements have some common aspects, but are different in detail. Such differences may include: (i) the possibility of *ex officio* proceedings; (ii) the onus of evidence for the person requesting the revocation; (iii) the grounds for revocation; (iv) the conduct of the review procedure; (v) whether a request for revocation/invalidation may be made after the expiry of the life time of the patent; (vi) the standard for providing evidence; and (vii) the composition of the reviewing board.

240. The following paragraphs illustrate existing administrative revocation or invalidation systems in a number of countries/regions.

(ii) National/Regional laws

China

241. China currently has a system of post-grant patent invalidation. According to Article 45 of the Chinese Patent Law,¹⁷⁹ beginning from the publication of the grant of the patent, a unit or individual may request that the patent review board declare the patent right invalid. According to Rule 64 of the Implementing Regulations of the Patent Law,¹⁸⁰ the requester shall submit a request including evidence related to the grounds of invalidation. The invalidation process is conducted *inter partes*. The Patent Review Board will send a copy of the request to the patentee and request him to present observations within a specified time. The patentee may amend the claims of the patent. The patent review board may decide, at the request of the parties or *ex officio*, to hold an oral hearing.

242. According to Article 46 of the Chinese Patent Act, a patent review board shall examine the request for declaring a patent right invalid and make a decision in a timely manner and notify the requesting person and the patentee of its decision. The patent review board consists of technical and legal experts appointed by the patent administration.¹⁸¹ The decision on declaring a patent right invalid shall be registered and announced by the patent administration.

243. Further, it is possible to appeal the decision of the board. A person who is dissatisfied with the patent review board's decision on declaring a patent invalid or its decision on affirming the patent may take legal action before the People's Court, within three months from the date of receipt of the notification. The People's Court shall notify the opposite party in the invalidation procedure to participate in the litigation as a third party. If the patent right has been declared invalid, it shall be considered non-existing from the beginning, but the decision shall not have retroactive effect on previous judgments.¹⁸²

¹⁷⁹ Patent Law of the People's Republic of China, 2008.

¹⁸⁰ Rules for the Implementation of the Patent Law of the People's Republic of China.

¹⁸¹ Rule 59 of the Implementation of the Patent Law.

¹⁸² Article 47 of the Chinese Patent Law.

Costa Rica

244. In addition to the opposition system, Article 21 of the Costa Rican Patent Law¹⁸³ provides the possibility of requesting the nullity of a patent already granted. 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 a patent, where it is demonstrated that the patent was granted in contravention of any of the patentability criteria as provided for in Articles 1 and 2 of the Costa Rican Patent Law. The request could be made by any person providing the full proof of the nullity considering all relevant elements. Invalidity could be declared at any time prior to expiry of the patent.

245. Once the request for nullity has been received, the patent owner shall be notified that he should take action in that regard within one month. 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. It is possible to appeal to the Administrative Registration Tribunal against that decision by raising grounds for revocation and/or appeal within a period of three and five days, respectively.

Japan

246. Article 123 of the Japan Patent Act¹⁸⁴ provides for the possibility to request¹⁸⁵ for a trial for patent invalidation before a Board of Appeal and Trials. Generally, any person can file such a request.¹⁸⁵ In case of two or more claims, a request for each claim has to be filed. The request can be filed at any time, even after the expiration of the patent term.¹⁸⁶ It can be based on any ground enumerated in Article 123(1) of the Japan Patent Act which renders the patent invalid. The requester will have to provide evidence that the patent is invalid. Decisions by the Board could be appealed to the Intellectual Property High Court.

247. The request for trial has to contain the facts on which the invalidation of the patent is based in specified concrete terms, and the relationship of each fact to be proved by the relevant evidence.¹⁸⁷ After filing the request, the chief trial examiner will submit a written request to the patentee and give him an opportunity to submit a written answer within a specified time limit. The chief trial examiner may question the parties with regard to the trial. The trial shall be conducted by a panel consisting of three or five trial examiners deciding by majority vote.¹⁸⁸ The examiner of the original patent shall be excluded from hearing the case as a trial examiner. Generally, the trial is conducted, according to Article 145 of the Japan Patent Act, by oral proceedings, but the chief trial examiner may, upon request or *ex officio*, decide to conduct the trial by documentary proceedings. Any person who is entitled to request a patent invalidation may intervene in existing invalidation proceedings. Evidence may be examined on request or *ex officio*. It is possible to extend the proceedings *ex officio* to any ground not pleaded by a party. If the patent is invalidated, it is considered *ex tunc* invalid. Once a final trial decision is registered, the party (and any other intervener) may not file a request for a trial on the same facts and evidence. Administrative trial proceedings may be suspended, if necessary, until the conclusion of the relevant court proceedings. Similarly, civil proceedings may be suspended, if necessary, during the trial for patent invalidation under certain circumstances.

¹⁸³ Costa Rican Patent Law, No. 6867.

¹⁸⁴ Japan Patent Act (Act No. 121 of April 13, 1959, as last amended by Act No. 63 of June 8, 2011).

¹⁸⁵ Exceptionally, only a person having the right to a patent may file a request for invalidation on some of the grounds relating to the entitlement to a patent.

