

QUESTION 99

Participation of third parties in the patent granting and amendment procedures

Yearbook 1991/I, pages 291 - 294

Q99

Executive Committee of Barcelona, September 30 - October 5, 1990

Question Q99

Intervention of third parties in the patent granting and amendment procedures

Resolution

The Executive Committee of AIPPI, meeting in Barcelona on September 30-October 5, 1990, taking into account the drafts of the Harmonization Treaty under discussion at the WIPO, in particular Articles 17 and 18 of document HL/CE/VIII/3, and the resolutions of the Amsterdam Congress in 1989 in the frame of the study of Question 89, has adopted the following resolution:

I. Intervention of third parties in the pre-grant and post-grant proceedings of patents

Considering that the Offices in charge of the examination of patent applications, cannot have at their disposal all the pertinent elements for determining patentability, and whereas, in the public interest, only valid patents which are well defined relative to the state of the art should be issued;

Considering that, in the countries which do not provide for a substantive examination, it is also in the interest of the public to be informed of the existence of factors which may call into question the validity of a patent;

1.1 AIPPI is favourable to the intervention of third parties in the patent pre-grant and post-grant proceedings:

In the case of opposition proceedings AIPPI recommends:

- the establishment of a system providing for opposition by third parties after grant in those countries having substantive examination,

- the replacement, after a possible transitional period, of a pre-grant opposition system with a post-grant opposition system in those countries now having a pre-grant opposition system,

In the case of countries with or without substantive examination, AIPPI recommends:

- providing the possibility for third parties to file observations after publication of the patent application or of the patent;
- in countries with substantive examination, the third party submitting the observations shall be informed by the Office about its action taken.

1.2 As Concerns the practice of the post-grant opposition proceedings, AIPPI recommends that:

- an opposition period be fixed, and that this period be not less than 6 months, and not more than 9 months, after publication of the patent grant,
- the opposition grounds be limited to substantive grounds, and exclude formal grounds, the latter including the lack of unity of invention,
- the opposition grounds should extend to all requirements of patentability, and not only to the lack of novelty or inventive step (non-obviousness) resulting from printed publications,
- during the course of opposition proceedings, the opponent and the owner of the patent should be able to present, at least in written form, their arguments, before the Office in charge of the opposition proceedings.

1.3 In the case of countries having re-examination proceedings which can be initiated by a third party throughout the life of the patent, AIPPI is of the opinion that it is not desirable to cumulate the opposition proceedings, as defined hereinabove, with such re-examination proceedings due to the increased insecurity this would bring to the patentee.

In any event, in most countries the third party has the right to contest the validity of the patent before a Court.

AIPPI recognizes that national legislation may authorize a Court to ask the Patent Office which conducts substantive examination, for its opinion on the validity of the patent if it is contested by a third party.

1.4 In countries with substantive examination and which authorize the owner of the patent to request re-examination of his patent after grant, AIPPI recommends that:

- the Office in charge of the re-examination take the necessary steps to inform the public that such re-examination has been requested by the patentee,

- a period be fixed for enabling third parties at least to present observations on the pertinence of the grounds for re-examination;
- the period should be three months from the date of publication of the re-examination request,
- the Office informs the public of the result of the re-examination, and allow the public to have full access to the re-examination file.

1.5 In countries without substantive examination and in the absence of opposition proceedings, AIPPI recommends that:

- a period be fixed after the publication of the patent application or of the patent for allowing third parties to present observations on patentability,
- this period be of the same duration as the one foreseen in the case of opposition, namely between 6 and 9 months,
- the observations may cover grounds identical to those set out hereinabove for opposition proceedings,
- the Patent Office concerned should take the necessary steps to inform the public that observations have been filed and to grant the public full access to the file.

II. Intervention of third parties in the proceedings for changes in patents

Insofar as the owner of a patent is authorized to ask for changes to his granted patent (as in reissue proceedings), AIPPI recommends that third parties should be authorized at least to present observations during such proceedings and that the Patent Office should inform the public of the request for any such changes and publish the same.

Appendix to Q 99 Resolution

According to Q 99 Resolution, the opinion of AIPPI on the present wording of the Draft Treaty on the Harmonisation of Patent Laws (document HL/CE/VIII/3) can be summarized as follows:

(i) Article 18 does not take sufficiently into consideration the right of third parties to intervene in the pre-grant and post-grant proceedings of patents. Indeed, the provisions of this Article only concern countries having substantive examination.

In the case of countries both with and without substantive examination AIPPI also recommends to authorize third parties to file observations after the publication of the patent application or of the patent.

(ii) As far as opposition proceedings in countries with substantive examination are concerned, AIPPI generally approves the principle of the post-grant revocation system as provided for in Article 18 paragraph 1 sub-paragraphs (a), (b), (c) and paragraph (2), except that AIPPI recommends the adoption of a more extensive definition of the opposition grounds, namely an explicit statement that opposition can cover all substantive requirements of patentability.

(iii) Although the present draft of Article 18 does not deal with re-examination, the provisions of paragraphs I-1.3 and I-1.4 of Q 99 Resolution should be of interest if the situation of countries having such a re-examination system is the subject of further discussions during the next session of the Committee of Experts in October 1990 and / or the Diplomatic Conference contemplated for June 1991.

(iv) It should be appropriate to suggest adding to Article 18 a new paragraph (3) in accordance with the provisions of paragraph I-1.5 of Q 99 Resolution, so that the public would be informed of factors which may call into question the validity of the patent in countries which do not provide for a substantive examination.

(v) Article 17 (Changes in Patents) has already been discussed during the June 1990 session of the Committee of Experts and its wording will most probably be further amended.

As it presently stands, the text of this article does not provide for any form of intervention of third parties if the owner of a patent asks for changes after the grant of the patent. Paragraph(4) only states that the changes be published after study by the office.

According to paragraph II of Q 99 Resolution AIPPI recommends that more attention be paid to third parties and to the public interest in proceedings for amending a patent after grant.

* * * * *