¹⁸⁶ Article 123(3) of the Japan Patent Act.

¹⁸⁷ Article 131(2) of the Japan Patent Act.

¹⁸⁸ Article 136 of the Japan Patent Act.

Mexico

248. According to Section 78 of the Patent Law of Mexico¹⁸⁹ an action seeking invalidation could be based on the ground that the patent was granted in violation of the patentability criteria at any time. The declaration of invalidity shall be an administrative decision by the Institute, either *ex officio* or at the request of any third party or of the Federal Public Prosecutor, if the Federal Government has some interest in the case. The declaration of invalidity shall cancel the effects of the patent or registration concerned with retroactive effect to the filing date of the application.

Philippines

249. Section 61 of the Intellectual Property Code¹⁹⁰ provides for an administrative invalidation mechanism. Any interested person may, upon payment of the required fee, petition to cancel the patent or any claim thereof, or parts of the claim, on any of the following grounds: (i) what is claimed as the invention is not new or patentable; (ii) the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art; or (iii) the patent is contrary to public order or morality. The petition for cancellation shall be in writing, verified by the petitioner or by any person on his behalf who knows the facts, specify the grounds upon which it is based, include a statement of the facts to be relied upon, and filed with the Office. Copies of printed publications or of patents of other countries, and other supporting documents mentioned in the petition shall be attached.

250. Upon filing of a petition for cancellation, the Director of Legal Affairs shall notify the filing thereof to the patentee and all persons to whom licenses or any other right or title have been granted or who have interest in and to the patent and the invention covered thereby, as appears in the Office's record, and notify the date of hearing thereon on such persons and the petitioner. The notice of the filing of the petition shall be published in the IPO Gazette. In cases involving highly technical issues, on motion of any party, the Director of Legal Affairs may order that the petition be heard and decided by a Committee composed of the Director of Legal Affairs as chairman and two members who have the experience or expertise in the field of technology to which the patent sought to be cancelled relates.

251. If the Committee finds that a case for cancellation has been proved, the patent shall be invalidated or amended. The rights conferred by the patent or any specified claim or claims cancelled shall terminate. Notice of the cancellation shall be published in the IPO Gazette. Unless restrained by the Director General, the decision of invalidation may be immediately executed, despite any potentially pending appeal.¹⁹¹

Republic of Korea

252. The Republic of Korea provides for a quasi-judicial invalidation trial. The administrative review system is a part of the three instance procedure which consists of the Intellectual Property Tribunal (IPT) of the Korean Intellectual property Office (KIPO), composed of a president and administrative judges, the Patent Court and the Supreme Court. Its purpose is to promote and strengthen the protection of patents while guaranteeing fair and prompt settlements of patent-related disputes.

253. According to Article 133 of the Korean Patent Act, within three months after the publication of the granted patent, any person may request invalidation before the IPT. However, after the expiration of that period, only an interested party or an examiner may demand a review

¹⁸⁹ Industrial Property Law of June 25, 1991, as amended by the Decree of December 26, 1997.

¹⁹⁰ Intellectual Property Code of the Philippines of June 6, 1997, (Republic Act No. 8293).

¹⁹¹ Section 65 Intellectual Property Code of the Philippines.

to invalidate the patent. The grounds for invalidation of a patent are generally the same as the reasons for the rejection of a patent application covering, in particular, the substantive patentability criteria. If the patent contains two or more claims, a request for invalidation trial may be made for each claim.

254. A trial for invalidation of a patent may be demanded even after the expiration of the patent right. Where a trial decision invalidating a patent has become final and conclusive, the patent right shall be deemed never to have existed; however, where a patent is invalidated by any reason that has arisen after the grant of the patent, the patent right is deemed not to have existed from the time when such reason originated.

255. According to Article 146, the IPT is composed of a board of three or five administrative patent judges. The consultations of the board are not open to the public. The submission by the requester will be submitted to the defendant and the response will be submitted by the presiding administrative judge to the requester. If an administrative judge was an examiner who granted the patent, he/she shall be excluded from the trial.¹⁹² The trial proceedings could be oral or documentary. The oral proceedings are generally public. Evidence may be taken on the request of either party or *ex officio*. The trial decision applies to parties and non-parties alike, unless the final decision is a dismissal. During the trial proceedings, civil litigation must be stayed.¹⁹³

Russian Federation

256. According to Article 1398 of the Russian Civil Code,¹⁹⁴ any person can request, at any time during the life time of a patent, that the patent be recognized as invalid in full or in part on the following grounds: (i) failure to meet the patentability criteria; (ii) the claims of the granted patent feature elements which go beyond the original description or graphic representation of the invention; (iii) the grant of a patent in case of several applications for identical inventions having the same priority date; or (iv) the grant of a patent to a person who is not the inventor of the invention. Any legal entity or individual person may file a nullity action based on those grounds by the submission of an appeal to the Chamber for Patent Disputes. The petitioner does not need to show any particular legal interest in filing such a nullity action. There is no time limit for filing such a nullity action.

257. Recognition of a patent as invalid signifies the reversal of the decision of the federal executive authority on the grant of the patent for the invention and annulations of the record in the corresponding official register.

Slovakia

258. Slovakia provides for an administrative revocation. According to Article 46(1) of the Slovak Patent Act, the patent office shall revoke a patent on one of the grounds upon request by a third party or *ex officio*: (i) the substantive patentability criteria have not been met; (ii) the invention has not been fully disclosed and described so that it could be carried out by a person skilled in the art; (iii) the claims of the patent or a divisional application go beyond the original patent application; (iv) the scope of protection was expanded after the grant of the patent; (v) the owner is not entitled to a patent; or (vi) other requirements for the grant of a patent pursuant to the Regulations have not been met.

¹⁹² Article 148 of the Korean Patent Act.

¹⁹³ Article 164 of the Korean Patent Act.

¹⁹⁴ Civil Code of the Russian Federation (Part Four)

259. The patent could be amended or only partially revoked. If a patent has been revoked, it shall be considered *ex tunc* invalid within the scope of the revocation decision. The patent office may also revoke a patent after its lapse, if the requester proves a legal interest. According to Article 46(6) of the Slovak Patent Act, the patent office shall notify a decision of revocation or partial revocation in the Journal. The requester has to pay an administrative fee. The patentee is given the possibility to respond within a certain time limit and the Office could continue with the proceedings, in case of no response by the patentee, by making a decision on the basis of contents of a file. The Office shall deliver to the requester the response by the patentee. According to Article 47(5) of the Patent Act, if it is impossible to decide on the basis of the written filings of the parties, the Office shall determine a date for an oral hearing.

United Kingdom

260. While the United Kingdom provides no opposition system, it is possible for anyone to request revocation of a patent under Section 72 of the Patent Act 1977. Upon request of any person, the Comptroller may, by order, revoke a patent for an invention on any of the following grounds: (i) the invention is not a patentable invention; (ii) the patent was granted to a person who was not the only person entitled; (iii) the specification of the patent does not disclose the invention clearly and completely enough for it to be performed by a person skilled in the art; (iv) the matter disclosed in the specification of the patent extends beyond the original patent application as filed; and (v) the protection conferred by the patent has been extended by an amendment which should not have been allowed.

261. The quasi-judicial *inter partes* proceedings, which are conducted by a senior official, are very similar to post-grant opposition proceedings, but without any time limit for commencement.¹⁹⁵ The applicant has to make a written statement and the patentee is given the possibility to file a counterstatement. The Comptroller might revoke patents *ex officio*. The request can be made during the life time of the patent. According to Section 72(5), the decision of the Comptroller on the request for revocation has no estoppel effect. The revocation has an *ex tunc* effect.¹⁹⁶

VII. INTERFACE BETWEEN THE DIFFERENT MECHANISMS

A. RECENT REFORMS OF NATIONAL SYSTEMS

262. The national and regional opposition systems have seen many changes in recent years. Some of those changes in national legislation are further described below.

Japan, China and the Republic of Korea

263. The changes made to the Japanese opposition system during the past 15 years are interesting from a policy perspective. Prior to 1996, the Japan Patent Law provided a pre-grant opposition system which allowed the public to complement the examination by substantive examiners. However, concerns over delays in granting patents became stronger,¹⁹⁷ and in

¹⁹⁵ See document SCP/14/10, paragraph 201.

¹⁹⁶ UK IPO: Manual of Patent Practice, 72.03; available at: <http://www.ipo.gov.uk/p-manual-practice>.

¹⁹⁷ In connection with the Structural Impediments Initiative (SII) negotiated between the United States of America and Japan in late 1980s, the former argued that a great number of pre-grant oppositions filed by Japanese firms on the patent applications filed by US firms purposely delayed the grant of patents on US inventions, and thus unfairly benefitted the Japanese industry. Japan responded that its opposition system had not delayed the patent granting process, since among a small number of opposition cases, it was only in very exceptional cases where a great number of opposition requests had been filed on one application.

1996, the pre-grant opposition system was replaced by a post-grant opposition system. Consequently, two mechanisms to challenge the validity of granted patents coexisted in Japan, i.e., a post-grant opposition system and an administrative appeal for revocation of a patent. The post-grant opposition could be filed by anyone within six months from publication of the gazette containing the patent. However, the opponent could not fully participate in the review process, which was 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.¹⁹⁸ Therefore, the previous post-grant opposition system in Japan was conducted mostly *ex parte*.¹⁹⁹ On the other hand, the appeal for revocation of a patent, which was an *inter partes* procedure, could 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 capable of reviewing the validity of patents regardless of the status and outcome of the administrative appeal proceedings at the Japan Patent Office.²⁰⁰

264. 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 trial for invalidity or appeal for revocation. 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.²⁰¹

265. 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 patents. 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 filing 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 over-burdened the State Intellectual Property Office (SIPO). At present, the patent invalidation procedure is the only

¹⁹⁸ Goto A, Motohashi K. Construction of a Japanese Patent Database and a First Look at Japanese Patenting Activities. *Research Policy* 2007; 36:1431-42. The authors concludes that the change to the post-grant opposition system from the pre-grant opposition system resulted in the Japan Patent Office accelerating the granting of patents, and all pending patents under the old pre-grant opposition period prior to 1996 were processed in that year.

¹⁹⁹ 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.
²⁰⁰ Fujitsu v. Texas Instruments, 1998(O)No. 364, Supreme Court, April 11, 2000.

²⁰¹ While, at present, the academic research providing conclusive evidence on the role of the oppositions systems in enhancing innovation in Japan is scarce, one paper focusing on the topic of patents and incentive to innovate in Japan and the United States of America suggests that the Japanese first-to-file system as compared to the (soon-to-be-replaced) first-to-invent in the United States of America places more information in the public domain sooner, induces the filing of a patent application sooner in the innovation process; and that the opportunity for pre-grant opposition strengthens the incentives to monitor competitors' patent filings early on. (See Wesley Cohen et al., R&D and Spillover, Patents and the Incentives to Innovate in Japan and the United States, *Research Policy*, 31 (2002)).

mechanism available for challenging the validity of a patent.²⁰² However, it is possible to submit pre-issuance third party observations.

266. Similar experiences were had in the Republic of Korea. In order to ensure the prompt granting of a right, the pre-grant opposition system existing in the Republic of Korea was abolished and a post-grant opposition system was implemented. Since July 1, 2007, the only way to challenge a patent in the Republic of Korea is through invalidation proceedings. One particular feature of the Korean invalidation proceedings is that it integrated the post-grant opposition system into the invalidation procedure by allowing any third party to request invalidation within three months from the publication of the patent grant. After the expiration of that period, only interested parties can request invalidation. In order to reduce the time of patent prosecution, since 2006, it is possible to submit third party observations even before the publication of the patent application.

267. Although it may still be too early to draw any conclusions from the changes that took place in Japan, China and the Republic of Korea, and which were made within the specific contexts of these countries, it appears that designing a national opposition system is linked to the availability of other possibilities of reviewing the validity of patents. Other countries which abolished the pre-grant opposition system include the United Kingdom.

268. It may be worth considering that if more than one review mechanism exists in the national patent system, any additional mechanism should have additional benefits and not just be a duplication of existing processes. Otherwise, this could complicate the procedures, delay the process of delivering final administrative decisions and increase legal uncertainty.²⁰³

Australia

269. In Australia, the pre-grant opposition system is considered to have two objectives: to ensure that non-patentable inventions do not proceed to grant and to provide an alternative to revocation by a court. Several attempts have been made to move from a pre-grant to a post-grant opposition system, but these have failed due to the lack of evidence of beneficial effects from changing the system. One proposal in the Intellectual Property Laws Amendment Bill 2011 in subsection 60(3) was to reduce the standard of proof on all grounds in oppositions to the balance of probabilities. Some scholars have shown that evidence-based grounds for opposition are less likely to be successful in a pre-grant opposition than law-based grounds, such as errors in specification or claims.²⁰⁴ In addition, it has been proposed to increase the efficiency of the pre-grant opposition system by reducing delays. According to the cited scholars, the average period of time from the end of the pre-grant opposition period to the time on which the opposed patent is finally sealed is 2.4 years.²⁰⁵

The United States of America

270. The United States of America provides for a multiple system of administrative review and opposition. In 1980, the Congress enacted an *ex parte* re-examination procedure, by which a third party could seek re-examination of the patent. The legislature aimed at strengthening “investor confidence in the certainty of patent rights by creating a system of administrative reexamination of doubtful patents.” Re-examination was considered as an efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy

²⁰² Sun, Post-Grant Patent Invalidation in China and in the United States.

²⁰³ It has to been noted that the overall percentage of *inter partes* post-grant reviews (i.e. post-grant opposition and trial for invalidity) has dropped in Japan after the abolishment of the post-grant opposition, while it has been stable in China. See WIPO World Indicators 2011, Figure A.10.1.

²⁰⁴ Weatherall [et al.] Patent Opposition in Australia the Facts (2011), 93, 106, 119.

²⁰⁵ Ibid.

infringement litigation.²⁰⁶ Although re-examination is designed as a quality check conducted by the Office, some authors have argued that due to the *ex parte* nature of the process, allowing only the patentee's involvement, it was of limited use by challengers.²⁰⁷

271. In 1999, the Congress created an *inter partes* re-examination system in the American Inventors Protection Act of 1999. It is limited to certain grounds raising substantial new questions of patentability. Further, it has estoppel creating effect as requesters were not able to challenge, in any later civil action, any fact determined during the process of the optional re-examination procedure.²⁰⁸ The original limitation of the appeal against the re-examination decision to the patentee was later extended in 2002 to third parties.²⁰⁹

272. The AIA 2011 revised and expanded the opposition procedures. The Act retains the existing *ex parte* reexamination, adds some elements in the pre-issuance submissions by third parties, expands *inter partes* re-examination and renames it "*inter partes* review", and adds a post-grant review.²¹⁰

273. The new possibility for post-grant review aims at increasing the quality of patents by allowing for a new administrative post-grant review similar to the so-called "opposition systems" *stricto sensu*. Those amendments had been proposed by the National Academies of Science (NAS) and the Federal Trade Commission (FTC) in order to provide earlier, quicker and less costly routes to challenge patents.²¹¹ The AIA makes the system for opposition in the United States of America multi-faceted and unique. In sum, the US system provides for third party observations, two different possibilities of *inter partes* post-grant review and an *ex parte* re-examination.

Re-examination in Denmark and Norway

274. In Norway, an administrative re-examination system was introduced in 2008 in order to offer a less costly, simplified and quicker alternative to court proceedings for those who want to challenge patents after the expiry of the opposition period.²¹² The Danish re-examination system, which was introduced into the Danish Patent Law in 1993, provides for a similar administrative re-examination mechanism.

275. At first glance, the re-examination system available in Denmark and Norway may resemble the *inter partes* review newly introduced in the United States of America, in the sense that both are *inter partes* procedures available after the expiration of an opposition period (or the period for the post-grant review in the United States of America). However, the objective and the role of the re-examination in Denmark and Norway should be considered in the context of the patent system in Europe where national patent systems and a regional patent system under the European Patent Convention (EPC) co-exist. In Europe, with respect to European patents granted by the EPO, if no opposition is filed within nine months from the date of issuance of the European patent, the only way to invalidate that patent is to challenge its validity in the court of each EPC Member State, which could be a long, expensive process. In addition, not all courts

²⁰⁶ 20 House Report No. 96-1307, 96th Cong., 2d Sess. (1980).

²⁰⁷ Carrier, Post-Grant opposition: A proposal and a comparison to the America Invents Act, 2009.

²⁰⁸ USPTO: Summary, American Inventors Protection Act, available at:

<http://www.uspto.gov/patents/law/aipa/summary.jsp>

²⁰⁹ 35 U.S.C. § 315, 21st Century Department of Justice Appropriations Authorization Act, Public Law 107-273, 107th Congress, November 2, 2002.

²¹⁰ Document SCP/17/13 Prov. 77; see, Toshiko Takenaka, Harmony with the rest of the world? The America Invents Act, *Journal of Intellectual Property Law & Practice*, 2012, Vol. 7, No.1, p. 4 ff. (2012).

²¹¹ Federal Trade Commission Report 2003, Recommendation 1; USPTO, The 21st Century Strategic Plan.

²¹² See document SCP/17/13, para. 69.

of Member States may be equipped by judges specialized in patent law and technically qualified. The re-examination proceedings in Denmark (and Norway) are available for both Danish (and Norwegian) national patents and the European patents validated in Denmark (and Norway). The re-examination proceedings therefore offer an opportunity for the assessment of the validity of a European patent by a patent examiner of those countries, and can be used for testing the validity of the patent with a view to subsequent court proceedings in other EPC Member States.²¹³

B. COMBINATION OF VARIOUS MECHANISMS

276. Annex II to this document provides a summary table of selected countries that provide third party observations, opposition systems and/or other administrative revocation and invalidation mechanisms under the respective national laws. Since the different types of national mechanisms are not always easy to classify within the given categories (see the example of the Republic of Korea, below), the solution presented here should be considered as a rough approximation of categories. From the limited number of countries listed in Annex II, the following points can be summarized:

- (i) Among the countries listed in Annex II, most national laws provide at least one pre-grant mechanism and at least one post-grant mechanism that allow third parties to contribute with their prior art knowledge in granting/revocation procedures.
- (ii) No country provides all administrative mechanisms identified in this document. In other words, there appears to be a choice by each national government as to which administrative mechanisms are provided in the national context.
- (iii) At the pre-grant stage, the (*ex parte*) third party observations are widely used by many offices. Considering that *inter partes* pre-grant opposition after the publication of applications (and before substantive examination) also has the function of assisting examiners with prior art information submitted by third parties, it seems that, at the pre-grant stage, many offices prefer utilizing third parties' prior art knowledge as an additional information source for examiner's substantive examination.
- (iv) At the post-grant stage, many offices predominantly use *inter partes* procedures (except Australia), which allow a thorough review of patent granting decisions by fully involving both the patentee and the third party in the proceedings.
- (v) National offices utilize a number of different combination of mechanisms during the post-grant stage, sometimes combining *inter partes* procedures with an *ex parte* mechanism.

Some countries introduce various types of opportunities for third parties to challenge the validity of patents post-grant, some of which may not readily fit into the given categories. For example, in the Republic of Korea, the administrative revocation system can be considered as a hybrid system with post-grant opposition, since during the period of three years from the grant of the patent, any third party may request an administrative revocation before the IP Tribunal. In Spain, according to Section 47 of the Spanish Law on Patents, an appeal against the decision to grant the patent may be filed, within one month from the publication

²¹³ Susanne Høiberg and Louise Aagaard, Re-examination: a convenient tool for testing patent validity, Building and enforcing intellectual property value 2011, AIM

of the grant of the patent, with the Spanish Patent and Trademark Office. In the general procedure (without substantive examination), it's possible to file an appeal against the granting of the patent only regarding formality aspects. However, in the procedure with substantive examination, an appeal may be filed on the grounds of lack of novelty and inventive step and other substantive issues. In the latter case, the effect of the appeal may be considered similar to that of post-grant oppositions, although the appeal can only be filed by an interested party.

277. Beyond the above general observations, the cost and benefit of the various combinations of the different mechanisms of third party observations, oppositions, re-examination and administrative revocation and invalidation can be analyzed only in the context of a given country. The different mechanisms have to be seen in the national context as a whole, and must take into account its historical evolution. Nevertheless, the various combinations of the different mechanisms that have been adopted and developed at the national level intend to set up a legal framework that ensure: (i) the submission of prior art knowledge by third parties; and (ii) the provision of alternative administrative mechanisms to litigation, so that patents are granted only on inventions that meet the patentability requirements. In particular, the first element is often found in the pre-grant stage as a way to assist the patent office examination, and the second element is often provided in the post-grant stage so that the administration has an opportunity to review its decision through *inter partes* proceedings.

278. While analyzing which combination of various mechanisms is the most successful model in a given country would be interesting, it is probably very difficult to quantitatively measure the full effects of the various models. A simple increase or decrease in the number of oppositions filed would not be an appropriate indicator for measuring the success of such mechanism. Regular feedback from stakeholders on the effectiveness of the mechanisms applied may provide useful information about the efficiency of the system in the country.

279. The primary purpose of the opposition systems and other related mechanisms is to ensure that patents are granted only on inventions that meet the patentability requirements. To that end, the participation of third parties in the granting procedures and/or in the administrative revocation is encouraged by a low level of fees (or no fee at all), simplified formalities and the fact that any person may challenge the validity of patents. On the other hand, the national statistics show that the number of oppositions and other administrative revocations is relatively low. Similarly, even if third parties may file prior art information free of charge in many countries, the number of such prior art submissions is not particularly high. It appears that many third parties may be motivated to revoke a patent only where that patent has a potential negative impact on their business.

280. It is assumed that the value of the various combination of mechanisms that contribute to improve the quality of granted patents lies in the availability of those complementary mechanisms for third parties. While there is no doubt that the quality of granted patents continues to be primarily determined by the accuracy and efficiency of the substantive examination conducted by the patent office, the mere fact that many national laws provide those complementary tools demonstrates their general usefulness.

[Annex I follows]

STATISTICS ON OPPOSITIONS

AUSTRALIA

	2006/07	2007/08	2008/09	2009/10	2010/11
Re-examination ¹	5	11	18	15	22
Opposition ²	130	109	167	120	143
Applications Filed ³	27594	27979	26259	25443	26473

¹ The re-examination number is third-party requested re-examination only. It does not include re-examinations that are initiated by the Commissioner in other circumstances.

² The oppositions numbers relate to Section 59 oppositions only.

³ The applications filed number does not include provisional filings, but does include both innovation and standard patent applications.

COSTA RICA

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

FINLAND

(a) Number of granted patents against which an opposition has been filed in 2006-2010

Year	Number of opposed patents	Number of oppositions filed
2006	29	31
2007	20	21
2008	18	21
2009	24	26
2010	20	23

(b) Decisions taken in oppositions filed in 2006-2010

Year*	Rejection of the opposition	Maintenance in amended form	Revocation of the patent
2006	13	3	10
2007	9	4	5
2008	8	1	6
2009	5	2	4
2010	1	1	0

* Refers to the year in which the opposition has been filed, not to the year in which the decision has been taken.

GEORGIA

- 6814 – Satisfied appeal concerning invention of semi - rigid collapsible container;
- 8520 – The appeal was dismissed;
- 9438/01 – Proceedings are terminated;
- 8690 – Rejected the appeal;
- 9792 (keyboard) – Refused the appeal concerning the invention of;
- 9985 (non - peptide bradykin antagonist and their pharmaceutical compositions) – the appeal was upheld;
- 9635 (method of granulation) – the appeal was refused;
- 10640 (helicopter main motor aerodynamic aerofoil) – refused the appeal;
- 106041 (accumulation) – the appeal was rejected.

GERMANY

- 665 oppositions were filed in 2010.
- Opposition proceedings conducted in 2010 were concluded as follows:
 - 75 cases by the abandonment of the patents by the patent owner;
 - 87 cases by the abandonment of the patents by non-payment of annual fee;
 - 278 cases by the revocation of the patents;
 - 538 cases by the decisions to maintain the patents in full or in part.
- Patent owners lodged appeal against the revocation of their patents in 61 cases.
- In 123 cases, appeal was lodged against the decisions of the DPMA to maintain the patents in full or in part.

PAKISTAN

S. No	Year	Accepted cases	Opposition received	Area of Technology	Rate of opposition
1	2007	115	33	Pharma	32.63%
2	2008	577	199		
3	2009	501	246		
4	2010	667	129		

REPUBLIC OF KOREA

Number of invalidation / Number of invalidation trial (Invalidation rate)

	<u>2005</u>	<u>2006</u>	<u>2007</u>	<u>2008</u>	<u>2009</u>	<u>2010</u>
<u>Patent</u>	<u>221/438</u>	<u>228/454</u>	<u>359/623</u>	<u>360/615</u>	<u>318/529</u>	<u>336/633</u>
	<u>50.5%</u>	<u>50.2%</u>	<u>57.6%</u>	<u>58.5%</u>	<u>60.1%</u>	<u>53.1%</u>
<u>Utility model</u>	<u>50.1%</u>	<u>59.4%</u>	<u>53.7%</u>	<u>56.8%</u>	<u>62.9%</u>	<u>62.5%</u>
	<u>202/403</u>	<u>148/249</u>	<u>160/298</u>	<u>134/236</u>	<u>110/175</u>	<u>85/136</u>

PORTUGAL

Number of oppositions filed at the Portuguese Institute of Industrial Property since the year 2005. Please notice that these oppositions concern patent applications and also utility model applications.

Year	Number of Oppositions
2005	4
2006	6
2007	3
2008	2
2009	2
2010	8
2011	4
Total	29

SLOVAKIA

Year	2006	2007	2008	2009	2010
Number of published applications	231	167	181	179	153
Number of filed pre-grant opposition <u>third party observations</u>	2	3	3	4	5
<u>Number of administrative revocations filed</u>	<u>2</u>	<u>3</u>	<u>9</u>	<u>3</u>	<u>5</u>
<u>Number of administrative revocations decided</u>	<u>2</u>	<u>3</u>	<u>3</u>	<u>3</u>	<u>6</u>

SWEDEN

Year	2005	2006	2007	2008	2009	2010
Oppositions filed	57	42	30	26	31	33
Objection revoked	16	13	17	17	16	15
Patents maintained as amended	9	6	11	13	12	9
Revoked patents	6	20	20	11	17	8

UNITED STATES OF AMERICA

(a) Statistical data on the performance of the USPTO reexamination program

Inter Partes Reexamination Filing Data – June 30, 2011

1. Total requests filed since start of *inter partes* reexam on 11/29/991286²¹⁴
2. Number of filings by discipline
 - a. Chemical Operation 224 17%
 - b. Electrical Operation 676 53%
 - c. Mechanical Operation 371 29%
 - d. Design Patents 15 1%
3. Annual Reexam Filings

Fiscal Yr.	No.	Fiscal Yr.	No.	Fiscal Yr.	No.	Fiscal Yr.	No.
2000	0	2003	21	2006	70	2009	258
2001	1	2004	27	2007	126	2010	281
2002	4	2005	59	2008	168	2011 YTD	271
4. Number known to be in litigation.....910 71%
5. Decisions on requests 1155
 - a. No. granted.....1099 95%
 - (1) By examiner 1092
 - (2) By Director (on petition) 7
 - b. No. not granted.....53 5%
 - (1) By examiner 48
 - (2) Reexam vacated 5
6. Overall reexamination pendency (Filing date to certificate issue date)
 - a. Average pendency 36.6 (mos.)
 - b. Median pendency 33.0 (mos.)
7. Total *inter partes* reexamination certificates issued (1999 – present)..... 278
 - a. Certificates with all claims confirmed 35 13%
 - b. Certificates with all claims cancelled (or disclaimed) 123 44%
 - c. Certificates with claims changes 120 43%

²¹⁴ Of the requests received in FY 2011, 3 requests have not yet been accorded a filing date, and 5 requests have had preprocessing terminated, for failure to comply with the requirements of 37 CFR 1.915. See Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).

Ex Parte Reexamination Filing Data – June 30, 2011

1. Total requests filed since start of *ex parte* reexam on 07/01/8111604²¹⁵
 - a. By patent owner 3761 33%
 - b. By other member of public 7677 66%
 - c. By order of Commissioner 166 1%

2. Number of filings by discipline
 - a. Chemical Operation 3180 27%
 - b. Electrical Operation 4323 37%
 - c. Mechanical Operation 3922 34%
 - d. Design Patents 179 2%

3. Annual *Ex Parte* Reexam Filings

Fiscal Yr.	No.	Fiscal Yr.	No.	Fiscal Yr.	No.	Fiscal Yr.	No.
1981	78 (3 mos.)	1989	243	1997	376	2005	524
1982	187	1990	297	1998	350	2006	511
1983	186	1991	307	1999	385	2007	643
1984	189	1992	392	2000	318	2008	680
1985	230	1993	359	2001	296	2009	658
1986	232	1994	379	2002	272	2010	780
1987	240	1995	392	2003	392	2011 YTD	581
1988	268	1996	418	2004	441		

4. Number known to be in litigation3823 33%

5. Decisions on requests 11095
 - a. No. granted10182 92%
 - (1) By examiner 10064
 - (2) By Director (on petition) 118
 - b. No. denied9138%
 - (1) By examiner 878
 - (2) Reexam vacated 35

6. Total examiner denials (includes denials reversed by Director) 996
 - a. Patent owner requester 468 48%
 - b. Third party requested 528 52%

7. Overall reexamination pendency (Filing date to certificate issued date)
 - a. Average pendency 25.7 (mos.)

²¹⁵ Of the requests received in FY 2011, 6 requests have not yet been accorded a filing date, and preprocessing of 33 requests was terminated for failure to comply with the requirements of 37 CFR 1.510. See Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).

b. Meridian pendency 20.0 (mos.)

8. Reexam certificate analysis

	Owner Requester	3 rd Party Requester	Comm'r Initiated	Overall
a. All claims confirmed	21%	24%	11%	23%
b. All claims cancelled	9%	13%	23%	11%
c. Claims changes	70%	63%	66%	66%

9. Total *ex parte* reexamination certificates issued (1981 – present) 8375

a. Certificates with all claims confirmed	1913	23%
b. Certificates with all claims cancelled	960	11%
c. Certificates with claims changes	5502	66%

10. Reexam claim analysis – requester is patent owner or 3rd party or Commissioner initiated

a. Certificates – PATENT OWNER REQUESTER 3026

(1) All claims confirmed	646	21%
(2) All claims cancelled	264	9%
(3) Claim changes	2116	70%

b. Certificates – 3rd PARTY REQUESTER 5192

(1) All claims confirmed	1249	24%
(2) All claims cancelled	660	13%
(3) Claim changes	3283	63%

c. Certificates – COMMISSIONER INITIATED REEXAM 157

(1) All claims confirmed	18	11%
(2) All claims cancelled	36	23%
(3) Claim changes	103	66%

(b) Statistical data on the number of filed protests for the years 1996-2011

FY	Description	Entries
2011	Protest - 3rd Party (before publication or with applicant's consent)	4
2010	Protest - 3rd Party (before publication or with applicant's consent)	6
2009	Protest - 3rd Party (before publication or with applicant's consent)	13
2008	Protest - 3rd Party (before publication or with applicant's consent)	5
2007	Protest - 3rd Party (before publication or with applicant's consent)	7

FY	Description	Entries
2006	Protest - 3rd Party (before publication or with applicant's consent)	6
2005	Protest - 3rd Party (before publication or with applicant's consent)	12
2004	Protest - 3rd Party (before publication or with applicant's consent)	31
2003	Protest - 3rd Party (before publication or with applicant's consent)	5
2001	Protest - 3rd Party (before publication or with applicant's consent)	2
2000	Protest - 3rd Party (before publication or with applicant's consent)	5
1999	Protest - 3rd Party (before publication or with applicant's consent)	7
1998	Protest - 3rd Party (before publication or with applicant's consent)	4
1997	Protest - 3rd Party (before publication or with applicant's consent)	9
1996	Protest - 3rd Party (before publication or with applicant's consent)	11

EUROPEAN PATENT OFFICE (EPO)

Year	2008	2009	2010
No. of oppositions filed against European patents granted	2800	2700	2770
No. of decisions in opposition cases which took effect	1980	2310	2310
Opposition rate: %	5.32%	4.7%	5.2%

Outcome of Opposition cases: 2010

Rejection of oppositions	29%
Revocation of the patent	33%
Maintenance in amended form	38%

[\[Annex II follows\]](#)

COMPILATION OF DIFFERENT OPPOSITION SYSTEMS AND RELATED MECHANISMS

<u>Country</u>	<u>Third Party Observation and Protest</u>	<u>Pre-grant Opposition</u>	<u>Post-grant Opposition</u>	<u>Re-examination (ex-parte)</u>	<u>Re-examination (inter partes)</u>	<u>Administrative revocation and invalidation</u>
<u>Australia</u>	√	√		√		
<u>Brazil</u>			√			
<u>China before 1992</u>		√				√
<u>China 1992-2000</u>			√			√
<u>China since 2000</u>	√					√
<u>Costa Rica</u>		√				√
<u>Denmark</u>	√		√		√	
<u>Egypt</u>		√				
<u>Finland</u>	√		√			
<u>Germany</u>			√			
<u>Honduras</u>		√				
<u>India</u>		√	√			
<u>Japan before 1996</u>		√				√
<u>Japan 1996-2004</u>			√			√
<u>Japan since 2004</u>	√					√
<u>Mexico since 2010</u>	√					√
<u>Norway before 2008</u>	√		√			
<u>Norway since 2008</u>	√		√		√	

<u>Country</u>	<u>Third Party Observation and Protest</u>	<u>Pre-grant Opposition</u>	<u>Post-grant Opposition</u>	<u>Re-examination (ex-parte)</u>	<u>Re-examination (inter partes)</u>	<u>Administrative revocation and invalidation</u>
<u>Pakistan</u>	√	√	√			
<u>Philippines</u>	√					√
<u>Portugal</u>		√				
<u>Republic of Moldova</u>			√			
<u>Republic of Korea</u>	√					√
<u>Russian Federation</u>	√					√
<u>Slovakia</u>	√					√
<u>Spain</u>	√	√				
<u>Sweden</u>			√			
<u>United Kingdom</u>	√					√
<u>United States of America</u>	√			√	√ (<i>inter partes re-examination</i>)	
<u>United States of America after Sept. 16, 2012</u>	√		√	√	√ (<i>inter partes review</i>)	
<u>EAPO</u>			√			
<u>EPO</u>	√		√			
<u>PCT (2012)</u>	√					

[End of Annex II and of document]